

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

Trade Mark Application Nos. T03/12742A and T03/12744H

15 May 2008

**IN THE MATTER OF AN APPLICATION BY
ASTRO ALL ASIA NETWORKS plc
TO REGISTER TRADE MARKS
IN CLASSES 16 and 35**

And

**OPPOSITION THERETO BY
MEDIACORP NEWS PTE LTD**

Hearing Officer: Anne Loo
Principal Assistant Registrar

Mr Colin Phan (Messrs Gateway Law Corporation) instructed by Messrs Ella Cheong Spruson & Ferguson (Ms Kiran Dharsan and Ms Mary Thomas) for the Applicants

Mr Rizwi Wun and Ms Pearl Teo (Messrs KhattarWong) for the Opponents

GROUND OF DECISION

1 These are 2 oppositions against the trade mark application numbers T03/12742A in Class 16 for “Calendars; folders (stationery); greeting cards; magazines; photographs; posters; printed publications; office requisites (except furniture); letterheads; envelopes; complimentary slips; mailing labels; business cards; pamphlets; catalogues; charts; signboards of paper and cardboard; printed products for packaging purposes; advertising circulars” and T03/12744H in Class 35 for “Consultancy and advisory services relating to business; industrial and business

management assistance; business enquiries; business investigations; business management and organization consulting; business research; business appraisals; publicity; business administration services; compilation of business statistics; compilation and provision of commercial information; consultancy and advisory services relating to business mergers and acquisitions” respectively.

2 The trade marks as applied for are as follows:



T03/12742A (Class 16)



T03/12744H (Class 35)

3 The Applicants ASTRO ALL ASIA NETWORKS plc filed the trade mark applications T03/12742A in Class 16 and T03/12744H in Class 35 on the 22 August 2003. The trade marks in Classes 16 and 35 were accepted and were advertised in Trade Marks Journal No. 22/2004 dated 16 April 2004 at page 50 and in Trade Marks Journal 20/2004 dated 2 April 2004 at page 77 respectively.

4 The Opponents MEDIACORP NEWS PTE LTD lodged the Notices of Opposition against the trade mark applications on the 16 June 2004. The Applicants contested the opposition by filing their Counter-Statement on 16 October 2004. The Opponents filed evidence in support of their opposition on 21 April 2005. The Applicants filed evidence in support of their application on 7 October 2005. The Opponents filed evidence in reply on 11 July 2006. The matter was fixed for a Pre-Hearing Review on 2 November 2006. As negotiations to explore settlement between the parties were on-going, further Pre-Hearing Reviews were held on 11 January 2007, 1 March 2007, 1 August 2007 and 27 November 2007. The matter was fixed for hearing on 28 February 2008 but was adjourned and finally heard on 15 May 2008.

The grounds of opposition

5 The Opponents relied on the grounds of opposition under Sections 8(1), 8(2), 8(3) and 8(4) of the Trade Marks Act, 1999 Ed. (Chapter 332) (hereinafter “the Act”) in the Notice of Opposition. The Applicants in their Counter-Statement raised section 28(1) of the Act to defend the use of their name in the mark.

6 In their written submissions and at the hearing on 15 May 2008, the Opponents made substantive arguments in respect of Sections 8(2), 8(3), and 8(4). They did not proceed with their ground of opposition under Section 8(1). The Applicants similarly did not pursue section 28(1).

The Opponents’ Evidence

7 The Opponents’ evidence was declared by Han Chuan Quee, the Opponents’ Senior Assistant Vice President (Corporate Services) in 2 statutory declarations dated 20 April 2005 and 7 July 2006 respectively.

8 Mr Han declares that the Opponents own and manage Channel NewsAsia, an English TV news channel established in March 1999 in Singapore. Its second feed, Channel NewsAsia (International), a satellite channel beamed via Asiasat 3S, was launched in September 2000. Channel NewsAsia is headquartered in Singapore and has an extensive network of journalists in 12 Asian cities and key Western capitals, including London, New York, Washington D.C., Paris and Moscow. It provides a staple of news on politics, business and social issues and also features lifestyle programmes.

9 Channel NewsAsia was established with the aspiration to become the authoritative voice of Asia, originating from Asia, covering news from Asia with Asian perspectives. At the time it was established, an Asian-owned all news channel in English did not exist and Channel NewsAsia filled that void. Much publicity was generated locally and overseas before and during the launch of Channel NewsAsia via promotional materials, advertisements and articles in the newspapers and in other local and overseas publications as shown in the exhibits lodged in the statutory declaration.

10 The Opponents are owners of the trade mark “CHANNEL NEWSASIA” and “A” device in Singapore in classes 35, 36, 38, 41 and 42; and have applications and registrations in other jurisdictions including Australia, Brunei, China, Hong Kong, Indonesia, India, Japan, Korea, Malaysia, Philippines, Thailand, United Kingdom, the United States of America and Vietnam.

11 The deponent states that the Opponents’ “CHANNEL NEWSASIA” mark has been substantially used in Singapore and other countries in respect of the services covered by the registrations. Channel NewsAsia is viewed by 16.3 million homes and hotels in 19 territories across Asia and has consistently enjoyed a high viewership especially amongst the public in Singapore. The channel is also online at www.channelnewsasia.com and www.cna.tv (Chinese website).

12 The Opponents exhibited materials and feature articles evidencing the use and recognition of the Opponents’ mark in Singapore and other countries. They also exhibited the landmark speeches and “live” news conferences from the region that Channel NewsAsia has covered since its inception in March 1999, as well as the prestigious international awards and accolades received for their highly acclaimed documentaries, current affairs and analysis programmes. Channel NewsAsia has also been extensively promoted and advertised over television, the local newspapers and both the local as well as overseas publications, and have actively raised their profile through the organisation of interactive games and tournaments.

13 The Opponents have expended a substantial sum in the advertising and promotion of their Channel NewsAsia mark and the annual expenses for the period between 2000 and 2005 as extracted from the Opponents’ accounting records which have been subjected to statutory audit are:

<u>For Financial Year ended</u>	<u>Singapore \$</u>
31 March 2001	3,886,753
31 March 2002	1,652,261
31 March 2003	1,390,759
31 March 2004	1,021,822
31 March 2005	934,294

14 The annual turnover figures for the period between 2000 and 2005 as extracted from the Opponents' accounting records which have been subjected to statutory audit are as set out:

<u>For Financial Year ended</u>	<u>Singapore \$</u>
31 March 2001	17,254,371
31 March 2002	27,144,565
31 March 2003	21,356,418
31 March 2004	26,315,130
31 March 2005	28,626,685

15 In the statutory declaration in reply filed on 7 July 2006, the Opponents stressed that the Opponents' mark have been used extensively in Singapore and elsewhere over 7 years such that the public have come to recognise the Opponents as the established and authoritative voice of Asian news.

The Applicants' Evidence

16 The Applicants evidence was lodged by Lim Meng Leong, Head Counsel of the Applicants. He states that the Applicants are the region's leading cross-media operator with Direct-To-Home ("DTH") satellite television services in Malaysia and Brunei. It is also the leading commercial radio broadcaster and a major publisher of TV guides and lifestyle magazines in Malaysia.

17 The Applicants are the parent company of the Astro Group of companies and were registered as a foreign company in Malaysia on the 16 September 2003; and operate out of the All Asia Broadcast Centre, a fully-integrated digital broadcast and production complex in Kuala Lumpur. The Applicants have many subsidiary companies operating out of the same complex in Kuala Lumpur, such as Celestial Pictures, owns the world's largest Chinese film library and its digitally remastered films are released internationally through theatrical, video, television and new media distribution, and the Celestial Movies channels. The Applicants also wholly own MEASAT Broadcast Network Systems Sdn Bhd, which holds a 20-year exclusive licence for direct-to-home ("DTH") satellite transmission in Malaysia.

18 The Applicants derive a greater part of its revenue from subscriptions to its pay-TV services and to a lesser extent, from advertisements through its TV and radio services and distribution of its content assets. The Applicants' services have also extended into interactive and multimedia services including provision of content for mobile telephony. The Applicants' subscription TV service broadcasts 55 channels to more than 1.6million subscribers, or to some 31% of television homes in Malaysia. The Applicants through a joint venture also distribute these services in Brunei; and intend to significantly expand its services to the region in the future with the launch of the MEASAT-3 satellite.

19 The Astro Group operates eight FM terrestrial radio stations in Malaysia, which include the top-ranking stations in key Malay, Chinese, Indian and English vernacular demographics. These stations cumulatively reach over 10 million listeners a week or 62% of all radio listeners in Malaysia, and command over 79% of the radio industry's advertising expenditure. In addition, the Astro Group also packages 17 music channels in 6 languages for distribution over its DTH platform. The Group has also won awards for these services.

20 The Astro Group provides studio infrastructure and airtime sales and programming services for two radio stations in Kolkatta, India. The Group is also active in content origination and during the financial year 2005, it produced 1,300 hours of in-house content in the key Malay, Chinese, English and Indian languages; with further 5,000 hours of subtitling and dubbing.

21 The Group publishes entertainment and lifestyle magazines in Malaysia and produces animated content through its subsidiary, Philippine Animation N.V Group, Philippine's leading animation studio and reportedly one of the world's top animated service providers over the past years. The Astro Group provides interactive TV services and distributes multimedia content to a variety of users through the many communication and mobile devices available today. The Group also offers broadband content through its portal Astro.tv and have 25% stake in a joint venture with MAXIS Communications, an affiliate company and one of Malaysia's leading mobile operators to own 3G spectrum and provide 3G services.

- 22 The Applicants gave a brief chronology of their significant milestones:
- 2005**
 - Launches broadband portal *Astro.tv*
 - Acquires *Thr.fm*
 - Announces proposed investment in Indonesia Pay-TV Multimedia venture
 - Launches first Bahasa Malaysia publication - *InTrend*
 - 2004**
 - Launches iFEEL entertainment magazine
 - Commences broadcast of *Sinar FM* and *XFresh.fm*
 - 2003**
 - Undertakes SE Asia's largest IPO
 - Acquires Celestial Pictures and Philippines Animation Studio Inc
 - Establishes MAESTRO
 - Provides airtime management for India FM radio stations
 - 2002**
 - Launches *VMAG* leisure and lifestyle magazine
 - 2001**
 - First telecast of *Astro News*
 - 2000**
 - *Kristal-Astro* begins transmission in Brunei
 - 1999**
 - Begins production of first Malay feature film
 - Launches *Astro* Digital Multimedia System
 - 1997**
 - Radio commences operations with 5 FM stations
 - Achieves Multimedia Super Corridor status
 - 1996**
 - Completes state-of-the-art digital All Asia Broadcast Centre
 - *Astro* commences broadcast with 22 TV channels and 8 themed music channels

23 The Applicants completed their listing on the Kuala Lumpur Stock Exchange on the 23 October 2003. The Applicants are also proprietors of applications and registrations in Malaysia, Brunei, Indonesia and the United Kingdom in classes 16, 25, 35, 36, 38 and 41.

The applicable law and the burden of proof

24 The Opposition falls to be determined under the Trade Marks Act Chapter 332, 2005 Revised Edition. The burden of proof under the grounds of opposition lies with the Opponents. *Kerly's Law of Trade Marks and Trade Names 14th Edition* 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 [UK] 1994 Act [which is the corresponding provision to Section 8 of the Act] he must make them out.”

Decision

Ground of opposition under section 8(2) of the Act

25 The Opponents rely on section 8(2) which is reproduced below:

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.

Earlier trade mark

26 Section 2 of the Act defines this as:

(a) a registered trade mark or international trade mark (Singapore), the application for registration of which was made earlier than the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks; or

(b) ...

and includes a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph (a) subject to its being so registered.

27 The criterion of “an earlier trade mark” is satisfied as the Opponents have other registrations in classes 35, 36, 38, 41 and 42. The mark which was registered on 15 April 2000 is reproduced as follows:



CHANNEL NEWSASIA

<u>Registration No.</u>	<u>Class</u>	<u>Specification</u>
T00/06342B	35	Advertising material (updating of-); advertising matter (dissemination of-); advertising space (rental of); artists (business management of performing-); business information; commerce and marketing information; publication of publicity texts; television advertising; television commercials; all included in Class 35.

<u>Registration No.</u>	<u>Class</u>	<u>Specification</u>
T00/06343J	36	Financial information; provision of information relating to stock exchange prices, financial services, property [real estate] and investment; all included in Class 36.
T00/06344I	38	Communications by computer terminals; computer aided transmission of messages and images; electronic mail; information services relating to broadcasting and telecommunications; message sending; news agency services (transmission of news); rental of telecommunications equipment; satellite transmission; television broadcasting; all included in Class 38.
T00/06345G	41	Dubbing; editing (videotape); education information; entertainment; entertainment information; film production; recreational information; live performances (presentation of); motion pictures (rental of); movie studios; news programme services for television; organization of shows (impresario services); production (videotape film); production of documentaries; production of radio and television programmes; production of shows; recording studio services; rental of lighting apparatus for theatrical sets or television studios; rental of show scenery; rental of video cameras; rental of videotapes; rental of audio equipment; television entertainment; all included in Class 41.
T00/06346E	42	Reporter services [news-]; reporting [film-]; all included in Class 42.

The Opponents' submissions

28 The Opponents state that the acid-test for determining whether registration should be disallowed under section 8(2) of the Act is summarised in *Kerly's Law of Trade Marks and Trade Names 14th Edition* at paragraphs 9-033 to 9-046, which considered the principles in *Sabel BV v Puma AG [1998] RPC 199*. In order to ascertain whether the Applicants' mark is identical to the Opponents' mark, the rule laid down by the European Court of Justice decision in *SA Societe LTJ Diffusion v Sadas Vertbaudet SA [2003] FSR 34* (which was cited with approval in the Singapore High Court case of *Pan-West (Pte) Ltd v Grand Bigwin Pte Ltd [2003] 4 SLR 755*) is instructive:

“... a sign is identical with the trade mark where it reproduces, without modification, omission, or addition, all the elements

constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average and reasonably well informed, observant and circumspect consumer”.

29 The Opponents cite the case of British *Sugar Plc v James Robertson & Sons Ltd [1996] RPC 281* at pages 296 -297 (“*British Sugar*”) for the factors to be considered in assessing the similarity of goods or services.

30 The Opponents submit that a global assessment of all the facts should be taken to determine if there is likelihood of confusion. The customers or potential customers of the Applicants’ and Opponents’ products or services are the “average consumers who are deemed reasonably well informed and circumspect and observant” (*Lloyd Schuhfabrik Meyer & Co GmbH v. Klijsen Handel BV [2000] FSR 77*) for it is the perception of marks in the minds of these average consumers which play a decisive role in the global appreciation of the likelihood of confusion (*Sabel BV v Puma*) The Opponents rely on the local High Court case of *The Polo/Lauren Co., LP v. Shop-In Department Store Pte Ltd [2005] 4 SLR 816* which states that the test for likelihood of confusion requires an examination of phonetic, visual and conceptual similarity of the marks. Extraneous factors such as the whether the likelihood is real or merely speculative or hypothetical can be considered and the Opponents state that since the nature of the goods and services are similar, the trade channels utilised are similar, and the Applicants’ nature of business is in direct competition with the Applicants’ nature of business is in direct competition with the Opponents’; the likelihood of danger is very real.

31 The Opponents also cite the Court of Appeal’s decision of *Kellogg Co v Pacific Food Products Sdn Bhd [1999] 2 SLR 651* for the principle that the test for likelihood of confusion when applied to a reactive audience is the same as the passing off case of *Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd [1991] SLR 133*.

32 In the alternative, the Opponents submit that the marks are visually and conceptually very similar. Although the Applicants’ mark has the words “ASTRO ALL ASIA plc” appearing below the device, these are presented in such a miniscule

font that would not serve to sufficiently distinguish the Applicants' mark from the Opponents' mark. The Opponents cite the cases of *Boby Footwear Pte Ltd v The Polo/Lauren Company, L.P. [2005] SGIPOS 16* and *SPA Esprit Pte Ltd v Esprit International [2005] SGIPOS 2*

The Applicants' Submissions

33 The Applicants submit that these marks are not identical or similar, judging the marks by their look and sound, (*The Pianotist Company Ltd Application (1906) 23 RPC 774* at 777), and also after considering "the visual, aural or conceptual similarity of the marks in question", (*Lloyd Shuhfabrik Meyer & Co GmbH v KlijsenHandel BV (2000) FSR 77* at 84).

34 The Applicant's mark is completely distinct from that of the Opponents' and conveys a different visual and phonetic impact on the consumer. The Applicants have incurred much time and expense in developing and creating the Applicants' new corporate image and the present "A device" which is in dispute evolved from the 1996 version, to the 2002 version to the present.

35 The Applicants cite the case of *The European Limited v The Economist Newspaper Limited [1998] FSR 283 at 288*, where the English Court of Appeal observed that "[s]imilarity is a matter of degree; and except in the case where there is absolutely no similarity at all between sign and mark (which is not this case) the question is whether the similarity is such as to be likely to cause confusion in the mind of the public. A degree of similarity is tolerable; the question is whether there is a confusing similarity." This was quoted with approval by the late Lai Kew Chai J in *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd [2005] 4 SLR 816* at paragraph 22. The Applicants also submit that the law assumes that the ordinary consumer will exercise some care and intelligence in the selection of their merchandise [*McDonald's Corp v Future Enterprises Pte Ltd [2005] 1 SLR 177*]

36 In relation to the similarity and/or identicalness of goods or services, the Applicants state that they are the region's leading cross-media operator with direct-to-home (DTH) satellite television services in Malaysia and Brunei. The Applicants derive a great part of their revenue from subscriptions to their pay-television services, and, to a lesser extent from advertisements through television and radio services, as

well as distribution of its content assets. They are also the leading commercial radio broadcaster in Malaysia and a major publisher of television guides and lifestyle magazines in Malaysia. They also own many subsidiary companies, one of which specializes in digital re-mastering of Chinese films which are shown through out Asia in Malaysia, Brunei, Indonesia, Singapore, Hong Kong, Australia, Mainland China and Thailand.

37 The Applicants submit that considering the nature of the goods and/or services provided, the average consumer of such goods would be a discerning and knowing lot, who would exercise more than a modicum of care before making a purchase. *Itochu Corporation v Worldwide Brands, Inc. [2007] SGIPOS 9*. The Court of Appeal in the Polo case also held that the average consumer is “not an unthinking person in a hurry but... would be someone who would exercise some care and good sense in making his purchases.” The Opponents have not filed any independent evidence from consumers in Singapore or elsewhere (by way of survey evidence or otherwise) to show that there exists a likelihood of confusion and thus has not discharged its burden of proof under Section 8 of the Act. The Applicants submit that the Opponents have failed to adduce any instances of actual confusion in markets where the respective Marks have been circulating and quote from *Kerly’s Law of Trade Marks and Trade Names 14th Edition* at paragraph 17-073 where it says that:

“The absence of evidence of actual deception is a circumstance which varies greatly in weight according to the nature of the case. Even where the proper inference to be drawn is that there has been no confusion, this cannot be conclusive by itself, the decision is for the court, which cannot abdicate it in favour of the witnesses. Nevertheless, where the marks have been circulating side by side in the market where deception is alleged to be probable, the fact that no one appears to have been misled is very material, unless satisfactorily explained.”

38 The Applicants also pointed out that the Opponents had not opposed the Applicant’s earlier applications, T02/00374E and T02/00375C, which were registered on 8 January 2002 after the registration of the Opponents’ Mark, and that there is co-

existence of the Opponents' Mark and the Applicant's earlier marks T96/06671A, T96/06672Z, T02/00374E and T02/00375C.

Decision

39 As the Opponents have the burden of proof under the section 8(2) ground of opposition, they will have to satisfy the following criteria:

- a) the Opponents have earlier registration which satisfies the definition in section 2 of the Act - this criteria is satisfied for the Opponents have earlier trade marks;
- b) [for section 8(2)(a)] the application mark and the earlier trade marks are identical and the goods of the application mark and of the earlier trade marks are similar;
- c) [for section 8(2)(b)] the application mark and the earlier trade marks are similar and goods of the application mark and of the earlier trade marks are identical or similar;
- d) and there is a likelihood of confusion by virtue of the similarity of the marks and the goods.

Is there identity between the marks?

40 The Opponents have argued that the Applicants' trade mark is identical with the Opponents' earlier trade mark and is to be registered for goods or services similar to this earlier trade mark. In their written and oral submissions, they state that the marks are highly similar and even though there are some minute elements which are different, these are so insignificant that they are likely to go unnoticed by an average consumer. When compared as wholes, they say that the Opponents' and Applicants' marks are very confusingly similar especially where both marks contain an "A" device which sits above their individual corporate names appearing in small font below the device. These marks when scaled down to size on writing materials, correspondence or the televisions screen, are likely to appear visually identical.

41 The Applicants' argued that the Opponents' device has a hook at the bottom right hand corner which is the dominant feature of the device and which makes the device look like a triangle, or even the musical instrument of the same name (triangle) rather than the letter "A". The Opponents' device also has a flattened top, which does not appear at all in the Applicants' device. The words below each of the Opponents'

and the Applicants' marks are completely distinct from each other; the Applicants' mark has the words "Astro All Asia Network plc" below its device while the Opponents' mark has the words "Channel News Asia" below its device. The Applicants submit that these numerous differences between the marks are not considered insignificant.

42 The principle that is used in determining the identity of marks is that which is found in the case of *Sadas* where the European Court of Justice was asked to interpret Article 5(1)(a) of the First Council Directive 89/104 of December 21, 1988 (our section 8(1) of the Act, which is the relative ground for refusal of registration where the application mark and the earlier trade mark are identical and used on identical goods or services.). The test in *Sadas* has been endorsed as the principle to apply in establishing identity of marks under Section 8(1) of the Act in Singapore. It has also been held in *Sadas* that the test for identity of marks is to be interpreted strictly for an opposition under the ground of Article 5(1)(a) [our section 8(1)] for once the identity of the marks and the identity of the goods or services of the marks are established, the likelihood of confusion is presumed. The test for identity of marks derived from *Sadas* however may be applied to the relative ground for refusal under section 8(2)(a) of the Act where the criteria is that that the marks must not be identical; albeit here the other criteria relates to similarity and not identity of goods or services.

43 The test for identity of marks in *Sadas* requires us to ask whether the Applicants' Mark "is identical with the Opponents' trade mark where it reproduced, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer", who is deemed to be "reasonably well-informed, reasonably observant and circumspect".

44 The crux of the Opponents' argument rests on the appearance of what I would term the triangular devices in both the Applicants' and the Opponents' marks; which the Opponents have strenuously argued are identical, if not highly similar. Although both the marks as they appear on the register each have words below their respective

triangular devices, the Opponents deem that these words are so insignificant in size that they are likely to go unnoticed by an average consumer.

45 I am not able to agree that the Applicants' and the Opponents' marks when "*viewed as a whole ... contain differences so insignificant that they may go unnoticed by an average and reasonably well informed, observant and circumspect consumer*". The presence of the words in Applicants' and the Opponents' marks though small relative to the size of the devices, disqualify the marks as "identical" marks for these are clearly modifications or additions which can hardly be considered insignificant. Furthermore, the words in the respective marks spell out the corporate names of the Applicants and Opponents respectively and these would not be insignificant differences which would pass the notice of the consumer.

46 Although the *Pan-West* case which was cited by the Opponents has held that the signs do not have to be exactly the same in order to be considered identical, *Pan-West* may be distinguished on the facts. In *Pan-West*, the marks in question were "Katana Golf" with a device of the letters "kG" (where the word "Golf" and the letters "kG" were disclaimed) and "Katana". The Court held that the distinct and dominant part of the plaintiff's mark was the word "Katana" and this had been reproduced in the defendant's mark. Additionally, the learned judge noted in *Pan-West* that the defendants themselves had conceded that their mark was "... in law and in fact identical with or substantially similar to the registered trade mark." The Opponents' and the Applicants' marks in the present case have the words "CHANNEL NEWSASIA" and "ASTRO ALL ASIA NETWORK plc" below the respective triangular devices. The presence of these words in the marks clearly indicates that there is no identity of marks.

47 The marks are not identical as required by section 8(2)(a). The issue therefore is whether the marks may be considered similar so as to be caught by section 8(2)(b) of the Act.

Similarity between the Applicants' mark and the Opponents' mark under section 8(2)(b)

48 When trade marks are to be compared, one must consider their visual, aural and conceptual similarity. The oft cited case of *In the Matter of an Application by*

the Pianotist Company Ld for the Registration of a Trade Mark (1906) 23 RPC 774

encapsulates this principle at page 777 where Parker J. states:

“You must take the two words. You must judge them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of the customer who would be likely to buy those goods. In fact, you must consider all the circumstances; and you must further consider if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks.”

49 The Applicants’ marks are a series of 2 marks, one which is limited to the colours blue, red and yellow; and the other mark in black and white. The mark has a triangular device with the words “ASTRO ALL ASIA NETWORK plc” below. The Opponents’ mark also has a triangular device with the words “CHANNEL NEWSASIA” below its device.

Aural similarity

50 The words “CHANNEL NEWSASIA” and “ASTRO ALL ASIA NETWORK plc” appear in the Opponents’ and the Applicants’ marks respectively. As the words “CHANNEL NEWSASIA” and “ASTRO ALL ASIA NETWORK plc” are vastly different from one another, I find that there is no aural similarity between the marks.

Visual Similarity

51 The marks as they appear on the Register are device marks with words below. What strikes the eye first when looking at the Opponents’ and the Applicants’ marks are these triangular devices for in both the marks, the devices are much larger in size relative to the words. The Applicants’ triangular device is presented in a bold red colour, and the evidence lodged by the Opponents shows that their device is always used in a similarly bold red hue. The words in relation to the devices are placed in a less prominent position - below the devices - giving them a lower visual impact compared to the devices. At a glance therefore, the marks may be said to be visually similar.

Conceptual similarity

52 The Opponents have in their evidence stated how their mark is derived and describe it thus:

“Channel NewsAsia's symbol reads as a single red letter "A" in order to heighten the word "Asia" in its name. Both the letter-form and the space within it have been reshaped to form a delta, the symbol for change that aims to capture the profound nature of the Channel's business of capturing change, particularly within Asia. Lowering the crossbar of the “A” to sit at its base creates a unique and distinctive “A”. This gives the impression of it rising from the horizon of its base, reflecting in abstraction an emerging Asia. Red was chosen as the symbol's colour because it is striking and bold. Red is also considered an auspicious colour in many Asian cultures.”

53 The Applicants' evidence is that their mark is a stylised “A” device which was derived from its name “ASTRO ALL ASIA NETWORK plc” and the Applicants state that it is an evolved form from the earlier versions of their marks, in particular a 1996 version and a 2002 version which has achieved registration in Singapore. The marks however are registered in the name of Measat Broadcast Network Systems Sdn. Bhd, a wholly owned subsidiary of the Applicants. The Applicants' present mark has two curves which were derived from the ellipse found in the 1996 version and which had been stylized as two bands on the right limb of 2002 version of the mark. The present mark is a product of a re-branding exercise that the Applicants undertook in 2003 to commemorate its public listing.

54 Visually, the marks have in common a triangular device which looks similar in form and in colour, when in actual use. Many different descriptions have been coined by the Applicants and the Opponents to describe the device: “an incomplete inverted “V”, an “A” device, a triangle (being the name of the musical percussion instrument), an incomplete “A”, etc. However described or named by the parties, the device in each of the marks is undisputedly a triangular device. Both the Opponents' and the Applicants' marks plainly described might read: “marks with red triangular devices which sit above the corporate name of the respective entity”. Conceptually therefore, the marks are quite similar in form and presentation.

55 I find therefore that the marks are visually and conceptually similar but not aurally similar.

Similarity of the Goods and Services

56 There are two opposition matters being decided, the Applicants' Mark in Class 16 and in Class 35. The Applicants' class 16 is for "calendars; folders (stationery); greeting cards; magazines; photographs; posters; printed publications; office requisites (except furniture); letterheads; envelopes; complimentary slips; mailing labels; business cards; pamphlets; catalogues; charts; signboards of paper and cardboard; printed products for packaging purposes; advertising circulars".

57 The Opponents do have any earlier registration in Class 16. The Opponents had in their statutory declaration led evidence to show actual use of their mark on goods that fall in Class 16 such as letterheads, stationery, advertising circulars, greeting cards, letter pads and post cards; and had stressed the fact that the Applicants have not used their mark in Singapore at all. In the Opponents' statutory declaration in reply, samples are exhibited which confirms that the Opponents' "CHANNEL NEWSASIA" and device mark are used. However, it is also pertinent to note that in the exhibits, the mark is more often than not co-branded with the mark "MEDIACORP News". The "MEDIACORP News" mark appears more prominently, usually positioned above the "CHANNEL NEWSASIA" and device mark.

58 The Opponents cited the case of British *Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 for the assessment of identity or similarity of goods or services. The test as laid out by Jacob J in *British Sugar* gives guidance as to whether there is similarity between the classes. Jacob J at pages 296 – 297 of the *British Sugar* case states:

"...the sort of considerations the court must have in mind are similar to those arising under the old Act in relation to goods of the same description. ... the purpose of the conception in the old Act was to prevent marks from conflicting not only for their respective actual goods, but for a penumbra also. And the purpose of similar goods in the Directive and Act is to provide protection and separation for a similar sort of penumbra. Thus, I think the

following factors must be relevant in considering whether there is or is not similarity:

- (a) The respective uses of the goods and services;
- (b) The respective users of the goods and services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods and services reach the market;
- (e) In case of self-service consumer items, where in practice they are respectively found or is likely to be found in supermarkets and in particular whether they are, or are likely to be found on the same or different shelves;
- (f) The extent to which the respective goods and services are competitive.”

59 In respect of the goods in Class 16 as opposed to the Opponents’ service classes, it is difficult to force-fit the individual items belonging to a class of goods into the *British Sugar* guidelines in order to compare the same to items within a class of services. It might be easier if the comparison of the service class related to trade in closely related goods; for example, comparison of a class 43 specification for the services for providing food and drink against a class 32 specification for goods (say, for beverages like beers and other non-alcoholic drinks; other preparations for making beverages). In any event, using the guidelines provided by *British Sugar*, I do not find that the Applicants’ class 16 goods are similar to the Opponents’ services. Although the Opponents had provided some evidence of use of the mark on the goods stated above, the use appears to be incidental to the running of the business.

60 Although both Applicants and Opponents have class 35 registrations, the items within the individual specifications are not identical. The services in the Opponents’ class 35 registration mainly deal with advertising matters such as television advertising, dissemination of advertising matter and rental of advertising space; but also include business management of performing artists, television commercials, publication of publicity text, provision of business, commerce and marketing information. The Applicants’ specification of services are more generally worded and appear to be geared towards services for the running of a business - this includes consultancy and advisory services, industrial and business management assistance, business enquiries, investigations, business management and organisation consulting;

business research and appraisals; compilation of business statistics; compilation and provision of commercial information; consultancy and advisory services relating to business mergers and acquisitions. However, there are clearly some areas of overlap between the Opponents and the Applicants class 35 specifications, especially the services relating to normal commercial activities that businesses engage in, such as provision and preparation of business, commerce and marketing information, production or publication of publicity texts.

61 The factors set out by Jacob J. are guidelines to assist one in the consideration of similarity of the goods or services and should not be regarded as requirements that must all be satisfied before the goods or services in question can be treated as similar. (*Johnson & Johnson v Uni-Charm Kabushiki Kaisha [2007] 1 SLR 1082*) In the comparison of the class 35 specifications, I would also take note of *Richemont International SA v Goldlion Enterprise (Singapore) Pte Ltd [2006] 1 SLR 401* where the Singapore High Court held that once the goods have been determined to be identical from a comparison of the specifications, there is no need to consider the factors as laid out by Jacob J in *British Sugar*.

62 I find therefore that there is similarity in respect of the class 35 services.

The Likelihood of Confusion

63 As the similarity in respect of both the marks as well as the services has been met in relation to the class 35 application, the next consideration under this ground of opposition is whether or not there is a likelihood of confusion on the part of the public. However, since I have found no similarity in the Applicants' class 16 goods and the Opponents' service classes; I will not consider the likelihood of confusion in respect of this class for the *Richemont* case states that "...the identity or similarity requirement in respect of both the marks as well as the goods or services are "threshold" requirements which have to be met before one may proceed to consider whether or not there is a likelihood of confusion on the part of the public."

64 The wording of section 8(2)(b) requires that the likelihood of confusion must arise from the similarity of the marks used on similar services, and if this is proved then the application mark shall not be registered. The decided cases have also all

underscored the importance that confusion must stem from similarity of the mark as well as the goods (or services) to which they are applied.

65 The case of *Sabel* states that the likelihood of confusion is to be assessed globally taking into account all factors relevant to the marks and goods and services in issue. The Singapore Court of Appeal in their decision of *Shop-In Department Store* gives a list (though not exhaustive) of what qualifies as “all the circumstances” that needs to be considered in assessing the question of likelihood of confusion. At paragraph 28, it was said 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”.

66 At this juncture, it is pertinent to note that the Applicants have not used their mark in Singapore. Hence I would only be able to consider notional use by the Applicants in the assessment of likelihood of confusion.

Closeness of the Services

67 The Applicants’ submissions weigh heavily on the fact that the Opponents’ and their business are dissimilar. The Applicants attempted to impress upon the Registrar that that the scope of their services rendered are not the same as that of the Opponents. The Applicants’ argue that their services are primarily the provision of platforms for the distribution of television such as Direct Broadcast Satellite, (“DBS”) or "Direct-To-Home" (“DTH”) satellite television services which is delivered by way of communications satellites. The Applicants’ revenue is derived mainly from subscriptions to their pay-television services. The Opponents in contrast own and manage a news broadcasting channel, and provide news and lifestyle programmes.

68 In the Applicants' evidence however, they state that they do derive a part of their revenue (although much less compared to that which is derived from pay-TV services) from "advertisements through television and radio services, as well as distribution of its content assets". From the evidence filed by the Applicants, it would appear that the "content assets" include a news channel (*Astro News* which was first telecast in the year 2001). The Applicants have also been involved in content origination and have stated in evidence that the Astro Group is active in content origination having produced in the year 2005 a total of 1,300 hours of in-house content in the key Malay, Chinese, English and Indian languages. It can be said therefore that the Applicants' and the Opponents' services are close and there are areas of overlap.

The impression given by the marks

69 Although it has been held that visually and conceptually the Opponents' and the Applicants' marks are similar, I have examined the Opponents' statutory declarations and note that the Opponents' evidence shows that the mark in actual use is almost always co-branded with the words "**MEDIACORP News**" or "**MEDIACORP**". In Exhibit B of the Opponents' Statutory Declaration in Reply ("SDIR"), the exhibits show that on screen during the news programmes, the red triangular device appears on its own within the ticker tape with the words "**CHANNEL NEWSASIA**" placed prominently above it; and the words "**MEDIACORP**" always positioned on the upper right side of the screen.

70 Exhibit B of the SDIR also features photographs of a vehicle presumably belonging to the Opponents. The vehicle has on it the red triangular device with the words "**CHANNEL NEWSASIA**" below and the words "**MEDIACORP News**" prominently above. Exhibit B of the same statutory declaration also show print matter, notepads, and paper where the "**CHANNEL NEWSASIA**" and the red triangular device are co-branded with "**MEDIACORP News**". In print form, the words "**MEDIACORP News**" appear very prominently as part of the branding. Pages from the website www.channelnewsasia.com are also included in Exhibit B of the SDIR and once again, the Opponents' mark is shown with the words "**MEDIACORP News**" featured prominently above as part of the whole branding.

71 The manner in which the mark is actually used may give rise to the impression that the Opponents' mark "CHANNEL NEWSASIA" and device mark as a whole includes the words "MEDIACORP News" or "MEDIACORP". This would lessen the similarity between the Opponents' and the Applicants' 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; and the kind of customer

72 What is pertinent in an opposition under this ground ultimately is the kind of customer or consumer of the services and the Registrar has to take into account how the average consumers perceive the marks, if there is the possibility of imperfect recollection and the risk that the consumer might think that the goods comes from economically linked undertakings when considering whether there would be confusion.

73 The Opponents' mark has had the advantage of wide exposure to public eye in that their mark is constantly in the media – particularly on television. Television is a powerful visual tool, and although the Opponents' evidence does not provide exactly how much viewership the Opponents enjoy in Singapore, it may be presumed that the Opponents have a fairly high viewership. This is because the Opponents provide a news channel which cuts across race, age and gender and which is not a programme specifically tailored for any one sector of the population. Hence, it would reach a very wide cross-section of people in Singapore. Besides the news programme, the Opponents also provide lifestyle and entertainment programmes which are shown over the television.

74 The Opponents' have stated that their target consumers are "PMEBs" (Professionals, Managers, Executives and Businessmen), professional and senior executives, people from various backgrounds and educational levels. To this consumer base, I would add a good portion of the general population in Singapore. As mentioned earlier, Opponents' mark has the advantage of being, literally, in the news (no pun intended) and will reach out to very wide cross-section of public. This is

especially so in Singapore where there is little difficulty in accessing a television or computer.

75 The Opponents have argued that their consumers do not have the luxury of time to engage in the minute analysis of the marks when reading or watching the news. The Opponents made reference to the case of Tong *Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd [1991] SLR 133* where the court reiterated that the test to be applied is whether ordinary sensible members of the public - those who were endowed with general but not perfect recollection - would be confused. In this matter, whilst it might not be expected of viewers of television or those who read the news on-line to analyse marks in the same manner a company doing a trade mark watch would, greater credit should be accorded to these consumers. Consumers who read or watch the news are likely to be quite discerning of the source of news and would have their own preferences as to which channel they would watch (or read). In this age of connectivity, consumers are not short of choices of sources of news; they are savvy about the different types of media – be it print or electronic - and will make considered choices before deciding what they want. This would be particularly true of the profile of consumers that the Opponents are targeting, the “PMEBs” – consumers who are the professionals, the managers, the executives and those who are businessmen.

76 Whether there is a conscious effort to identify marks or whether this passively seeps into the subconscious through watching the Opponents’ news or other programmes on television, the point remains that because of the way the Opponents marks are used, the mark may well be remembered as a whole as “**MEDIACORP News**” + “**CHANNEL NEWSASIA**” + the red triangular device. In the light of such strong co-branding of these two signs or marks, the Opponents give the impression that both marks must inevitably always be used together. In light of this, if the Applicants’ mark were used, it is not likely that the average consumer will be confused into thinking that the Applicants’ mark and the Opponents’ mark emanate from the same source.

Decision

77 Having taken into account the evidence of use before me, the type of consumers and all the circumstances of the case, I do not think that there is a likelihood of confusion among a substantial number of average consumers in Singapore, if the Applicants' mark is allowed to proceed to registration. The opposition under section 8(2)(b) therefore fails.

Ground of opposition under section 8(3) of the Act

78 Section 8(3) of the Act states that where an application for registration of a trade mark is made before 1st July 2004, if the trade mark —

- (a) is identical with or similar to an earlier trade mark; and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,
the later trade mark shall not be registered if —
 - (i) the earlier trade mark is well known in Singapore;
 - (ii) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered would indicate a connection between those goods or services and the proprietor of the earlier trade mark;
 - (iii) there exists a likelihood of confusion on the part of the public because of such use; and
 - (iv) the interests of the proprietor of the earlier trade mark are likely to be damaged by such use.

The Opponents' submissions

79 The Opponents submit that in determining whether a trade mark is well-known in Singapore, it is relevant to take into account any matter from which it may be inferred that the trade mark is well-known and these include the degree to which the trade mark is known or recognised by any relevant sector of the public in Singapore, the duration, extent and geographical area of ant use, publicity, registration or application of registration of trade marks, any successful enforcement and any value associated with the trade mark.

80 The Opponents' assertion is that at the time of application for registration by the Applicants of their mark, the Opponents were well-known in Singapore. The

Opponents highlight the evidence filed in their statutory declarations pointing to extensive coverage of Channel NewsAsia's launch in March 1999, the launch of the second feed Channel NewsAsia (International) in September 2000, their numerous applications and registrations worldwide, the awards and accolades won by the Opponents, their extensive coverage of news and current affairs which have made the Opponents a well-known, authoritative and current newsfeed both in Asia and in Singapore. The Opponents have also shown in their evidence that they have expended considerable and substantial sums of money to promote and advertise their mar, hence there is considerable goodwill generated from this which has accrued to the Opponents.

81 The Opponents state that in determining whether a mark is well-known under section 8(3) of the Act, section 2(9) places consideration on all actual consumers and potential consumers in Singapore of the Opponents' services; all persons in Singapore involved in the distribution of the Opponents' services and all businesses and companies in Singapore dealing in Opponents' services to which the trade mark is applied. The Opponents supply current news, politics, business and social issues in Asia and are also involved in various broadcasting stations, local and overseas newspapers, local and overseas publications, cable and internet companies; hence a large and substantial proportion of the general population in Singapore knows of Channel NewsAsia . The Opponents cite *Hyundai Mobis v Mobil Petroleum Company, Inc, [2007] SGIPOS 12* and *Amanresorts Limited v Novelty Pte Ltd [2007] SGHC 201*

82 As the Applicants' and the Opponents' services overlap, the public may perceive a connection between the marks. Coupled with the identity or the similarity of the Opponents and Applicants marks, the existence of the Applicants' mark will damage or dilute the reputation and distinctive character of the Opponents' mark or cause the public to mistakenly believe services of the Applicants originate from or are connected with the Opponents. There is therefore is a real risk and likelihood of damage to the Opponents' interest.

The Applicants' Submissions

83 The Applicants submit that although the Opponents satisfy the requirements under 8(3)(b) of an "earlier trade mark" in classes where the goods are not similar to

those of the Applicants, this sub-section has to be read in tandem with 8(3)(a) which requires that the Applicants' Marks have to be identical or similar to the Opponents' mark.

The Opponents also have to prove that there has to be:

- a. Use of the later trademark would indicate a connection between those goods or services and the proprietor of the earlier trade mark;
- b. There exists a likelihood of confusion on the part of the public; and
- c. The interests of the proprietor of the earlier trade mark are likely to be damaged by such use.

84 The Applicants state that there can be no question of identity or similarity between the Applicants' and the Opponents' marks, and no question of confusion either. The Opponents have also not shown that their interests are likely to be damaged apart from a bare allegation in their Statutory Declarations and thus have not discharged their burden under Section 8(3).

Decision

85 In order to succeed under this ground of opposition, the Opponents must show that the requirements of all four subparagraphs of s 8(3) of the Act are met. In the recent High Court case of *Mobil Petroleum Company Inc v Hyundai Mobis [2008] SGHC 104* Lee Seiu Kin J. states that:

“From the construction of s 8(3), consideration of the four subparagraphs must necessarily proceed serially. Therefore, if the requirement in subparagraph (i) is not met, ie, that the earlier mark must be well known in Singapore, then it is not necessary to consider the remaining requirements. Similarly, proceeding to subparagraph (ii), if no connection between the two sets of goods is indicated, it becomes unnecessary to consider the next requirement. This is because there cannot be any confusion unless a connection is indicated. But even if a connection is indicated, Mobil must then show that, arising from the connection, there exists a likelihood of confusion on the part of the public.”

86 Applying section 8(3) therefore, I find that 8(3)(a) and (b) are satisfied as the Applicants' mark is similar to the Opponents' earlier trade marks and that the Applicants' Class 16 goods are not similar to Opponents' class 35 services.

87 *Subparagraph (i): Are the Opponents' earlier trade marks well known in Singapore?*

In order to assess whether the mark is well-known in Singapore, section 2(7) of the Act lays down guidelines which are to be taken into account relevant for such assessment. These include:

- (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.*

88 Subsection (8) of section 2 guides us in the determination of who the “*relevant sector of the public in Singapore*” is. “*Relevant sector of the public*” includes the Opponents’ actual consumers and the potential consumers in Singapore of the Opponents’ services to which the trade mark is applied. It also extends to persons in Singapore involved in the distribution of the services and all businesses and companies in Singapore dealing in the services to which the trade mark is applied.

89 Based on what has been discussed under section 8(2)(b), it is clearly obvious that the Opponents are recognised by the relevant sector of the public as described in section 2(8) of the Act. The Opponents are principally involved in the industry of broadcasting, producing and distribution of films and television programmes. Their mark is a familiar mark amongst the public with its wide exposure since its inception in 1999 through the mass media, print and television. The channel is also online at www.channelnewsasia.com and www.cna.tv. There are numerous applications and

registrations of the Opponents' "**Channel NewsAsia** and device" marks in jurisdictions which include Australia, Brunei, China, Hong Kong, Indonesia, India, Japan, Korea, Malaysia, Philippines, Thailand, United Kingdom, the United States of America and Vietnam.

90 The evidence also states that the Opponents' programmes are viewed by 16.3 million homes and hotels in 19 territories across Asia and has consistently enjoyed a high viewership especially amongst the public in Singapore. The Opponents claim that their mark has become a household name in Singapore. The annual turnover figures from 2001 to 2005 are on the increase and stand in the sum of twenty plus million dollars a year. All the evidence lodged seems to point to the fact that the Opponents are known and recognised by the relevant public for the services of which their mark is applied.

91 The question is whether this level of recognition corresponds to that which would elevate a mark to the status of a "well known mark" under the Act. The 2 cases which have been cited by the Opponents, *Hyundai Mobis v Mobil Petroleum Company* and *Amanresorts Limited* will give an indication of how some marks have attained the status of a well known mark.

92 In *Hyundai Mobis*, the evidence was indisputable that the MOBIL mark had attained a well known mark status. Even though the matter went on appeal from the Registrar's decision, there was never a challenge against the finding that MOBIL was a well known mark in Singapore. The Opponents and their predecessors had had a presence in Singapore for over a century, since 1893 as evident from their publication "Mobil 100 years in Singapore" and had used the MOBIL mark since the 1960s. Based on the company's sales of hundreds of millions of dollars each year and promotional expenditure which was in excess of a million Singapore dollars per year; and going by the size of Singapore and its population, it was held that it would not be difficult to reach a substantial number of people.

93 Similarly, in *Amanresorts*, the evidence showed that the mark enjoyed 2 decades of history, huge sales revenue worldwide (of which more than a third was attributable to the Singapore office), substantial promotional and marketing through

travel agents, collaboration with airlines and credit card companies targeting the rich, that they had 20 plus domain names over the internet. There was also evidence led to show the fact that the plaintiff (owners of the **Aman** and **Amanusa** marks) were acknowledged in two domain name dispute decisions before the Administrative panels of the World Intellectual Property Organisation ('WIPO') as being well known as Amanresorts, and that the Aman group was well known in the premium end of the hotel and resort market.

94 In the present case, although the Opponents have shown that their services are recognised by a large sector of the relevant population, based on the thresholds that have been set in the preceding cases of *Hyundai Mobis* and *Amanresorts*, I am not able to conclude that the Opponents' mark is a well known mark in Singapore.

95 As subparagraph (i) of section 8(3) is not met, it is therefore not necessary for me to consider the remaining requirements. I find that the opposition fails under this ground.

Ground of opposition under section 8(4)(a) [re-numbered as s.8(7) of the Trade Marks Act (Chapter 332) 2005 Revised Edition] of the Act: Passing Off

96 Section 8(4)(a) [re-numbered as s.8(7)] reads:

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; ...

The Opponents' submissions

97 The Opponents state that they have used their mark extensively in respect of a wide spectrum of goods and services in Singapore and abroad since 1999 as shown in their evidence. The Opponents therefore have acquired substantial reputation in their mark in respect of the goods and services applied for, including news and television broadcasting, provision of entertainment services, production of radio and television programmes, television advertising, publicity services, printed materials, printed publication, advertising circulars and stationery.

98 In view of the Opponents' established reputation in their mark, the high degree of similarity between the Opponents and the Applicants' marks, the ordinary consumer in Singapore is likely to mistakenly infer from the Applicants' mark or use thereof that a connection between the marks. Coupled with the identity or the similarity of the Opponents and Applicants marks, the existence of the Applicants' mark will damage or dilute the reputation and distinctive character of the Opponents' mark or cause the public to believe services of the Applicants originate from or are connected with the Opponents.

The Applicants' Submissions

99 The Applicants cite the case of *WILD CHILD TM [1998] RPC 455* at 460, which was cited with approval by the late Lai Kew Chai J in the Singapore High Court Decision of *Pan-West (Pte) Ltd v Grand Bigwin Pte Ltd [2003] 4 SLR 755* at 48, as "the oft-cited trinity of requirements for a passing-off action" - goodwill or reputation, misrepresentation and damage.

100 The Applicants state that the Opponents have to show that they have goodwill and that they are a leader in the news-casting industry. They also state that the Opponents have not shown that there has been any misrepresentation, innocent or otherwise that is likely to lead or may have led the public to believe that their goods and services offered originate from the Opponent. The Opponents have made a mere averment in their various Statutory Declarations that registration of the Applicants' Marks in Class 16 and 35 is likely to result in the public being mistaken into believing that any goods and/or services from the Applicants bearing the Mark originate from the Opponents instead.

101 Although the Opponents are alleging that the use of the Applicants' Marks will be damaging and injurious to the Opponents' goodwill and proprietary rights in the Opponents' marks, the Opponents have not furnished any evidence or proof of damage caused which has allegedly resulted from the claim in passing off. For the Opponent to successfully claim damage caused, he must show that there is a real probability of damage, mere possibility is not enough. In *HP Bulmer Ltd and Showerings Ltd v J Bollinger SA [1978] RPC 79*

102 The Opponents' evidence does not meet with this standard of probability and naturally must fail. The Opponents' allegations of passing off must also fail as they have completely failed to meet the standard of proof required.

Decision

103 In the case of ***WILD CHILD TM [1998] RPC 455***, Mr Geoffrey Hobbs Q.C. at page 460 states the necessary elements of an action for passing off as:

- (1) The plaintiff's goods and services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation."

104 The Opponents have shown in their evidence that they have used their mark since 1999 in relation to the services for which their marks are registered. The evidence is supported by yearly sales of more than 20 million dollars (from 2001 to 2005) and advertising figures. The evidence also highlights the numerous local and international awards and accolades which the Opponents have received for their documentaries, current affairs and analysis programmes. In light of the evidence lodged, the Opponents have acquired a goodwill or reputation in the market in respect of the services applied for.

105 I have however found under the ground of opposition of section 8(2)(b) that although the Opponents' and the Applicants' marks are visually and conceptually similar, there is no confusing similarity between the said marks. Similarly, for the same reasons, I do think that there can be any misrepresentation by the Applicants (if their mark is used) leading or likely to lead the public to believe that goods or services offered by the Applicants are goods or services of the Opponents. As I have found above that there is no misrepresentation, there will be no necessity to consider the third element of damage.

106 The opposition under section 8(4) [now 8(7)] of the Act therefore fails.

107 Having considered all the pleadings and evidence filed and the submissions made orally and in writing, I find that the oppositions in respect of T03/12742A in Class 16 and T03/12744H in Class 35 do not succeed. The applications may proceed to registration. The agreed or taxed costs of this opposition are to be paid by the Opponents to the Applicants.

Dated this 15th day of August 2008

Anne Loo
Principal Assistant Registrar
Registry of Trade Marks
For Registrar of Trade Marks
Intellectual Property Office of Singapore