

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

Trade Mark Application No. T0720701B
14 May 2010

IN THE MATTER OF A TRADE MARK APPLICATION BY

**NG WEE PING
("the Applicant")**

And

OPPOSITION THERETO BY

**S.TOUS, S.L.
("the Opponents")**


Hearing Officer: Ms Lee Li Choon
Principal Assistant Registrar

Applicant appearing in person: Mr Ng Wee Ping
Acting for Opponents: Mr Paul Teo and Ms Joanna Lim from Drew & Napier LLC

Cur Adv Vult

GROUND OF DECISION

1 The Applicant applied to register Singapore Trade Mark Application No.

T0720701B for the device mark,  as a series of 2 marks (the representation of the 2

marks in series is as follows:  ) in classes 14, 18 and 25 for use on:

Class 14

Goods made of precious metals, their alloys or plated therewith, in particular, ornamental objects, boxes and cases, powder compacts; jewellery, jewellery articles (including fashion jewellery) in particular, rings, rings for keys, rings, earrings, cufflinks, bracelets, charms, brooches, chains, necklaces, tie pins, ornamental pins, medallions; timepieces and chronometric instruments including watchstraps, watches, wristwatches, pendulum clocks, pendulettes, alarm clocks, caskets and cases for timepieces.

Class 18

Leather and imitation leather; travelling bags, travelling sets (leather goods), trunks and suitcases, garment bags for travel purposes, vanity cases, backpacks, shoulder bags, handbags, attache cases, document holders and briefcases of leather, clutch bags, wallets, purses, key cases, card cases; umbrellas.

Class 25



Clothing and underwear including sweaters, shirts, tee-shirts, lingerie, belts (clothing), scarves, neckties, shawls, vests, skirts, raincoats, overcoats, suspenders, trousers, denim trousers, pullovers, dresses, jackets, sashes for wear, gloves, tights, socks, bathing suits, bath robes, pajamas, nightshirts, shorts, pockets (clothing); shoes, boots, slippers; headgear.

The mark will hereinafter be referred to as the “Application Mark”. The application was accepted for registration and published on 22 February 2008 for opposition purposes. The Opponents, S.Tous, S.L., filed their Notice of Opposition on 22 April 2008. The Applicant contested the opposition by filing his Counter-Statement on 21 May 2008. The Opponents filed evidence in support of their opposition on 20 August 2008. The Applicant filed evidence in support of his application on 17 October 2008. The Opponents did not file any evidence in reply. The matter was fixed for a Pre-Hearing Review on 25 June 2009 and a Further Pre-Hearing Review on 24 August 2009. Thereafter, the Applicant filed further evidence by way of a Statutory Declaration of Loo Sooi Wan on 25 September 2009. There being no other outstanding matter thereafter, the case was fixed for a full hearing on 5 May 2010.

Grounds of Opposition

2 In their Notice of Opposition, the Opponents objected to the registration of the Application Mark under sections 8(2), 8(4)(a) read with 8(4)(b)(i) and 8(7)(a) of the Trade Marks Act (Cap 332, 2005 Revised Edition) (“the Act”), namely, that the Application Mark should be refused registration because:

- (i) as a result of the similarity between the Application Mark and the


Opponent’s earlier “TOUS Bear” mark  or  (for which the Opponents have applications and registrations in many classes throughout the world and in Singapore, including registrations for the latter “TOUS Bear” mark in classes 14, 18 and 25) and the similarity of the goods covered by both Application Mark and the Opponents’

- marks, there exists a likelihood of confusion on the part of the public between the two marks (section 8(2), in particular, section 8(2)(b));
- (ii) as a result of the similarity of the Application Mark to the Opponents'



- earlier "TOUS Bear" mark which is well-known in Singapore, the use or proposed use of the Application Mark in respect of the proposed specification would indicate a connection between the Applicant's goods and the Opponents and is likely to damage the interests of the Opponents as a result (section 8(4)(a) read with 8(4)(b)(i));
- (iii) in view of the long and extensive use of the Opponents' "TOUS Bear"




mark and other variants such as the mark, , in relation to the Opponents' goods and the substantial goodwill and reputation subsisting in the Opponents' marks, the use or proposed use of the Application Mark in respect of the proposed specification is likely to mislead the public into believing that the Applicant's goods originate from or are somehow associated with the Opponents when this is not the case, causing damage to the Opponents' business and goodwill and as such, the registration is liable to be prevented in Singapore by virtue of the law of passing off (section 8(7)(a)).

Opponents' Evidence

3 The Opponents' evidence consists of 3 almost identical Statutory Declarations declared by Nuria Garros Ribera dated 25 July 2008 ("NGR's SD), each in respect of each class of goods.

4 The Opponents was established in Manresa, Spain in 1920. In or around 1985, an employee of the Opponents came up with a drawing of a bear design which subsequently became known as the "TOUS Bear" mark and symbol of the Opponents. The Opponents'



"TOUS Bear" mark looks like this : . In addition, the Opponents have earlier registrations (T0315786Z, T0315787H, T0315788F) all dated 7 May 2003 for the bear



mark,  in respect of the following goods:

Class 14 : Precious metals and their alloys and goods made of these materials or coated therewith not included in other classes; jewelry, precious stones; timepieces and chronometric instruments.

Class 18 : Bags, wallets and key holders of leather.

Class 25 : Clothing, footwear, headgear and belts (clothing).

5 The Opponents also have an earlier registration for the same “TOUS Bear” mark in class 9 in respect of “spectacles and spectacle frames” in Singapore. The Opponents’ jewellery products bearing the “TOUS Bear” mark were sold soon after 1985 in Spain. As the Opponents’ business grew, the Opponents’ range of products expanded from jewellery to other accessories such as bags, small leather articles, gloves, shawls, glasses, perfumes, chinaware and watches. The “TOUS Bear” mark appears on many of the Opponents’ products. The Opponents have an international presence with numerous distributors and more than 300 points of sale worldwide. In particular, the Opponents have numerous retail stores in Hong Kong, Japan, Korea and China. From the Opponents’ ‘Corporate Press Dossier 2008’, it is shown that Opponents’ sales reached 325 million Euros in 2007 and the Opponents have 1,850 employees. The Opponents also submitted as evidence, printouts from their website, www.tous.es and copies of catalogues and brochures showing the use of the “TOUS BEAR” mark on their goods and shop locations. In addition to www.tous.es, the Opponents also have numerous other registered domain names in various countries worldwide such as www.tous.jp, www.tous.sg, www.tous.us e.t.c. The Opponents have also registered the copyright of the “TOUS BEAR” mark in Mexico.

6 The Opponents have received various awards for their products and development such as the “Internationalization Award” from Spain in 1999, First Prize in “Gold Trends 2000. Alternate Realism. Gold for the Millennium Design Competition” in 2000, shortlist in “Europa 500” e.t.c.. The Opponents have also used very well-known personalities, both in Spain and worldwide to participate in their public relations campaign. For example, well-known celebrity Kylie Minogue is the new face of the Opponents from 2008 to 2010.

7 As for use in Singapore, the Opponents have been using the “TOUS BEAR” mark since at least 2002. Goods bearing the “TOUS BEAR” mark have been sold in Isetan in Singapore. In addition, the Opponents have also established an online store “TOUS shops” in the US, Puerto Rico and Canada. The “TOUS BEAR” mark has been advertised worldwide, including in Italian Vogue which is available in Singapore from major bookstores and newsstands, and in Ronda Iberia, which is the in-flight magazine of the Spanish national airline Iberia which flies to Singapore. The Opponents have also registered the “TOUS BEAR” mark in at least 50 countries such as the US, UK, Korea, Hong Kong, Italy, Australia and Japan.

8 The Opponents’ “TOUS BEAR” mark has also been held to be a reputed and well-known mark in several court rulings and opposition proceedings, mostly in Spain and in one proceedings in Taiwan. In addition, the Opponents have also taken various legal actions against infringers of the “TOUS BEAR” mark in Spain.

Applicants' Evidence

9 The Applicant's evidence is submitted through his own statutory declaration dated 15 October 2008 as well as the statutory declaration of Loo Sooi Wan dated 25 September 2009. The Applicant averred that the design of his mark was conceived and created by him in September 2007 when he was trying to create a new range of products and was searching for an icon, design or trade mark that most people could relate to, from children to adults. The Applicant came up with the idea of a teddy bear as he felt that such a device would relate to most people. His idea was also to use different colours for his bear. He filed for registration of the mark in 3 classes on 12 October 2007. In his application form, the Applicant described his mark as a "silhouette of a teddy bear shape, be it in Black and White or filled with any colours". In his statutory declaration, the Applicant claimed that his colleague, Ms Sharon Loo of IC No. S7575414J had witnessed the whole creation of the teddy bear design and had given him comments during the design and creation process on his own personal laptop computer.

10 In the Applicant's statutory declaration, he highlighted the differences between the two marks and his comparison table is reproduced wholesale below:

Opponent's Trade Mark	Applicant Trade Mark
1) The trade mark hands are down by the side.	1) The trade mark hands are extended up with opening gesture.
2) The trade mark legs are close together.	2) The trade mark legs are open wide.
3) The trade mark with facial features, the eyes and nose.	3) The trade mark in silhouette without any facial features.
4) The trade mark is void or mostly void of any colours within the sign.	4) The trade mark is filled with solid colours within the sign.
5) The trade mark's feet is more rounded.	5) The trade mark's feet is pointed and facing upward.
6) The trade mark ear is more horizontal positioned.	6) The trade mark ear is higher to the top position.
7) The trade mark profile is more slim line looking.	7) The trade mark profile is more wider.

11. The Applicant also tendered the following entries on the Trade Marks Register as maintained by the Intellectual Property Office of Singapore as evidence that there are other "sitting bear" marks in relation to the goods in class 25:



MC BOARD



Classic Teddy

12. The Applicant also tendered the results of a survey carried out by him as evidence to support his case. There were 81 participants in the Applicant's survey. As stated in the Applicant's statutory declaration, the breakdown is as follows:

- a. More than 82% responded that both trade marks do not bear any similarity
- b. More than 87% think they will not be confused with the marks
- c. More than 86% think that the Applicant's mark is not trying to pass off as the Opponents' mark
- d. More than 93% think that both marks have distinctive differences

13 Through the statutory declaration of Loo Sooi Wan, the Applicant's evidence is that the Applicant had shown Loo Sooi Wan, a Sales Executive who worked directly under him, drawings of his design when he was in the process of developing a mark that he could use for his goods.

Applicable Law and Burden of Proof

14 The applicable law is the Trade Marks Act (Cap 332, 2005 Revised Edition) (hereinafter, “the Act”) and the burden of proof in an opposition under section 8 of the Act is on the Opponents. *Kerly’s Law of Trade Marks and Trade Names 14th Edition* on UK’s Trade Marks Act 1994 which has provisions in pari materia with ours, at paragraph 9-164 states:

“There is no overall onus on the applicant either before the Registrar or in opposition proceedings. And so when an opponent raises objections under section 5 of the 1994 Act [which corresponds to section 8 of our Trade Marks Act] he must make them out.”

MAIN DECISION

Grounds of Opposition

15 At this juncture, it would be useful to set out in full the relevant provisions of the Act that are relied upon as grounds of opposition and that will be referred to in this decision. Section 8(2)(b) reads:

“Relative grounds for refusal of registration

8. —(1) ...

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected; or

(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.”

Section 8(4)(a) read with section 8(4)(b)(i) reads:

“Relative grounds for refusal of registration

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; or”

Section 8(7)(a) reads:

“Relative grounds for refusal of registration

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;”

Opposition under section 8(2)(b)

Opponents’ submissions

16 The Opponents submitted that the relevant test to be applied is that stated by the Court of Appeal in *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2006] 2 SLR(R) 690. Based on the test, the Opponents need to show that the 2 marks are similar, and that the goods are similar and that, on account of such similarities, there exist a likelihood of confusion. On similarity of marks, the Opponents cited the case of *MediaCorp News Pte Ltd v Astro All Asia Networks PLC* [2009] 4 SLR(R) 496 for the proposition that in the case of device marks, visual similarity will usually be the most important factor. From *Kerly’s Law of Trade Marks and Trade Names (14th Edition)* at paragraphs 17-028 and 17-029, it is also that in cases of device marks, especially, it is helpful before comparing the marks to consider what are the essentials of the claimant’s [Opponents] device.

17 The Opponents also contended that the question is not whether if a person is looking at two trade marks side by side there would be a possibility of confusion. Rather, the question is whether the person who sees the proposed trade mark in the absence of the other trade mark, and in view only of his general recollection of what the nature of the other trade mark was, would be liable to be deceived and to think that the trade mark before him is the same as the other, of which he has a general recollection. The Opponents also cited the case of *Caterpillar Inc v Ong Eng Peng (formerly trading as Catplus International)* [2006] 2 SLR(R) 669 where our High Court applied the test that marks must be assessed as wholes, taking into account imperfect recollection.

18 The Opponents also cited as examples 5 rather old cases and 6 more recent cases, all UK cases, which involved device marks that have been found to be similar as illustrations.

19 On aural similarity, the Opponents submitted that both marks would be described as either “BEAR” or “TEDDY BEAR” marks and thus, are aurally similar. On conceptual similarity, the Opponents cited the case of *MediaCorp News Pte Ltd v Astro All Asia Networks PLC* [2009] 4 SLR(R) 496 wherein the High Court at 514 said that, “the analysis of conceptual similarity will have to be done from the viewpoint of the consumer” and that in that case, “what the consumers will likely conceptualise from seeing both marks is ...a triangular device...similar in form and colour...Furthermore, both marks were devoid of any semantic or symbolic content or meaning that could lead the consumer to distinguish the two marks conceptually.” The Opponents submitted that in this case, both the Application Mark and the Opponents’ “TOUS BEAR” mark are obvious and straightforward representations of a teddy bear in a sitting position and as

such, the average consumer is likely to take away the same impression when encountering both marks. Thus, the 2 marks in question are also conceptually similar.

20 The Opponents contended that their “TOUS BEAR” mark is very distinctive and therefore, applying the test laid down by the High Court in *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd [2005] 4 SLR(R) 816* and *Newmans Chocolate Ltd v Societe Produits Nestle SA [2003] SGIPOS 2* – that a more distinctive mark generally receives greater protection as the distinctiveness will result in the differences between the compared marks being insufficient to negate the strong similarities.

21 On similarity of goods, the Opponents submitted that the test is that laid down in *Johnson & Johnson v Uni-Charm Kabushiki Kaisha (Uni-Charm Corp) [2007] 1 SLR(R) 1082* and applying this test, given the identity or overlap of the respective goods claimed, the uses, users, physical nature of the goods, as well as the trade channels through which the goods reach, the market will be same.

22 On likelihood of confusion, the Opponents submitted the decision of *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd [2006] 2 SLR(R) 690*, where our Court of Appeal held that “to determine the existence of confusion, the court is entitled to look outside the mark and the sign, as well as the articles to assess whether there is a likelihood of confusion.” The Opponents submitted that the goods in question are purchased by a very broad spectrum of the public and the average consumers of the goods will be ordinary retail customers. In particular, consumers of the Opponents’ goods will be specifically looking out for a simple bear device in a sitting position. As such, the average consumer would find the Application Mark, which similarly consists of a simple bear device in a sitting position, to be confusingly similar to the Opponents’ mark. The Opponents’ mark is often used as part of the designs of intricate jewellery and trinkets, or as small charming prints on the Opponents’ various products. The Opponents submitted that the use of the Opponents’ “TOUS BEAR” mark in small dimensions or in slightly contorted forms in practice blurs the differences between the Application Mark and the Opponents’ mark. As the Applicant did not tender any evidence of use of the Application Mark, the Opponents submitted that notional use on all the goods specified in the application must be assumed and based on such notional use in a normal and fair manner, the presentation, marketing and promotion of the Applicant’s goods are likely to be carried out in the same manner as that of the Opponents as well. The Opponents contended that taking all circumstances into account, there exists a likelihood of confusion on the part of the public.

Applicants’ submissions

23 The Applicant submitted that the fact that the marks are conceptually similar is not a strong factor in the overall analysis as to whether the marks are similar. The Applicant listed 7 distinctive and strong physical differences as detailed in paragraph 10 above. The Applicant also submitted that based on the results of the survey conducted by him, there is no likelihood of confusion among the public. The Applicant cited the case of *Goldlion Enterprises (Singapore) Pte Ltd v Baume & Mercier SA [2005] SGIPOS 10*

for the principle that “*The likelihood of confusion must be appreciated globally, taking into account of all factors relevant to the circumstances of the case. The global appreciation of 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 component*”. On the basis of this principle, the Applicant submitted that there is no likelihood of confusion amongst the public as the marks are physically and visually very different.

24 The Applicant also submitted that there are other registered marks comprising of a bear design in a sitting position (as detailed in paragraph 11 above). The Applicant’s contention is that this points to the fact that therefore, the Opponents’ conclusion that the Application Mark is similar to the Opponents’ “TOUS BEAR” mark simply because the Application Mark also consists of a bear device in a sitting position cannot be supported.

Decision on section 8(2)(b)

25 The test enunciated by the Court of Appeal in *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd [2006] 2 SLR(R) 690 (“Polo”)* at [8] is applicable where an opposition is lodged under section 8(2)(b). Three conditions must be present before the Application Mark is to be refused registration under section 8(2)(b) of the Act. First, the Application Mark must be shown to be similar to the Opponents’ earlier trade mark (which as defined in section 2 of the Act, refers to the earlier registrations of the



Opponents for the mark, , in T0315786Z, T0315787H, T0315788F in classes 14, 18 and 25 respectively). Second, both the Application Mark and the Opponents’ earlier trade mark must be used in relation to similar goods. Third, on account of the presence of the first two conditions, there exists a likelihood of confusion on the part of the public. On the first condition, the decided cases show there are three aspects to similarity: visual, aural or phonetic, and conceptual. I will therefore look in turn at the visual, aural and conceptual similarities, if any, between the Application Mark and the





Opponents’ earlier trade mark, , bearing in mind that similarity is a matter of degree. On comparison of similarity of marks, the High Court in *MediaCorp News Pte Ltd v Astro All Asia Networks PLC [2009] 4 SLR(R) 496 (“MediaCorp”)* at [32] had this to say, “*However, it is clear that the law does not require all three similarities to be made out before the finding that the marks are similar can be made. Instead, the relative importance of each factor will depend on the circumstances at hand, in particular, the goods and the types of marks involved (Bently and Sherman, Intellectual Property Law (Oxford University Press, 3rd Ed, 2009) (“Bently”) at p864). Conversely, the fact that one similarity is made out does not necessarily mean that the marks are similar. Indeed, regard should be had to the type of marks concerned. In the present case, given that both marks are device marks, visual similarity will be the most important factor...*” (emphasis mine).


Visual Similarity

26 Both the Application Mark and the Opponents' earlier trade mark (T0315786Z, T0315787H, T0315788F in classes 14, 18 and 25 respectively) consist of the device of a bear, and specifically, a teddy bear. Visually, the Opponents' earlier trade



mark,  consists of a unique design of a teddy bear with rather distinctive and memorable features such as facial features comprising of three dots and chubby, short

lower limbs. The overall impression of the Opponents' earlier trade mark, , that of a cute, bloated-bodied creature that, whilst it immediately strikes you that he is a teddy bear, you remember that he is a unique sort of teddy bear with distinctive and memorable features. The shaded, "bloated body" of the Opponents' teddy bear in the Opponents' earlier registrations also gives it a three-dimensional appearance.

27 The Application Mark,  appears flatter and two-dimensional. It is also a silhouette and has no facial or bodily features. The shape of the teddy bear in the Application Mark is also the more common shape usually adopted for the drawing of teddy bears with outspread upper and lower limbs. In fact, whilst the Opponents' earlier mark is easily recognisable as a unique sort of bear, the Application Mark is less so, partly because, the Application Mark is a silhouette without features.

28 On the whole, I find that the Application Mark and the Opponents' mark are visually dissimilar and distinguishable from each other.

Aural and Conceptual Similarity

29 Both marks consist of the idea of a teddy bear and will be referred to as the "teddy bear" marks by consumers and the general public. Thus, it is undisputed that the two marks are conceptually similar as well as aurally similar (considering that both marks will be called the "teddy bear" marks).

Overall

30 However, as both marks are device marks, and as stated by the High Court in "*MediaCorp*", aural and conceptual similarity between the two marks is not the most important factor. Whether the marks are on the whole similar or not will depend more on their visual similarity. As I have found above, the marks are visually dissimilar. Therefore, overall, the marks are dissimilar.

Similarity of Goods

31 The test to see if the goods are similar is that as held in ***British Sugar plc v James Robertson & Sons Ltd [1996] RPC 281 (“British Sugar”)*** at 296 which has been followed in all our local cases. The following factors may be used to assess if the goods are similar:-

- (a) the respective uses of the goods;
- (b) the respective users of the goods;
- (c) the physical nature of the goods;
- (d) the trade channels through which the goods reach the market;
- (e) for self-serve consumer items, whether in practice they are found or likely to be found, in particular, on the same or different shelves; and
- (f) the extent to which the respective goods are competitive.

32 For ease of reference, the goods to be compared by class are as follows:

Class	Application Mark	Opponents’ Earlier Trade Mark in T0315786Z, T0315787H, T0315788F
14	Goods made of precious metals, their alloys or plated therewith, in particular, ornamental objects, boxes and cases, powder compacts; jewellery, jewellery articles (including fashion jewellery) in particular rings, rings for keys, rings, earrings, cufflinks, bracelets, charms, brooches, chains, necklaces, tie pins, ornamental pins, medallions; timepieces and chronometric instruments including watchstraps, watches, wristwatches, pendulum clocks, pendulettes, alarm clocks, caskets and cases for timepieces.	Precious metals and their alloys and goods made of these materials or coated therewith not included in other classes; jewelry, precious stones; timepieces and chronometric instruments.
18	Leather and imitation leather; travelling bags, travelling sets (leather goods), trunks and suitcases, garment bags for travel purposes, vanity	Bags, wallets and key holders of leather.

	cases, backpacks, shoulder bags, handbags, attache cases, document holders and briefcases of leather, clutch bags, wallets, purses, key cases, card cases; umbrellas.	
25	Clothing and underwear including sweaters, shirts, tee-shirts, lingerie, belts (clothing), scarves, neckties, shawls, vests, skirts, raincoats, overcoats, suspenders, trousers, denim trousers, pullovers, dresses, jackets, sashes for wear, gloves, tights, socks, bathing suits, bath robes, pajamas, nightshirts, shorts, pockets (clothing); shoes, boots, slippers; headgear.	Clothing, footwear, headgear and belts (clothing).

33 The Applicant's goods are wider and the Opponents' goods are encompassed within the specification sought by the Applicant. It is clear that the goods overlap. Applying the relevant factors to the instance case:-

- (a) In all three classes, the goods of the Applicant and the Opponents have the same or similar uses.
- (b) In all three classes, the goods of the Applicant and the Opponents will share the same group of users, namely, general consumers or the common public.
- (c) In all three classes, the physical nature of the goods of the Applicant and the Opponents is the same.
- (d) In all three classes, there will be a variety of trade channels through which the goods can reach the market, for example, through departmental stores or through speciality or general retail shops. In any event, the trade channels for the goods are the same or similar.
- (e) The goods in Classes 18 and 25 are self-serve consumer items and the Applicant's goods and Opponents' goods are likely to be found on the same shelves.
- (f) Based on the specification sought, the goods are competitive.

34 Applying the test in "**British Sugar**" for the assessment as to whether the goods are similar, there is no doubt that the Applicant's and Opponents' goods are very similar as seen above.

Likelihood of Confusion – Taking into account all the circumstances of the case

35 Section 8(2)(b) requires that the likelihood of confusion has to arise from the identity or similarity between the Application Mark and the Opponents' earlier trade mark as well as from the identity or similarity between the goods. As I have found that the Application Mark and the Opponents' earlier trade mark are not visually similar and not similar on the whole, although the marks are used on goods which are similar, there is no likelihood of confusion. The Court of Appeal in **"Polo"** states, *"First, the alleged offending sign must be shown to be similar to the registered mark. Second, both the sign and the mark must be used in relation to similar goods or services. Third, on account of the presence of the first two conditions, there exists a likelihood of confusion on the part of the public...,if either of the first two conditions is not satisfied there will not be any need to go into the third question of determining whether there exists a likelihood of confusion."*

36 In the event that I am not correct in finding that the Application Mark and the Opponents' earlier trade mark are dissimilar, it is still a fact that no likelihood of confusion can arise. I will use the circumstances listed in **"Polo"** to show this. In **"Polo"** at [28], it was held that:

*"...the question of likelihood of confusion has to be looked at globally taking into account all the circumstances including **the closeness of the goods, the impression given by the marks, the possibility of imperfect recollection and the risk that the public might believe that the goods come from the same source or economically-linked sources...**Steps taken by the defendant to differentiate his goods from those of the registered proprietor are also pertinent...So also is the kind of customer who would be likely to buy the goods."*

37 I now turn to the circumstances at hand. Firstly, the closeness of the goods is not an issue; it is undisputed that there is similarity of goods. With respect to the impression given by the marks, the overall impression given by the marks is different. One is a three-dimensional and a unique teddy bear shape with facial and bodily features. The other is a flatter, two-dimensional silhouette and a more common teddy bear shape. The impression given by the two marks is very different.

38 As for the risk that the public might believe that the goods come from the same source or economically-linked sources, the risk is very low. It is noted that all three classes of goods are general consumer goods that cater to a wide sector of the public. For this type of goods, it is common to see the shapes or devices of teddy bears being used as a trade mark or as ornaments, motifs or prints (for clothing for example) or as clasps or buttons (for wallets for example). It is also common to see the different shapes or devices of teddy bears being used as charms or pendants in jewellery items or as part of the design of intricate jewellery and trinkets. This could be due to the fact that teddy bears are generally seen as adorable creatures that appeal to a wide spectrum of consumers, especially children, girls, and women. Given such circumstances, consumers of such goods are already inundated with all the different types, shapes and designs of teddy bears that are being used in connection with such goods in the three classes concerned. As consumers are used to seeing the device of teddy bears being used in one form or other, either as a trade source or as design items, they would be more discerning when it

comes to identifying or differentiating one teddy bear device from another and thus, may not be so easily confused between one teddy bear shape and another. That is to say, consumers who are used to seeing the device of teddy bears being used in relation to such goods would look out for the differentiating features of one teddy bear device from another and thus, would be able to identify one teddy bear device from another and not be confused.

39 An independent search of our Register of Trade Marks by me reveals the following marks:



(i) (T0512433J)

in Class 25, in respect of, “Clothing, footwear, headgear, pants, shorts, sweatpants, overalls, shirts, tee-shirts, sweatshirts, blouses, jackets, vests, coats, rainwear, shoes, lingerie, sleepwear, underwear, swimwear, gloves, socks, hosiery, belts, scarves, hats, ties, and slippers.”



(ii) (T0907205Z)

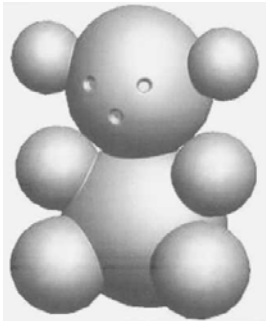
in Class 25, in respect of, “Aprons (clothing); caps (headwear); clothing; clothing for gymnastics; gloves (clothing); hats; jumpers (shirt fronts); pants; shirts; shoes; socks; sweaters; trousers; underclothing; uniforms.”



(iii), (iv), (v) (T0615678C, T0901255C, T0615677E)

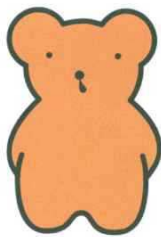
in Class 25, in respect of, “Clothing, Footwear, Headgear”; and
in Class 14, in respect of, “Horological and chronometric instruments, namely, wristwatches, pocket watches, clocks, table watches, digital watches, chronographs, chronometers, watch bands, watch cases, watch chains made of precious metals; jewellery and custom jewellery, namely, chains, necklaces, bracelets, rings, pendants, brooches, earrings, medals, cuff links, tie clips.” and

in Class 18, in respect of, “Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.”



(vi) (T0915414E)

in Class 14, in respect of, “Precious metals and their alloys and goods made of or coated with these materials not included in other classes; jewellery, precious stones; timepieces and chronometric instruments.”



(vii) (T0307201E)

in Class 18, in respect of, “Leather and imitations of leather and goods made of these materials”



(viii) (T0306323G)

in Class 18 in respect of, “Leather and imitations of leather and goods made of these materials”

With the exception of mark (vi) which is still a pending application, all the above marks are registered. As can be seen, these are marks that comprise different shapes and devices of a teddy bear. Notwithstanding that the marks all consist of a device of a teddy bear, they are all either being or are registered as different trade sources and belonging to different entities. It is also obvious that each teddy bear device in the list of marks above is distinguishable from and therefore dissimilar to another. The list shows that no one trader monopolises the device of a teddy bear as a trade source. The list also shows that

as long as a particular device of a teddy bear in question has differentiating features that makes the teddy bear device different from the other teddy bears on the register such that there is no confusion amongst consumers as to the trade source of the goods, and the device is capable of distinguishing the goods in question, it can be registered.

40 Thus, whether from common knowledge or from the Register, it is clear that the device of a bear or a teddy bear is quite commonly used either as a trade mark or as an element (ornament, motifs, charms) as far as trade in goods such as those in Classes 14, 18 and 25 are concerned. Thus, consumers, being inundated with all forms or shapes of teddy bears, will be looking out for the more unique features that will set one teddy bear apart from the others. Given that the Opponents' "teddy bear" has its own unique and distinctive features, consumers will remember it differently from the Applicant's teddy bear, even with imperfect recollection. Consumers who are inundated with marks that bear the shape of a teddy bear will exercise a little more care when purchasing goods such as clothing, accessories, jewellery items such as bracelets, handbags, vanity cases and such other goods in the three classes of goods concerned. The ordinary consumer would not be quick to draw the conclusion that the goods with different-looking "teddy bear" marks come from the same commercial undertaking simply because the concept of a teddy bear is used in the marks. In conclusion, I am of the view that the risk that the public might believe that the goods come from the same source or economically-linked sources is extremely low, if not non-existent. The Opponents have not been able to discharge their burden of showing that there is a real likelihood of confusion between the Application Mark and the Opponents' earlier trade mark.


41 The co-existence of the different "teddy bear" or "bear" trade marks on the Register also shows that the registration of one bear shape should not block the registration of another bear or teddy bear shape that is different. The Court of Appeal in "**Polo**" at [11] quoted the trial judge with approval, "*It is settled that the courts are wary of allowing companies to monopolise words that are either purely descriptive or used in everyday parlance...*". Applying the same rationale, given that the shape or device of a bear or a teddy bear is commonly used in the trade, one must be wary of allowing companies to monopolise the teddy bear shape at the expense of all the other "teddy bear" shapes that are different. The fact remains that the "teddy bear" in the Application Mark is visually different from the "teddy bear" in the Opponents' earlier trade mark.


42 Having considered all the circumstances above, I conclude that it is unlikely that there would be a real likelihood of confusion amongst the relevant consumers as to the source of the Applicant's goods if the Application Mark was allowed to proceed to registration.

43 Accordingly, the opposition under section 8(2)(b) fails.

Opposition under section 8(4)(a) and 8(4)(b)(i)

Opponents' submissions

44 The Opponents submitted that their mark,  or its variants such


 as, is well known in Singapore. The relevant factors in determining whether a trade mark is well known in Singapore are found in section 2(7) of the Act. On the factor concerning the degree of knowledge or recognition of the Opponents' mark, the Opponents argued that they had received prominent recognition and numerous awards in relation to its products and development including the Internationalisation Year 1999 and Internationalisation Year 2000 Awards. The Opponents were also shortlisted by "Europa 500" as one of the 500 best enterprises in 2000. The Opponents have also chosen well known personalities such as Kylie Minogue to be the Opponents' spokesperson. On duration, extent and geographical area of use and promotion of the Opponents' mark, the Opponents claimed that they have been using the Opponents' mark worldwide since 1985 and in Singapore since 2002. The Opponents also have extensive international presence in more than 300 points of sale worldwide. In particular, the Opponents have numerous retail stores in Hong Kong, Japan, Korea and China and an online "TOUS" shop in the United States, Puerto Rico and Canada. The value of sales worldwide in relation to products bearing the Opponents' mark ranges from more than \$37million in 2000 to more than \$78million in 2002. In addition, the Opponents own numerous applications and registrations for the Opponents' mark in numerous jurisdictions including Austria, Belgium, Brazil, Denmark, Hong Kong, Spain, Italy, Japan, China, Korea, Switzerland and so forth. The Opponents have also instituted a number of legal suits in several countries worldwide to protect the Opponents' mark. In particular, the Opponents' mark was held to be well known by the Intellectual Property Office in Taiwan.


Applicants' submissions

45 The Applicant did not make any specific submission related to the ground of opposition under section 8(4)(a) read with section 8(4)(b)(i).

Decision on section 8(4)(a) read with section 8(4)(b)(i)

46 In addition to the registered mark  in the relevant classes, the Opponents

claimed that the following 2-dimensional, line-drawing of the bear device  also belongs to them and for the opposition under section 8(4)(a) read with section 8(4)(b)(i),

both marks would be relevant for consideration as to whether the Opponents'  or






mark is well known in Singapore. Section 8(4) states:



“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;


47 First, the whole or an essential part of the Application Mark has to be identical

with or similar to the Opponents'  or  mark (earlier trade mark). On this requirement, I have already found above that the Application Mark is not similar to the

Opponents'  mark (which is the relevant earlier trade mark) under section

8(2)(b). As both the Opponents'  and  are the same in terms of their “look and feel”, the same conclusion that I have reached in relation to the mark,

 also applies to the mark, . That is to say, the Application Mark is also

not similar to the Opponents'  mark. Having reached this conclusion, strictly speaking, the ground of opposition under section 8(4)(a) read with section 8(4)(b)(i) can be disposed of right away since the important condition of similarity is not even met. However, for completeness, I will now turn to examine the other requirements under this ground of opposition.

48 In assessing whether a trade mark is “well known in Singapore”, the matters in Section 2(7) may be relevant. Section 2(7) 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.

49 It is clear that the factors listed in section 2(7) above are not an exhaustive list as Section 2(7) makes it explicit that it shall be relevant to “take into account **any** matter from which it may be inferred that the trade mark is well known”. The Court of Appeal in *Novelty Pte Ltd v Amanresorts Ltd and Another [2009] SGCA 13 (“Amanresorts case”)* at [137] said that the court is ordinarily free to disregard any or all of the factors listed in section 2(7) as the case requires (subject to one particular factor which will be elaborated on later), and to take additional factors into consideration. Thus, it is clear that the factors in Section 2(7) (with the exception of the factor in section 2(7)(a) which has a deeming effect in section 2(8)) are merely a set of guidelines to assist the Registrar in determining whether the mark is a well known trade mark. Section 2(7)(a), however, has a special effect. This is because of section 2(8) which states that, “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.”

50 With the above analysis as to the operation of our legislative provisions as regards “well known trade marks”, it shall first be considered as to the “degree to which [the



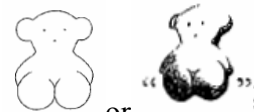
Opponents’ or [mark] is known to or recognised by any relevant sector of the public in Singapore”. As stated in the *“Amanresorts case”* at [140], once it is determined that the trade mark in question **is well known to “any relevant sector of the public in Singapore”** (emphasis mine), the deeming provision in section 2(8) kicks in and **the mark is deemed to be well known in Singapore**. In section 2(9), “relevant sector of the public in Singapore” in section 2(7) and 2(8) 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;

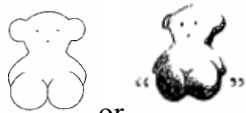
(b) all persons in Singapore involved in the distribution of the goods or services to which the trade mark is applied;


(c) all businesses and companies in Singapore dealing in the goods or services to which the trade mark is applied.

As for the ambit of “all actual consumers and potential consumers in Singapore of the goods”, the “*Amanresorts case*” has settled this issue as “the actual consumers and potential consumers of, specifically, the *Opponents’* goods only (see [142] to [154], specifically, [154]). Applying the law to the facts of this case, the relevant sector of the public would be actual and potential consumers in Singapore of the *Opponents’* goods in Classes 14, 18 and 25. As found above, as these goods are general consumer goods, the relevant sector of the public will be your ordinary member of the public and the distributors of such goods and other businesses and companies dealing in such goods.

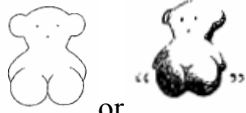



The question I have to ask is, is the *Opponents’* trade mark,  or  well known to this “relevant sector of the public”? And the relevant point in time to determine this question is as at the date of 15 October 2007, the date of application for registration of the Application Mark. If the answer is yes, then the *Opponents’*

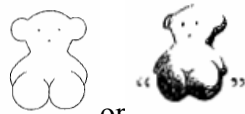



or  mark is deemed to be well known in Singapore.

51 Other than the mere fact of registrations of the *Opponents’*

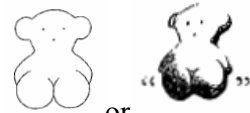



or  mark in various classes of goods and services (classes 3, 21, 16, 20, 28, 35, 9, 14, 18, 25) in Singapore, the oldest registration being since 2003, the evidence submitted by the *Opponents* did not point to the degree to which the mark is well known to the relevant sector of the public in Singapore. Thus, it is not possible to determine the

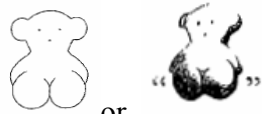


degree to which the *Opponents’* or  mark is well known to the relevant sector of the public in Singapore and therefore the deeming effect in section 2(8) does not apply here.

52 I now turn to the guidelines listed in section 2(7)(b)-(e). On the duration, extent

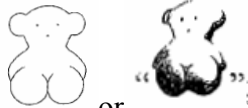


and geographical area of the use of the *Opponents’* or  mark, the evidence shows that the *Opponents* have commenced sale of their goods bearing the

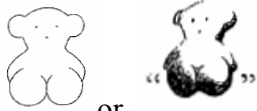


Opponents’ or  mark in Singapore since 2002. The *Opponents’* mark

was initially used on jewellery products. The Opponents have since expanded its use of the said mark to other goods such as bags, small leather articles, gloves, shawls, glasses, perfumes, chinaware and watches. The Opponents submitted worldwide sales figures for 3 years, from 2000 to 2002. But, beyond this limited period, there were no available sales figures. In fact, there were no available sales figures applicable to Singapore and in particular, such sales figures since 2002. On the promotion of the Opponents'



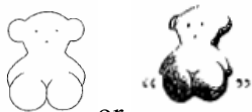
or mark, the evidence shows that the Opponents have conducted advertising, marketing and public relations campaigns for the Opponents' mark in international magazines such as Italian Vogue, Ronda Iberia and Fortune Magazine as well as in various Spanish, Japanese, Korean, Mexican, German and Portuguese publications. One point to note is that there is no specific evidence that points to



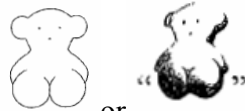
promotion of the Opponents' or mark in Singapore or elsewhere but which shows the impact in Singapore. On the registration of the Opponents'



mark, it is noted that the Opponents' registrations in Classes 14, 18 and 25 were lodged in 2003. Other than Singapore, the Opponents have applications and registrations



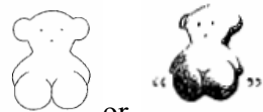
for the Opponents' or mark in about 49 jurisdictions. However, there is little information as to how long these registrations have been, except that the mark has been in use elsewhere other than Singapore since 1985. As for enforcement of rights by



the Opponents in relation to the Opponents' or mark, the information we have is that the Opponents' mark has been found to be well known by the Intellectual Property Office in Taiwan.





53 On the whole, I am not convinced that the Opponents' or mark is well known in Singapore. The evidence is skimpy and does not point to extensive use of the mark in Singapore or elsewhere with impact on Singapore since the launch elsewhere in 1985 and in Singapore in 2002. The mere fact of registrations in Singapore




since 2003 (7 years ago) does not point to the Opponents' or mark being well known in Singapore. The evidence of the numerous applications and

registrations outside of Singapore are not directly relevant to show the Opponents' mark's recognition in Singapore. All in all, the Opponents have not discharged their

burden of proving that their  or  mark is well known in Singapore.

54 Again, the above would be sufficient to dispose of the opposition under section 8(4)(a) read with section 8(4)(b)(i). For completeness, however, I will move on to the other elements that need to be established under this ground, namely, whether use of the Application Mark on the goods sought to be registered would indicate a connection between the goods claimed and the Opponents and whether the interests of the Opponents are likely to be damaged as a result. The Court of Appeal in "*Amanresorts*" at [234] held that the tests to be adopted for the purposes of the "connection" requirement and the "likely to damage the [plaintiff's] interests" requirement would yield the same results as those obtained from applying the corresponding tests vis-à-vis the claim for passing off which are, whether the "Applicant" has made a misrepresentation to the relevant sector of the public...which causes that section of the public to mistakenly think that the goods have the same source as or is connected with the Opponents' goods, and whether such misrepresentation has resulted in or is likely to result in damage to the interests of the


Opponents. As I have found the Application Mark and the Opponents'  mark to be dissimilar and that there is no likelihood of confusion, my conclusion is also that it is unlikely that potential customers would be misled into thinking that the Applicants' goods originate from the Opponents or that there is some connection between the two parties. Consequently, there is also no likelihood that the interests of the Opponents would be damaged as a result.

55 Accordingly, the ground of opposition under section 8(4)(a) read with section 8(4)(b)(i) fails.

Opposition under section 8(7)(a)

Opponents' submissions

56 In addition to the registered mark  in the relevant classes, the Opponents

claimed that the following 2-dimensional, line-drawing of the bear device  also belongs to them and for the opposition under section 8(7)(a), the Opponents rely also on this 2-dimensional mark. The Opponents submitted that the elements required in establishing passing off is set out in the High Court decision of *Johnson & Johnson v*

Uni-Charm Kabushiki Kaisha [2007] ISR(R) 1082 (“Johnson”) and they are: (a) that the “Opponents” goods have acquired goodwill or reputation in the market and are known by some distinguishing feature; (b) that there is a misrepresentation by the “Applicant” (whether or not intentional) leading or likely to lead the public to believe that goods offered by the “Applicant” are goods of the “Opponents”; and (c) that the “Opponents” have suffered or is likely to suffer damage as a result of the erroneous belief engendered by the “Applicant’s” misrepresentation.

57 The Opponents submitted that both the Application Mark and the Opponents’ mark consist of a teddy bear in a front-facing sitting position. The Opponents said they have shown that they have used their mark on a wide range of products including jewellery, necklaces, rings, bangles, earrings, silver ornaments and cases, porcelain items and ornaments, watches, clocks, powder compacts, makeup cases, bags, travel accessories, small leather articles, document bags and holders, gloves, shawls, glasses, perfumes, chinaware, leather goods, trunks, suitcases, wallets, key and card cases, mobile phone cases, ties, sunglasses, spectacle frames, belts, ski equipment, clothing, textile, shoes, headgear, gloves, pens, writing instruments, household items including cups,



dishes, couches and mirrors and that goods bearing both the Opponents’



mark have been sold in Singapore since 2002. The Opponents claimed that as a result of such use, they have goodwill and reputation in their business under both the



or



mark.

58 On the next element of misrepresentation, the Opponents cited “**Polo**” at [23] for the proposition that : “In a passing-off action, the requirement of misrepresentation is satisfied if there is a finding that ordinary sensible members of the public would be confused.” The Opponents submitted that the Application Mark and the Opponents’ mark are confusingly similar and that both the Applicant’s and the Opponents’ goods are similar. On the basis of similarity of the marks and goods, the Opponents submitted that potential customers are likely to be misled into thinking that the Applicant’s goods originate from the Opponents or that there is some connection between the parties and therefore, the element of misrepresentation is made out.

59 On the element of damage, the Opponents cited the Court of Appeal case of **Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd [1991] 1 SLR(R) 903 (“Tong Guan”)** at [31] for the proposition that : “If the goods in question are in direct competition with one another, the court will readily infer the likelihood of damage to the “Opponents’” goodwill, not merely through loss of sales but also through loss of the exclusive use of his name or mark in relation to the particular goods or business

concerned.” The Opponents submitted that as the goods and marks are similar, damage can be presumed. The Opponents’ case is that, as all the elements of passing off are made out, registration of the Application Mark would be contrary to section 8(7)(a).

Applicants’ Submissions

60 The Applicant did not make any specific submissions on the ground of opposition under section 8(7)(a).



Decision on section 8(7)(a)



61 It is accepted that the common law action of passing off comprises the following three limbs of (i) goodwill; (ii) misrepresentation; and (iii) damage. In particular, each limb has been succinctly elaborated in the case of “*Johnson*” which followed *WILD CHILD Trade Mark [1998] RPC 455* as follows:-



- (i) that the *Opponents’* goods have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (ii) that there is misrepresentation by the *Applicant* (whether or not intentional) leading or likely to lead the public to believe that goods offered by the *Applicant* are goods of the *Opponents*; and
- (iii) the *Opponents* have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the *Applicant’s* misrepresentation.

Goodwill



62 It is clear that passing off protects a person’s business or goodwill and not the mark used. The mark is only a tool used by the person to educate his customers to identify the goods that originate from his business. While this is so, the role of the mark is crucial when proving the element of goodwill. As stated in the *Law of Intellectual Property of Singapore, Rev Ed, Ng-Loy Wee Loon*, Chapter 17 at paragraphs 17.1.1 – 17.1.4, this is because the test which has been used by the courts to determine whether a person’s business has goodwill is whether the mark adopted by him has become *distinctive of his goods* in the sense that it is *associated or identified exclusively with his*

goods. In this case, the Opponents have used the Opponents’  or  mark

in Singapore since 2002. The Opponents’  or  mark is also used in a wide range of goods. The sales volume and amount of advertisement under the

Opponents’  or  mark is not insubstantial. The simple conclusion is that

the Opponents have shown that there is goodwill associated with the Opponents' business

through the Opponents'  or  mark.

63 I turn now to see if the element of misrepresentation is made out.



Misrepresentation

64 The key element for misrepresentation is deception. The main issue to be resolved is whether the *Applicant* had made a false representation that led to or is likely to lead to deception or confusion amongst the public. The nature of the deception or confusion may relate to the trade source of the goods. Although the key element is deception, it is not necessary to prove that the *Applicant* has an intention to deceive or mislead the public. It has been said that the state of the mind of the *Applicant* is immaterial but rather what matters is the *impact on the persons to whom the misrepresentation is addressed* (see ***Law of Intellectual Property of Singapore, Rev Ed, Ng-Loy Wee Loon***, Chapter 18 at paragraph 18.0.1)

65 The misrepresentation in this instance is that the use of the bear device mark,



by the Applicant constitutes a misrepresentation in that:- the public may be misled into thinking that the goods provided by the *Applicant* share the same source as the Opponents' goods; or that the goods of the Applicant are connected to the Opponents. The Opponents' case is that there is misrepresentation because the

Application Mark and the Opponents'  or  mark are confusingly similar since the marks consist of a teddy bear design in a front-facing sitting position.

66 As I have already concluded above that the marks are not similar and that there is no likelihood of confusion amongst the public that the Applicant's goods and the Opponents' goods originate from the same source, I am unable to find that there is misrepresentation. Indeed, in considering the impact on members of the public, it is to be noted that it is unlikely that the public would be deceived since members of the public are used to seeing with marks comprising the device of teddy bears in many different forms, shapes and designs. The public would look out for the differentiating features of each teddy bear device used as a trade mark and are not likely to be easily deceived into thinking the different "teddy bears" come from the same source.

67 I conclude that the Opponents have not discharged their burden of proving that the element of misrepresentation, a key element to a claim of passing off, has been made out.

Damage

68 As the element of misrepresentation for the action for passing off is not made out, it is not necessary for me to consider if damage is made out in this instance. In any case, there would be no damage since it is not proven that there is misrepresentation.

69 Accordingly, the opposition under section 8(7)(a) also fails.

Conclusion

70 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.

71 Accordingly, Trade Mark Application T0720701B shall proceed to registration.

72 There remains the question of whether costs can be awarded to the Applicant who was not represented by counsel. I would refer to the *Halsbury's Laws of Singapore, Volume 4, Civil Procedure* at [50.680] for the definition of "costs". In there, "costs" is defined as including, "fees, charges, disbursements, expenses and remuneration". At [50.681], it is made clear that the courts have full discretion to deal with costs. Specifically, at [50.712], it is stated that a litigant in person may be awarded costs of an amount that would reasonably compensate him for the time expended by him on the litigation, together with all expenses reasonably incurred. Thus, on the issue of costs, following the general principles just stated, the Registrar has the discretion to award costs to the Applicant despite the fact that he had no legal representation throughout the proceedings. In the circumstances, as the Applicant is the successful party, costs, to be taxed if not agreed, is awarded to the Applicant.

Dated this 25th day of June 2010

Lee Li Choon
Principal Assistant Registrar
Hearings and Mediation Division
Intellectual Property Office of Singapore