

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

Trade Mark Application No. T0605049G  
13 April 2011

**IN THE MATTER OF A TRADE MARK APPLICATION BY  
  
AVTAR SINGH AND HARKIRAT SINGH TRADING AS AERO CLUB**

**AND**

**OPPOSITION THERETO BY**

**THE TIMBERLAND COMPANY**

Hearing Officer: Ms See Tho Sok Yee  
Principal Assistant Registrar of Trade Marks

Ms Karol Goh and Ms Deryne Sim (ATMD Bird & Bird LLP) for the Applicants  
Ms Mary Thomas and Ms Kiran Dharsan (Ella Cheong Spruson & Ferguson (Singapore) Pte  
Ltd) for the Opponents

*Cur Adv Vult*

**GROUND OF DECISION**

1 Avtar Singh and Harkirat Singh trading as Aero Club (“the Applicants”), applied on 20 March 2006 to register a series of two trade marks, “WOODLAND & tree device” (“the Application Mark”, represented as a series below), in Singapore in Class 25 in respect of “Clothing, clothing belts, socks, footwear, headgear.”



2 The application was accepted and published on 5 April 2007 for opposition purposes. The Timberland Company (“the Opponents”), filed their Notice of Opposition to oppose the registration of the Application Mark on 3 August 2007. The Applicants filed their Counter-Statement on 29 November 2007.

3 The Opponents filed evidence in support of the opposition on 27 November 2008. The Applicants filed evidence in support of the application on 18 November 2009. They then amended their Counter-Statement on 29 January 2010. The Opponents filed evidence in reply on 18 October 2010. After three postponements of the hearing, the matter was finally re-fixed to be heard on 13 April 2011. Three working days before the hearing, on 8 April 2011, the Opponents sought to adduce further evidence. This comprises a statutory declaration by Hoo Guan Seng, Retail Manager of The Timberland Company Asia Pacific Pte Ltd, the Opponents' subsidiary; and another statutory declaration by Tang Pei Fen, a private investigator of Commercial Investigations LLP. Both SDs are dated 7 April 2011. The Opponents also sought to include a ground of opposition under Section 7(6) at the same time. The Applicants objected to both applications. The Registrar directed that these issues be adjudicated at a separate interlocutory hearing.

4 The opposition was heard on 13 April 2011 based on the agreed grounds under Sections 8(2)(b), 8(7)(a) and 8(4)(i). As the Opponents' grounds of opposition did not clearly disclose on the face of the record that they relied on Section 8(4)(ii)(A) or 8(4)(ii)(B) or both, the Applicants objected to the Opponents proceeding on Section 8(4)(ii). The Registrar also directed that this issue be adjudicated at the interlocutory hearing.

5 An interlocutory hearing was convened on 20 April 2011 to determine whether to allow the Opponents to amend their grounds of opposition to include two other grounds under Sections 7(6) and 8(4)(ii)(A) and (B), as well as whether to allow further evidence from the Opponents. In her written decision issued on 25 April 2011, Principal Assistant Registrar Lee Li Choon disallowed the applications for the Opponents to file further evidence and amend their grounds of opposition. However, the Opponents may proceed on Section 8(4)(ii)(A) without amending their grounds of opposition as the ground has been pleaded in substance (*Crown Confectionery Co Ltd v Morinaga & Co Ltd* [2008] SGIPOS 12 at [68]).

6 A case management conference was convened on 6 May 2011 to discuss the further conduct of the matter. The parties agreed that they would file written submissions on Section 8(4)(ii)(A) and written rebuttals thereto in lieu of appearing in person at a hearing. Written submissions were filed on 10 June 2011 and written rebuttals were filed on 24 June 2011.

### **Grounds of Opposition**

7 The Opponents rely on Sections 8(2)(b), 8(7)(a), 8(4)(i) and 8(4)(ii)(A) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”) in this opposition. They did not pursue the

grounds of opposition under Article 6bis of the Paris Convention and Section 55 of the Act, which were claimed in their Notice of Opposition. They also did not proceed on Section 8(2)(a), although they had pleaded Section 8(2) in general in their Notice of Opposition.

### **Opponents' Evidence**

8 The Opponents' evidence comprises a Statutory Declaration ("SD") sworn by Michelle Hanson, Assistant General Counsel and Assistant Secretary of the Opponents, on 3 November 2008 in the United States of America, as well as an SD in Reply made by the same deponent on 11 October 2010 in the United States of America.

9 In the Opponents' further written submissions of 10 June 2011, they annexed as Exhibit A photographs of WOODLAND and Timberland shoes with their price tags. Their intent was to show that there is not much difference in the price range between the respective goods of the parties. The Opponents had in fact sought to admit further evidence earlier with such content. However, the Principal Assistant Registrar refused the application to file further evidence on 25 April 2011. Notwithstanding, the Opponents persist in relying on the photos via their written submissions. These shall accordingly be disregarded as they are essentially unsworn evidence and their probative value is in question.

### **Applicants' Evidence**

10 The Applicants' evidence comprises an SD affirmed by Harkirat Singh, a partner of the Opponents, on 29 October 2009 in India. Also, a Supplementary SD by Harkirat Singh dated 22 June 2011 was admitted into evidence on 18 July 2011, correcting an error in his earlier SD of 29 October 2009.

### **Applicable Law and Burden of Proof**

11 As the applicable law is the Trade Marks Act (Cap 332, 2005 Rev Ed), there is no overall onus on the Applicants either before the Registrar or in opposition proceedings. The undisputed burden of proof in the present case falls on the Opponents.

### **Background**

12 The Applicants started operations in 1992 in New Delhi, India and adopted the Application Mark in respect of a wide range of goods including clothing and footwear. Today, the Application Mark is a household brand in India with over 200 exclusive stores and more than 1000 distributor stores across the country. Their goods found success with the young, mobile and outgoing population of India. The Applicants have published cautionary notices in leading Indian newspapers to warn members of the trade and public not to use their "WOODLAND & tree device", "WOODLAND" word mark, and "tree device" without authorisation. In India, the Applicants are also a major entertainment and event promoter. They are involved in fashion shows featuring India's leading models, beauty contests, celebrity pop shows, rock concerts, game shows, cricket matches and Hollywood movie premieres. The Applicants regularly sponsor major events such as cricket matches

13 The Applicants also have a network of distributors and franchisees worldwide. Their goods are sold in Singapore, Hong Kong, the UAE, the UK, Bangladesh and Nepal. Their

worldwide gross revenue in FY2005-2006 is approximately US\$29,578,370 (almost US\$30 million).

14 The Applicants have registered “WOODLAND & tree device” in Class 25 in various countries including Kuwait, Iran, New Zealand, Nepal, Hong Kong, Afghanistan, Lebanon, Turkmenistan, and India. Across these countries, the specifications of goods include footwear.

15 In addition, on 8 June 1995, the Applicants have registered the word mark "WOODLAND" in Singapore under T9505140J in respect of footwear in Class 25. The mark was advertised before acceptance.

16 The Applicants claim that they have used the Application Mark in Singapore since at least end-2005, as evinced by Invoice No. ASO/69/05-06/SIN dated 21 December 2005 in Exhibit D of Harkirat Singh's SD dated 29 October 2009. However, the invoice in question does not support the use of the Application Mark in Singapore, as the goods are only described as "gents leather shoes". The earliest dated invoice in evidence showing WOODLAND footwear sold to Singapore is dated 16 August 2007, with the exporter indicated as "Aero Shoes" and the consignee as "Mohamed Mustafa & Samsuddin Co Pte Ltd". Thus, the earliest date of first use in Singapore borne out by the evidence is 16 August 2007.

17 Other than a handful of invoices to Mohamed Mustafa & Samsuddin Co Pte Ltd, there is little other qualitative or quantitative evidence specific to Singapore. At the hearing, the Applicants' agents confirmed that there is no Singapore-specific revenue, advertising and promotion figures.

18 The Opponents' mark, TIMBERLAND, was conceived under commission in 1973 by an advertising firm to give the Opponents' key product, a high quality waterproof leather boot, an outdoors image to promote and sell such boots to a wider market. The Opponents first used their mark in 1973 in the United States.

19 The Opponents own numerous trade mark applications and registrations worldwide, such as in the United States, European Community, Australia and Japan, for the word mark "TIMBERLAND" and/or the composite mark "Timberland & tree device" in various classes including Class 25.

20 In the present opposition, the Opponents rely on the following marks (collectively "the Opponents' Marks") registered in Singapore:

S/No.	TM No.	Trade Mark	Class	Specification
1	T8403966H		25	Articles of outer clothing and T-shirts; footwear, being articles of clothing and articles of sports clothing.
2	T8403967F		25	Articles of outer clothing and T-shirts; footwear, being articles of clothing and articles of sports clothing.

3	T8904485F		25	Articles of outer clothing and T-shirts; footwear, being articles of clothing and articles of sports clothing
4	T9910179H	<b>TIMBERLAND</b>	35	Retail store services; retailing services via a telecommunications network.
5	T9910175E		35	Retail services relating to waterproofing products, shoe care preparations, utility knives, hand tools, cutlery, eyewear, flashlights and lamps for lighting, watches and jewelry, appointment and address books, stationery and writing instruments, bags and carrying cases, furniture and picture frames, portable coolers, lunch boxes and vacuum bottles, clothing, footwear and headgear, shoe laces; retail services in relation to general merchandise via a telecommunications network.

21 The Opponents used their mark TIMBERLAND in Singapore since as early as 1983. Their goods are sold in various retail locations through Singapore, including at Timberland Stores in Suntec City Mall, Centrepoint Mall, Vivo City, Raffles City Shopping Centre and Takashimaya Shopping Centre; and at other sales outlets such as Bata and Metro. They also have an online presence at [www.timberland.com](http://www.timberland.com), which drew 35,132 visitors from Singapore between 30 June 2005 and 29 June 2006.

22 From 2000 to 2006, the Opponents' average sales in Singapore were approximately US\$10.061 million. In 2007, their net revenue was US\$13.129 million; in 2008 it was US\$12.356 million and in 2009, it was US\$10.394 million.

23 According to Mr Harkirat Singh's first SD, the Opponents' total expenditure for advertising and promotion in Singapore from 2000 to 2005 is approximately US\$70,000.

## MAIN DECISION

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

24 Section 8(2)(b) of the Act reads:

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***

25 The Opponents submit that the Application Mark is highly and confusingly similar to the Opponents' Marks.

26 The Application Mark comprises a word and a tree device, as does the Opponents' registration T8403967F. The representations of the respective marks are set out below:

<b>Application Mark</b>	<b>Opponents' T8403967F</b>
	

27 Applying the doctrine of imperfect recollection, the Opponents submit that the main general impression is the idea of a word and a tree. Further, the two tree devices are not only visually similar, they also form the significant detail in both marks such that consumers will be confused when they come across both marks in the marketplace. The verbal differences "WOOD" and "Timber" are less significant than the tree devices in both marks.

28 Visually and phonetically, the marks end with the same syllable "LAND" and contain similar/identical tree devices.

29 Further, the word "WOOD" is still conceptually similar to the Opponents' Marks because "WOOD" conveys the same idea of a tree. "Timber" refers to trees or wooded land considered as a source of wood; or to wood used as building material; which is related to and synonymous with "WOOD". The main concept of the Application Mark and the Opponents' Marks is "wood"/"timber" and "land". They evoke the same concept of trees and nature.

30 Overall, the respective marks are visually, phonetically and, more importantly, conceptually very similar when looked at as wholes such that without the benefit of comparing the marks side by side, the average consumer will be confused that the marks originate from the same source.

31 The Opponents also submit that the respective goods are similar as both parties deal with clothing and footwear.

32 Finally, the Opponents submit that there is a likelihood of confusion taking into account the relevant factors such as the closeness of the goods, the impression given by the marks, the possibility of imperfect recollection and the risk that the public might believe the goods come from the same source or economically linked sources.

### ***Applicants' Submissions***

33 The Applicants do not dispute that the respective goods are similar. Hence, the outstanding issues under Section 8(2)(b) are whether the respective marks are similar; and whether, because of the similarity of marks and goods, there exists a likelihood of confusion on the part of the public.

34 The Applicants submit that the respective marks are not similar visually because:

- (i) The word marks in the Application Mark and the Opponents' T8403967F do not use the same font.
- (ii) The word "WOODLAND" in the Application Mark is written entirely in capital letters, while the word "TIMBERLAND" in the Opponents' T8403967F begins with its only capital letter, namely "T", and ends with the letters "i-m-b-e-r-l-a-n-d" in lower case letters.
- (iii) The Opponents' T8403967F uses only one font size, while the letters "W" and "D" are of a larger font size than the rest of the alphabets in the Application Mark.
- (iv) The Applicants' "WOODLAND" word mark is top-aligned, while the Opponents' "TIMBERLAND" word mark is bottom-aligned.
- (v) The Opponents' tree device is situated to the right of the word "TIMBERLAND". The Applicants' "tree plant leaves" device is placed squarely in the centre and behind the word "WOODLAND", partially hidden.
- (vi) The Opponents' T8403967F takes on a linear, elongated shape, with the word "TIMBERLAND" being the more distinctive and dominant element of the mark. The Opponents' tree device consists of branches, but has no leaves and flanks the right of the word "TIMBERLAND". In contrast, the most striking feature of the Application Mark is the Applicants' "tree plant leaves" device, which consists of eighteen radially-arranged leaves. While the Opponents' tree device is relegated to the end of the Opponents' Mark, Applicant's "tree plant leaves" device protrudes prominently from the centre of the Application Mark, creating an apex and giving the dominant features of the Application Mark a triangular shape.

35 The respective marks are also not aurally similar. The Opponents' T8403967F consists of three syllables and begins with the high-pitched "TIM", while the Application Mark consists of two syllables and begins with a low guttural sound, "WOOD". The first syllable of a mark is the most important as there is a tendency for persons to slur the termination of words. On the other hand, there is only one common syllable, "LAND". The words "TIMBER" and "WOOD" are so phonetically disparate that the average customer will not mistake one mark for the other, even if hearing the marks for the first time.

36 Conceptually, the marks are also not similar. "TIMBERLAND" brings to mind the following ideas:

- (i) A warning sound which lumberjacks make to inform people that they have felled a tree
- (ii) Wood processed for use as building material
- (iii) Land covered with industrial wood crops thought of in terms of its potential and value as timber

37 On the other hand, "WOODLAND" would be associated with:

- (i) Land that is mostly covered with woods or dense growths of trees and shrubs
- (ii) A suburban town in northern Singapore.

38 Further, the average consumer would also be more familiar with the word "WOODLAND", which is a common English word, as compared to the word "TIMBERLAND".

39 Further, the pronunciation of the respective marks amplifies the divergence of ideas conveyed by each. The staccato pronunciation of "TIMERLAND" with its associated ideas in Paragraph 35 conveys as hurried, commercial feel. In contrast, the dulcet tones of the Application Mark considered with the imagery of unmolested forests convey a more laidback, outdoor and suburban feel. Therefore, the respective marks are not similar conceptually.

40 The Applicants highlight that the respective marks co-exist on the trade mark registers in India, New Zealand, Hong Kong and Singapore. This shows that the marks are not similar. In Singapore, the mark of note is the Opponents' registration for T9505140J in Class 25 for the plain word mark "WOODLAND" in respect of "footwear", which the Opponents have not challenged at the time of this hearing.

41 The Applicants further submit that there is no likelihood of confusion because of the vast differences between the respective marks, the sharp disparity in prices, the locations at which the respective goods are sold and the different target consumers.

42 A search of the trade marks register in Singapore also disclosed that the suffix "LAND" and the tree device are common elements in Class 25. The Applicants found 9 marks with the "LAND" suffix and 7 marks with a tree device in this class, for example, "GRASSLAND", "JUNGLELAND", "LEAVELAND & tree device". The common occurrence of "LAND" and tree devices in Class 25 would cause consumers to pay more attention to other features of the respective marks, namely "TIMBER" and "WOOD" and thereby distinguish them.

#### ***Decision on Section 8(2)(b)***

43 As a preliminary point, there was some dispute during the hearing on the proper test to apply in a determination under Section 8(2)(b). The Opponents had relied on both *The Polo/Lauren Co, LP v Shop-In Department Store Pte Ltd* [2006] 2 SLR 690 ("*Polo/Lauren*") and *Sabel BV v Puma AG* [1998] RPC 199, while the Applicants contended that it is the test enunciated in *Polo/Lauren* that applies in Singapore. The implication is that if there is either no similarity of marks, or no similarity of goods, or both, there is no need to consider whether there is a likelihood of confusion.

44 In this respect, the Court of Appeal in *Polo/Lauren* at [8] has made it amply clear that the 3-step approach is applicable in Singapore, rather than the global assessment test in *Sabel BV v Puma AG*. This 3-step test was again affirmed in the recent High Court decision of *Ferrero SPA v Sarika Connoissuer Cafe Pte Ltd* [2011] SGHC 176 ("*Ferrero*") at [21].

45 To succeed under Section 8(2)(b), the Opponents have to prove three elements, namely that the marks are similar; the goods are identical or similar; and, because of the foregoing, there is a likelihood of confusion on the part of the public. The Applicants do not dispute that the respective goods claimed are similar, and I also find that they are indeed so. Hence, the outstanding issues pertain to the similarity of marks and likelihood of confusion.

46 I shall examine these issues in turn.

### *Similarity of Marks: Principles*

47 In considering the similarity of marks, several principles are germane. The High Court in *Ferrero* at [50] sets these out as follows:

(a) First, the court considers the two signs/marks “as a whole” (*Polo* at [8]; *City Chain* at [47], [50]). However, the court would not take into account “any external added matter or circumstances” because the comparison is “mark for mark” (*MediaCorp* at [33], citing *Caterpillar Inc v Ong Eng Peng* [2006] 2 SLR(R) 669 at [55] (“*Caterpillar*”)).

(b) Second, the signs/marks are considered from the viewpoint of the average consumer – *not* an unthinking person in a hurry, but rather, a person who would exercise some care and good sense in making his purchases (*Polo* at [34]).

(c) Third, when comparing the two signs/marks, what is relevant is the “imperfect recollection” of the customer (*MediaCorp* at [33], citing *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” (*MediaCorp* at [33], citing *Caterpillar* at [55]).

48 I am mindful of the above in considering whether the respective marks are similar.

### *Visual Similarity*

49 For avoidance of doubt, I will first consider the Application Mark vis-à-vis the Opponents' registration T8403967F  later with the rest of the Opponents' Marks.

50 The High Court in *Ferrero* at [51] states that:

In the case of word marks, a determination of visual similarity typically involves looking at the (a) length of the marks; (b) structure of the marks (*ie*, whether there are the same number of words); and (c) whether the same letters are used in the marks (*Ozone Community* at [49], citing *Bently & Sherman, Intellectual Property Law* (Oxford University Press, 3rd Ed, 2009) at 865 (“*Bently & Sherman*”)).

51 With regard to the length of the marks, "WOODLAND" contains 8 letters while "Timberland" contains 10 letters. If the respective devices are taken into consideration, since marks are to be perceived as wholes, then the Opponents' T8403967F is even longer, because of the tree device to the right of the word "Timberland". In contrast, the tree device in the Application Mark lies behind the word "WOODLAND", adding to the height but not the length of the mark.

52 As for the structure of the marks, "whether there are the same number of words", it is noted that the respective marks each comprises one word. For good measure, it is also noted that the respective marks each contain a different tree device.

53 Third, one is to consider "whether the same letters are used in the marks". The Application Mark contains the word "WOODLAND". The Opponents' T8403967F contains the word "Timberland". It is fair to say that most of the letters in the two marks are not the same. Put another way, only the last 4 letters in the two marks are the same, namely "-LAND".

54 Summarising the visual perception of the respective marks, they are not visually similar when viewed holistically. The closest visual overlap are the tree devices (not identical) and the suffix "-LAND" in both marks. However, this alone does not lend itself to a finding of visual similarity for the purposes of Section 8(2)(b), as marks should be considered as wholes.

55 As compared to the remaining Opponents' Marks, the Application Mark is all the more not visually similar. Trade Mark Nos. T8403966H, T8904485F, T9910179H and T9910175E are registrations for either the word element "TIMBERLAND" or the tree device. If the Application Mark is not visually similar to the Opponents' T8403967F, which combines the word "Timberland" with a tree device, then marks comprising separate elements of the latter are even further removed on the scale of visual similarity.

#### *Aural Similarity*

56 In an aural comparison of marks, the principle is often put forward that "*the first syllable of a mark is most important as there is a 'tendency of persons using the English language to slur the termination of words'*", see the High Court decision in ***Johnson & Johnson v Uni-Charm Kabushiki Kaisha (Uni-Charm Corp)*** [2007] 1 SLR 1082 at [11] citing with approval ***In the Matter of London Lubricants (1920) Limited's Application to Register a Trade Mark*** (1925) 42 RPC 264, 279 ("*London Lubricants*"). This principle may enjoy a certain enshrined status due to its antiquity but it should not be applied in a "blanket fashion", see ***Valentino Globe BV v Pacific Rim Industries Inc*** [2009] 4 SLR(R) 577 at [34].

57 The Applicants would have us apply the above principle to find that, notwithstanding the identical endings, the beginnings of the respective marks, "TIMBER" and "WOOD", are so phonetically disparate that the average customer will not mistake one mark for the other, even if hearing the marks for the first time.

58 Here, there is no tendency to slur the endings of the marks. The suffix "-LAND" does not lend itself to slurring. However, this does not necessarily lead to a conclusion that the first syllable of both marks here are therefore not important. In fact, it is more likely than not that the stress in the Application Mark is on the first syllable "WOOD-" and the stress in the Opponents' T8403967F is on the first syllable "TIM-". The deepest aural impression accordingly lies herein, while the remaining syllables are, so to speak, background notes. "WOOD" and "TIM" are clearly aurally dissimilar; and when the respective marks are pronounced as wholes with the stress on "WOOD" and "TIM", they do not come across as aurally similar either. Another obvious aural difference is that "WOODLAND" is dual-syllabic while "Timberland" has three syllables.

59 The Opponents have argued that the verbal differences "WOOD" and "Timber" are less significant than the tree devices in both marks. However, I am slow to accept this in the present case, being mindful of the High Court's decision in *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 ("*Festina*") at [56] regarding consumer goods:

Even where the pictorial device forms the dominant element of a trade mark, it would be extremely rare for a consumer to describe the product by its pictorial element because the description ... is a much more difficult task ... as compared to the relatively easy articulation of the word element / brand name.

60 In the present instance, I would not say that the tree device in both marks form the dominant element in each, let alone find that consumers will describe the parties' goods, such as footwear, as "the brand with the tree logo". It is much more plausible, as the High Court in *Festina* found, that consumers will describe the parties' goods by the brand name, in this case either "WOODLAND" or "Timberland".

61 Hence, I find that the Application Mark and the Opponents' T8403967F are not aurally similar. Likewise, the Opponents' Trade Mark Nos. T8403966H and T9910179H comprise the word mark "TIMBERLAND" and the same considerations and findings above apply to these two registrations. Trade Mark Nos. T8904485F and T9910175E are registrations for a tree device, which is not pronounceable. As compared to the latter, the Application Mark is all the more not aurally similar.

#### *Conceptual Similarity*

62 On the issue of conceptual similarity, one is to consider what the respective marks both denote and connote. The easiest understanding of "denotation" is the "dictionary meaning" of a word. On the other hand, "connotation" refers to the association that springs to mind upon apprehension of a word. Thus, even for invented words (such as "NUTELLA" and "NUTELLO" in the *Ferrero* case), although there may be no dictionary meaning, it may be still be possible to compare the associated ideas behind the mark in an exercise to determine conceptual similarity.

63 In this respect, the High Court in *Ferrero* at [66] states that:

In considering whether there is *conceptual* similarity between marks, it is necessary to consider the *ideas that lie behind or inform the earlier mark (Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 ("*Festina*") at [38], citing *Bently & Sherman* at p 866).

64 The Opponents' argument under this heading has been set out at [29] above. The gist is that the dominant elements of both marks, "WOOD" and "Timber", are conceptually similar while "LAND" in both marks is conceptually identical. Both marks, in their words and pictorial devices, evoke the same concept of trees and nature.

65 The Applicants on the other hand focus on the conceptual distinctions by drilling down to precise meanings of "WOODLAND" and "Timberland", see [36]-[37] above. The Applicants also suggest, at [39] above, that the staccato pronunciation of "TIMERLAND" with its associated ideas in [36] conveys as hurried, commercial feel. In contrast, the dulcet

tones of the Application Mark considered with the imagery of unmolested forests convey a more laidback, outdoor and suburban feel.

66 As set out at [47] above, marks should be considered from the viewpoint of the average consumer with the possibility of imperfect recollection. The average consumer who compares marks removed in time and space rather than side by side in detail is likely to come to a different conclusion from a literary writer with fecundity of imagination and heightened sensitivities. In the shoes of the average consumer, both marks, by their word and pictorial elements, would generally leave some mental impression of trees and nature.

67 I borrow the words of the High Court in *Festina* at [45] in finding that "*there are some conceptual similarities between the two marks, as opposed to complete or significant similarities*" in the arboreal associations of both, conveyed by their word and pictorial elements. Likewise, there is also some conceptual similarity, but less, between the Application Mark and the Opponents' Trade Mark Nos. T8403966H and T9910179H comprising the word mark "TIMBERLAND" as the tree device is absent from the latter two marks. Again, the Application Mark is conceptually similar to Trade Mark Nos. T8904485F and T9910175E but less so as the latter two marks only comprise a tree device.

#### *Likelihood of confusion*

68 As the Application Mark and the Opponents' Marks have some conceptual similarity, and as the respective goods are similar, I am required to pursue the line of inquiry by further determining whether, as a result of the aforesaid similarity of marks and goods, there is a likelihood of confusion under Section 8(2)(b).

69 The guiding principles pertaining to likelihood of confusion are succinctly summarised by the High Court in *Ferrero* at [92] to [100]. The test for likelihood of confusion is "*whether a substantial portion of the relevant public will be confused*". The three different aspects of this test are (a) the meaning and nature of the "confusion" required; (b) the meaning and nature of the "relevant public"; and (c) the requirement of a "substantial portion" of the relevant public being confused.

70 Addressing these three issues, the High Court in *Ferrero* stated at [93] to [96] as follows:

93 With regard to the meaning and nature of the "confusion" required, the Court of Appeal in *City Chain* noted that in determining confusion, one should be cognisant of the risk that the public might believe that the goods come from the *same source* or *economically-linked* sources (see *City Chain* at [52]). In other words, the relevant confusion is not limited to the "classic confusion" scenario where consumers believe that the goods or services emanate from a particular origin (when they in fact come from another origin). There is instead a "broader" kind of confusion stemming from the consumer's (incorrect) assumption of some kind of economic connection between the users of the marks (*eg* that the goods are being provided by a subsidiary or licensee of the trade mark proprietor) (see *Bently & Sherman* at p 872).

94 It should further be noted that, by virtue of the wording of s 27(2) of the TMA, the likelihood of confusion must arise *because* of the similarities in the respective marks and goods concerned. It is insufficient that the confusion arises for *any other*

*reason*. For instance, it would clearly not be sufficient if a member of the public appears confused as to the origin of the “Nutello” drink, such confusion stemming from his incapability of understanding the survey questions directed at him (*eg* his inability to understand what it means to “produce” a drink, or to “licence / authorise” a drink, *etc*). This has important implications on the framing of survey questions, and will be dealt with in greater detail at [136] *et seq*.

95 With regard to the meaning and nature of the “relevant public”, it is trite that the issue of likelihood of confusion is to be determined by reference to average consumers of the goods and services in question. Such consumers are reasonably well-informed, reasonably observant and circumspect, and will exercise ordinary care and intelligence. They are also literate, educated, “constantly exposed to the world, either through travel or media” and are unlikely to be “easily deceived or hoodwinked” (*McDonald’s Corp v Future Enterprises Pte Ltd* [2005] 1 SLR(R) 177 at [64]).

96 With regard to the requirement that a “substantial portion” of the relevant public must be confused, it is insufficient that only a “single member of the public”, or “a very small unobservant section of society”, or “a moron in a hurry”, would be confused (*Mobil Petroleum Co Inc v Hyundai Mobis* [2010] 1 SLR 512 (“*Mobil (CA)*”) at [79], citing *Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd* [1991] 1 SLR(R) 903 (“*Tong Guan*”) at [24]). The degree of confusion must be taken above a “*de minimis* level”, and while there does not have to be a “majority” of the relevant public that is confused, there must be a “not insubstantial number” (*Mobil (CA)* at [77]-[78]).

71 It is also useful to set out the other principles relevant to the test for likelihood of confusion, as enunciated by the High Court in *Ferrero* at [97] to [100]:

97 I turn now to other relevant principles *vis-à-vis* the test for likelihood of confusion. First, it is now well-settled that the issue of likelihood of confusion is to be addressed *globally*, taking into account all the circumstances of the case. This would include, *inter alia*, 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 (*City Chain* at [52], *Polo (CA)* at [28]).

98 Second, following from the phrasing of s 27(2)(b) of the TMA, the requirement of confusion is not automatically made out just because the marks and the respective goods on which they are used are similar (*Polo (CA)* at [25]). In other words, there is *no presumption* that confusion arises where the marks and goods are similar (*Polo (CA)* at [8]). However, it is also clear from s 27(2)(b) that the likelihood of confusion which is relevant is the likelihood of confusion which is *caused* by the similarity of the respective marks and goods to each other. Accordingly, it stands to reason that where there is *greater similarity* in the marks and the goods, it would be easier to find a likelihood of confusion (*Mobil (CA)*); *Future Enterprises (HC)* at [22]). For the same reason, where the earlier mark is *distinctive*, it is more likely that a court would find that a likelihood of confusion exists (see *Sabel BV v Puma AG, Rudolf Dassler Sport* [1998] RPC 199 at 224).

99 Third, it should be noted that steps taken by the alleged infringer to differentiate his goods from those of the registered proprietor are also relevant (*City Chain* at [53],

*Polo (CA)* at [28]). Where the alleged infringer has taken pains to distinguish his products from those of the registered proprietor, the likelihood of confusion may turn out to be “merely hypothetical or speculative” (*City Chain* at [53], citing *Polo (HC)* at [21]).

100 Finally, the “mere association” of the public between the two marks based on their similar use is not *in itself* a sufficient basis for concluding that there is a likelihood of confusion in the absence of any possibility of misapprehension as to the *origin* of the goods or services (*City Chain* at [58]). I emphasise that this holding is *not inconsistent* with the point made in [93] above with regard to the “broader” kind of confusion stemming from the consumer’s (incorrect) assumption of some kind of economic connection between the users of the marks. The “economic connection” point relates to the *origin* of the goods or services, *viz.*, the (erroneous) belief that the goods are originating from a licensee of the registered proprietor’s goods. This must be contrasted with the “mere association” point, which relates to – as the phrase itself suggests – a *mere* association, without any confusion as to *origin*.

72 Thus, it is clear that just because the first two elements of Section 8(2)(b) have been made out, that there is some similarity of marks and goods, it does not necessarily follow as a matter of presumption that there is a likelihood of confusion. In [98] of the *Ferrero* decision above, not only is there no such presumption, the likelihood of confusion that is relevant is only that “*caused by the similarity of the respective marks and goods to each other. Accordingly, it stands to reason that where there is greater similarity in the marks and the goods, it would be easier to find a likelihood of confusion*”.

73 In the present case, however, the degree of similarity between the marks is on the low side. Thus, it would not be “*easier to find a likelihood of confusion*” as compared to marks which are more similar to each other, such as “NUTELLA” and “NUTELLO”. However, the particular factual matrix may still lead to a conclusion that there is a real likelihood of confusion and hence, we must proceed to a global consideration of all the circumstances of the instant case.

74 A preliminary question to be answered is: Who is the relevant public in this case?

75 Both parties seem to agree that this is the general public at large who is deemed to be “*reasonably well-informed, reasonably observant and circumspect, and will exercise ordinary care and intelligence. They are also literate, educated, 'constantly exposed to the world, either through travel or media' and are unlikely to be 'easily deceived or hoodwinked'*”, [95] of *Ferrero*.

76 At the same time, the Applicants point out that the courts will still take the trouble to ascertain who, precisely, the target consumers are. By way of example, the Applicants cite *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 at [59] (“*City Chain*”) where the Court of Appeal found that the target consumers of the appellant's watch were likely to be young and trendy consumers looking for a bargain, whereas the target consumers of the respondent's watch were likely to be more sophisticated and of a high income level.

77 The Opponents take the position that the respective marks have the same or similar target market. The Applicants contend that the marks have very different target consumers.

They submit that the Opponents' goods are targeted at fashion-conscious consumers from the moderate to high income level, because their goods are more expensive and sold at upmarket shopping centres like Suntec City Mall, Takashimaya Shopping Centre and Raffles City Shopping Centre. The Applicants' goods, in contrast, are targeted at bargain hunters or migrant workers from the Indian sub-continent.

78 There is no direct evidence that the Applicants' target market is indeed bargain hunters or migrant workers from the Indian sub-continent. However, as a matter of submission and inference, the Applicants point to the reasonable prices of the Applicants' shoes, the goodwill and presence they have in India, and the fact that the Applicants' shoes are sold at Mustafa, a shopping complex in Little India. The Applicants' evidence shows that they participated in a bus advertisement exercise apparently organised by Mustafa in 2006 to advertise their goods on three buses plying Orchard Road, Selegie Road and Serangoon Road. The inference which the Applicants invite me to draw is that these areas, and Mustafa itself, are frequented by bargain hunters or migrant workers from the Indian sub-continent. WOODLAND shoes originate from India and the Applicants' reputation lies there. Hence, it is reasonable to infer that the Applicants would target the same consumers in Little India, Singapore, as they would in India, their base.

79 I would refrain from concluding that the Applicants' relevant purchasing public is confined to bargain hunters and migrant workers from the Indian sub-continent. To my mind, this is too narrow. For one, Mustafa, though a shopping mecca for many foreign workers in Singapore, is patronized by a much wider spectrum of society. It is a tourist attraction that draws custom from tourists from all over the world. It is also patronized by regular Singapore residents. Second, the circumstances of sale in Singapore are not necessarily the circumstances of sale in India; the nature and composition of the Singapore and India markets are different. The evidence does not sufficiently persuade me that the Applicants' target consumers are only as narrow as bargain hunters and migrant workers from the Indian sub-continent.

80 With regard to the sales points of the Opponents' Timberland goods, I am also slow to accept the Applicants' submission that they are upmarket and therefore suggest a consumer base that is of moderate to high income level. Shopping centres like Suntec City Mall, Takashimaya Shopping Centre and Raffles City Shopping Centre, where Timberland Stores selling Timberland goods are situated, are not unequivocally upmarket. To my mind, these shopping centres are patronized by a broad spectrum of the public in Singapore. With respect, they are not particularly exclusive and are located very near MRT stations with high traffic volumes that bring in the general public. The Opponents' evidence also shows that Timberland goods are also sold at other retail outlets, besides specialised Timberland Stores. For example, they are sold at Bata shoe shops and Metro department stores, as evidenced by the invoices exhibited by the Opponents. Such outlets are found all over Singapore, in the city and in the heartlands where the majority of Singapore residents live.

81 In ascertaining target markets, perhaps equally or more important than the sales venues *per se* are the prices of the respective goods. Thus, even if I am wrong in my observations about Mustafa, Suntec City Mall, Takashimaya Shopping Centre, Raffles City Shopping Centre, Bata and Metro above, I am still unable to conclude that the Opponents' goods are targeted at moderate to high income earners, while the Applicants' goods are targeted at bargain hunters or migrant workers from the Indian sub-continent.

82 I am not sufficiently convinced by the Applicants' argument price-wise for the following reasons. The Applicants' evidence does not reflect retail prices for WOODLAND shoes in Singapore, only consignment prices to Mustafa. Likewise the Opponents' evidence only discloses aggregated distributor prices; the per unit prices are redacted. It is therefore difficult to compare the prices of the parties' goods in a meaningful and conclusive way from the evidence. Without better evidence, I cannot conclude that there is a price differential between the respective goods in Singapore such that there is a distinct "relevant public" for each of WOODLAND goods and Timberland goods. This scenario is distinguishable from that in the *Polo/Lauren* case where the evidence showed a definite price differential and therefore supported a finding of distinct target markets of the plaintiffs and defendants.

83 I would therefore take the "relevant public", the average consumer, in this case to be the general public. There are three main reasons. First, there is insufficient evidence on any significant price disparity between the parties' goods in Singapore. Second, both WOODLAND and Timberland goods are sold at mass market retail venues including Mustafa, Bata and Metro, so the Applicants' purported distinction of target consumers differentiated by upmarket shopping centres and the mass market Mustafa fails. Third, considering the nature of the goods themselves, clothing and shoes are goods commonly available and purchased by the general public (likewise watches in *City Chain* at [56]).

84 As noted above, the general public is reasonably well-informed, reasonably observant and circumspect, and will exercise ordinary care and intelligence.

85 Now, having answered the question of who the relevant public is, we will stand in the shoes of the relevant public, who is the general public, to consider the surrounding circumstances.

86 The Opponents cite the closeness of the goods in favour of finding likelihood of confusion. The nature and trade channels of the goods are the same; the Applicants are direct competitors with the Opponents.

87 I agree with the Opponents to some extent. In the absence of clear evidence on any price differential between the respective goods, it is reasonable to infer that the trade channels overlap in the market (taking into account mass market sales venues like Mustafa, Bata shoe shops and Metro department stores for such consumer goods) and the parties compete to some extent in the same general marketplace.

88 The Opponents also submit that due to the similarities between the respective marks, in view of the Opponents' reputation, the use of the Application Mark may impress on consumers that the goods are an extension of the Opponents' business.

89 I would be cautious about making the logical leap propounded by the Opponents above in the absence of better evidence, for example, from the market. Is it an established industry practice for a shoe company to launch another brand that does not appear to have any strategic price or product differentiation from the older brand to the same general public? In this regard, I call to mind the High Court's decision in *Ferrero* at [100]:

... the "mere association" of the public between the two marks based on their similar use is not *in itself* a sufficient basis for concluding that there is a likelihood of

confusion in the absence of any possibility of misapprehension as to the *origin* of the goods or services (*City Chain* at [58]).

90 Incidentally, there is an interesting item of evidence exhibited at page 327 of Mr Harkirat Singh's first SD. There, Applicants reproduced a magazine article, published in India, referring to their advertisement for WOODLAND shoes. Part of the article goes:

The brand leading the hiking boots wave is Timberland, from The Timberland Company. Not too far from Woodland, is it?

The Aero Group seems to have read the Timberland phenomenon very early, and saw no reason why it could not be replicated in India. In doing so, Woodland's marketers have shown a remarkable lack of qualms. The first Woodland ads by Delhi-based agency Inke in fact, showed a visual of two shoes – one, the ad proclaimed, was a Timberland, and the second, an identical shoe, it crowed, was a Woodland. "You can buy this (the Timberland) from Macy's, New York for \$110 a pair." said the headline. "Or you can buy this in India for Rs 890 a pair." No half measures here. The brand was aimed squarely at an upmarket audience that was aware of international fashion trends, had heard of Timberland, and would be willing to pay a good price for an Indian product that equalled the real thing in quality and looks.

91 There are a couple of points of note. First, this appears to be evidence supporting the Applicants' submission that shoes sold under the respective marks are differentiated by price, and, by inference, the target consumers are therefore different. However, the advertisement only refers to a price for Timberland shoes in the USA and a price for Woodland shoes in India. There is no indication of relative pricing in Singapore. It therefore does not contribute to a finding against a likelihood of confusion in Singapore.

92 Second, the advertisement appears to support the Opponents' case that the Applicants are trying to evoke the same impression projected by the Opponents' earlier mark, Timberland. The common impression given by the respective marks leads to a likelihood of confusion. The Opponents submit that the consumers targeted by the Applicants are the same consumers of Timberland shoes. By making comparison with the Opponents' shoes in the advertisement, the Applicants are competing with the Opponents. The Opponents highlight the pointed question in the article: "Not too far from Woodland, is it?"

93 The Applicants submitted at the hearing that the advertisement shows that the respective goods are substitute products. The Applicants sell Woodland shoes on the basis that they are different from Timberland shoes, and there is no fault in being inspired as long as there is sufficient differentiation to negate a likelihood of confusion. In this case, the Applicants differentiated Woodland shoes from Timberland shoes by price. The message by the advertisement is: Buy Woodland instead of Timberland. This negates any likelihood of confusion.

94 In the Court of Appeal decision in *City Chain* at [60], it was noted that "*The trial judge himself held that the Appellant's customers may buy the Solvil watch because they resemble the Respondent's watch (at [74] of the GD), thereby implicitly recognising that the customers of the Appellant appreciate that they are not buying the Respondent's watches.*"

95 That holding sheds light on the present scenario. In the advertisement, there is a price differential in India and the USA between Woodland shoes and Timberland shoes respectively. It is reasonable to say that the Applicants' customers may buy Woodland shoes in India because they resemble the Opponents' Timberland shoes from the USA but are sold at a lower price, and that these customers appreciate that they are not buying the Opponents' shoes. As such, there is no likelihood of confusion.

96 Having said that, I am mindful that on the sworn evidence available in this case, there is no substantiation that the prices for the Opponents' goods are significantly higher than those of the Applicants' goods in Singapore. Hence, the foregoing considerations have no direct application to the present inquiry on the likelihood of confusion in Singapore.

97 Returning to the issue of impression given by the marks, the pertinent question is, beyond any chance of association, is there a real possibility of misapprehension as to the origin of the goods or services?

98 As opined at [89] above, I would be slow to answer in the affirmative based on the state of the evidence. The respective marks are not visually or aurally similar, and only conceptually similar to a limited extent in their general arboreal associations. The lower the degree of similarity between the marks, all other things being the same, the more difficult it is to establish a likelihood of confusion.

99 I have earlier determined that the respective goods are close and that the parties compete with each other to some extent. However, this alone is not the litmus test for likelihood of confusion over the origin of the goods. If it were so, then all *bona fide* brands truly competing in a given market, regardless of degree of similarity to each other, would lead to a likelihood of confusion. This cannot be the case. Section 8(2)(b) itself is clear that the relevant likelihood of confusion must stem from both similarity of marks and identity or similarity of goods.

100 Here, the closeness of the goods does not outweigh the low degree of similarity of the marks to support a finding of likelihood of confusion. Even though there is insufficient evidence of a price differential, the marks are sufficiently different for the general public (who is reasonably well-informed, observant and circumspect) not to be confused. In the selection and purchase of shoes, which are a personal item worn on the feet and usually tried on before purchase, the average consumer will exercise due care and intelligence in relation to the various factors such as size fit, comfort, design, colour etc. and in doing so will usually not fail to notice the brand in the process. At times, it would be the brand that first draws the consumer's attention. Under ordinary circumstances, the process of selection and purchase of shoes allows the consumer the opportunity to apprehend the brand. Even if there be a remote possibility that a consumer in a hurry grabs the first pair of shoes off the shelf that vaguely looks outdoorsy and in so doing chooses WOODLAND shoes instead of Timberland shoes, this is not relevant to our determination. First, the requirement is only that a "substantial portion" of the relevant public is confused; "*it is insufficient that only a 'single member of the public', or 'a very small unobservant section of society', or 'a moron in a hurry', would be confused*", *Ferrero* at [96]. Second, and more fundamentally, such a mistake may not be due to confusion over the origin of the shoes arising from the similarity of "WOODLAND" and "Timberland". It may be a case where the consumer in his hurry had not even given thought to the respective marks, let alone have the opportunity to be confused by their limited similarity.

101 Taking into account all the surrounding circumstances, on the balance, I find that there is no reasonable likelihood of confusion.

### *Conclusion*

102 While there is a minor conceptual similarity of marks as well as identity/similarity of goods, there is no likelihood of confusion and the ground of opposition under Section 8(2)(b) fails.

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

103 Section 8(7)(a) of the Act 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

### *Opponents' Submissions*

104 The Opponents submit that they have, over the years, gained goodwill and reputation based on the extensive use of the Opponents' Marks. Such goodwill exists in Singapore among the public who are not regarded as negligible i.e. the average consumer in the retail industry.

105 They further submit that there is a high likelihood that a substantial portion of the relevant customers would be confused into thinking that the Applicants' goods which include "clothing and footwear" originate from the Opponents who also deal with similar goods. The use of the Application Mark on the goods claimed would cause sensible consumers to be misled into thinking that there is a connection between the parties.

106 In view of the Opponents' reputation, the high degree of similarity between the respective marks, as well as the overlap between the respective goods, the Opponents submit that the ordinary consumer in Singapore is likely to infer from the use of the Application Mark in Singapore that the Applicants' goods originate from or have some form of connection with the Opponents. This erodes the distinctiveness of the Opponents' Marks and causes damage to the Opponents.

### *Applicants' Submissions*

107 The Applicants submit that any goodwill the Opponents have is confined to a specific sector of the public, being English-speaking consumers of a medium to high income level who shop at upmarket shopping malls. For example, the Opponents concentrate their marketing and promotional efforts at Raffles City Shopping Centre; their advertisements for Timberland are placed in fashion and/or lifestyle magazines read by sophisticated, English-speaking consumers.

108 The Opponents have not adduced any evidence to show that they enjoy goodwill in relation to the Applicants' target audience, being bargain hunters or migrant workers from the

Indian sub-continent who frequent the Little India shopping belt. Therefore, the Opponents' goodwill does not extend to the Applicants' target consumers.

109 The Opponents' actual or potential customers are not likely to think that the Applicants' goods come from the same source as the Opponents', or that there is a connection or association between the parties.

110 There is also no evidence to substantiate the Opponents' claim that the use of the Application Mark will damage their goodwill.

***Decision on Section 8(7)(a)***

111 The test for passing off is mostly uncontroversial and the High Court in *Ferrero* sets out the elements to be established at [193] as follows:

To succeed in an action for passing off, the Plaintiff must establish the following elements of the “classical trinity” (*Amanresorts* at [36]-[37], citing *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR(R) 975 (“*CDL Hotels*”) at [86]):

(a) First, that the plaintiff has goodwill attached to the goods which he supplies in the mind of the purchasing public by association with the identifying “get-up” (including, *inter alia*, brand names) under which his particular goods are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods (hereinafter, referred to as the element of “goodwill”).

(b) Second, that the defendant has made a misrepresentation to the public (whether intentional or otherwise) leading or likely to lead the public to believe that goods offered by the defendant are those of the plaintiff (hereinafter, referred to as the element of “confusing misrepresentation”); and

(c) Third, that the plaintiff suffers, or is likely to suffer, damage by reason of the erroneous belief engendered by the defendant’s misrepresentation (hereinafter, referred to as the element of “damage”).

112 I will examine these requisite elements in turn.

***Goodwill***

113 The following guidance from *Ferrero* at [196]-[197] on goodwill is instructive:

196 Goodwill is the association of a good, service or business on which the plaintiff’s mark, name, labelling *etc* (referred to generically as the plaintiff’s “get-up”) has been applied with a particular source (*Amanresorts* at [39]; *City Chain* at [62]). It is an “attractive force which brings in custom” (*ibid*).

197 In determining whether goodwill exists in a name, *exposure* of the name is the relevant criterion (*Amanresorts* at [53]). Proving goodwill or distinctiveness is a question of fact (*City Chain* at [62]). Possible indicia of goodwill include volume of sales, trading, advertisements and promotion expenditure (*ibid*; *Caterpillar* at [64]).

However, mere sales figures without more are not necessarily coincident with goodwill (*Nation Fittings* at [158]).

114 The background and information on the use and promotion of the Opponents' Marks have been set out at [18] to [23] above. From 2000 to 2006, the Opponents' average sales in Singapore were approximately US\$10.061 million. In 2007, their net revenue was US\$13.129 million; in 2008 it was US\$12.356 million and in 2009, it was US\$10.394 million. The average annual sales figures in Singapore are not insubstantial. In the 23 years in Singapore from 1983 to 2006, Timberland goods have been sold in various retail locations, including at Timberland Stores in Suntec City Mall, Centrepoint Mall, Vivo City, Raffles City Shopping Centre and Takashimaya Shopping Centre; and at other sales outlets such as Bata and Metro.

115 I am reasonably satisfied that the Opponents have made out the element of goodwill.

### *Misrepresentation*

116 The High Court in *Ferrero* at [204] describes the form of misrepresentation alleged by the Opponents in this case:

The former type of misrepresentation (*viz.*, trade origin) may take the form of a false representation by the defendant that his goods are those of the plaintiff, or that there is a business connection between the plaintiff and the defendant in relation to the goods provided by them (*CDL Hotels* at [72]). Such misrepresentation occurs when a defendant represents that his goods, services or business are the plaintiff's by using a name, word, device or other mark which is deceptively similar to the plaintiff's. The representation may be express or implied, and deceives either by diverting customers from the plaintiff to the defendant or by occasioning a confusion between the parties' businesses, *eg* by suggesting that the defendant's business is an extension, branch or agency or otherwise connected with the plaintiff's business.

117 The target audience of the misrepresentation comprises the actual and potential customers of the Opponents because only misrepresentations directed to the Opponents' customers are likely to damage the Opponents' goodwill, *Ferrero* at [207], *Amanresorts* at [73].

118 With reference to the magazine article exhibited at page 327 of Mr Harkirat Singh's first SD (described at [90] above), the Applicants cite the English High Court decision of *Ciba-Geigy Plc v Parke Davis & Co. Ltd.* [1994] FSR 8 ("*Ciba-Geigy*"). In that case, the plaintiff used a green apple as the brand symbol for its VOLTAROL RETARD drug, a diclofenac. The defendant launched a competing drug called DICLOMAX RETARD. The defendant's advertisements had a picture of a green apple with a bite out of it and the words "Diclomax Retard takes a chunk out of your prescribing costs", "Cost savings of around 25% compared with the leading diclofenac retard cost as quoted in MIMS". The plaintiff alleged that the defendant misrepresented that its product was a product of the plaintiff or a produced associated or connected in the course of trade with the plaintiff; and misrepresented that its product was the same as or identical to VOLTAROL RETARD. Aldous J found that:

The defendant's advertisements use the apple which has become associated with Voltarol. The intention seems to be to say to the reader, "Voltarol". However, the

name Diclomax Retard is also prominently used and I cannot see how anybody could misunderstand the message, namely, that Diclomax is the same as Voltarol but 25 per cent cheaper. There is nothing in the advertisements, when looked at as a whole, which represents that Diclomax is made by the same company as makes Voltarol or that it is a product connected in any way with Voltarol or its makers.

119 Aldous J concluded that the representation made by the advertisement is "Voltarol substitute but cheaper" and the plaintiffs had not established misrepresentation.

120 The parties' submissions in respect of this advertisement and the element of likelihood of confusion under Section 8(2)(b) at [92] and [93] above are called to mind. The comparative advertising engaged by the Applicants in this case is similar to the *Ciba-Geigy* case above. Explicit reference is made to the two brands in issue; their differences are highlighted (in both the advertisements in *Ciba-Geigy* and the present case, the difference between the two is the price); the message to the consumer is to buy the cheaper equivalent product. In these circumstances, it is difficult to see any misrepresentation that the Applicants' good originate from or are otherwise connected to the Opponents. On the contrary, a normal and fair reading of the advertisement would cause the consumer to realise that two different, competing brands are being compared and the cheaper brand is putting itself out as the brand of choice instead of the more expensive brand. There is therefore no misrepresentation.

121 However, as opined under [96] above, there is no sworn evidence available that can substantiate any significant price differential between WOODLAND and Timberland goods in Singapore. The advertisement in issue also does not appear to have been published in Singapore. The inquiry into misrepresentation therefore does not end here.

122 Under Section 8(2)(b), I have found that there is no reasonable likelihood of confusion between the respective marks. One important reason is the low degree of similarity between the marks. They are neither visually nor aurally similar, and only slightly conceptually similar because of their arboreal associations. Another important reason is that the general public buying shoes is likely to go through a careful process of selection and trying on before purchase. The circumstances of sale are such that a reasonably careful consumer intending to buy shoes would not generally be confused between WOODLAND and Timberland shoes.

123 Likewise here under passing off, for the same reasons detailed above under Section 8(2)(b), I find that the Opponents have not established misrepresentation on a balance of probabilities.

#### *Damage*

124 As I am not persuaded that there is misrepresentation, the Opponents will not suffer damage to their goodwill.

#### *Conclusion*

125 Overall, therefore, the ground of opposition under Section 8(7)(a) fails.

#### **Ground of Opposition under Section 8(4)(i)**

126 Section 8(4) of the Act reads:

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

- (a) the earlier trade mark is well known in Singapore; and
- (b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —
  - (i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark; or
  - (ii) if the earlier trade mark is well known to the public at large in Singapore—
    - (A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or
    - (B) would take unfair advantage of the distinctive character of the earlier trade mark.

Section 2(1) defines “earlier trade mark” as:

- (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

Section 2(1) defines “well known trade mark” as:

- (a) any registered trade mark that is well known in Singapore; or
- (b) any unregistered trade mark that is well known in Singapore and that belongs to a person who —
  - (i) is a national of a Convention country; or
  - (ii) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,whether or not that person carries on business, or has any goodwill, in Singapore

Sections 2(7) and (8) are pertinent to a consideration of whether a trade mark is well known in Singapore. They are set out below:

- (7) Subject to subsection (8), in deciding, for the purposes of this Act, whether a trade mark is well known in Singapore, it shall be relevant to take into account any matter from which it may be inferred that the trade mark is well known, including such of the following matters as may be relevant:
  - (a) the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;
  - (b) the duration, extent and geographical area of —

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

(8) 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.

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

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

### ***Opponents' Submissions***

127 The Opponents claim that the Opponents' Marks are widely recognised in Singapore and by the time the Application Mark was filed on 20 March 2006, the former was already well known in Singapore.

128 In support of their case that the Opponents' Marks are well known in Singapore, the Opponents rely on the use and promotion of their marks in the USA and worldwide since 1973. In Singapore, the Opponents' Marks were used as early as 1983, before the Application Mark was first used in India in 1992. The long history and extensive use of the Opponents' Marks satisfies the requirements for well known marks. The Opponents also have trade mark applications and registrations in respect of the Opponents' Marks in various classes and countries, mostly filed before 20 March 2006. The Opponents have defended and enforced the Opponents' Marks extensively against any mark that is confusingly similar / identical, including against the Applicants in: the current opposition; oppositions and cancellation actions in India; and in an opposition in Syria.

129 The Opponents refer to the IPOS decision of *Hyundai Mobis v Mobil Petroleum Company* [2007] SGIPOS 12 (*Hyundai Mobis*) at [77] for the guidance that " *in a country with a size like Singapore and with a population of about 4 million people, if a business spends a million dollars every year advertising their brand, it would be hard not to reach a substantial number of people.*"

130 Applying the above, the Opponents claim to have invested more than S\$1m per year through sales and advertisement. With sales outlets in well known shopping centres and

substantial website visitor figures from Singapore and worldwide, it is not impossible for the Opponents to reach a substantial number of people each year in Singapore. Thus, the Opponents' marks are well known.

131 Further, since there is an overlap in the respective goods, there would be a connection drawn by the public between the goods covered under the Application Mark and the Opponents' Marks. As submitted earlier, both marks are confusingly similar and hence a real likelihood of confusion by the public exists. The existence and use of the Application Mark will dilute or damage the reputation and distinctive character of the Opponents' Marks, or lead to confusion. Therefore, there is a real risk and likelihood of damage to the Opponents' interests.

### ***Applicants' Submissions***

132 The Applicants submit that the Opponents' Marks are not well known. They refer to the Court of Appeal decision in *City Chain* at [91] for the proposition that "*evidence of use was not enough and proof of actual recognition by the public had to be shown*".

133 The Applicants further submit that there is no confusing connection between the Applicants' goods and the Opponent and no damage to the Opponents' interests.

### ***Decision on Section 8(4)(i)***

#### ***Well Known in Singapore***

134 To succeed under this ground, the Opponent must first establish that the Opponents' Marks are well known in Singapore before the Application Mark's filing date of 20 March 2006.

135 The Court of Appeal in *Novelty Pte Ltd v Amanresorts Ltd and Another* [2009] 3 SLR(R) 216 ("*Amanresorts*") makes clear at [149] that:

... the deeming provision in s2(8) still requires the trade mark in question to be "*well known*" [emphasis added] to the relevant sector of the public in Singapore ... there are different degrees of public knowledge of a trade mark, and the requisite level of knowledge required under Singapore's legislation tends towards the higher end of the scale: ... the trade mark concerned must be more than merely "known" to the relevant sector of the public in Singapore.

136 However, the Court of Appeal also opines further in the same case at [229] 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] ... which sector could in certain cases be miniscule.

137 The background and information on the use and promotion of the Opponents' Marks have been set out at [18] to [23] above. From 2000 to 2006, the Opponents' average sales in Singapore were approximately US\$10.061 million. In 2007, their net revenue was US\$13.129 million; in 2008 it was US\$12.356 million and in 2009, it was US\$10.394

million. Mr Harkirat Singh's first SD states that the Opponents' total expenditure for advertising and promotion in Singapore from 2000 to 2005 is approximately US\$70,000. It is not clear whether he means US\$70,000 for each of the years from 2000 to 2005, or US\$70,000 for the entire 6 years spanning 2000 to 2005 (since the wording is "total expenditure"). However, even taking the higher figure of US\$70,000 per annum, this still falls far short of the "excess of a million Singapore dollars per year" in promotional expenditure envisaged in *Hyundai Mobis*. The Opponents' claim at [130] above includes sales revenue figures, to bring the so called "investment" to more than S\$1m per year. However, this is a wrong application of the guideline in *Hyundai Mobis*, which pertained to advertising and promotion expenditure.

138 Still, the Opponents' Marks have been used in Singapore since as early as 1983. In the 23 years of use in Singapore from 1983 to 2006, Timberland goods have been sold in various retail locations through Singapore. The Opponents' Marks also enjoy online exposure at [www.timberland.com](http://www.timberland.com), which drew 35,132 visitors from Singapore in the year between 30 June 2005 and 29 June 2006. The average annual sales figures in Singapore of US\$1 million from 2000 to 2006 are not insubstantial.

139 The Court of Appeal in *Amanresorts* at [154] interpreted Section 2(9)(a) of the Act as "the actual and/or potential consumers of the (trade mark proprietor's) goods and services." This has been consistently recognised and applied, such as in the recent *Ferrero* decision at [159]. Thus, the question here is whether the Opponents' Marks are well known to the actual and/or potential consumers of the Opponents' goods. If they are, then, by virtue of the deeming provision in Section 2(8), they shall be deemed to be well known in Singapore.

140 On the balance, taking into account all the evidence, I am more persuaded than not that the Opponents' TIMBERLAND mark is sufficiently recognised by at least the actual consumers of TIMBERLAND goods to an extent that the mark is well known to this "relevant sector of the public in Singapore".

141 Thus, applying Section 2(8), I find that the Opponents' Marks, to be more precise, Trade Mark Nos. T8403966H, T8403967F and T9910179H which all contain the word "TIMBERLAND", are well known in Singapore.

142 I expressly do not find the remaining Opponents' Marks, namely Trade Mark Nos. T8904485F and T9910175E well known in Singapore. These marks comprise the Opponents' tree device alone. The Court of Appeal in *City Chain* found, at [95]:

... no evidence of the degree to which the Flower Quatrefoil mark on its own is known to, or recognised by, any relevant sector of the public in Singapore; there is no evidence that the Flower Quatrefoil mark has been used on its own as a trademark; there was limited promotion of the Flower Quatrefoil mark on watches; and there is no evidence of any value associated with the Flower Quatrefoil mark. Although we observe that the Flower Quatrefoil mark has been registered in many countries and the duration of the registration has been substantial, that does not *per se* prove that it is well known, particularly in Singapore.

143 Likewise, there is insufficient evidence to show that the Opponents' tree device, alone, is recognised by the relevant sector of the public in Singapore.

### *Confusing Connection*

144 Further, Section 8(4)(b)(i) requires a confusing connection between the goods on which the Application Mark is used and the Opponents (note that the connection is not between the goods covered under the Application Mark and the Opponents' Marks, as erroneously submitted by the Opponents at [122] above). That the confusion element is required is made clear in *Amanresorts* at [233]:

In our view, the widespread availability of protection to trade marks which are "well known in Singapore" should be balanced by interpreting s55(3)(a) of the current TMA as requiring a likelihood of confusion to be shown ...

Since the material part of the wording in Section 55(3)(a) and Section 8(4)(i) of the Act are similar, the above interpretation applies in the present case.

145 I have found earlier that the Application Mark is not confusingly similar to the Opponents' Marks under Section 8(2)(b). For the same reasons detailed, on the balance of probabilities, I find that the use of the Application Mark in relation to the goods claimed would not indicate a connection between those goods and the Opponents. Consequently, such use is not likely to damage the interests of the Opponents.

### *Conclusion*

146 The ground of opposition under Section 8(4)(i) therefore fails.

### **Ground of Opposition under Section 8(4)(ii)(A)**

147 The relevant provisions, Section 8(4), Section 2(1),(7), (8) and (9) of the Act, have been set out at [126] above. I reproduce Section 8(4)(ii)(A) for ease of reference here:

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 —

...

(ii) if the earlier trade mark is well known to the public at large in Singapore—

(A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark

### *Opponents' Submissions*

148 The Opponents assert that the Opponents' Marks are well known to the public at large in Singapore. They submit that because of the conceptual similarities between the respective marks, the use and advertisement of the Application Mark in the marketplace would take a free ride of the reputation and goodwill in the Opponents' Marks. Such use is likely to erode or damage the goodwill and reputation as well as dilute the distinctive character of the Opponents' Marks. Over time, the use of the Application Mark will lead consumers to cease to associate the Opponents' Marks exclusively with the Opponents. Therefore, such use

would gradually whittle away or water down the distinctive character of the Opponents' Marks.

### ***Applicants' Submissions***

149 The Applicants submit that the Opponents' Marks are not well known to the public at large as the degree of recognition required is much higher and the marks needs to be well known to most if not all sectors of the public.

150 The Applicants contrasted the present case with *Clinique Laboratories, LLC v Clinique Suisse Pte Ltd and Another* [2010] 4 SLR 510 ("*Clinique*"), where the CLINIQUE mark was found to be well known to the public at large. There, the plaintiff spent around \$3 million on advertising, promoting and marketing the mark in Singapore each year from 2004 to 2008. Here, the Opponents' advertising expenditure in Singapore only averages US\$70,000 each year from 2000-2005.

151 Likewise, in *Volvo Trade Mark Holdings AB v Hebei Aulion Heavy Industries Co Ltd* [2011] SGIPOS 1 ("*Volvo*"), the Principal Assistant Registrar found that the VOLVO mark was not well known to the public at large in Singapore. In that case, the sales and advertising figures for the VOLVO mark were "impressive" and much higher than those for the present Opponents in respect of the Opponents' Marks.

152 Further, there will be no dilution of the Opponents' Marks because of the lack of similarity between the respective marks, whether the standard of similarity is confusing similarity or the higher standard of identity or near identity of marks.

### ***Decision on Section 8(4)(ii)(A)***

#### ***Well Known to the Public at Large***

153 The recent High Court decision in *Ferrero* succinctly comments at [153] on the requirement for a mark to be well known to the public at large in Singapore as follows:

The TMA does not define the phrase "well known to the public at large in Singapore". However, in *City Chain*, the Court of Appeal emphasised that the test "well known to the public at large in Singapore" must mean *more* than just "well known in Singapore"; to come within the former test, the trade mark must necessarily enjoy a *much higher* degree of recognition (*City Chain* at [94]). It "must be recognised by most sectors of the public though we would not go so far as to say all sectors of the public" (*City Chain* at [94]). Such an approach, as the Court of Appeal recognised, would be in line with the United States' approach in determining famous marks (*City Chain* at [94]). It flows from the logic in *City Chain* that *if* a trade mark is shown to be "well known to the public at large in Singapore", it is *necessarily* also "well known in Singapore".

154 The Court of Appeal in *Amanresorts* cautioned at [229] that "*such protection (i.e. protection despite the absence of confusion) should, for now, properly be the preserve of a rare and privileged few.*" Trade marks which attain "*the coveted status of being 'well known to the public at large in Singapore' ... form a rare and exclusive class*", [233].

155 I have earlier found under Section 8(4)(i) that the Opponents' Trade Mark Nos. T8403966H, T8403967F and T9910179H, which all contain the word "TIMBERLAND", are well known in Singapore. Now, I should determine whether these marks are well known to the public at large in Singapore.

156 To do so, these marks "*must necessarily enjoy a much higher degree of recognition*", and the recognition must be "*by most sectors of the public*", see *Ferrero* at [153]. The evidence adduced by the Opponents do not establish, on a balance of probabilities, that Trade Mark Nos. T8403966H, T8403967F and T9910179H are well known to such a high degree and recognised by most sectors of the public as to be "well known to the public at large in Singapore". Perhaps, with better evidence such as strong survey evidence to reflect strong recognition across most sectors of the public; and more detailed breakdown of sales-related figures e.g. number of pairs of shoes sold, there could be at least a possibility that the Opponents' Marks might have been found to belong to that "*rare and exclusive class*" of marks well known to the public at large in Singapore. For now, with the available evidence, this finding cannot be substantiated.

157 I also agree with the Applicants' foregoing submissions and comparisons with the decisions in *Clinique* and *Volvo*. In any case, the court found a likelihood of confusion in *Clinique*. Here, where the respective marks were not found confusingly similar under Section 8(2)(b), one ought to be very slow to find that the Opponents' Marks are well known to the public at large despite less impressive advertising, promotional and revenue figures as compared to *Clinique* and *Volvo*.

158 As the Opponents' Marks are clearly not well known to the public at large based on the evidence, there is no practical need to continue with an inquiry into the remaining element of dilution.

#### *Conclusion*

159 I find that the ground of opposition under Section 8(4)(ii)(A) fails.

#### **Conclusion**

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

Dated this 26<sup>th</sup> day of September 2011

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See Tho Sok Yee

Principal Assistant Registrar of Trade Marks

Hearings and Mediation Division

Intellectual Property Office of Singapore