

**IN THE HEARINGS AND MEDIATION DEPARTMENT OF
THE INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
REPUBLIC OF SINGAPORE**

Trade Mark No. 40201804512R
9 June 2020

IN THE MATTER OF A TRADE MARK APPLICATION BY

POINT TEC PRODUCTS ELECTRONICS GMBH

AND

OPPOSITION THERETO BY

**COMPAGNIE DES MONTRES LONGINES, FRANCILLON S.A. (LONGINES
WATCH CO., FRANCILLON LTD.)**

Hearing Officer: Ms Sandy Widjaja
Principal Assistant Registrar of Trade Marks

Representation:

Mr Chua Shangli (Donaldson & Burkinshaw LLP) for the Opponent (written submissions
only)

Ms Ruby Tham (Drew & Napier LLC) for the Applicant

GROUND OF DECISION

- 1 Take flight. Or not.
- 2 In this dispute, the subject mark, 40201804512R ("*Application Mark*"):



is sought to be registered for “Watches and chronometric instruments” in Class 14 by POINT tec Products Electronic GmbH (the “*Applicant*”).

3 The *Application Mark* was accepted and published on 20 July 2018 for opposition purposes. Compagnie Des Montres Longines, Francillon S.A. (Longines Watch Co., Francillon Ltd.) (the “*Opponent*”) filed its Amended Notice of Opposition¹ to oppose the registration of the *Application Mark* on 19 September 2018. The matter was originally set down for a hearing on 7 April 2020. However, due to the COVID 19 situation, the oral hearing was heard on 9 June 2020 via zoom.² In addition, the *Opponent* also informed the Registrar, via its letter dated 7 April 2020 that it will only rely on written submissions and will not appear for the oral hearing.³

Grounds of Opposition

4 The *Opponent* relies on sections 8(2)(b), 8(4)(b)(i)⁴ and 8(7)(a) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“Act”) in this opposition.

Evidence and written submissions

5 The evidence comprises the statutory declarations of:

- (i) Mr Walter Von Kanel, President of the *Opponent*, dated 19 June 2019 (“*Opponent’s 1st SD*”);
- (ii) Mr Walter Von Kanel, President of the *Opponent*, dated 23 December 2019 (“*Opponent’s 2nd SD*”);
- (iii) Ms Nathalie Birk, Chief Operating Office of the *Applicant*, dated 5 November 2019 (“*Applicant’s SD*”).

6 Parties submitted the following written submissions:

- (i) *Opponent’s* written submissions dated 6 March 2020 (“*OWS*”); and
- (ii) *Applicant’s* written submissions dated 9 March 2020 (“*AWS*”).

¹ The original Notice of Opposition was filed on 6 September 2018. The Amended Notice of Opposition was made to input the correct trade mark number which is relied on as an earlier mark.

² See IPOS letter of 2 June 2020.


³ This was in response to the Registrar’s letter of 31 March 2020, where he queried if parties wish to proceed based on written submissions only in light of COVID 19. In contrast, the *Applicant* opted for an oral hearing (*Applicant’s* letter of 7 April 2020). The *Opponent* maintained its position to only proceed based on written submissions despite the *Applicant’s* decision to proceed with oral submissions (see the Notice of Hearing dated 8 April 2020 and the *Opponent’s* responses of 22 April 2020).

⁴ The *Opponent* dropped the ground of opposition under section 8(4)(b)(ii) during the Pre-Hearing Review on 4 February 2020.

Applicable Law and Burden of Proof

7 As the applicable law is the Act, there is no overall onus on the *Applicant* either before the Registrar or in opposition proceedings. The undisputed burden of proof in the present case falls on the *Opponent*.


Background

8 The *Opponent* deposed that it has used  logo since 1867 and the signature hourglass logo has been registered in Switzerland since 1889, holding the record for the oldest registered trade mark in the world.⁵ The *Opponent* deposed that it is a renowned market leader for the manufacture and retail of watches and is synonymous with high end luxury and style.⁶ The Longines brand, including its hourglass logo,



is used by the *Opponent* on its products globally, including in Singapore.⁷ The *Opponent*'s products are sold in Singapore at official Longines boutiques and retailers, including a flagship store, as well as through its e-commerce platform.⁸

9 The *Opponent* relies on its following earlier registered marks (collectively, the *Opponent's Earlier Marks*)⁹ in these proceedings:

S/N	<i>Opponent's Earlier Marks</i>	Class
1		Class 14 Precious metals and their alloys and goods made of these materials or coated therewith included in this class, namely figurines, trophies; jewelry, namely rings, earrings, cuff links, bracelets, charms, brooches, chains, necklaces, tie pins, tie clips, jewelry caskets (cases), cases; precious stones, semi-precious stones; timepieces and chronometric instruments namely chronometers, chronographs, clocks, watches, wristwatches, wall clocks, alarm clocks as well as parts and accessories for the aforesaid goods namely hands, anchors, pendulums, barrels, watch cases, watch straps, watch dials, clockworks, watch chains, movements for timepieces, watch springs, watch glasses,
	T1315264Z	


⁵ *Opponent's 1st SD* at [4].

⁶ *Opponent's 1st SD* at [4].

⁷ *Opponent's 1st SD* at [4].

⁸ *Opponent's 1st SD* at [4].

⁹ At [6] *OWS*.

S/N	Opponent's Earlier Marks	Class
		presentation cases for timepieces, cases for timepieces.
2		Class 14 Watches, clocks, pendulum, chronometers, their parts and fittings, jewelled-watches, watch-straps made in precious metal, articles of jewellery.
	T7669349D	

10 The *Applicant* deposed that it was founded in 1987 and is one of the largest watch manufacturers in Germany.¹⁰ The *Applicant* deposed that its history is inextricably linked to aviation inspired watches also known as pilot watches.¹¹ The *Applicant*'s watches draw heavily on the design characteristics of pilot watches while staying true to the high quality standards of German watchmaking and the Bauhaus design movement.¹² The Bauhaus movement is a German modernist movement in the arts as well as design.¹³ Bauhaus design is characterised by simplified forms and a focus on functionality.¹⁴ The use of simple linear and geometrical forms is preferred over complex curvilinear or floral forms.¹⁵

MAIN DECISION

Ground of Opposition under Section 8(2)(b)

11 Section 8(2)(b) provides:

8(2) A trade mark shall not be registered if because...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public.

Decision on Section 8(2)(b)

Step-by-step approach

12 In *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 ("*Staywell*"), the Court of Appeal re-affirmed the 3-step test approach in relation to an objection under section 8(2)(b).¹⁶

¹⁰ *Applicant's SD* at [5].

¹¹ *Applicant's SD* at [6].

¹² *Applicant's SD* at [8].

¹³ *Supra.*

¹⁴ *Supra.*

¹⁵ *Supra.*

¹⁶ At [15] and [55] of *Staywell*.

- (i) Under the step-by-step approach, the three requirements of similarity of marks, similarity of goods or services, and likelihood of confusion arising from the two similarities, are assessed systematically. The first two elements - namely similarity or identity of the marks and similarity or identity of the goods / services - are assessed individually before the final element which is assessed in the round.
- (ii) Once the two threshold requirements have been met, the issue of the likelihood of confusion arises and the tribunal / court is directed to look at (a) *how* similar the marks are, (b) *how* similar the goods / services are, and (c) given this, how likely the relevant segment of the public will be confused.

Similarity of Marks

13 The law in relation to this issue is as follows:¹⁷

- (i) The three aspects of similarity (i.e. visual, aural and conceptual similarities) are meant to guide the court's inquiry. Trade-offs can occur among the three aspects of similarity.
- (ii) Technical distinctiveness (discussed further below) is an integral factor in the marks-similarity inquiry. A mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it.
- (iii) While the components of a mark may be inherently technically distinctive, ultimately the ability of the mark to function as a strong badge of origin must be assessed by looking at the mark as a whole. Conversely, the components of a mark may not be inherently distinctive, but the sum of its parts may have sufficient technical distinctiveness.
- (iv) When speaking of the assessment of a mark as a whole, the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.
- (v) The similarity of marks is ultimately and inevitably a matter of impression rather than one that can be resolved as a quantitative or mechanistic exercise. The court must ultimately conclude whether the marks, when observed in their totality, are similar or dissimilar.
- (vi) The assessment of marks similarity is mark-for-mark without consideration of any external matter.

¹⁷ *Staywell* at [15] to [30].




14 Further, the Court of Appeal provided in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941 ("**Hai Tong**"): ¹⁸

[40(c)] The relevant viewpoint is that of the average consumer who would exercise some care and a measure of good sense in making his or her purchases, not that of an unthinking person in a hurry.

[40(d)] It is assumed that the average consumer has “imperfect recollection” such that the two contesting marks are not to be compared or assessed side by side (and examined in detail). Instead, the court will consider the general impression that will likely be left by the essential or dominant features of the marks on the average consumer.

Opponent’s Earlier Marks

15 While bearing in mind that the marks are not to be compared side by side, for ease of reference, the marks are:

S/N	<i>Opponent’s Earlier Marks</i>	<i>Application Mark</i>
1		
	T1315264Z	
2		
	T7669349D	

16 There are two preliminary points which I wish to make before discussing the issue of distinctiveness. Firstly, I agree with the *Applicant* ¹⁹ that the focus for the comparison exercise will be on T1315264Z. The two earlier marks are similar in the main and most of the evidence tendered by the *Opponent* do not reflect T7669349D. It is observed that the *Opponent* itself refers to T1315264Z when providing its background. ²⁰ Thus, moving forward, the term *Opponent’s Earlier Mark* will simply refer to T1315264Z **only**. Secondly, the relevant date in this instance, which is the date of application of the *Application Mark*, is 30 May 2017 (“*Relevant Date*”). ²¹

Distinctiveness

17 I am mindful of the Court of Appeal’s guidance in *Staywell* that distinctiveness is a factor integrated into the visual, aural and conceptual analysis as to whether the competing

¹⁸ At [40(c)] and [40(d)] *Hai Tong*.

¹⁹ Via oral submissions.

²⁰ See above as well as the *Opponent’s 1st SD* at [4].

²¹ See [6] *AWS*.

marks are similar and it is not a separate step within the marks-similarity inquiry. However, for ease of analysis, I will summarise my findings on distinctiveness first, before applying them within the context of the mark-similarity analysis (this was also the approach taken by the Court of Appeal in *Hai Tong*).²²

Opponent's Earlier Mark

18 The *Applicant* submitted:²³

[18] On how the distinctiveness of the earlier mark affects the similarity analysis, we refer to the remarks of the Court of Appeal in *Hai Tong* at [30]:

“...the more fancy or inventive or arbitrary a mark, then in general, the greater the protection it will receive, in the sense that the defendant would have to demonstrate to a more compelling degree that his mark or sign is indeed dissimilar from the registered mark... On the other hand, the more descriptive a mark, the greater the latitude afforded to the defendant in using words or ideas of a generic nature, even if these have some similarity to what is found in the registered mark.”

[19] It is submitted that the [*Opponent's Earlier Mark* has] at best a *normal degree of distinctiveness*.

[Emphasis mine].

I agree.

19 In coming to this conclusion, while I agree with the *Opponent* that “[*Opponent's Earlier Mark*] has no direct meaning or significance in relation to the goods”,²⁴ the fact is that the *Opponent* has *never* relied on *Opponent's Earlier Mark* on its own. The *Applicant* made extensive submissions in this regard.²⁵

[22] We also highlight that there is *no evidence* that the [*Opponent's Earlier Mark*] [is] used *independently* from the mark, “LONGINES”. The evidence lodged by the *Opponent* [mostly] show use of the mark, “LONGINES” or composite mark,

LONGINES
 :²⁶


²² See *Hai Tong* at [26].


²³ *AWS* at [18].


²⁴ *OWS* at [8].


²⁵ *AWS* at [22].


²⁶ The composite mark, as can be seen, includes *both* the word LONGINES as well as the “winged” (or “hourglass”, as described in the *Opponent's 1st SD* at [4]) device.

(a) **Invoices found in Exhibit D of the [Opponent's 1st SD]:** The marks used were LONGINES and  .

(b) **Website printouts in Exhibit E of the [Opponent's 1st SD]:** The marks used were LONGINES and  . The [Opponent's Earlier Mark] can be seen on page 128 of the [Opponent's 1st SD] on the image of the store front at the door handle. However, the date of the press release, 13 October 2018 is past the [Relevant Date]. In any case, the composite mark is positioned nearby, again pointing to the conclusion that the mark is rarely, if ever, used independently.

(c) **Advertisements in Exhibit F²⁷ of the [Opponent's 1st SD]:** The marks used were LONGINES and  . The advertisements from pages 151 and 17[6]²⁸ are from foreign publications and therefore are irrelevant to the state of affairs in Singapore...

(d) **Copy printouts of the Opponent's website and social media pages in Exhibit G²⁹ of the [Opponent's 1st SD]:** The marks used were LONGINES and  ...it is not clear that they are dated prior to the [Relevant Date].

(e) **Copy printouts of press releases and media reports on events sponsored by the Opponent in Exhibit H of the [Opponent's 1st SD]:** The marks used were LONGINES and  .

(f) **Copy printouts of the Opponent's watches in Exhibit A of the [Opponent's 2nd SD]:** The materials are undated.³⁰ Even leaving that aside, the evidence does *not* support independent use of the mark, as the watches also

²⁷ For the avoidance of doubt, while it appears that there is a swap in exhibits, it does not affect the analysis. Specifically, Exhibit F of the *Opponent's 1st SD* was intended to include exhibits relating to the *Opponent's* social media activities (see [12] of the *Opponent's 1st SD*), while Exhibit G of the *Opponent's 1st SD* was intended to include exhibits relating to the *Opponent's* promotional activities via publications (see [13] of the *Opponent's 1st SD*).

²⁸ Pages 177-178 of Exhibit F of the *Opponent's 1st SD* includes a Singapore subscriber version of the TIME magazine although the race appears to be scheduled to take place in Hong Kong. In any event, they cannot be taken into account as they are dated after the *Relevant Date*.

²⁹ See footnote relating to Exhibit F of the *Opponent's 1st SD* above.

³⁰ And not paginated. References to page numbers for the *Opponent's 2nd SD* is as it appears on the PDF version of the document.

bear the historical 1889 Longines composite mark³¹ (referred to at paragraph



[41] of the [*Applicant's SD*]) or the mark.³²

[Emphasis mine].

20 I will only add that Exhibit I of the *Opponent's 1st SD* pertains to publications such as the *Opponent's* celebrity endorsements as well as official launches of limited edition watches, amongst others.³³ It is observed again that the evidence lodged mainly show use



of the mark, "LONGINES" or composite mark,

21 Taking into account all of the above evidence, it is clear that there is a *dearth* of evidence showing use of the [*Opponent's Earlier Mark*] *per se*.³⁴

22 The *Opponent* submitted that "the fact that some of the evidence shows the [*Opponent's Earlier Mark*] being used in conjunction with other marks does not preclude the fact that the [*Opponent's Earlier Mark*] was in fact being used, by analogy to the established principle that "the distinctive character of a mark ... may be acquired in consequence of the use of that mark as part of or in conjunction with a registered trade mark".³⁵

23 This could be so in some cases. But such is not the case here. In this regard, I agree with the *Applicant* that:³⁶



[23] Use of the composite mark is *insufficient* to establish distinctiveness of the device mark *alone*. In the composite mark, the wing device plays a *smaller role* comparatively to the word "LONGINES" by virtue of both its *placement* at the bottom and *smaller size* within the mark.

[Emphasis in italics and in bold mine].

24 In addition, the *Applicant* has also tendered evidence to the effect that "[t]he concept of utilising wings as part of a trade mark for watches is *not unique* to the *Opponent*. The

³¹ Page 8 of the *Opponent's 2nd SD*.

³² Page 9 of the *Opponent's 2nd SD*.

³³ Documents which are undated (for example, page 227) or dated after the *Relevant Date* (for example, pages 265 - 267) are not be taken into account.

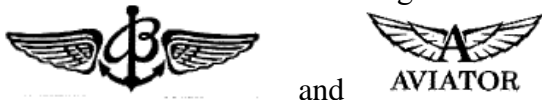


³⁴ For the avoidance of doubt, this is so even if instances where "LONGINES" or appear in the vicinity are taken into account.

³⁵ *OWS* at [10].

³⁶ See [23] *AWS*.

Applicant provided evidence of numerous trade marks registered in Singapore³⁷ that contain winged devices for watches that sold in Singapore”.³⁸ In particular, the *Applicant* tendered evidence³⁹ as to “winged-device marks” in the market. Some examples⁴⁰ are:



25 Following the above, I disagree with the *Opponent* that “[*Opponent’s Earlier Mark*] is a unique, stylized device created and used by the *Opponent*...and...[*Opponent’s Earlier Mark* is] inherently highly distinctive”,⁴¹ and that evidence of the surrounding circumstances cannot be taken into account.⁴²

26 In coming to the above conclusion, it is necessary to address the issue as to whether the evidence of the actual circumstances can be taken into account at this stage of the mark similarity inquiry since *Staywell* clarified that the assessment of marks similarity is mark-for-mark without consideration of any external matter.

27 As the *Applicant* submitted at the oral hearing, this is an unsettled area of the law. Nonetheless, I agree with the *Applicant* that the better view is that evidence should be taken into account at this stage of the analysis. In this regard, the IP Adjudicator opined, in *Monster Energy Company v NBA Properties, Inc* [2018] SGIPOS 16, albeit *obiter*:

[41] One interesting question that arose from this dispute is to what extent the knowledge of the average consumer, which may include awareness of facts that are widely known to the public or common general knowledge, is relevant to the mark-similarity analysis in trade mark opposition proceedings. ***More specifically, is it permissible for the parties to adduce evidence of public activities which may have shaped consumer knowledge of, and familiarity with, a word mark?*** This question arises because of the emphasis that the Court of Appeal has placed on how “the assessment of marks similarity is mark-for-mark without consideration of any external matter” (*Staywell* at [20]) and is related to the unresolved question of whether the acquired distinctiveness of a mark ought to be relevant to mark-similarity (Step 1) analysis.

...

[46] In my view, how the average consumer *understands* what he *sees* (which is the essence of the mark-similarity analysis) must necessarily depend on *what he knows*. As such, the knowledge of the average consumer, and *how* he is likely to *understand* or *interpret* the word device element of a composite mark, ***must be relevant to mark-***

³⁷ However, the Register may not present an accurate picture of the actual circumstances since it is possible to register a mark with an intention to use.

³⁸ See [20] *AWS*.

³⁹ See [62] and Exhibit 19 of the *Applicant’s SD*.

⁴⁰ Those evidence which are dated after the *Relevant Date* in Exhibit 19 are not taken into account.

⁴¹ At [8] *OWS*.

⁴² See [14] of the *Opponent’s 2nd SD* (which sought to deny the *Applicant’s SD* at [61] – [66]); this is a legal submission which should have included in the written submissions instead.

similarity assessment. What words (or images, for that matter) *mean* to the average consumer must be evaluated contextually. It follows that the parties should be ***permitted to adduce evidence of those surrounding circumstances*** that are relevant towards establishing the general knowledge possessed by the average consumer. ***To consciously ignore this context would entail the adoption of a highly contrived, and artificially blinkered, approach*** towards mark-similarity assessment that is ***incompatible with the commercial realities*** within which the trade mark regime operates.

[Emphasis as in bold and italics mine]



28 Having regard to the above, as alluded above, I agree with the Applicant that the ***Opponent’s Earlier Mark*** on its *own*, is at most, only of a normal level of distinctiveness.

29 I am aware that the IP Adjudicator in *Valentino S.P.A v Matsuda & Co* [2020] SGIPOS 8 (“*Matsuda*”)⁴³ does not agree with the above approach.⁴⁴ Nonetheless, with the greatest respect to the IP Adjudicator in *Matsuda*, I am of the opinion that “a ***common-sense*** overall comparison of mark-for-mark” ***necessarily encompasses*** the context within which the marks reside for reasons described above. As at the ***Relevant Date***, the consumer would have been exposed to the surrounding circumstances in which the marks reside so as to be subconsciously influenced by them when making the comparison. Discounting the context will result in an unrealistic analysis of the comparison process.

30 In any event, even if the approach in *Matsuda* is applied, the same result will ensue in this case. This is because the ***Opponent’s Earlier Mark*** on its *own, sans* any evidence of the surrounding circumstances, is ***not*** of an “enhanced level of distinctiveness”⁴⁵ such as to enjoy “a high threshold before a competing sign will be considered dissimilar to it”.⁴⁶ Even at such a “higher” level of distinctiveness (in contrast to the normal level of distinctiveness) any similarity between the marks will be ***offset*** by the presence of the words “IRON ANNIE” within the ***Application Mark*** such that the marks, when viewed as wholes, are more dissimilar than similar.

Visual Similarity

31 For ease of reference only, the marks are as follows:

S/N	<i>Opponent’s Earlier Mark</i> ⁴⁷	<i>Application Mark</i>
1		

⁴³ Issued on 30 July 2020.

⁴⁴ See foot note 1 at [22].

⁴⁵ [11] *OWS*.

⁴⁶ [12] *OWS*.

⁴⁷ I have indicated above that for the purposes of comparison only this mark will be taken into account.

It is obvious that the *Opponent's Earlier Mark* is a device *only* mark while the *Application Mark* is a *composite* mark. A “winged” device⁴⁸ is common to the marks while the *Application Mark* has additional words on top of the device.

32 As submitted by the *Opponent*:⁴⁹

[21] In *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2005] 4 SLR(R) 816 [OBA Tab 9], Lai Kew Chai J held (at [26]), that in cases where there is a common denominator, it is important to look at the *differences* between the marks to decide whether the challenged mark is able to distinguish itself sufficiently...

[Emphasis in bold and italics mine]

33 For the relevant principles in relation to the visual similarity of composite marks, the guidance in *Hai Tong* at [62] is helpful:⁵⁰

[62(a)] As we have noted above at [40(c)] and [40(d)], when assessing two contesting marks or signs, the court does so with the “imperfect recollection” of the average consumer...The two marks or signs should *not be compared side by side or examined in detail* because “the person who is confused often makes comparison from memory removed in time and space from the marks”...

[62(b)] The visual similarity of two contesting marks or signs must normally be assessed by reference to the *overall impressions* created by the marks or signs, bearing in mind their *distinctive and dominant components*. When the other components of a complex mark or sign are of negligible significance, it is permissible to make the comparison solely on the basis of any dominant element(s).

[62(c)] The overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components...

[62(d)] The textual component of a composite mark or sign *could* (but will not necessarily or always) be the dominant component of the mark or sign. Some instances where this might be the case include where:

- (i) The two marks or signs in question each *contain a similar device*. The overall resemblance between them may then be diminished if they bear words which are entirely different from each other...

⁴⁸ As alluded to above, it is described as an “hourglass logo” in the *Opponent's 1st SD* at [4].

⁴⁹ See [21] *OWS*.

⁵⁰ See also [30] *AWS*.

- (ii) *The textual component is large, and is in a prominent location* in relation to the other components or stands out from the background of the mark or sign...
- (iii) The textual component is *in itself* already widely known...
- (iv) The composite mark or sign is applied to goods or services marketed or sold primarily through *online* trade channels...

[62(e)] The device component has been found to be an *equally significant*, if not the dominant, component of a composite mark or sign where:



- (i) the device is *significant and large*...
- (ii) the accompanying word(s) are devoid of any distinctive character, or are purely descriptive of the device component... or
- (iii) the device component is of a complicated nature...

But usually *not* where:

- (iv) the device is simple and will not evoke any particular concept for the average consumer...
- (v) the device component does not attract the attention of the average consumer of the goods in question because such a consumer is regularly confronted with similar images in relation to those goods...
- (vi) the device component is more likely to be perceived as a decorative element rather than as an element indicating commercial origin...

[Emphasis in bold and italics mine]

34 Returning to the visual comparison of marks:

S/N	<i>Opponent's Earlier Mark</i>	<i>Application Mark</i>
1		

as mentioned above, it is obvious that there is a common “winged” device in both marks.

35 Applying the above to the current case, I agree with the *Applicant* that the “visual impression of the *Application Mark* is *dominated by two elements*, namely, the words, “IRON ANNIE” and the “winged device with the geometric centre device”⁵¹ for the following reasons:

⁵¹ See [31] *AWS*.

- (i) Both the device and the words are almost of *equal* size and occupy *central* positions in the *Application Mark*.^{52 53}
- (ii) Distinctiveness of the words “IRON ANNIE”. The words are meaningless and invented in the context of the goods (watches and chronometric instruments).

36 In my view, the devices are similar to *a low extent*. They can be considered essentially as “winged” devices. The main distinction, if any, is the centre, in particular having regard to the colour contrast.⁵⁴ In this regard, I do not think it is appropriate to go down into a detailed analysis of the differences between the two winged devices.⁵⁵

37 I agree with the *Applicant* on the applicability of *The Polo/Lauren Company, L.P. v United States Polo Association* [2015] SGIPOS 10 (“*POLO USPA IPOS*”):⁵⁶

[45]...the IP Adjudicator concluded that there was “an extremely low degree of visual similarity between the two marks”, as “whilst there is a *small degree of similarity* between the devices, *the presence of text “USPA” in the Application Mark significantly reduces this similarity.*”

[46] On appeal to the High Court...the Honourable Justice Lee Seiu Kin J stated in upholding the above finding at [17]...:

[17] ... I would point out that even if I were to accept the plaintiff’s submission that the Application Device is highly similar to the Opposition Mark, applying the principle set out in *Hai Tong* at [62(d)(i)], *the Application Text would in any diminish the overall resemblance between them.*

38 In conclusion, taking the two marks as wholes, I am of the view that the presence, placement and size of an “equally distinctive”⁵⁷ and “co-dominant”⁵⁸ textual element of “IRON ANNIE” in the *Application Mark*, renders the marks visually more dissimilar than similar.

39 For the avoidance of doubt, the *Opponent*’s reliance on *Abercrombie & Fitch Europe SAGL v MMC International Services Pte Ltd* [2016] SGIPOS 6 (“*Abercrombie*”) for the proposition that “a composite mark consisting of word and device elements may be deemed to be visually similar to a pure device mark”⁵⁹ is misplaced.

⁵² The *Applicant* relied on the case of *The Polo/Lauren Company, L.P. v United States Polo Association* [2015] SGIPOS 10 for this proposition ([32(c)] – [34] *AWS*).

⁵³ I agree with the *Applicant* that “it is *not* likely that a consumer would *not* notice the “IRON ANNIE” text, which is in capitalised letters and placed above the device element, such that she / he would focus on the device to the exclusion of the “IRON ANNIE” words” ([37] *AWS*).

⁵⁴ See [40(c)] *AWS*.

⁵⁵ Whether it is a “winged hourglass” device ([40(b)] *AWS*) or “winged device with the geometric centre device” ([31] *AWS*).

⁵⁶ See [45] and [46] *AWS*.

⁵⁷ See [53] *AWS*.

⁵⁸ See [52] *AWS*.

⁵⁹ See [19] *OWS*.

40 As explained at [107] of *Abercrombie*:

[107] Similarly, the Application Mark has taken up the whole of the Opponents' Earlier Moose Device Mark. The moose *device* takes up about *two thirds* of the Application Mark...

[Emphasis in italics mine]

This is clearly not the case here. As indicated above, in the *Application Mark*, the device is of *equal* size to the words, "IRON ANNIE".

Aural Similarity

41 With regard to aural similarity, the Court of Appeal in *Staywell* stated at [31] and [32] that there are two approaches. One approach is to consider the dominant component of the mark ("Dominant Component Approach") and the other is to undertake a quantitative assessment as to whether the competing marks have more syllables in common than not ("Quantitative Assessment Approach").

42 Here, as alluded to above, *Opponent's Earlier Mark* is a device only mark. As submitted by the *Applicant*, "the position on whether 'a mark that is found to have no aural component may nonetheless found to be aurally similar to another mark does not appear to be settled law'".⁶⁰

43 At one end, "[t]he position taken in some decisions is that a device without an aural component cannot be verbalised. It would then follow that no aural comparison can be made if any of the marks to be compared is such a device".⁶¹ On the other end, "there are the decisions which verbalise marks with no aural component, by describing the images that they depict".⁶²

44 I am of the view that the initial approach is more appropriate in the instant case. The latter approach is more suitable where the device is an uninvented, everyday item / thing, such as a cat. If I am correct, then no aural comparison can be made.

45 In any event, even if I am wrong, the *Opponent's Earlier Mark* would be described as a "winged device", and the two marks would be aurally more dissimilar than similar since the *Application Mark* would be described as "IRON ANNIE".

46 As explained in *The Polo/Lauren Company, L.P. v United States Polo Association* [2016] SGHC 32 ("*POLO USPA HC*"):⁶³

⁶⁰ At [56] *AWS*, quoting from [22] *The Polo/Lauren Company, L.P. v United States Polo Association* [2016] SGHC 32.

⁶¹ See [58] *AWS*.

⁶² See [60] *AWS*.

⁶³ See [61] *AWS* quoting from [23] – [24] *POLO USPA HC*.

[23] But even if I were to accept that the Opposition Mark would be verbalised as “polo-player”, I am not persuaded in respect of the Application Mark....

[24] ...As I have already found above, I am of the view that *neither* the Application Device nor the Application Text is the dominant component of the Application Mark. That being the case, *I did not see any particular reason why the reasonable consumer would choose to pronounce the Application Mark as “polo-players” rather than as “USPA”, which while invented, is not unpronounceable*. As counsel for the defendant highlighted in his oral submissions, no one has sought to pronounce Nike’s “Swoosh” device even though it is only accompanied by the text “NIKE”, which the public may not know to be a Greek goddess”.

47 In conclusion, the marks are either aurally neutral or aurally more dissimilar than similar.

Conceptual Similarity

48 The Court of Appeal in *Staywell* expounded at [35] as follows:

[35] ...Unlike the aural analysis, which involves the utterance of the syllables without exploring the composite meaning embodied by the words, the conceptual analysis seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole...*Greater care* is therefore needed in considering what the conceptually dominant component of a composite mark is, because the idea connoted by each component might be very different from the sum of its parts...

[Emphasis in italics mine]

49 The *Applicant* submitted:

[66] The only concept that may be said to be *common*...is the concept of “extended wings”.

[67] However, the Application Mark is a composite mark, made up of the *equally* dominant, if not more dominant words, “IRON ANNIE” *and* an extended wing device...

[Emphasis in bold and italics mine]

50 I am of the view that the *Applicant*’s proposition that “the Application Mark, as a whole, evokes the impression of a strong and determined girl with some connection to aviation or flight”,⁶⁴ is reasonable and plausible.

⁶⁴ At [69] *AWS*.

51 Even if I am wrong, and the general impression of the *Application Mark* is something *other than* that described above, the overall idea as exuded by the *Application Mark* must be *more* than “one of wings and/or flight”.⁶⁵ In this regard, I am of the view that, having regard to “a specialised historical fact”⁶⁶ that ““Iron Annie” is used as a nickname of a German aircraft model”⁶⁷ “will not be known to most of the general public in Singapore”,⁶⁸ it is too much of a leap in logic to propose that “the term “Iron Annie”...[is] associated with wings and/or flight”.⁶⁹

52 I find support in the decision of *Tiger Coatings v Seng Fong Paints* [2019] SGIPOS 10,⁷⁰ where the marks compared were found to be conceptually dissimilar, despite having the shared concept of a “tiger”:

Opponent’s Mark	Application Mark
	

53 As submitted by the *Applicant*:⁷¹

[73] The IP Adjudicator reasoned...the textual elements...“LNK Coatings” in the application mark featured prominently, with the result that the concept conveyed *incorporated those elements*, as opposed to the imagery of a tiger on its own (at [77])...

54 Taking all of the above into consideration, I am of the view that the marks are conceptually more dissimilar than similar.

Conclusion on the similarity of marks

55 It is to be recalled that:

- (i) The court must ultimately conclude whether the marks, when observed in their totality, are similar rather than dissimilar. In this regard, trade-offs can occur among the three aspects of similarity.

⁶⁵ See [23] *OWS*.

⁶⁶ *Supra*.

⁶⁷ *Supra*.

⁶⁸ *Supra*..

⁶⁹ *Supra*.

⁷⁰ At [72] *AWS*.

⁷¹ See [73] *AWS*.

- (ii) The average consumer:
 - (a) has an “imperfect recollection” and there is a need to consider the general impression that will likely be left by the dominant features of the marks.
 - (b) is one who would exercise some care and a measure of good sense in making his or her purchases, not that of an unthinking person in a hurry.

56 In light of all the above, in my view, the ***Application Mark*** is:

- (i) Visually more dissimilar than similar in comparison to the ***Opponent’s Earlier Mark***;
- (ii) Aurally neutral or more dissimilar than similar in comparison to the ***Opponent’s Earlier Mark***;
- (iii) Conceptually more dissimilar than similar in comparison to the ***Opponent’s Earlier Mark***,

such that it is ***overall more dissimilar*** than similar to the ***Opponent’s Earlier Mark***.

57 Having regard to the 3-step test, my conclusion above ends the inquiry with regard to the objection under Section 8(2)(b). However, in the event that I am wrong, I will proceed with the other two elements. In such a case, the marks can at most be said to be similar to a low extent.

Similarity of Goods / Services

58 For ease of reference, the relevant goods and services are as follows:

<i>Opponent’s Earlier Mark</i>	<i>Application Mark</i>
<p><u>Class 14</u> Precious metals and their alloys and goods made of these materials or coated therewith included in this class, namely figurines, trophies; jewelry, namely rings, earrings, cuff links, bracelets, charms, brooches, chains, necklaces, tie pins, tie clips, jewelry caskets (cases), cases; precious stones, semi-precious stones; timepieces and <i>chronometric instruments</i> namely chronometers, chronographs, clocks, <i>watches</i>, wristwatches, wall clocks, alarm clocks as well as parts and accessories for the aforesaid goods namely hands, anchors, pendulums, barrels, watch cases, watch straps, watch dials, clockworks, watch chains, movements for timepieces, watch springs, watch glasses, presentation cases for timepieces, cases for timepieces.</p>	<p><u>Class 14</u> <i>Watches and chronometric instruments</i></p>

It is obvious that this element has been satisfied since “watches and chronometric instruments” appears in both specifications.

Likelihood of Confusion

59 The relevant principles for assessing likelihood of confusion have been expounded by the Court of Appeal in *Staywell*:

- (i) In opposition proceedings, the inquiry must take into account the full range of the competing monopoly rights that are already enjoyed on the one hand, namely the *actual and notional fair uses* to which the incumbent proprietor has or might fairly put his registered trade mark, and compare this against the *full range of such rights* sought by the applicant *by reference to any actual use by the applicant (assuming there has been prior use) as well as notional fair uses* to which the applicant may put his mark should registration be granted (*Staywell* at [60]).
- (ii) Once similarity between the competing marks and goods or services has been established, the *impact* of these similarities on the relevant consumers' ability to understand where those goods and services originate from falls to be considered. The only relevant confusion is that which results from the similarity between marks and goods or services. However, the plain words of section 8(2) do *not* have the effect of making a finding of confusion automatic upon the establishment of similarity of marks and goods or services (*Staywell* at [64]).
- (iii) On the effect of the foregoing (i.e. similarity of marks and goods or services) on the relevant segment of the public – *extraneous* factors may be considered to the extent that they inform the court as to how the *similarity of marks and goods* will likely *affect* the consumer's perception as to the source of the goods (*Staywell* at [83]).
- (iv) The following represents a non-exhaustive list of factors which are regarded as admissible in the confusion inquiry (*Staywell* at [96]):
 - (a) Factors relating to the impact of *marks-similarity* on consumer perception:
 - (1) the *degree of similarity* of the marks themselves;
 - (2) the *reputation* of the marks (a strong reputation does *not* necessarily equate to a higher likelihood of confusion, and could in fact have the contrary effect);
 - (3) the *impression* given by the marks; and
 - (4) the *possibility of imperfect recollection* of the marks.
 - (b) Factors relating to the impact of *goods-similarity* on consumer perception (factors concerning the very nature of the goods without implicating any steps that are taken by the trader to differentiate the goods).

- (1) The *normal way in, or the circumstances under, which consumers would purchase goods of that type*;
- (2) Whether the products are *expensive or inexpensive items*;
- (3) Whether they would tend to *command a greater or lesser degree of fastidiousness and attention* on the part of prospective purchasers; and
- (4) The *likely characteristics of the relevant consumers* and whether the relevant consumers would or would not tend to apply care or have *specialist knowledge* in making the purchase.

[Emphasis in italics mine]

Factors relating to the impact of marks-similarity

60 I have concluded above that the ***Application Mark*** is overall more dissimilar than similar in comparison to the ***Opponent's Earlier Mark*** or at most, similar to a low extent. As watches are usually displayed on shelves in the brick and mortar shops or online platforms, it is the visual component which is crucial. In this regard, I have earlier concluded that the marks are visually more dissimilar than similar.

61 In relation to the *reputation* of the ***Opponent's Earlier Mark***, I have already indicated above that most of the evidence cannot be taken into account such that there cannot be any reputation to speak of. On the other hand, the sales and promotional figures of the ***Applicant*** do not appear to be extensive:

S/N	Year	Number of watches sold ⁷²
1	2017 ⁷³	5,000
S/N	Year	Promotional and Advertising Expenditure in € ⁷⁴
2	2017 ⁷⁵	30,000

In fact, the extent to which the figures above relate to sales and promotion of products bearing the ***Application Mark*** in *Singapore* is unclear.⁷⁶

62 Having regard to all of the above, even taking into account the possibility of imperfect recollection, the overall impression of the marks is that they are more dissimilar than similar.

⁷² At [18] of the ***Applicant's SD***.

⁷³ The figures for 2018 and 2019 are disregarded as they occur after the ***Relevant Date***. For convenience, the year 2017 is taken into account even though the ***Relevant Date*** is 31 May 2017. For the avoidance of doubt, this does not affect the analysis in this case.

⁷⁴ At [20] of the ***Applicant's SD***.

⁷⁵ As above.

⁷⁶ See [17] – [20] of the ***Applicant's SD***.

Factors relating to the impact of goods-similarity

63 I agree with the **Applicant** that “watches are “highly personal item[s] which blend function and style”⁷⁷ ...[h]ence, watches would tend to “command a greater degree of fastidiousness and attention”⁷⁸...from consumers, who would consequently be less likely to be confused”.⁷⁹

64 As a type of product, watches span a whole range of prices. Nonetheless, while they are not as expensive as a car, they are definitely not cheap items or “a 50 pence purchase in the station kiosk”.⁸⁰ For clarity, the price of the product is only **one** of the many factors accounting for the level of attention exuded by the would be consumers. As the IP Adjudicator clarified in **POLO USPA IPOS**:

[109]...I do not think that it is necessary in every case to focus on the price of the type of goods concerned. Ultimately, ***the aim of the exercise is to determine the degree of care*** that the average consumer is likely to pay when purchasing that type of goods...

[Emphasis in bold and italics mine]

65 In terms of the mode of purchase, as alluded to above, this would either be via brick and mortar shops or via online purchases.

66 For purchases via shop fronts, as submitted by the **Applicant**, “visual...[aspects] play important roles...[watches] would be placed on shelves and purchased with the help of assistants”.⁸¹ In such a case, consumers would peruse the marks visually before asking the assistant for help for a closer look at the watch. In this regard, I have concluded above that the marks are visually more dissimilar than similar.

67 For clarity, the **Applicant** also submitted that an alternative mode of purchase where “consumers...ask the sales assistants for a watch by their trademark, before perusing the watches visually”.⁸² I am of the view that even via this mode of purchase, it is the visual aspect that is critical as it is a visual inspection which will ultimately enable the consumer to confirm if he/she is purchasing the watch that he/she is looking for. This is unsurprising, given that, as alluded above, watches are “highly personal item[s] which blend function and style”.⁸³

⁷⁷ See [89] **AWS** referring to [98] *Swatch AG v Apple Inc* [2019] SGIPOS 1.

⁷⁸ **Supra**.

⁷⁹ See [89] **AWS**.

⁸⁰ **Staywell** at [96(b)].

⁸¹ See [92] **AWS** referring to [96] *Swatch AG v Apple Inc* [2019] SGIPOS 1.


⁸² See [92] **AWS**.

⁸³ See footnote 78.

68 In the same vein, for purchases via online platforms, even if the consumer would have to type in the description of the mark he is looking for,⁸⁴ ultimately, it is the visual aspect that is crucial since it is a visual inspection which enable the consumer to conclusively confirm he/she is purchasing the watch that he/she is looking for.

69 Thus, having regard to the usual factors relating to the impact of marks-similarity and goods-similarity, there is *no* likelihood of confusion that they are one and the same or are at least economically linked.

70 Before I conclude, the *Opponent* submitted:⁸⁵

[34]...in a number of the *Applicant*'s watch models, the logo “” is often prominently positioned on the product and placed above or some distance away from the words “IRON ANNIE”, making this graphic element the distinctive feature of the Application Mark...Based on the use of the graphic element in this way, there is a high possibility that consumers are likely to mistake the Application Mark for the [*Opponent's Earlier Mark*].

The *Opponent* is clearly misguided as the *Application Mark* must be assessed *as sought to be registered* for the purposes of *this* ground of opposition.

71 The *Opponent* also sought to argue that there is a likelihood of confusion as “there is a high possibility that consumers would be misled to believe that there is an economic link between the *Opponent* and the *Applicant* due to the highly distinctive nature of the [*Opponent's Earlier Mark*]”, and that “[t]his is further exacerbated by the fact that the “Iron Annie” series was only created in 2017 with a full collection launched in 2019...as this means that it is not a long-established brand name”.

72 Firstly, I have earlier concluded that I am of the view that the *Opponent's Earlier Mark* is only of a *normal* level of distinctiveness. Further, as alluded to above, having regard to the fact that watches are personal items, consumers are likely to pay more attention during the purchasing process, such that there is no danger of such a form of confusion.

Conclusion on Section 8(2)(b)

73 The ground of opposition under Section 8(2)(b) therefore fails.

⁸⁴ See *Hai Tong* above where it was commented that “[t] textual component of a composite mark or sign *could*...be the dominant component of the mark or sign...[where] [t]he composite mark or sign is applied to goods or services marketed or sold primarily through *online* trade channels ([62(d)]).

⁸⁵ See [34] *OWS*.

Ground of Opposition under Section 8(4)(b)(i)

74 Section 8(4) of the Act reads:

8(4) Subject to subsection (5), where an application for registration of a trade mark is made on or after 1st July 2004, if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark, the later trade mark shall not be registered if —

- (a) the earlier trade mark is well known in Singapore; and
- (b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —
 - (i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark...

Decision on Section 8(4)(b)(i)

Similarity of marks

75 In relation to this ground, it is clear that the first element that must be satisfied is that "the whole or essential part of the trade mark must be identical or similar to an earlier mark". This element is essentially the same as the similar element under section 8(2)(b).⁸⁶ Thus, my conclusion in relation to this is the same as that for the objection under section 8(2)(b) above.

Well-known in Singapore

76 The critical question is whether the *Opponent's Earlier Mark*:



is well known in Singapore at the *Relevant Date*.

77 The definition of a well known trade mark is provided in section 2 of the Act:

2.—(1) In this Act, unless the context otherwise requires —

“well known trade mark” means —

- (a) any registered trade mark that is well known in Singapore; or
- (b) any unregistered trade mark that is well known in Singapore and that belongs to a person who —

⁸⁶ See *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA (Sarika CA)* [2013] 1 SLR 531 at [70] and [71].

- (i) is a national of a Convention country; or
- (ii) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country, whether or not that person carries on business, or has any goodwill, in Singapore;

78 Further, section 2(7), (8) and (9) of the Act is relevant for the concept of “well known in Singapore”. Section 2(7) of the Act states:

Subject to subsection (8), in deciding, for the purposes of this Act, whether a trade mark is well known in Singapore, it shall be relevant to take into account any matter from which it may be inferred that the trade mark is well known, including such of the following matters as may be relevant:

- (a) the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;
- (b) the duration, extent and geographical area of –
 - (i) any use of the trade mark; or
 - (ii) any promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied;
- (c) any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application;
- (d) any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory;
- (e) any value associated with the trade mark.

Section 2(8) of the Act reads:

Where it is determined that a trade mark is well known to any relevant sector of the public in Singapore, the trade mark shall be deemed to be well known in Singapore.

Section 2(9) of the Act states:

In subsections (7) and (8), “relevant sector of the public in Singapore” includes any of the following:

- (a) all actual consumers and potential consumers in Singapore of the goods or services to which the trade mark is applied;

- (b) all persons in Singapore involved in the distribution of the goods or services to which the trade mark is applied;
- (c) all businesses and companies in Singapore dealing in the goods or services to which the trade mark is applied.

79 These provisions have been the subject of further exposition by the Courts:

- (i) Section 2(7)(a) is arguably the most crucial factor when determining whether a trade mark is well known in Singapore. This is because section 2(8) of the Act *deems* a trade mark to be well known in Singapore where it is determined to be well known to *any* relevant sector of the public in Singapore (see [139] of *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] SGCA 13 ("*Amanresorts*").).
- (ii) Aside from section 2(7)(a) of the Act, the court is ordinarily free to disregard any or all of the factors listed in section 2(7) as the case requires and to take additional factors into consideration (*Amanresorts* at [137]).
- (iii) In relation to section 2(8) of the Act, the Court of Appeal in *Caesarstone CA* clarified that:

[101] ...we said in *Amanresorts* that it is “not too difficult” for a trade mark to be regarded as well known in Singapore⁸⁷ ...

[102] We do not think that this comment in *Amanresorts* was made to lay down a general principle...the context of this comment was the desire to clarify that, in order for a mark to be well known in Singapore, the relevant sector to which a mark must be shown to be well known can be *any* relevant sector of the Singaporean public, and this sector need not be large in size. *Beyond this, it should not be read as suggesting (more generally) that the threshold for a trade mark to be regarded as well known in Singapore is a low one.*

[Emphasis in italics mine]

- (iv) Last but not least, with regard to the ambit of section 2(9)(a), the inquiry is into the specific goods or services to which the opponent’s trade mark has been applied ([152] *Amanresorts*).

80 The **Opponent** made extensive submissions⁸⁸ as to how the **Opponent’s Earlier Mark** is well known to the relevant public in Singapore. I have dealt with the evidence above and I will not repeat my analysis here. In short, most of the evidence cannot be

⁸⁷ The Court of Appeal in *Amanresorts* commented that it is *not too difficult* for a trade mark to be regarded as “well known in Singapore” since the trade mark in question need only be recognised or known by “*any* relevant sector of the public in Singapore” which could in certain cases be *miniscule* ([229] *Amanresorts*).

⁸⁸ [41] – [47] **OWS**.

taken into account because they do not relate to the *Opponent's Earlier Mark per se* and/or are undated / dated after the *Relevant Date*.

81 Accordingly, this element has not been made out.

Confusing connection

82 In relation to this element, the Court of Appeal in *Staywell* provided at [120]:

...As for the third element, the detailed analysis in Amanresorts has put it beyond doubt that the connection requirement of s 8(4)(b)(i) and s 55(3)(a) of the Act will be satisfied where there is a likelihood of confusion...

83 Accordingly, I am of the view that there will be no confusing connection here for largely the same reasons that I have provided for my conclusion in relation to the likelihood of confusion under section 8(2)(b).

Likelihood of Damage

84 In light of my conclusion above that there is no confusing connection, there can be no damage.

Conclusion on Section 8(4)(b)(i)

85 The ground of opposition under section 8(4)(b)(i) fails.

Ground of Opposition under Section 8(7)(a)

86 Section 8(7)(a) of the Act reads:

8(7) A trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented —

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade.

Decision on Section 8(7)(a)

87 In relation to this ground, it is trite that there are three elements to be established (i) goodwill; (ii) misrepresentation; and (iii) damage.

88 Some further elaboration on the law of passing off:

(i) The opponent must establish that it has acquired goodwill as at the *relevant date*, that is, the date on which the defendant's conduct complained of started. Applying this principle, it is the *Relevant Date* in this instance (*Law of*

Intellectual Property of Singapore (Sweet & Maxwell, 2nd Edition, 2014) (“***Law of Intellectual Property of Singapore***”) at [17.2.5]).

- (ii) Goodwill, in the context of passing off, is concerned with goodwill in the *business as a whole*, and not specifically in its constituent elements. The issue of *whether a mark or get-up is distinctive* of a plaintiff’s products or services is a question best dealt with in the context of the inquiry as to whether the defendant has made a misrepresentation (*Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading* [2016] 4 SLR 86 (“***Singsung***”)). Evidence of sales and income of the business are a “proxy for the attractive force of the business” (***Singsung*** at [58]). The “get up” can include various aspects of the business, *including* a mark (***Law of Intellectual Property of Singapore*** at [17.2.10] – [17.2.11]).
- (iii) Section 8(7)(a) of the Act at the very least requires an opponent to adduce sufficient evidence to establish a *prima facie* case on goodwill, misrepresentation and damage (*Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] SGHC 216 at [164]).

89 It is not in dispute that the ***Opponent*** has the relevant goodwill.

Misrepresentation

90 As alluded to above, in an action in passing off, it is permissible for the ***Opponent*** to rely on its *get-up* (which includes the ***Opponent’s Earlier Mark***).



91 I have already commented above that the bulk of the evidence tendered by the ***Opponent***⁸⁹ do not relate to the ***Opponent’s Earlier Mark*** *per se*⁹⁰ and/or are undated / dated after the ***Relevant Date***.

92 It is important to recall that for the purposes of this ground of objection, the ***Opponent’s*** get-up is compared to the ***Application Mark*** as sought to be registered. In this regard, section 8(7)(a) provides:

8. (7)(a) *A trade mark shall not be registered* if, or to the extent that, its use in Singapore is liable to be prevented by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade.




[Emphasis in italics mine]

⁸⁹ Those parts which can be taken into account having regard the ***Relevant Date***.

⁹⁰ Most of the evidence pertain to the mark, “LONGINES” or composite mark,  and when ***Opponent’s Earlier Mark*** does appear on its own, “LONGINES” or  are usually in the vicinity.

This is in contrast to an action under the common law of passing off.

93 Accordingly, the comparison of get-ups / marks are as follows:

S/N	<i>Opponent's earlier get-ups</i>	<i>Application Mark</i>
1	LONGINES 	IRON ANNIE 
2	LONGINES	
3		

94 In light of the above, I am of the view that, on a balance of probabilities, there is clearly *no* likelihood of misrepresentation that the *Applicant* and the *Opponent* are one and the same or that they are economically linked.

Damage

95 As I have found that the element of misrepresentation has not been made out, there is no need for me to look into the element of damage.

Conclusion

96 The ground of opposition under section 8(7)(b) therefore fails.

Conclusion

97 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition fails on all grounds. Accordingly, the *Application Mark* shall proceed to registration. The *Applicant* is also entitled to costs to be taxed, if not agreed.

Date of Issue: 28 August 2020