

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

Trade Mark Application No. T07/22222D
11 May 2010

IN THE MATTER OF TRADE MARK APPLICATION NO T07/22222D

**IN THE NAME OF
CIDORE HOLDING LIMITED**

**AND
OPPOSITION THERETO BY
SEBAPHARMA GMBH & CO.**

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

Ms. Joanna Lin (Drew & Napier LLC) for the Opponents
Mr Michael Loh (Clifford Law LLP) for the Applicants

Cur Adv Vult

GROUND OF DECISION

Cidore Holding Limited (“Applicants”) sought to file an application for registration of the following mark (T07/22222D) as shown below:-



in relation to Class 3 with respect to the following goods:

“Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; cleansing preparations for skin; facial cleansing milk; facial cleansing soap; facial cleansing cream; bath liquid; preparations for use in shower and bath; preparations for the care and protection of the skin; skin care moisturizers; skin toners; preparations for the care and protection of sensitive skin (not for medical use); non-medicated preparations for massage; deodorant preparations for personal use; anti-perspirants for personal use (cosmetics); non-medicated preparations for protection and care of the skin; pore astringents creams; anti-wrinkle creams (cosmetics); non-medicated cream for keratosis removal; non-medicated body powder; preparations for age spot reduction; preparations for whitening the skin; skin and body masks; sunscreen and sunblock preparations (cosmetics); body massage oils; body massage creams; preparations for care of bust (cosmetics); bust beautifying and firming skin care products (cosmetics); aromatic oil for personal use, not for medical use; products for babies' skin care; non-medicated preparations for care of the eyes; cosmetic eye treatment masks, not for medical use; cosmetic eye treatment cream, not for medical use; eye creams for firming skin around eyes; non-medicated acne care preparations; acne removing preparations; cosmetic for make-up; essences for cosmetic purposes; lip stick; preparations for care of lips; make-up removers; cosmetic preparations for slimming purposes; cosmetic preparations for skin care; products of make-up; non medicated preparations for care of hair; hair shampoos; hair cleansing preparations; hair cleansing gels; hair conditioners; oils for the care of hair; preparations for the regeneration of hair; preparations for hair waving; preparations for hair colouring; non-medicated preparations for use in oral hygiene; preparations for cleaning teeth; non-medicated preparations for care of hands; treatment for conditioning and care for scalp, hair and hand, not for medical use; cosmetic preparations for nails; preparations for care of nails; non-medicated anti-bacterial and anti-microbial hand washes; hand lotion; non-medicated preparations for care of foot; hair removal preparations; shave creams; preparations for use before shaving and after shaving.”

(“Application Mark”). The Application Mark was published on 4 July 2008.

Chronology of the Matter

2 The Opponents filed their Notice of Opposition on 3 September 2008. The Applicants filed their Counter-Statement on 31 October 2008. The Opponents filed evidence in support of the opposition 13 May 2009. The Applicants on the other hand filed evidence in support of the application on 6 August 2009. The Opponents on 28 September 2009 wrote to the Registrar to inform that the Opponents do not wish to file any evidence in reply. At the Pre-Hearing Review on 9 November 2009, the parties were directed to write to the Registrar in one month's time as to the status of the matter as it would appear that there may be a possibility of settlement. At the same time, the Registrar informed the Applicants that the attachments to the Counter – Statement cannot

be considered as evidence as they were not sworn (the Applicants referred to the attachments in their statutory declaration, indicating that they will be referring to the attachments in support of the application). The Registrar then directed the Applicants, in the event that they still wish to refer to the attachments, to write to the Opponents for consent and to request for leave from the Registrar to file such further evidence. On 4 December 2009, the Opponents informed that parties were no longer in settlement and that the opposition is to proceed accordingly. The Applicants then eventually filed their supplementary statutory declaration on 11 January 2010. The Opponents, via a letter dated 3 February 2010, informed that they do not wish to file any further evidence in reply and accordingly, a hearing date was set down for 11 May 2010.

Opponents' Evidence

3 The Applicants' evidence was declared by Thomas Maurer, the Vice Chairman of the Board of Directors of Sebapharma GmbH & Co. ("the Opponents' SD").

It is the Opponents' evidence that Mr Heinz Maurer founded Sebamate Chemie GmbH and began manufacturing products under the "Seba-med" and **sebamed** marks. The Opponents were established in 1983 and is in charge of sales and distribution of products under the **sebamed** mark. The Opponents' **sebamed** mark was first used in Germany in the late 1960s, and goods bearing the Opponents' **sebamed** mark have been sold worldwide since.

4 In Singapore, the Opponents have been selling goods bearing the Opponents' **sebamed** mark since at least 1983. The annual turnover figures in relation to goods bearing the Opponents' **sebamed** mark in Singapore are as follows:

Year	Value in Euros	Value in Singapore Dollars (1 EUR = S\$1.944)
1983	18,000	34,992
1984	7,000	13,608
1985	18,000	34,992
1986	30,000	58,320
1987	24,000	46,656
1988	35,000	68,040
1989	44,000	85,536
1990	31,000	60,264
1991	153,000	297,432
1992	186,000	361,584
1993	159,000	309,096
1994	123,000	239,112
1995	111,000	215,784
1996	172,000	334,368
1997	241,000	468,504
1998	186,000	361,584
1999	229,000	445,176

2000	126,000	244,944
2001	136,000	264,384
2002	197,000	382,968
2003	96,000	186,624
2004	165,000	320,760
2005	152,000	295,488
2006	292,000	567,648
2007	318,000	618,192

5 The Opponents' evidence is that the Opponents' personal care products have gained recognition for their excellence and quality worldwide. In particular, the "Superbrands" award has been granted to the Opponents' body care products under the Opponents' **sebamed** mark. It is also the Opponents' evidence that they have expended significant efforts and expenditure in advertising and promoting the goods sold under the Opponents' **sebamed** mark worldwide. The Opponents' case is that the Opponents have, through their long use and promotion of the **sebamed** mark, acquired substantial and valuable reputation and goodwill in Singapore and worldwide.

6 The Opponents own registrations for the **sebamed** mark in many countries including but not limited to the European Community, Australia, Hong Kong, the United Kingdom, the United States of America, Germany, Turkey, Malaysia and Indonesia. The Opponents also have instituted a number of legal proceedings in several countries including Australia and the European Community to protect the **sebamed** mark. In particular, the Office for Harmonisation in the Internal Market ("OHIM") had held that registration of a mark "Sebacin" will result in confusion with the **sebamed** mark and that as the **sebamed** mark is "recognized as a top trade mark for pharmaceutical preparations for skin diseases as well as for cosmetics", registration and use of "Sebacin" will take unfair advantage of or be detrimental to the distinctive character or reputation of the **sebamed** mark.

Applicants' Evidence

7 Both of the Applicants' statutory declarations, the Applicants' statutory declaration of 31 July 2009 (Applicants' first SD) and the Applicants' supplementary statutory declaration of 30 November 2009 (Applicants' second SD) were declared by Poon Sang Yu, a Director of the overseas operations of the Applicants respectively.

The Applicants are incorporated in the British Virgin Islands. No other evidence was provided in relation to the trading background of the Applicants. I note that page 27 of the Exhibit to the Applicants' second SD includes webpages of a company "Ausnow International (Hong Kong) Co., Ltd" ("Ausnow") which portrays the Application Mark. However, except for a statement that Ausnow promoted products of Paris Sewame (page 31 of the Exhibit to the Applicants' second SD) there is no further information provided

as to the relationship between the Applicants and Ausnow and thus evidence which appears to be related to Ausnow is not taken into consideration.

Applicable Law and Burden of Proof

8 The applicable law is the Trade Marks Act (Cap 332, 2005 Rev Ed) (“Act”) and the burden of proof in an opposition under the Act is on the Opponents. ***Kerly’s Law of Trade Marks and Trade Names 14th Edition*** (“*Kerly’s*”) at paragraph 5-118 states:

“There is no overall onus on the applicant either before the Registrar or in opposition proceedings.”

Grounds for Opposition

9 The Opponents relied on Section 8(2)(b), 8(4)(b)(i) and 8(7)(a) of the Act.

Ground of opposition under section 8(2)(b)

10 Section 8(2)(b) reads:

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

...

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

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

Opponents’ submissions

11 The Opponents submitted that in Singapore, the Opponents are the proprietors of the following registrations (“Opponents’ Marks”):

Trade Mark	Mark No.	Goods
	T9705976Z	Class 03 Cosmetics, essential oils, shampoos, cosmetic preparations for cleansing and care of the skin, the hair, the lips; cosmetic preparations for the external application for skin diseases; products for baby care, namely baby cleansing bars, baby foam baths, baby care baths, baby skin creams, skin care oil, tissues

		impregnated with cosmetic oils and lotions, moist tissues and shampoos for children, powder for children, creams for children; preparations for cleansing and care of the body; facial tonics, facial cleansers and facial care products in liquid and solid form, in form of lotions, creams, gels, facial toners (cosmetic); non-medicated bath essences; preparations for foot-care; preparations for sun protection and skin care in form of lotions, creams and gels, after sun skin balms, after sun sprays; all included in Class 3.
sebamed	T8206744C	Class 05 Pharmaceutical and sanitary substances; disinfectants (other than for laying or absorbing dust); medicated preparations having cleaning properties for the prophylaxis or treatment of diseases or disorders of the skin

12 The Opponents submitted that the issues to be decided under the ground of opposition under this Section are whether:

- (a) the Application Mark is similar to the Opponents' Marks;
- (b) the compared goods are identical or similar;
- (c) there exists a likelihood of confusion on the part of the public as a result of (a) and (b).

13 The Opponents submitted that the relevant test to be applied was stated in the case of *The Polo/Lauren Co, LP v Shop-In Department Store Pte Ltd* [2006] 2 SLR(R) 690 ("*Polo Case*"). While this case involved Section 27(2)(b) of the Act, the Court held, at [15]:

"It would be noted that the material part of the wording of this English provision... is identical to our s 8(2) of the Act. It is also similar to our s 27(2)(b)...Of course, this

English provision (as our s 8(2)) relates to refusing the registration of a mark, rather than the infringement of an existing mark. However, we do not think this distinction should mean that the meaning to be given to s 27(2)(b) should be any different from that ascribed to s 8(2)...”

In short, the same test under Section 27(2)(b) is applicable to Section 8(2)(b).

14 The Opponents referred to the test of similarity applied by the High Court in ***The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd [2005] 4 SLR(R) 816*** (“***Polo High Court Case***”) and cited with approval by the Court of Appeal:

“The decided cases suggest that there are three aspects to similarity: visual, aural or phonetic, and conceptual.”

The test of similarity was elaborated in ***MediaCorp News Pte Ltd v Astro All Asia Networks PLC [2009] 4 SLR (R) 496*** (“***MediaCorp Case***”) at [32] and [33]:

“32 The court will therefore consider whether there is conceptual, visual and aural similarity between the registered mark and the applicant’s mark. However, 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 p 864). Conversely, the fact that one similarity is made out does not necessarily mean that the marks are similar. Instead, regard should be had to the type of marks concerned. In the present case, given that both marks are device marks, visual similarity will usually be the most important factor (Bently at p 865; Tan Tee Jim, Law of Trade Marks and Passing Off in Singapore (Sweet & Maxwell, 2003) at p 119).”

33 When comparing the two marks, what is relevant is the “imperfect recollection” of the customer (Nautical Concept Pte Ltd v Jeffery Mark Richard [2007] 1 SLR(R) 1071 at [30]). The court will not compare the two marks side by side and examine them in detail, because “the person who is confused often makes comparison from memory removed in time and space from the marks” (Caterpillar Inc v Ong Eng Peng [2006] 2 SLR(R) 669 at [55]). Further, in examining whether or not there is similarity, the court will not take into account “any external added matter or circumstances”, as the comparison is mark for mark (Caterpillar Inc v Ong Eng Peng at [55]).”

15 Further the Opponents also referred to ***Trend Promoters (Malaysia) Sdn Bhd v Simmons Company [2005] SGIPOS 8***:

“The distinctive and dominant component of the Opponents mark “Simmons Gallery Picture the Possibilities in Bed” on the device of a headboard is the word Simmons... The added material in the Opponents mark, namely, the word “Gallery”, the tag line “Picture the possibilities in bed”, and the device of a headboard on which all the words are placed, do not take away the inherent distinctiveness of the word Simmons and neither do they add much in terms of distinctiveness.

In the Applicants mark too, the distinctive and dominant part of the mark is Simmons. The word Paolo which is placed in the top left hand corner of the word Simmons, which is written in script form, is not very legible and not the dominant part of the mark. The device of a dot and a wavy line is also not so prominent or dominant...

I have described above how the dominant and distinctive part of both marks is the word Simmons. Therefore when an average consumer remembers the Opponents mark it is likely to be the word Simmons that he remembers. When he sees the Applicants mark too, the part of the mark that will strike him first is also the word Simmons as Paolo is quite illegible."

Paragraph 9-038 of **Kerly's** was also referred to:

"the global appreciation of the likelihood of confusion must, as regards the visual, aural or conceptual similarity of the marks in question, be based upon the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components."

[Emphasis by the Opponents.]

Further the Opponents also referred to *Bently and Sherman's Intellectual Property Law (3rd Edition)* ("**Bently**"):

*"although the marks are compared as a whole, emphasis is placed on the "dominant" components. **The tribunals therefore struggle, particularly in the case of composite marks, to identify which are the dominant elements. In much of the case law there is a tendency to emphasize the textual elements.**"*

[Emphasis by the Opponents.]

16 The Opponents submitted that it is clear that the distinctive component in the Opponents' Marks is the word "Sebamed". On the other hand, the most distinctive and prominent component of the Application Mark is the word "Sewame". The Opponents submitted that the word "Sewame" is placed right in the centre forefront of the Application Mark and is portrayed in much larger dimension as compared to the other elements in the mark. In contrast the mountain device and the Chinese characters "雪完美" in the Application Mark are much less prominent than the word "Sewame" and are accordingly not as distinctive.

17 The Opponents referred to **Kerly's** at [17-028] and [17-029]:

"Two marks, when placed side by side, may exhibit many and various differences, yet the main idea left on the mind by both may be the same. A person acquainted with one mark, and not having the two side by side for comparison might well be deceived, seeing the second mark on other goods, into a belief that he was dealing with goods which bore the

same mark as that with which he was acquainted...Marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole. Moreover, variations in details might well be supposed by customers to have been made by the owners of the trade mark they are already acquainted with for reasons of their own.

When the question arises whether a mark so resembles another mark as to be likely to deceive or cause confusion, it should be determined by considering what is the leading characteristic of each...a critical comparison of two marks might disclose numerous points of difference, and yet the idea which would remain with any person seeing them apart at different times might be the same. Thus it is clear that a mark is infringed if the essential features, or essential particulars of it, are taken.”

18 The Opponents submitted that in visual terms the words “Sewame” in the Application Mark and “Sebamed” in the Opponents’ Marks are similar. While they are not exactly of the same length, both comprise three syllables. Both words begin with “Se” and share the same fourth to sixth letters “AME”. The Opponents submitted that the added elements in the Application Mark are not sufficient to render the Application Mark distinguishable from the Opponents’ Marks. As such applying the principle of imperfect recollection, the average consumer who encounters the Application Mark may naturally find the Application Mark to be confusingly similar to the Opponents’ Marks.

19 In terms of aural similarity, the Opponents referred to ***Hu Kim Ai trading as Geneve Timepiece v Liew Yew Thoong trading as Crystal Hour*** [2007] SGIPOS 11. At [40], the Principal Assistant Registrar held:

“Where marks have English words (whether proper English words with meaning or invented words like “BLANSACAR”) there is a tendency for the consumers to refer to the marks by that word, for words speak in marks.”

Thus the Opponents’ case is that the average consumer will refer to the Application Mark by the English word “Sewame” and the Opponents’ Marks by “Sebamed”.

20 The Opponents also referred to ***Kerly’s*** at [17-048]:

“examination of reported cases shows that where marks are meaningless words...the courts give as much weight to phonetic as to visual resemblance...careless pronunciation and the fact that the actual purchaser may be buying for someone else are both relevant.”

The Opponents also referred to ***INADINE Trade Mark*** [1992] RPC 421 in support of the above principles of careless pronunciation and purchase for a third party.

21 The Opponents also referred to ***Aristoc Ltd v Rysta Ltd*** (1945) 62 RPC 65 (“***Aristoc***”):

“The answer as to the question whether the sound of one word resembles too nearly the sound of another...must nearly always depend on first impression, for obviously a person who is familiar with both words will neither be deceived nor confused. It is the person who only knows the one word and has perhaps an imperfect recollection of it who is likely to be deceived or confused...”

Little assistance, therefore, is to be obtained from a meticulous comparison of the two marks, letter by letter and syllable by syllable, pronounced with the clarity to be expected of a teacher of elocution. The Court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description, but also of the shop assistant ministering to that person’s wants.”

The Opponents submitted, applying the above principles when comparing marks one has to take into account the effect of careless and slurred pronunciation, imperfect recollection, the fact that the consumer may be shopping for a third party and the limitation of the knowledge of the consumer and the shop assistant to only one of the marks, while ignorant of the other.

22 The Opponents also referred to *Sega Corporation v Segafredo Zanetti S.P.A.* [2006] SGIPOS 3 (“*Sega*”) and *London Lubricants Ltd’s Application (1925)* 42 RPC 264 (“*London Lubricants*”) for the principle that when considering aural similarity, the beginnings of words that have more significance and the ends of words may be lost in pronunciation.

23 The Opponents submitted that applying the above principles, “Sewame” and “Sebamed” are invented words which do not carry any meaning. Both words “Sewame” and “Sebamed” have 3 syllables and begin with the letters “Se”. The first syllables of the words will thus be pronounced in a similar manner as “SEE”. In addition, the Opponents submitted that the second and third syllables are “WA” and “BA” and “MAIR” and “MAD” respectively which are very similar in sound. Both words share the same symmetry in pronunciation. As emphasis is likely to be placed on the first syllables of the marks which are identical and in view of the similarity of the other two syllables, the Opponents submitted that the marks are aurally similar. Taking into account careless pronunciation, the limited knowledge on the part of the consumer and the shop assistant and the fact that the consumer may be shopping for a third party, the aural differences in the marks are further diminished.

24 In relation to conceptual similarity, the Opponents submitted that both “Sewame” and “Sebamed” are invented terms which do not have any meaning and thus cannot thus be distinguished conceptually. In support of this principle, the Opponents referred to *Astrazeneca AB v Pfizer, Inc.* [2007] SGIPOS 16.

25 It is also the Opponents’ case that the distinctive character of the Opponents’ Marks is enhanced through use in Singapore since at least 1983.

The Opponents submitted that the level of distinctiveness of the Opponents' Marks is relevant as a more distinctive mark generally receives greater protection. The Opponents referred to the *Polo High Court Case* at [27]:

"In the present case, the differences are obvious: the addition of the word "PACIFIC" together with the sign's different font and design. The question, then, is whether these differences are enough so as not to capture the distinctiveness of the registered mark. In order to decide this, I first have to consider whether the plaintiff's mark can be considered to be so distinctive that the differences would not negate the similarity. This is an important issue because a more distinct mark generally receives greater protection..."

[Emphasis by the Opponents.]

The Opponents also referred to *Bently* for the proposition that if an earlier mark is highly distinctive, a mark which has been substantially modified may nonetheless still be similar.

26 The Opponents submitted that the Opponents have been using the Opponents' Marks worldwide since the late 1960's on a wide range of personal care products. In Singapore, the Opponents have been selling goods bearing the Opponents' Marks since at least 1983. The Opponents have expended significant efforts and expenditure in advertising and promoting the goods sold under the Opponents' Marks in Singapore (paragraph 10 and Exhibit H of the Opponents' SD). The Opponents submitted that the distinctiveness of the Opponents' Marks has been further enhanced by the use and promotion made in Singapore by the Opponents since at least 1983. Consequently, this distinctiveness will result in the differences between the compared marks being insufficient to negate the similarities resulting from the visual and phonetic resemblances in the dominant elements of the marks.

27 By way of examples, the Opponents referred to the decisions where the marks were considered to be similar including:

- (a) "BENSYL" versus "BENTASIL" and "BENVIL" in *BENSYL Trade Mark [1992] RPC 529*;
- (b) "ACCUTRON" versus "ACCURIST" and "ACCULARM" in *ACCUTRON Trade Mark [1966] RPC 152*;
- (c) "BULER" versus "BULOVA" in *BULER Trade Mark [1966] RPC 141*;

28 In relation to similarity of goods, the Opponents submitted that the test for similarity of goods was laid down in *Johnson & Johnson v Uni-Charm Kabishiki Kaisha (Uni-Charm Corp) [2007] 1 SLR (R) 1082* ("*Johnson & Johnson*") at [14] which in turn applied *British Sugar Plc v James Robertson & Sons Ltd [1996] RPC 281* ("*British Sugar Case*"). The following factors are relevant:

- (a) the respective uses of the goods;
- (b) the respective end users of the goods;
- (c) the physical nature of the goods;

- (d) the respective trade channels through which the goods reach the market;
- (e) whether the respective goods are in competition with each other or complementary and how those in trade classify the goods;
- (f) in the case of self serve consumer items whether in practice they are respectively found or likely to be found in supermarkets and in particular whether they are or are likely to be found on the same or different shelves.

29 In relation to the Opponents' Marks with respect to Class 3 specification (ie T9705976Z), the Opponents submitted that there is a clear overlap of goods. The Opponents submitted that given the overlap of the goods, the uses, users, physical nature of the goods as well as the trade channels through which the goods reach the market will be the same. The goods will be marketed and sold alongside each other and the goods in relation to the Application Mark will be in competition with the goods in relation to the Opponents' Marks.

30 In relation to the Opponents' Marks with respect to Class 5 specification (ie T8206744C) the Opponents submitted that the goods are similar as the uses, users, physical nature of the goods as well as the trade channels are similar if not complementary. The Opponents submitted that, in particular, the Opponents' Marks with respect to Class 5 covers pharmaceutical substances and medicated preparations for treatment of diseases and disorders of the skin while the Application Mark is filed in relation to preparations for the care, protection and cleansing of the skin, hair and body including cleansing preparations for the skin and face, preparations for the care and protection of the skin, whitening preparations for the skin, preparations for age spot reduction and acne removing preparations. The Opponents submitted that due to the similar nature and purpose of these goods, they will be placed and sold alongside, and would be in competition with, each other.

In support of their claim above, the Opponents referred to *In the Matter of Vono Limited's Application for the Registration of a Defensive Trade Mark in Class 3 (1949)* **66 RPC 305** which held that the Applicant's "toilet preparations (not medicated), cosmetic preparations, essential oils and soaps" are similar to the Opponent's "medicinal powders, ointment, pills and other medicinal preparations – all being for human use".

31 The Opponents submitted that the question of whether a likelihood of confusion exists will require the consideration of a combination of factors not limited to the similarity of marks and /or goods. In the *Polo Case*, the Court held at [8]:

"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 exists a likelihood of confusion."

Further, at [28] the Court elaborated:

"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... But that is not all. 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 of the appellant and the respondent...”

32 The Opponents submitted that the goods in question are likely to be purchased by a broad spectrum of the public and the average consumers of the goods will be the ordinary retail consumers.

33 The Opponents submitted that the Opponents’ Marks have acquired a distinctive reputation through their use in Singapore. Given the distinctive nature of the Opponents’ Marks, the likelihood of confusion is increased as the mark is immediately recognizable in Singapore and the public will assume that the Application Mark belongs to the Opponents, given the lack of any significant differentiating aspects in the Application Mark.

34 In assessing the likelihood of confusion, the Opponents submitted that one has to assume the normal and fair use of the marks across the width of their respective specifications. This concept of notional use was expounded in ***Future Enterprises Pte Ltd v McDonald’s Corp* [2006] 4 SLR (R) 629** at [20]

“Where a mark is not used, the court assumes that the proprietor will use it “in a normal and fair manner”... When a trade mark Applicant who has secured registration has not used his mark on the goods for which it is registered, the Registrar has to assume that he will use it in the normal way that a trader of those goods will trade in those goods ... The question is whether: if MacCoffee for instant coffee mix is registered, would people be confused that it originates from the source which has registered McCAFE for coffee... This is the approach that the Registrar has to take when a trader has not used a mark on the goods for which he has sought registration. The Registrar has to assume that the trader who sought registration is going to use it on those goods for which it is registered. I must assume that one day on a supermarket shelf for coffee, there may be a packet or a bottle of coffee labeled McCAFE. Then I must consider that, if I allow registration of the mark MacCoffee (without the eagle device), there will be a bottle or packet of coffee on the same supermarket shelf which is labeled MacCoffee. I must not take into account what else may appear on these 2 bottles or packets of coffee in addition to the brand, as I have no evidence of how the McCAFE mark is going to be used on coffee and how the MacCoffee mark will be used in Singapore I must consider that the earlier registration is for coffee, which entitles the trader to sell coffee under the brand McCAFE, and what is likely to happen if I allow registration of the application mark, as another trader will then be entitled to sell coffee under the brand MacCoffee. And I must consider whether there will be confusion... where one mark has not been used, it is difficult to predict how the mark will be used and predict the reaction of the Singaporean consumer. What should sway the decision is the similarity of the marks in issue (as they appear on the register and in the application) and the goods in issue (as they appear on the register and in the application)...”

35 The Opponents submitted that the Applicants have not tendered any evidence of use of the Application Mark. It is unclear if the advertisements and brochures (at pages 5 - 26 of the Exhibit to the Applicants' second SD) are circulated in Singapore. The materials are in Chinese language and no English translations were provided. The Opponents submitted that it would appear that the advertisements and brochures tendered are circulated in China and / or Hong Kong.

36 The Opponents submitted that assuming notional use by the Applicants of the Application Mark with respect to all goods under the specification, the Opponents submitted that potential consumers are likely to be deceived into thinking that the Applicants' goods originate from the Opponents.

The Opponents submitted that both the Opponents' and the Applicants' goods, assuming that the Applicants do make use of the Application Mark in a normal and fair manner, are provided via the same or similar trade channels. The goods are likely to be placed along the same shelves in retail outlets and pharmacies. The Opponents submitted that the presentation, marketing and promotion of the Applicants' goods are likely to be carried out in the same manner as that of the Opponents. The type of consumers likely to purchase the Applicants' goods is also not likely to be very different from those of the Opponents' goods.

37 The Opponents also submitted that the materials at pages 27 – 31 of the Exhibit to the Applicants' second SD relates to the company Ausnow International. There is no indication in the materials lodged of the relationship between Ausnow International and the Applicants.

38 The Opponents submitted that in comparing two marks the average consumer rarely has the chance to make a direct comparison and examination between the marks but will instead refer to the imperfect recollection of the mark. The Opponents submitted as "Sewame" and "Sebamed" are invented words with no meaning, there will be a greater likelihood of confusion, particularly when allowance is made for imperfect recollection.

39 Further the Opponents submitted that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks and vice versa. For this proposition, the Opponents referred to *Canon Kabishiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117* at [17].

40 The Opponents submitted that taking all into account there exists a likelihood of confusion.

41 For all of the above reasons the Opponents submitted that the use and registration of the Application Mark will be contrary to Section 8(2)(b).

Applicants' submissions

42 The Applicants submitted that there is no possibility of confusion and that the opposition is misconceived.

43 The Applicants submitted that visually and phonetically, the marks are different. Visually, the Applicants' submitted that the design and layout of the Application Mark is different to that of the Opponents' Marks. The Applicants' case is that the combination of different elements in the Application Mark namely, the dark blue flag, the device of a white snowy mountain stretch, the word "SEWAME" the Chinese characters "雪完美" makes the Application Mark distinctive. In contrast, the Opponents' Marks only consists of the words "SEBAMED". In addition, the Application Mark is of a different font from the Opponents' Marks.

44 Phonetically, the Application Mark can be pronounced as "SE-WA-MAY" or "SE-WAM". "SEWAME" has 3 syllables "SE-WA-ME". Both marks have similar beginnings "SE". But the marks end differently "ME" for the Application Mark and "MED" for the Opponents' Marks. The Applicants submitted that in view of the fact that English is spoken as a first language in the local context, the Applicants case is that any pronunciation based on the spelling alone would never be confused with "SEBAMED".

The transliteration of the Chinese characters "雪完美" in English is "XUE WAN MEI" and the translation of the same is "snow perfection". The Applicants submitted that for Mandarin speaking consumers, they will simply look at the Chinese characters and thus there can be no confusion. Alternatively, the Applicants' case is that the pronunciation of "SEWAME" is close to the Chinese characters and thus cannot be mistaken for "SEBAMED".

45 In relation to the goods, the Applicants' case is that there is no similarity between the Opponents' Class 5 goods (T8206744C) and the Applicants' goods which are in Class 3. The Applicants pointed that the Opponents are in the promotion and sale of medical related products, which explains why the Opponents' Marks end with "MED" which is a short form for "medical".

The Applicants' case is that they are in the promotion and sale of products for cleaning / washing and cosmetic purposes. Due to the difference in emphasis, the consumers will know that there are great differences between the goods and as such confusion is not possible.

46 In relation to the Opponents Class 3 goods, the Applicants' case is that while some of the goods can be considered to be similar to the Applicants' goods, nevertheless, the marks are different such that there can be no confusion.

47 In relation to the likelihood of confusion, the Applicants submitted that following the above submissions in relation to the similarity between the marks and the goods, there can be no confusion.

Decision

48 Section 2(1) provides for the definition of an “earlier trade mark” as follows:

‘ “earlier trade mark” means —

(a) a registered trade mark or an 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) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was a well known trade mark,

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; ’

Both the Opponents’ Marks are registered before 20 November 2007 and thus they are both earlier marks.

49 The test in relation to Section 8(2)(b) is as per the ***Polo Case*** at [8]:

“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... While we can see some link and overlap between the first and the third conditions, it is clear that they are different. The fact that a sign is similar to a registered mark does not automatically mean that there will be a likelihood of confusion on the part of the public. That is a question of fact to be determined by the court, taking into account all the relevant circumstances... 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... 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 exists a likelihood of confusion...”

[Emphasis mine.]

The Court clarified that the test for Section 27 is similar to that for Section 8(2)(b) at [15]:

“...Of course, this English provision (as our s 8(2)) relates to refusing the registration of a mark, rather than the infringement of an existing mark. However, we do not think this distinction should mean that the meaning to be given to s 27(2)(b) should be any different from that ascribed to s 8(2) or the equivalent English provision...”

Similarity of Marks

50 It is clear that in order to assess the similarities between marks, there is a need to assess the visual, aural and conceptual similarities although the relative weight given to each aspect will depend of the actual circumstances of the case as per the *MediaCorp Case* at [32] and [33]:

“32 The court will therefore consider whether there is conceptual, visual and aural similarity between the registered mark and the applicant’s mark. However, 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...Conversely, the fact that one similarity is made out does not necessarily mean that the marks are similar. Instead, regard should be had to the type of marks concerned...”

33 When comparing the two marks, what is relevant is the “imperfect recollection” of the customer (*Nautical Concept Pte Ltd v Jeffery Mark Richard* [2007] 1 SLR(R) 1071 at [30]). The court will not compare the two marks side by side and examine them in detail, because “the person who is confused often makes comparison from memory removed in time and space from the marks” (*Caterpillar Inc v Ong Eng Peng* [2006] 2 SLR(R) 669 at [55]). Further, in examining whether or not there is similarity, the court will not take into account “any external added matter or circumstances”, as the comparison is mark for mark (*Caterpillar Inc v Ong Eng Peng* at [55]).

[Emphasis mine.]

Visual Similarity

51 The Opponents’ Marks are word-only marks, namely “SEBA-MED”. To begin with, the font of the Opponents’ Marks is different from that of the English word in the Application Mark. Further I note that the specific design of the Opponents’ Marks is such that “SEBA” is always placed slightly above “MED” so that it is clear that the Opponents’ Marks consists of two words namely “SEBA” and “MED”.

52 On the other hand, it is clear the Application Mark is a composite mark consisting of words and devices. In particular, the Application Mark consists of a flag device, the device of a mountain top and the word “SEWAME” as well as the Chinese characters “雪完美”. As stated by the Applicants, “SEWAME” is the transliteration of the Chinese characters and it means “snow perfection”.

In assessing a mark, it is important to assess it as a whole. In this instance, the Opponents' Marks are purely English word marks and the words "SEBA" and "MED" each takes up about 50% of the Opponents' Marks respectively. The Application Mark has 4 different elements, namely, a flag device, the device of a mountain top, an English word "SEWAME" and the Chinese characters "雪完美". It is clear that the device of the mountain top, the English word "SEWAME" and the Chinese characters "雪完美" each takes up about a third of the mark. Thus even taking into account of the principle of imperfect recollection of a consumer, the impression given by the Application Mark is different from that of the Opponents' Marks.

I am of the view that the marks are visually dissimilar.

Aural Similarity

52 The Opponents' Marks are pronounced as "SEE-BA-MED". The English word in the Application Mark on the other hand can be pronounced as "SEE-WA-MAY" or "SEE-WA-MEE" or even "SE-WAM" with the "ME" being silent. Given that the Application Mark contains Chinese characters, (for those who are bilingual) aurally, the English word in the Application Mark can be read as a transliteration of the Chinese characters and thus be pronounced as "SEE-WA-MAY" (above). Further, the Chinese characters in the Application Mark would be pronounced as "XUE-WAN-MEI".

In the Opponents' Marks, the second syllable has a strong consonant "BA" while the second syllable for the English word in the Application Mark is "WA" which will be subsumed within the mark when it is being pronounced. Further, "MED" ends with a strong consonant "D". While the first syllable for the Opponents' Marks and the English word in the Application Mark are the same (ie "SEE"), the second and third syllables, namely "WA-ME" and "BA-MED" are pronounced differently. Thus, for the English pronunciation, as two thirds of the marks are different aurally, I am of the view that the marks are aurally different.

Taking all of the above into consideration, I am of the view that the Opponents' Marks and the Application Mark taken as a whole respectively are aurally different on the whole.

Conceptual Similarity

53 Both the English word in the Application Mark "SEWAME" and the Opponents' Marks "SEBAMED" are invented words with no significance in the English language. Thus the marks are not conceptually similar.

54 In conclusion, I am of the view that the marks are visually, aurally and conceptually dissimilar.

Identity / Similarity of Goods

55 For ease of comparison the relevant goods of the Applicants' and the Opponents' are as follows and for ease of reference, they are, accordingly, the "Applicants' Goods", the "Opponents' Class 3 Goods" and the "Opponents' Class 5 Goods":

Applicants' Mark	Opponents' Marks	
T07/22222D (Class 3)	T9705976Z (Class 3)	T8206744C (Class 5)
Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; cleansing preparations for skin; facial cleansing milk; facial cleansing soap; facial cleansing cream; bath liquid; preparations for use in shower and bath; preparations for the care and protection of the skin; skin care moisturizers; skin toners; preparations for the care and protection of sensitive skin (not for medical use); non-medicated preparations for massage; deodorant preparations for personal use; anti-perspirants for personal use (cosmetics); non-medicated preparations for protection and care of the skin; pore astringents creams; anti-wrinkle creams (cosmetics); non-medicated cream for keratosis removal; non-medicated body powder; preparations for age spot reduction; preparations for whitening the skin; skin and body masks; sunscreen and sunblock preparations (cosmetics); body massage oils; body massage creams; preparations for care of bust (cosmetics); bust beautifying and firming skin care products (cosmetics); aromatic oil for personal use, not for medical use; products for babies' skin care; non-medicated preparations for care of the eyes; cosmetic eye treatment masks, not for medical use; cosmetic eye treatment cream, not for medical use; eye creams for firming skin around eyes; non-medicated acne care preparations; acne removing preparations; cosmetic for make-	Cosmetics, essential oils, shampoos, cosmetic preparations for cleansing and care of the skin, the hair, the lips; cosmetic preparations for the external application for skin diseases; products for baby care, namely baby cleansing bars, baby foam baths, baby care baths, baby skin creams, skin care oil, tissues impregnated with cosmetic oils and lotions, moist tissues and shampoos for children, powder for children, creams for children; preparations for cleansing and care of the body; facial tonics, facial cleansers and facial care products in liquid and solid form, in form of lotions, creams, gels, facial toners (cosmetic); non-medicated bath	Pharmaceutical and sanitary substances; disinfectants (other than for laying or absorbing dust); medicated preparations having cleaning properties for the prophylaxis or treatment of diseases or disorders of the skin

<p>up; essences for cosmetic purposes; lip stick; preparations for care of lips; make-up removers; cosmetic preparations for slimming purposes; cosmetic preparations for skin care; products of make-up; non medicated preparations for care of hair; hair shampoos; hair cleansing preparations; hair cleansing gels; hair conditioners; oils for the care of hair; preparations for the regeneration of hair; preparations for hair waving; preparations for hair colouring; non-medicated preparations for use in oral hygiene; preparations for cleaning teeth; non-medicated preparations for care of hands; treatment for conditioning and care for scalp, hair and hand, not for medical use; cosmetic preparations for nails; preparations for care of nails; non-medicated anti-bacterial and anti-microbial hand washes; hand lotion; non-medicated preparations for care of foot; hair removal preparations; shave creams; preparations for use before shaving and after shaving.</p>	<p>essences; preparations for foot-care; preparations for sun protection and skin care in form of lotions, creams and gels, after sun skin balms, after sun sprays; all included in Class 3.</p>	
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56 In relation to the Applicants' Goods and the Opponents' Class 3 Goods it is clear from the above that there are some overlapping goods. For example, the Applicants' Goods include "*cleansing preparations for skin*" while the Opponents' Class 3 Goods include "*preparations for cleansing and care of the body*".

57 In relation to the rest of the Applicants' Goods and the Opponents' Class 3 Goods, the test for similarity is that as set out in the *British Sugar Case* and the following factors are relevant:

- (a) the respective uses of the goods;
- (b) the respective end users of the goods;
- (c) the physical nature of the goods;
- (d) the respective trade channels through which the goods reach the market;
- (e) whether the respective goods are in competition with each other or complementary and how those in trade classify the goods;
- (f) in the case of self serve consumer items whether in practice they are respectively found or likely to be found in supermarkets and in particular whether they are or are likely to be found on the same or different shelves.

Other than "*Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations*" in the Applicants' Goods, it would appear that the rest of the goods are similar to the Opponents' Class 3 Goods. Both the

Applicants' Goods and the Opponents' Class 3 Goods can broadly be considered as toiletries. The uses, users, physical nature of the goods are thus similar. There is an overlap in relation to the trade channels as due to the "medical concept" behind the Opponents' goods (both in Class 3 and 5), doctors may be involved in the distribution of these products in addition to pharmacists. I refer to Exhibit A of the Opponents' SD which is a brochure illustrating the origins of Sebamat Chemie GmbH and the Opponents. I note, at page 20 of the brochure, it states "*Channels of distribution underline the qualified medical aspect. Market introduction is always done initially by doctors and chemists.*" The goods can be considered to be competitive to a certain extent as well since they are all suitable for the general public as well as those with sensitive make-up even though the Opponents' goods have a "medical concept" behind them. Finally both Applicants Goods and the Opponents' Class 3 Goods are self serve items likely to be found on similar shelves in the supermarkets / toiletry shops / pharmacies.

58 In relation to the Applicants' Goods and the Opponents' Class 5 Goods, the uses and users of the goods are different. This is because the uses of the products would be to treat medical conditions over and above the basic cleansing functions. The users would be those who have some minor medical conditions in relation to, for example, the skin. I say "minor" as these products while containing some medicinal input are generally placed on open shelves in the pharmacies. They are self serve items and not prescriptive products which can only be dispensed by the pharmacists. In relation to trade channels, similar to that in relation to the Opponents' Class 3 Goods (above), there is an overlap in relation to the trade channels. The Opponents' Class 5 Goods also would not be considered as competitive to the Applicants' Goods since they cater to a particular sector of the public. Applying the factors as laid out in the *British Sugar Case* the Applicants' Goods may not be similar to the Opponents' Class 5 Goods.

Likelihood of confusion

59 In the *Polo Case*, the Court expounded on this element at [28]:

"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..."

Thus there is a need to look into the actual circumstances of the case. In this instance, this will include, the nature of the industry, the kind of consumers, the way in which the products are sold and the impression given by the marks.

60 It would appear that the Applicants have not used the Application Mark in the local context. There is no evidence tendered to show use of the Application Mark in Singapore. In view of the above, in my analysis, I would have to assume a notional, normal and fair use of the Applicants' Mark.

61 In relation to the nature of the industry, it is clear that the personal products industry consists of an array of different brands. In light of this, consumers will be more careful in their purchase in that they will ensure that they are getting the brand that they are looking for. More pertinently, it is clear that these are personal products which are applied and used directly onto the face and body of the consumer. Thus it is natural that consumers will be more careful in ensuring that they are getting exactly what they are looking for. This is because the consequences of buying the wrong product can be far more serious than for example, buying the wrong magazine.

62 I note that in this particular instance both the Applicants and the Opponents provide general toiletries as well as products which are generally of a mild nature and thus cater to those with sensitive make-up. I refer to the Applicants' specification above which includes "*preparations for the care and protection of sensitive skin (not for medical use)*". In relation to the Opponents, they appear to have a range of products for different consumers including those with normal skin, sensitive skin (both in Class 3) and those with problematic skin (Class 5).

I refer to Exhibit F of the Opponents' SD which includes write-ups on the Opponents when they were awarded the "Superbrand" award in Hong Kong (in 2003) and Malaysia (in 2004) respectively (see page 57 of the Opponents' SD).

In the Hong Kong write-up (page 62 of Opponents' SD), under "Achievement" it states:

"The range [of Sebamed products] comprises care and cleansing products for sensitive and dry skin, special care products for facial use, for the problematic skin of adolescents, for mature and normal skin as well as for delicate skin of little babies."

Under "Brand Values" it states:

"Sebamed is proud of having the products developed on medical concept for both normal and distressed skin."

[Emphasis mine.]

Similarly, in the Malaysia write-up (page 66 of the Opponents' SD), under "Achievements":

"The Sebamed range now comprises care and cleansing products for sensitive and dry skin, special care products for facial use, for problematic adolescent skin, for mature and normal skin and even for the delicate skin of infants. This multi-varied range now also includes hair care products, deodorants and other special care and cleansing products."

Under “Brand Values”:

“The advantages for the consumer are tremendous as both normal and distressed skin can benefit from Sebamed products as they are based on a medicinal concept.”

The point is, in addition to the fact that in the personal products industry the consumers would be more careful in their purchase (as mentioned above) this is all the more so for consumers who have sensitive make-up, or those who require personal products with medicinal input. This is because the consequences of buying the wrong products would have especially grave consequences for these consumers.

63 As to the way in which the products are sold, the Opponents’ Class 3 Goods and some of the Opponents’ Class 5 Goods are / would be sold side by side with the Applicant’ Goods. These are goods which are displayed on open shelves and are self serve consumer items. That is, these goods are normally purchased by consumers off the shelves without asking for assistance and generally these goods bear the marks prominently for all to see. As such it is the visual aspect of the marks which is the most important aspect of the marks. A consumer who wishes to purchase the goods would not only have a chance to look at the Opponents’ goods at close range, but also to personally handle the goods. I have already concluded above that the marks are visually dissimilar. Thus this mode of sale will further reduce the likelihood of confusion.

64 I also note at this juncture that the Opponents’ Marks as used always come in a set of 2 different colours. I refer to Exhibit H of the Opponents’ SD which includes the Opponents’ promotional materials in Singapore. At page 72 of the Opponents’ SD, the Opponents’ Marks are such that “SEBA” is in green and “MED” is in blue. At page 73, “SEBA” is in green” and “MED” is in pink. At page 74, “SEBA” is in blue and “MED” is in pink. I am of the view that the Opponents’ use of contrasting colours for “SEBA” and “MED” (in addition to the way the words “SEBA” and “MED” are arranged – see above) will only serve to emphasize (to their customers) that the Opponents’ Marks only consists of two words “SEBA” and “MED”. This is in contrast to the Application Mark which contains 4 distinct elements, namely, the device of a flag, a mountain top device, an English word “SEWAME” and the Chinese characters “雪完美”.

Further, the above visual presentation will also serve to emphasize that the Opponents’ Marks are pronounced as “SEBA-MED” and nothing else. In contrast, as the Application Mark contains Chinese characters Chinese speaking consumers will only look at the Chinese characters “雪完美” which is pronounced as “XUE-WAN-MEI” while those who are bilingual will understand “SEWAME” to be a transliteration of the Chinese characters, that is, “SEE-WA-MAY”. The other possible pronunciations for the English word in the Application Mark is “SEE-WA-MEE” or “SEE-WAM” (above).

All of the above will only serve to further diminish the likelihood of confusion.

65 In view of all of the above, I am of the view that there is no likelihood of confusion.

66 Thus the ground of opposition under Section 8(2)(b) is not made out.

Ground of opposition under section 8(7)(a)

67 Section 8(7)(a) reads:

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

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

Opponents’ submissions

68 The Opponents submitted that the elements required to establish passing off is as per the case of ***Johnson & Johnson*** at [23]:

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

The above elements are further elaborated in the case of ***WILD CHILD Trade Mark [1998] RPC 455***:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (a) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and*
- (b) that the members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.*

...

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (i) the nature and extent of the reputation relied upon;*
- (ii) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;*

- (iii) *the similarity of the mark, name etc used by the defendant to that of the plaintiff;*
- (iv) *the manner in which the defendant makes use of the name, mark etc complained of and collateral factors;*
- (v) *the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”*

69 The Opponents submitted that goodwill is a question of fact which is determined by the extent of use of a trade mark in Singapore. The Opponents submitted that the evidence shows that the Opponents’ Marks have been used on a wide range of personal care products (paragraph 7 and Exhibits A, C, D and E of the Opponents’ SD). The Opponents submitted that the evidence also further shows that the products bearing the Opponents’ Marks have been sold in Singapore since at least 1983. The Opponents referred to the annual turnover figures in relation to goods bearing the Opponents’ Marks in Singapore (above and also Exhibit C of the Opponents’ SD). The Opponents submitted that in view of the Opponents’ long and extensive use of the Opponents’ Marks in Singapore, the Opponents would have acquired goodwill and reputation in their business under the Opponents’ Marks.

70 With regards to misrepresentation, the Opponents referred to the ***Polo High Court Case*** where it held at [23]:

“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 referred to their submissions above in relation to confusing similarity. The Opponents submitted that they are equally applicable to the analysis of misrepresentation. The Opponents submitted that the marks are visually and aurally similar. The distinctive part of the Opponents’ Marks is enhanced by their use in Singapore and any perceived difference between the marks is insufficient to distinguish the marks. In addition, the marks are intended to be used / have been used on overlapping and / or similar goods which are / will be sold through the same trade channels. The Opponents reiterated their submissions in relation to the similarity between the goods.

71 In relation to damage, the Opponents referred to ***Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd [1991] 1 SLR(R) 903*** at [31]:

“If the goods in question are in direct competition with one another, the court will readily infer the likelihood of damage to the plaintiff’s goodwill, not merely through loss of sales but also through the loss of the exclusive use of his name or mark in relation to the particular goods or business concerned.”

The Opponents also referred to ***Wadlow on Passing Off (3rd Edition)*** at page 248 that “a misrepresentation that the defendant’s goods or business are those of the claimant is

intrinsically likely to damage the claimant if the fields of business of the claimant are reasonably close.”

The Opponents submitted that even in the absence of any proof of actual damage, damage can be presumed by virtue of the close similarities between the marks and goods traded by both the Applicants and the Opponents.

72 For the above reasons, the Opponents submitted that the use and registration of the Application Mark will be contrary to Section 8(7)(a).

Applicants’ submissions

73 At the hearing, the Applicants submitted that given that there is no similarity between the marks, the passing off action must fail as there is no misrepresentation. The Applicants submitted that the Opponents have not made out a case of misrepresentation and damage.

Decision

74 It is clear that in order to bring about an action under passing off, the three elements of (i) goodwill; (ii) misrepresentation; and (iii) damage must be made out. At paragraph 36 of its Judgment, the Court of Appeal in ***Novelty Pte Ltd v Amanresorts Ltd and another [2009] SGCA 13*** (“*Amanresorts*”) referred to the following passage in ***CDL Hotels International Ltd v Pontiac Marina Pte Ltd [1998] 1 SLR(R) 975***:

“The law of passing off can be summarised in one short general proposition – no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the getup is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by [the defendant] are the goods or services of the plaintiff. Whether the public is aware of the plaintiff’s identity as the manufacturer or supplier of the goods or services is immaterial, as long as [the goods or services] are identified with a particular source which is in fact the plaintiff. For example, if the public is accustomed to rely upon a particular brand name in purchasing goods of a particular description, it matters not at all that there is little or no public awareness of the identity of the proprietor of the brand name. Thirdly, he must demonstrate that he suffers or, in a quia timet action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff.”

[Emphasis mine].

Goodwill

75 The Court of Appeal in *Amanresorts* clarified that goodwill is the attractive force which brings in custom. Further, the specific sector of the public to be considered could be limited to small sections of the public, so long as these sections are not negligible.

76 As to the mode of proving goodwill I refer to *Law of Intellectual Property of Singapore (Sweet & Maxwell, Revised Edition, 2009)* by Ng-Loy Wee Loon at [17.1.4]. The plaintiff usually discharges his burden of proving goodwill by tendering evidence of his sales volume, and / or the extent and amount of advertisement and media coverage of his business conducted under that mark.

77 I refer to the Opponents' annual turnover figures in relation to goods bearing the Opponents' Marks in Singapore above and repeated here for ease of reference.

Year	Value in Euros	Value in Singapore Dollars (1 EUR = S\$1.944)
1983	18,000	34,992
1984	7,000	13,608
1985	18,000	34,992
1986	30,000	58,320
1987	24,000	46,656
1988	35,000	68,040
1989	44,000	85,536
1990	31,000	60,264
1991	153,000	297,432
1992	186,000	361,584
1993	159,000	309,096
1994	123,000	239,112
1995	111,000	215,784
1996	172,000	334,368
1997	241,000	468,504
1998	186,000	361,584
1999	229,000	445,176
2000	126,000	244,944
2001	136,000	264,384
2002	197,000	382,968
2003	96,000	186,624
2004	165,000	320,760
2005	152,000	295,488
2006	292,000	567,648
2007	318,000	618,192

78 As the relevant date in this instance is 20 November 2007, the relevant period in this instance would be anytime prior to this date. With reference to the table above, the average annual turnover is approximately S\$259,431¹.

There is no evidence tendered as to the volume of sales in Singapore.

79 In relation to promotion of the Opponents' products in Singapore, while there are random copies of the Opponents' promotional materials in Singapore (Exhibit H at pages 72 – 85 of the Opponents' SD) there is no evidence tendered as to the expenditure expended to market such products in Singapore.

80 However, from the average annual value of sales above, it would appear that the Opponents have the requisite goodwill in Singapore.

Misrepresentation

81 I have concluded above under the ground of opposition under Section 8(2)(b) that there is no likelihood of confusion. For the same reasons, I find that there will be no misrepresentation if the Application Mark is used.

Damage

82 As the Opponents have not made out the element of misrepresentation, there is no need for me to look into the element of damage.

Ground of opposition under section 8(4)(b)(i)

83 Section 8(4)(b)(i) reads:

“8.— (4) Subject to subsection (5), where an application for registration of a trade mark is made on or after 1st July 2004, if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark, the later trade mark shall not be registered if —
(a) the earlier trade mark is well known in Singapore; and
(b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —
(i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark;”

¹ This figure is obtained by adding up the annual turnover in the table above with the exception for 2007 where only $\frac{3}{4}$ of the amount is taken into account ie 463,644 and dividing the sum total by 23.75. The figure of 463,644 and 23.75 is used as the relevant date falls within the year 2007.

Opponents' submissions

84 The Opponents submitted that the issues to be decided under this Section are whether:

- (a) the whole or essential part of the Application Mark is identical or similar to the Opponents' Marks;
- (b) the Opponents' Marks are well known in Singapore;
- (c) use of the Application Mark in relation to the goods claimed would indicate a connection between the goods claimed and the Opponents;
- (d) the interests of the Opponents are likely to be damaged as a result.

85 In relation to the first element, the Opponents repeated their submissions in relation to the confusing similarity between the marks.

86 With regards to the second element in relation to how well-known the Opponents' Marks are in Singapore, the Opponents referred to Section 2(7) which provides the criteria which will be relevant in determining whether a trade mark is well-known in Singapore:

- (a) the degree to which the trade mark is known to or recognized by any relevant sector of the public in Singapore;
- (b) the duration, extent and geographical area of –
 - (i) any use of the trade mark;
 - (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 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 recognized 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 recognized as well known by the competent authorities of that country or territory;
- (e) any value associated with the trade mark.

Further, Section 2(9) provides that “relevant sector of the public in Singapore” includes any of the following:

- (a) all actual consumers and potential consumers in Singapore of the goods to which the trade mark is applied;
- (b) all persons in Singapore involved in the distribution of the goods to which the trade mark is applied;

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

87 The Opponents submitted that the Opponents have gained worldwide recognition for their personal care products for their excellence and quality. In particular, “Superbrands” award has been granted to the Opponents’ body care products under the Opponents’ Marks in 2005 (paragraph 9 and Exhibit F of the Opponents’ SD). The Opponents have been using the Opponents’ Marks worldwide since the late 1960’s and in Singapore since at least 1983. The Opponents’ Marks have been used on a wide range of personal products (paragraph 5 to 8 and Exhibits B, C, D and E of the Opponents’ SD). The Opponents also expended significant efforts and expenditure in advertising and promoting the goods under the Opponents’ Marks worldwide and in Singapore (paragraph 10 and Exhibits G and H of the Opponents’ SD). The Opponents also have registrations in numerous jurisdictions (paragraph 12 and Exhibits I and J of the Opponents SD). Finally, the Opponents have instituted a number of legal suits in several countries worldwide, including Australia and the European Community to protect the Opponents’ rights in the Opponents’ Marks. In particular, the Opponents’ Marks were found to enjoy significant reputation by the Office for Harmonisation in the Internal Market (“OHIM”). OHIM recognized the reputation that the Opponents’ Marks enjoy in Germany and held that the registration of the mark “SEBACIN” will result in a likelihood of confusion as the mark is visually and phonetically similar to the Opponents’ Marks. It was further stated that the Opponents’ Marks were recognized as a top trade mark for pharmaceutical preparations for skin diseases as well as for cosmetics and the registration and use of the mark “SEBACIN” will take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponents’ Marks (paragraph 14 and Exhibit L of the Opponents’ SD).

88 In relation to the requirement of “indicate a connection” and “likely to damage the interests of the proprietor of the earlier trade mark” the Opponents referred to *Pensonic Corporation Sdn Bhd v Matsushita Electric Industrial Co. Ltd* [2008] SGIPOS 9 (“*Pensonic Case*”) at [103]:

“I am of the view that if the Applicants’ mark is used in Singapore, it is likely that when a consumer sees their Pensonic product, he would think that these products are somehow connected or related to the owner of the Panasonic mark. I do not think that the consumer would just be reminded of the Opponents mark which is insufficient to establish a connection.”

Further the Opponents also referred to *Amanresorts Ltd and another v Novelty Pte Ltd* [2008] 2 SLR (R) 32 at [32]:

“In my view, the tests to be adopted for “connection” and “is likely to damage the interests of the proprietor” in s 55(3)(a) of the Trade Marks Act are no different from those enunciated in case law on passing off.”

The Opponents submitted that Section 55(3)(a) of the Act shares similar elements namely “indicate a connection” and “likely to damage the interests of the proprietor” as Section 8(4). The Opponents submitted that the above passage was upheld by the Court of Appeal in *Amanresorts* although the Court of Appeal further clarified that while the tests are similar, the two tests are not identical in one aspect and that is the tests relating to misrepresentation and damage in passing off actions concern the plaintiff’s goodwill while the tests under s55 concern the interests of the plaintiff and not its goodwill.

Further the Opponents referred again to the *Pensonic Case* at [109]:

“I am of the view that under this section as well where it has been shown that the mark is well known and that there is an indication of connection, the likelihood of damage may be inferred.”

89 Applying the above principles, the Opponents submitted that their submissions in relation to similarity of marks, goods and likelihood of confusion under Section 8(2)(b) and misrepresentation and damage under Section 8(7)(a) would be applicable to the analysis of the elements of “indicate a connection” and “likely to damage the interests of the proprietor of the earlier trade mark”. In summary, in view of the similarity of the marks and goods, there is a real likelihood that the public will be misled into thinking that the Applicants’ products originate from the Opponents or that there is some connection between the two parties, which is thereby likely to result in damage to the interests of the Opponents.

90 For the above reasons, the Opponents submitted that the use and registration of the Application Mark will be contrary to Section 8(4)(b)(i).

Applicants’ submissions

91 In relation to the ground of opposition under Section 8(4)(b)(i), the Applicants submitted that there is no connection and no damage in this instance.

92 The Applicants submitted that Opponents’ Marks are well-known in Singapore and that consumers who want to purchase the Opponents’ products do so for their medical background. Thus when the consumers want to purchase the Opponents’ products they would want to see the products (to ensure that they are the products with the particular medical properties which they want to buy) and once they see the goods bearing the Opponents’ Marks, there will be no confusion.

Decision

Whether the whole or an essential part of the Application Mark is identical with or similar to the Opponents’ Marks

93 I have already concluded above that the marks are visually, aurally and conceptually dissimilar. Accordingly, this element of Section 8(4)(b)(i) is also not made out.

Whether the earlier trade mark is well known in Singapore

94 The Court of Appeal in *Amanresorts* provided some guidance in relation to the interpretation of Sections 2(7), (8) and (9) of the Act which pertain to the determination of how well-known a mark is in Singapore.

The Court explained at [137], [139] and [140]:

“137 The factors laid out in ss 2(7)(a)–2(7)(e) of the current TMA (which collectively correspond to Art 2(1)(b) of the Joint Recommendation) are not an exhaustive list in that the court is obliged to take into account “any matter from which it may be inferred that the trade mark is well known” [emphasis added] (per s 2(7) of the current TMA). It appears that the court is ordinarily free to disregard any or all of the factors listed in s 2(7) as the case requires (subject to one particular factor which we shall discuss at [139]–[140] below), and to take additional factors into consideration. The list of factors in s 2(7) can thus be more accurately described as a set of guidelines.

139 There has been some significant and interesting debate among legal commentators on the actual scope of ss 2(7)(c)–2(7)(e) of the current TMA. However, as the instant case does not turn on the consideration of these factors, we shall limit our discussion to s 2(7)(a) (primarily) and s 2(7)(b) of the current TMA. Despite what has been said earlier, it can be persuasively said that s 2(7)(a) is arguably the most crucial factor when determining whether a trade mark is well known in Singapore. This is because, by virtue of s 2(8) of the current TMA:

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.

140 This deeming provision suggests that the court cannot disregard s 2(7)(a) (which looks at “the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore” [emphasis added]) in its deliberations. Indeed, it appears that all the other factors listed in s 2(7) are irrelevant once it is determined that the trade mark in question is well known to “any relevant sector of the public in Singapore” (per s 2(7)(a)).”

95 Section 2(9) provides that “relevant sector of the public in Singapore” includes any of the following:

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

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

96 It is pertinent to note that the Court in *Amanresorts* commented on the level of protection granted to marks which are “well-known in Singapore” as follows at [229]:

“Finally, it will be recalled that it is not too difficult for a trade mark to be regarded as “well known in Singapore” – essentially, the trade mark in question need only be recognised or known by “any relevant sector of the public in Singapore” [emphasis added] (see s 2(7)(a) of the current TMA), which sector could in certain cases be miniscule...”

In this instance, I refer to the evidence tendered by the Opponents in relation to the annual turnover of the Opponents in Singapore. The Opponents have been selling the Opponents’ goods in Singapore since 1983. Thus it has been a span of about 23 years. During this period, the estimate annual sales turnover is S\$259,413 (see above).

In light of the above, I am prepared to accept that the Opponents Marks are well known to the relevant sector of the public, in this instance, to all actual and potential consumers in Singapore of products bearing the Opponents’ Marks such that the Opponents’ Marks are well known in Singapore.

Whether use of the Application Mark would indicate a connection between those goods or services and the Opponents

97 In relation to this element, the Court of Appeal in *Amanresorts* clarified that the confusion requirement is to be read into Section 55(3)(a). Thus under this limb, there is a need to show that the Application Mark would indicate a (confusing) connection between the goods bearing the Applicants’ Mark and the Opponents, and that such is likely to damage the interest of the Opponents.

The Court of Appeal in *Amanresorts* also commented at [234]:

“In the instant case, we agree with the Judge’s finding (at [74] of the Judgment) that the tests to be adopted for the purposes of the “connection” requirement and the “likely to damage the [plaintiff’s] interests” requirement in s 55(3)(a) of the current TMA would yield the same results as those obtained from applying the corresponding tests vis-à-vis the Respondents’ claim for passing off (which tests are, respectively, whether the Appellant has made a misrepresentation to the relevant sector of the public (ie, the persons delineated at [66] above) which causes that section of the public to mistakenly think that the Project has the same source as or is connected with the Respondents’ resorts, and whether such misrepresentation has resulted in or is likely to result in damage to the goodwill attached to the “Aman” names)... However, we pause to clarify that while the tests relating to misrepresentation and damage under the law of passing off

are substantively the same as the tests relating to, respectively, the “connection” requirement and the “likely to damage the [plaintiff’s] interests” requirement in s 55(3)(a) of the current TMA, the two sets of tests are not identical in one aspect. An important distinction is that the tests relating to misrepresentation and damage in passing off actions concern the plaintiff’s goodwill (see [69] above), whereas the corresponding tests under s 55(3)(a) of the current TMA concern the interests of the plaintiff and not its goodwill (indeed, as the definition of “well known trade mark” in s 2(1) of the current TMA makes clear, the plaintiff’s trade mark may be a “well known trade mark” for the purposes of s 55(3)(a) even if the plaintiff has no goodwill in Singapore”

[Emphasis mine.]

While the specific comments were made in relation to Section 55(3)(a), as Section 55(3)(a) is in *pari materia* with Section 8(4), the comments will apply equally to the current situation. The Court, at [216], mentioned that the “damaging connection” condition in Section 55(3)(a) corresponds to that in Section 8(4)(b)(i).

98 I have found above that the element of misrepresentation has not been made out. For the same reasons, this damaging connection element is also not made out under Section 8(4)(b)(i).

99 As the Opponents have not made out 2 of the elements under this Section 8(4)(b)(i), this ground of opposition fails.

Conclusion

100 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, the opposition fails on all grounds of the opposition. Trade Mark application number T07/22222D may proceed to registration. Accordingly, costs, to be taxed, if not agreed, are awarded to the Applicants.

Dated this 11th day of August 2010.

Sandy Widjaja

Principal Assistant Registrar of Trade Marks

Hearings & Mediation Division

Intellectual Property Office of Singapore