

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

Registered Trade Mark No. T0806894F
25 August 2011

**IN THE MATTER OF A TRADE MARK REGISTRATION BY
TOTO GROUP PTE. LTD.
formerly known as
TOTO PAINT PTE LTD**

AND

**INVALIDATION THEREOF BY
COLORLAND PAINT CENTRE PTE LTD**

Hearing Officer: Ms Anne Loo
Principal Assistant Registrar of Trade Marks

Mr Maurice Cheong and Mr Freddy Lim (Lee & Lee) for the Applicants

Mr David Wu and Ms Koh Shu Yan (Gateway Law Corporation) for the Respondents

Cur Adv Vult

GROUND OF DECISION

1 On 27 May 2008, Toto Paint Pte Ltd (the Respondents) applied for registration of mark No. T0806894F which comprised a series of 2 marks for the word “Colourland Colour Your Home” and brush device (the Respondents' mark), in class 2, for "paint including industrial paints; varnishes and lacquers; coatings (paints), primers, enamels for

painting". The application was registered with effect from the date of application. The mark is shown below:



2 On 26 March 2009, Colorland Paint Centre Pte Ltd (the Applicants) filed an Application for Declaration of Invalidity of the Respondents' mark. The Applicants filed an amended statement of grounds on the 19 May 2009. In the Statement of Grounds, the Applicants argued that the Respondents' mark was confusingly similar to their registered mark under section 8(2)(b) of the Trade Marks Act. The Applicants also argued that the Applicants' mark is a well known mark under section 8(4) of the Act. The Applicants further pleaded that the registration was made in bad faith in that it fell short of acceptable commercial behaviour and the Respondents could not have claimed to be the bona fide proprietor; and that therefore the Respondents' mark should be declared invalid under section 7(6). They also submitted that the Respondents' mark was not distinctive and devoid of distinctive character and that the Respondents' mark did not satisfy the definition of a trade mark under section 2(1) of the Act. Further, as the Respondents' mark consists exclusively of signs and indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, other characteristics of the goods, the registration should be declared invalid under section 7(1)(a), (b) and (c) of the Act. Therefore they pleaded that the Respondents' registration should be declared invalid under section 23 of the Trade Marks Act.

3 The Respondents filed their Counter Statement on 10 July 2009. The Case management conference was initially fixed on 16 September 2009 but vacated at the parties' request and re-fixed to be heard on 4 November 2011. The Applicants filed their evidence in support of their invalidations on 7 January 2010. The Respondents filed their evidence in support of their registrations on 3 December 2010. The Applicants filed their evidence in reply to the Respondents evidence on 25 March 2011. Parties indicated via written responses to the Registrar that a Pre-Hearing Review was not necessary, after which the matter was fixed for hearing on 16 August 2011. The hearing date was re-fixed at the request of parties to the 25 August 2011.

Grounds of Invalidation

4 The Applicants rely on Sections 8(2)(b), 8(4), 7(6) and 7(1)(a) to (c) of the Trade Marks Act (Cap 332, 2005 Rev Ed) ("the Act") in this invalidation action.

Applicants' Evidence

5 The Applicants' Statutory Declaration was executed by their managing director of the Applicants, Teo Thiam Huat, in Singapore on 16 December 2009. ("Applicants' First Statutory Declaration") and a Statutory Declaration In Reply by Alvin Leo Lung, the

senior manager of the Applicants on 23 March 2011 (“Applicants’ Statutory Declaration In Reply”).

6 The Applicants also tendered evidence in the form of a can of paint and a brochure at the hearing. The Respondents initially objected to this, but the Applicants pointed out that this was specifically mentioned as Exhibit E in the Applicants' statutory declaration in reply at paragraph 8. Further, prior to the hearing of the matter, the Registrar had written to the Applicants seeking confirmation whether the Applicants still intended to produce the said evidence at the hearing. The Respondents withdrew their objection and the can of paint and brochure were tendered and admitted into evidence and marked “AE-1” and “AE-2” respectively.

Respondents' Evidence

7 The Respondents' Statutory Declaration was executed by Tan Keong Jin, a director and owner of the Respondents, on 3 December 2010. (“Respondents' Statutory Declaration”)

Applicable Law and Burden of Proof



The applicable law is the Trade Marks Act (Cap 332, 2005 Rev Ed) (" the Act") and the Trade Mark Rules (Cap 332, 2008 Rev Ed) ("the Rules"). The undisputed burden of proof in an invalidation action under the Act falls on the Applicants.

Background

8 The Applicants have been active in the paint business in Singapore for more than 20 years and were one of the largest paint retailers in Singapore. They are a major dealer for both Nippon and ICI paints, and the sole agent for a number of D-I-Y hardware equipment and supplies. Their principal activities include retail and wholesale of paints, home decorations, hardware accessories and products, and construction materials, and they also provide painting and renovation services.

9 The Applicants produce their own brand of paint for sale called “Colorland Paint” which they state is well-known in Singapore amongst the members of the public and trade, the building and renovation industry, and the local paint industry. Their parent company, Chop Hup Moh started out as a supplier of paints, chemicals and other essentials to the boats that were stationed along the Singapore River; and in recent years, the Applicants have diversified into the supply of household and industrial paints to meet the needs of the fast-growing construction industry in Singapore. The Applicants at present have ten COLORLAND retail outlets situated across Singapore.

10 The Applicants have several registered COLORLAND Marks which were created and derived from the Applicants’ corporate name, “Colorland Paint Centre Pte Ltd”. These include:

TM No.	Mark	Class	Specification of Goods/Services	Date of Registration
T9910580G	COLORLAND	2	Paints and varnish.	22 September 1999
T9910581E	COLORLAND	16	Paint brushes.	22 September 1999
T9910582C	COLORLAND	35	Retail services.	22 September 1999
T9910583A	COLORLAND	37	Painting services	22 September 1999
T9910577G		16	Paint brushes.	22 September 1999
T9910579C		37	Painting services	22 September 1999

11 The Applicants first used the Applicants' COLORLAND Marks as early as 1989 for sales and services of their products in Singapore. The Applicants' evidence exhibits the sales and turnover of the Applicants' goods and services bearing the Applicants' COLORLAND Marks for the past five years, as well as the advertisement and promotion of their goods and services under the COLORLAND Marks in Singapore since 1989.

12 The Respondents are a private limited company which had entered into a legitimate business agreement with a Malaysian registered company, Colourland Paints Sdn. Bhd. ("Colourland Malaysia"), to sell its paints in Singapore. The Respondents say that the name "Colourland Paints" was adopted to show the connection to Colourland Malaysia as the Respondents' distributor and business partner. The Respondents applied to register the trade mark "Colourland COLOUR YOUR HOME" in class 2 as a series of 2 marks with the consent of and at the request of Colourland Malaysia. The said mark was accepted for registration and the Applicants had earlier filed a Notice of Opposition against its acceptance. However, the said opposition was never heard as it was withdrawn when the Applicants failed to file their Statutory Declaration within the statutory time limits for doing so. As a result, the Respondents' mark was registered.

13 The Applicants subsequently filed an application for the declaration of invalidity of the Respondents' registered trade mark. The Respondents state that as a result of this action, no investors have been willing to invest in the products bearing the Respondents' trade mark and the Respondents has since September 2009 temporarily ceased the sale of products bearing the Respondents' trade mark. Prior to the temporary cessation of sale of the goods however, the Respondents have evidence to show genuine use of their mark in Singapore.

MAIN DECISION

Ground of Invalidation under Section 23 read with Section 8(2)(b)

14 Section 23(3) of the TMA reads:

23.— (3) The registration of a trade mark may be declared invalid on the ground
(a) that there is an earlier trade mark in relation to which —
(i) the conditions set out in section 8 (1) or (2) apply...
unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

15 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.

16 An "earlier trade mark" is defined in Section 2(1) of the Act 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.

Applicants' Submissions

17 The Applicants submit that they satisfy the Section 2 of the Act's requirement of "an earlier trade mark" as the Applicants' COLORLAND Marks' date of application for registration is 22 September 1999 which is earlier than the date of registration of the Respondents' mark which was 27 May 2008.

18 The issues to be determined where a declaration of invalidation is made under section 8(2)(b) are whether the Respondents' mark and the Applicants' COLORLAND Marks are similar; whether the goods of the Respondents are identical or similar to the goods of the Applicants' COLORLAND Marks; and whether there is a likelihood of confusion as a result of this.

19 The Applicants say that visually, both the parties' marks are similar. The common element in both the marks is the dominant word "colorland" or "colourland". The only difference is the missing "u" in the word "color" of the Applicants' **COLORLAND** Marks. The word "color" is spelt without "u", which is American spelling and the meaning and pronunciation of the word "color" is the same as the word "colour". It is submitted that the omission or addition of the letter "u" is insignificant as the members of the public would associate and accept both types of spelling and would not pay attention to this small difference.

20 As both the parties' marks consists of the same word, the aural aspect of the parties' marks is relevant. Phonetically, there is clear similarity between the Applicants **COLORLAND** Marks and the Respondents' mark. Both the parties' marks have three syllables and the sound of "co-lor-land" is identical to "co-lour-land". Accordingly, the pronunciation of both the Applicants **COLORLAND** Marks and the Respondents' mark would be identical. It is submitted that an average consumer calling over the telephone line to order the Respondents' products would not be asking for "colour your home" brand. He or she would ask for "co-lour-land" brand and both of the brand names would sound identical.

21 Conceptually, both the parties' marks convey the same idea, namely, "Colorland" or "Colourland", which has a literal meaning of a land filled with colour. The Applicants state that marks are remembered rather by general impressions or by some significant detail than by photographic recollection of the whole (*Kerly's "Law of Trade Marks and Trade Names" (14th Edition* at paragraph 17-028.) An idea or impression of a mark is an important consideration when comparing marks. In *De Cordova v. Vick [1951] 68 RPC 103*, it was held that "marks are generally remembered by generally impressions or by some significant detail than by any photographic recollection of the whole". In the present case, it is clear that the only essential feature in the parties' marks are "Colorland" or "Colourland" and these words are the only impression or leading characteristic which an average consumer will remember; rather than a recollection of the whole of the Respondents' mark.

22 The Applicants also cited the following decided cases where the courts held that the marks are confusingly similar despite an omission or a difference of one or more alphabets or letters in one of the marks: *General Electric v Consolidated Electrodynamics [1963] R.P.C, G.E" [1973] R.P.C. 297, Rheinliebling" [1966] R.P.C. 68, L'AMY [1983] R.P.C. 137*

23 The Applicants state that applying the principles in the Court of Appeal case of **The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd [2006] 2 SLR(R) 690**, in the determination of 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. The Applicants in Exhibit D of the Applicants' First Statutory Declaration exhibit their brochures showing their actual range of products. In Exhibit E of the Applicants' Statutory Declaration in reply, they exhibit the Respondents' paints and brochures to show that in comparison, the graphics and the layout of the Respondents'

paint brochure are almost similar to the Applicants' product. The Applicants state that it is pertinent to note that the Respondents' paint product does not show the exact mark for which the Respondents' mark is registered. The paint product shows the brand "COLOURLAND" without the words "colour your home" in a brush device. The font of the word "Colourland" is almost the same as the Applicants' mark.

Respondents' Submissions

24 The Respondents state that the court of appeal in *Valentino Globe BV v Pacific Rim Industries Inc* [2010] 2 SLR 1203 ("Valentino") at [13] lays down the principles to be followed for the application of section 8(2)(b). Marks should be looked as a whole (Polo at [24]) and the Court had regards of the opinion expressed by Parker J in *In the Matter of an Application by the Pianotist Company Ld for the Registration of a Trade Mark* (1906) 23 RPC 774 at 777. The Court of Appeal in *Polo* also endorsed the step-by-step approach enunciated in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC ("British Sugar") at [8].

25 The Respondents in their submissions compare the Respondents' and the Applicants' marks closely and highlight the individual differences between the marks. They state that there are clear visual dissimilarities between the marks in terms of the colours used by each mark, the style and manner of presentation and the spelling of the word "colour" in each of the marks; one being spelt in the American fashion and the other in British English. Aurally, the Respondents submit that the Applicants' mark has only 3 syllables as opposed to the Respondents' 7 syllables. Conceptually, the Respondents state that their mark conveys a different concept from the Applicants' mark in that the Respondents' mark as a whole conveys the primary concept of the ability to "colour your home". This is evidenced by the trail of dripping paint manifested by the paintbrush device. The presence of the word "Colourland" is merely to indicate that the Respondents' products are connected to the Colourland Malaysia and the variety of colours available to the consumer to colour his home.

26 The Respondents state that the Applicants have also not adduced any evidence to show that a single instance of actual confusion had occurred.

Decision on Section 8(2)(b)

27 The Applicants have several earlier registrations in classes 2, 16, and 37 all of which were registered on the 22 September 1999. These trade marks registered in the name of the Applicants all qualify as "earlier trade marks" as defined in section 2(1) of the Act. In particular, the Applicants' Class 2 trade mark no. T9910580G for the mark "COLORLAND" in respect of "paints and varnish" will be most pertinent in this invalidation action. The Respondents have conceded at the hearing that the goods of their registration being "paint including industrial paints; varnishes and lacquers; coatings (paints), primers, enamels for painting" are similar goods to the Applicants' "paints and varnish".

28 The test for the requirements under section 8(2)(b) is that enunciated in the Court of Appeal case of *The Polo/Lauren Co, LP v Shop-In Department Store Pte Ltd* [2006] SGCA 14 ("*Polo/Lauren*"). Although *Polo/Lauren* dealt with requirements for infringement under section 27(2)(b), the Court held that these requirements are the same as those under the relative grounds in section 8(2)(b) (*Polo/Lauren* at [15]) The Court in *Polo/Lauren* endorsed the 3-step approach enunciated in *British Sugar PLC v James Robertson & Sons Ltd* [1996] RPC 281 ("*British Sugar*") at [8]:

It seems to us that there will be infringement under that provision only if three conditions are present. 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.

- 29 Applying this to the facts here, the Applicants will have to show:
- i. that the Respondents' mark is similar to the Applicants' earlier trade mark;
 - ii. that the goods of the Respondents' mark and of the Applicants' earlier trade mark are identical or similar; and
 - iii. there is a likelihood of confusion by virtue of the similarity of the marks and the goods.

30 The second requirement relating to the similarity of goods is not in contention as the Respondents have conceded that the Respondents' and the Applicants' goods are similar goods. What remains is the assessment of the similarity of marks and likelihood of confusion.

31 For the comparison of marks, there are several principles that should be borne in mind. The first, is that marks should be considered as a whole, not dissected into separate parts to be compared point-by-point as "marks are generally remembered by general impressions or by some significant detail than by any photographic recollection of the whole" *De Cordova v Vick* (1951) 68 RPC 103. Consumers of goods do not usually have the luxury of a side by side comparison of marks. More often than not, the consumer will have to rely on his imperfect recollection when purchasing goods.

32 I will now proceed to assess the similarity of marks and likelihood of confusion. In order to assess the similarity of marks, the visual, aural and conceptual similarities of the Applicants' and the Respondents' marks will have to be considered.

Visual Similarity

33 Visually, both the Applicants' and the Respondents' mark contain a similar word: "Colourland" or "Colorland". One major difference between these two words is that the manner in which the words are spelt. Both counsel have pointed out that the Applicants' "COLORLAND" is spelt using then the American spelling whereas the Respondents' "Colourland", is spelt using the British spelling. The result is merely a difference of the single letter "u"; which I agree with the Applicants, is not a significant visual difference.

However, the Respondents' mark bears more than the word "Colourland", it has a device of a paint brush brushing a streak of paint below "Colourland" forming a banner-like space which holds the words "COLOUR YOUR HOME" in capital letters. As these words "COLOUR YOUR HOME" are relatively very much smaller in size compared to "Colourland", the overall visual effect of the Respondents' mark is still that it comprises mainly the word "Colourland" This is what primarily strikes the eye when the Respondents' mark is viewed.

I find therefore that the marks are visually similar.

Aural Similarity

34 The Respondents have submitted that their mark comprises 7-syllables (COLOUR-LAND-CO-LOUR-YOUR-HOME) as opposed to the Applicants' 3-syllables (CO-LOR-LAND). I am inclined to disagree. When enunciating a mark, the tendency is to read what the eye perceives, and in this case, what springs to the eye is the main and more dominant word in the Respondents' mark: Colourland. As mentioned in the earlier paragraph, the words in the tagline "COLOUR YOUR HOME" are minute compared to the dominant word "Colourland" in the mark. Although the Respondents' mark has other features such as the tagline and a brush device, words speak in marks and the word "Colourland" which remains the dominant part of the mark will be enunciated. In the High Court's decision in *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR where the dominant feature was not the word mark, it was held that:

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.* [emphasis mine]

35 Hence, as Colourland and COLORLAND are both enunciated in the exact same way despite the difference in the spelling, I find that the Respondents' Mark and the Applicants' mark aurally similar.

Conceptual Similarity

36 Conceptually, both the marks evoke the same idea when viewed – what comes to mind upon sight of the marks is the idea of a place of many colours, literally a land of colour. The idea behind the marks is essentially the same. As the marks both carry the same dominant feature, the word "Colourland" or "Colorland", American or British spelling notwithstanding, the marks are conceptually similar.

Likelihood of confusion

37 As the marks are found to be similar and the goods are also similar, the question that has to be determined is whether there exists a likelihood of confusion. In *Polo/Lauren* at [25], the Court held that just because the marks are similar and the goods are also found to

be similar, it would not necessarily lead to the conclusion that the likelihood of confusion would automatically arise.

38 The Court in the *Polo/Lauren* at [28] states:

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...

39 It is settled that the goods are similar, the impression given by the marks is also the same. As there is conceptual similarity of the marks, it is highly probable that an ordinary consumer of the goods would experience an imperfect recollection of the marks – recalling the “Colourland” marks as “COLORLAND” and vice versa. It is equally important to be aware of the risk that the public might believe that the goods come from the *same source* or *economically-linked* sources. The relevant public here is not confined to the renovation contractors, persons from the building industry but potentially any member of the public who owns a home, rents a room or has an item that needs a coat of paint. The Respondents' and the Applicants' customer base is essentially the same and bearing in mind the similarities of the marks and goods, the potential danger that this customer base might believe that the goods all come from the same source or economically-linked sources is very high. The Applicants in their evidence have shown that the Respondents have made no attempt to differentiate their goods from the Applicants, choosing instead to produce brochures and packaging that look familiarly close to the Applicants'. Ordinary consumers and purchasers of paint, unlike consumers of retail items like clothing or watches, are not likely to spend an inordinate amount of time carefully choosing the items that are regarded "utility purchases". Seasoned contractors and those in the building or renovation industry will have their own fixed preferences of brand and type; but the general purchasing public are likely to be swayed by price and assurances of quality, and would rely on the recommendation of the retailer or the glossy product brochure.

40 The Applicants have disputed the Respondents' claim that there has been no instance of confusion. The Applicants in their statutory declaration cite actual instances of confusion among the Applicants' customers, and complaints from retail shops that customers had been confused between the Applicants' and the Respondents' marks. The Applicants have also submitted that it was noteworthy that even the Respondents themselves have been confused between the respective parties' marks and failed to distinguish the Applicants' COLORLAND Marks from the Respondents' mark. The Applicants pointed out that the Respondents had on two occasions in paragraph 17 of their statutory declaration incorrectly referred to the Applicants' marks as “COLOURLAND” marks. Quite telling is the amendment made to statement of grounds

on the 19 May 2009 by the Applicants to correct the misspelling of the Applicants' name from "COLOURLAND" to "COLORLAND".

Conclusion

41 Taking into account all the surrounding circumstances, I find that there is a reasonable likelihood of confusion. The ground of objection under Section 8(2)(b) therefore succeeds.

Ground of Invalidation under Section 23 read with Section 8(4)

42 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.

“earlier trade mark” and "well known mark" are defined in Section 2(1):

"earlier trade mark":

- (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

“well known trade mark” :

- (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

Applicants' Submissions

43 The Applicants have given evidence that there has been use in Singapore of the Applicants' COLORLAND Marks on the Applicants' goods and services since 1989. The Applicants' COLORLAND Marks have come to be distinctive of and associated with the Applicants through extensive sales and promotional activities in relation to the use of the Applicants' COLORLAND Marks on the Applicants' goods and services. The paint industry is small in Singapore and there have been actual incidents of confusion between the Applicants' and the Respondents' marks and the Applicants had received complaints from retail shop.

44 The Applicants depose that they have sales and turnover of the Applicants' goods and services bearing the Applicants' COLORLAND Marks for the past five years from 2003 to 2008. They further depose that since 1989, the Applicants have actively sold, advertised and promoted their goods and services under the Applicants' COLORLAND Marks in Singapore. The Applicants have ten COLORLAND retail outlets across the island and their wide range of paint products are also sold by other retail shops. There is no registration or application for the registration of the Applicants' COLORLAND Marks in other countries. There has been no enforcement of right in the Applicants' COLORLAND Marks in other jurisdiction.

45 The Applicants state that their COLORLAND Marks have through extensive sales in many retail shops, advertising and promotional activities in Singapore since 1989 come to be distinctive of and associated with the Applicants. The Applicants have acquired substantial goodwill and reputation in the Applicants' COLORLAND Marks and recognition in the relevant trade, and therefore, the Applicants' COLORLAND Marks is a well-known mark.

46 The Applicants submit that by reason of the use and promotion of the Applicants' COLORLAND Marks and the goodwill and reputation enjoyed by the Applicants on the Applicant's COLORLAND Marks in Singapore, the Respondents' mark if used on the goods claimed in the registration is calculated to deceive or cause confusion in the minds of the public and trade. The members of the public and trade will be deceived or confused into believing that the goods bearing the Respondents' mark have the same degree of quality as the Applicants' goods and services, or that there is some connection in the course of trade between the Applicants and the Respondents when in fact no such connection exists. The use of the Respondents' trade mark will therefore be damaging to the Applicants' goodwill and reputation. The use of the Respondent's trade mark would further cause dilution in an unfair manner of the distinctive character of the word

“COLORLAND” in the Applicants’ COLORLAND marks and/or would take unfair advantage of the distinctive character of the Applicants’ COLORLAND Marks. The registration of the Respondent’s mark should be declared invalid by virtue of Section 23(3)(a) (iii) read with Section 8(4) of the Act.

Respondents’ Submissions

47 The Respondents submit that the Applicants will first have to establish that "the whole or an essential part" of the Respondents' mark is similar or identical to the Applicants' mark. Thereafter, the Applicants must show that their mark is well known in Singapore within the meaning of section 8(4) read with section 2(7) of the Act.

48 Respondents cite Amanresorts at [137-138] for the list of factors that serve as guidelines to determine whether the trade mark is well known in Singapore, and state further that the court has wide discretion and is ordinarily free to disregard any or all of the factors listed in section 2(7) as the case requires. Despite this wide discretion, the Court in Amanresorts highlighted the significance of section 2(7)(a) which looks at the degree of recognition of the mark by any relevant sector of the public in Singapore, and states that this may not be disregarded. The Respondents say that the Applicants have not provided any evidence to show that the Applicants' marks satisfy the test of being "well known in Singapore". The Applicants have not provided any financial statements to support the alleged sale and turnover figures of its goods and services bearing the Applicants' goods. The Respondents also questions the figures that the Applicants have produced, stating that these figures are curiously low for a company that is allegedly "the largest paint retailer in Singapore". The promotional and advertising items similarly do not support the Applicants' claim that it is well known in Singapore as the items appear to be merely standard corporate brochures or stationery. The Respondents also highlights that a substantial number of the advertising and promotional material submitted by the Applicants relate to other brands of paint, Nippon Paint and ICI Paints.

49 The Respondents state that the Applicants' mark is not well known and there is no need to consider whether the use of the Respondents' mark on the Respondents' goods would indicate a connection between the Respondents' and the Applicants' goods. Similarly, as there is insufficient evidence to show that the Applicants' mark are well known in Singapore, the Applicants' marks cannot also be said to belong to the rare and exclusive class of marks that are well known to the public at large in Singapore. The Applicants' marks therefore are not covered by the extended protection of the "unfair dilution" condition under section 8(4)(b)(ii)(A) and the "unfair advantage" condition provided by 8(4)(b)(ii) (B).

Decision on Section 8(4)

50 As the entirety of section 8(4) has been pleaded as a ground of objection, I will deal with this ground in two parts, on section 8(4)(a) read with 8(4)(b)(i) and section 8(4)(a) read with 8(4)(b)(ii).

Section 8(4)(a) read with 8(4(b))(i)

Well known to a relevant sector of the public in Singapore

51 Under section 8(4), the Applicants must first establish that the whole or an essential part of the Respondents' trade mark is identical with or similar to the Applicants' earlier trade mark. This has been established under the section 8(2) ground where it was held that the Respondents' mark is similar to the Applicants' mark.

- 52 What has also to be proven in order to succeed under section 8(4)(i) is:
- i. whether the Applicants' COLORLAND Marks are well known in Singapore before the registration date of the Respondents' marks, which is the 27 May 2008, and
 - ii. whether that the Respondents' use of their mark bearing the similar word "Colourland" in relation to "paint including industrial paints; varnishes and lacquers; coatings (paints), primers, enamels for painting" indicate a connection between the Respondents' products and the Applicants and is likely to damage the interests of the Applicants.

53 In the consideration of whether a trade mark is well known in Singapore, sections 2(7), (8) and (9) of the Act are relevant. These 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.

54 The Court of Appeal in *Novelty Pte Ltd v Amanresorts Ltd and Another* [2009] 3 SLR(R) 216 ("*Amanresorts*") at [149] and at [229] gives guidance as to the application of section 2(8) in relation to what may be regarded as "well known in Singapore". At [149]:

... 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.

And at [229]:

... 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" ... which sector could in certain cases be miniscule.

55 The Court of Appeal in *Amanresorts* at [154] also settled the issue of the "relevant sector of the public in Singapore" as set out in Section 2(9)(a) of the Act as "the actual and/or potential consumers of the Respondents' goods and services". From the Applicants' submissions and the evidence filed, these would be the purchasers of the Applicants' goods and services, the members of the public and trade, renovation contractors, and home designers.

56 Applying the law to the facts of this matter, the question is whether "COLORLAND" is known to or recognised by this identified sector of the public; such that it may be deemed to be a mark well known to the public in Singapore?

57 The Applicants claim to have been the largest paint retailer in Singapore and state that they have had a commercial presence in Singapore since 1989. Their evidence of sales and turnover from 2003 to 2008 are as follows:

<u>Year</u>	<u>Amount (S\$)</u>
2007 – 2008	517,092.00
2006 – 2007	519,105.00
2005 – 2006	470,970.00

2004 – 2005	385,695.00
2003 – 2004	178,650.00

The annual turnover figures show an increase over the years. The evidence of sales and turnover are supported by copies of sales invoices, mainly made out to hotels such as the Raffles Hotel, the Fullerton, the Conrad Centennial, and the National University Hospital. The Applicants' also depose that they have 10 retail outlets across Singapore selling their products and services, in the more populous residential areas in Singapore such as the East Coast, Yishun, Serangoon Central, Tampines, Toa Payoh and Bedok. The Applicants state that they do not have separate advertising and promotion as these are usually sponsored by their suppliers. However, the invoices in the evidence show that the Applicants' COLORLAND mark is often "co-branded" with their supplier's marks on the collaterals and brochures. In exhibit D of the Applicants' statutory declaration, the Applicants' COLORLAND mark is seen on brochures of suppliers of Nippon paint, usually affixed onto the brochures with the words "Exclusively for [Applicants' mark]". The Applicants' COLORLAND mark is also affixed onto all the products that they sell - paints, stains, varnishes, thinner, shellac, and turpentine, amongst others. Taking into account all the evidence of sales, the turnover figures and the use of the Applicants' marks on the goods, I am satisfied that the Applicants' COLORLAND mark is sufficiently recognised by the actual consumers of COLORLAND goods to an extent that the mark is well known to this "relevant sector of the public in Singapore".

Confusing Connection

58 Section 8(4)(b)(i) further requires a confusing connection between the goods on which the Respondents' Mark is used and the Applicants' goods and whether the interests of the Opponents are likely to be damaged as a result. As I have found earlier that the Respondents' Mark is confusingly similar to the Applicants' Marks under Section 8(2)(b) such that there is a likelihood of confusion; similarly by the same reasoning, I find that the use of the Respondents' Mark in relation to Respondents' goods would indicate a connection between those goods and the Applicants, and such use is likely to damage the interests of the Applicants.

Conclusion

59 The ground of objection under section 8(4)(a) read with section 8(4)(b)(i) therefore succeeds.

Decision on Section 8(4)(a) read with Section 8(4)(b)(ii)

Well Known to the Public at Large

60 Having found that the Applicants' Trade Marks are well known in Singapore under Section 8(4)(a) read with 8(4)(b)(i), what needs to be determined under section 8(4)(a) read with 8(4)(b)(ii) are the following elements:

- (i) That the Respondents' mark is identical or similar to the Applicants' COLORLAND mark;

- (ii) That the Applicants' COLORLAND mark is "well known to the public at large in Singapore"
- (iii) That the Respondents' mark used in relation to "paint including industrial paints; varnishes and lacquers; coatings (paints), primers, enamels for painting", would:
 - a. cause dilution in an unfair manner of the distinctive character of the Applicants' COLORLAND mark;
 - or would
 - b. take unfair advantage of the distinctive character of the Applicants' COLORLAND mark.

61 As mentioned in paragraph 49 above, the Respondents' mark has been held to be similar to the Applicants' COLORLAND mark. The question to determine is whether the Applicants' "COLORLAND" mark can fall within what is defined as being "well known to the public at large in Singapore".

62 Unlike the term "well known in Singapore" which has the benefit of legislative guidelines for its definition under sections 2(7), (8), and (9), the Act does not define "well known to the public at large in Singapore". For this, I take guidance from the Court of Appeal decision in *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 ("*City Chain*") at [94] where it was stressed 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. 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.

63 The Court of Appeal in *Amanresorts* at [229] has also emphasized the difference between marks that are merely "*well known in Singapore*" as opposed those that are "*well known to the public at large in Singapore*". The Court held that the protection accorded under section 8(4)(ii)(A) and 8(4)(ii)(B) to marks that are *well known to the public at large in Singapore* "... should, for now, properly be the preserve of a **rare and privileged few.**" [emphasis mine]

64 The Respondents have in their submissions pointed out that the Applicants' highest annual turnover figures are not impressive, these are the 2007-2008 figures which stand at SGD 517,092.00. The difficulty here is that there is no basis of comparison has been presented – what figure would constitute a substantial turnover or indicate a high volume of sales transactions in this industry? Neither the Applicants nor Respondents tendered any figures tendered to give an indication of what might be considered substantial figures in the industry concerned. If a sampling however, were taken from the invoices lodged by the Applicants in their statutory declaration, for example, from the invoices of the sales to Conrad Centennial Singapore, each invoice would on the average amount to SGD2,000.00. Using this figure as an indication of the amount per sale, a rough estimate using the Applicants' annual figure of SGD 517,092.00 translates to approximately 250

sales. Against a backdrop of 10 retail outlets across Singapore, I am inclined to agree with the Respondents that the annual turnover figures are not substantial.

65 Again as an illustration to show the different league in which marks that are well known to the public at large move in; in *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, an approximate figure of \$3 million was spent on advertising, promoting and marketing the mark in Singapore each year from 2004 to 2008. In this present case, the Applicants have deposed that their promotional and advertising expenditure in Singapore derived from sponsorships. Although the comparison between the cosmetic and paint industries is one of chalk and cheese, the example is illustrative to show the distinction between marks that may merely be *well known in Singapore* and those that fall within the "rare and exclusive class" of being *well known to the public at large*. The Applicants have failed to show in their evidence that their mark is one which has attained the status of the rare and privileged class of being a mark which is well known to the public at large.

Conclusion

66 I find that the Applicants have not discharged the burden of proving that the Applicants are well known to the public at large. Having reached this conclusion, there is no need to proceed with the remaining element of whether the Applicants' mark is entitled to protection against the unfair dilution and the taking of unfair advantage under section 8(4)(ii)(A) and (B) respectively. The ground of objection under Section 8(4)(a) read with 8(4)(b)(ii) therefore fails.

Ground of Invalidation under Section 23 read with Section 7(6):

67 Section 7(6) reads:

Absolute grounds for refusal of registration

"7. – (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith."

Applicants' Submissions

68 The Applicants submit that the Court is entitled to draw inference of bad faith even if the marks in question were not so similar as to cause confusion because bad faith is a separate, distinct and independent argument.

Rothmans of Pall Mall Limited v. Maycolson International Ltd [2006] 2 SLR(R) 551
Valentino Globe BV v Pacific Rim Industries Inc [2010] 2 SLR 1203 ("*Valentino*")
Weir Warman Ltd v Research & Development Pty Ltd [2007] 2 SLR(R) 1073 ("*Weir Warman*")

69 The Applicants state that the Respondents had knowledge of, or reason to know the Applicants' COLORLAND Marks at the time of registration of the Respondents' mark.

The Applicants registered their COLORLAND Marks in 1999 and have been selling their products bearing the Applicants' COLORLAND Marks since 1989, about 19 years before the date of application of the Respondents' mark, that is, on 27 May 2008. The paint industry in Singapore is small and the Applicants have acquired substantial goodwill and reputation in their COLORLAND Marks through extensive sales, promotion and advertisement of the Applicants' products under the COLORLAND Marks in Singapore. Members of the public and trade are able to associate the Applicants' products with the Applicants.

70 The Applicants state that on 29 May 2008, the Applicants lodged a business name complaint to the Accounting & Corporate Regulatory Authority ("ACRA") against a business entity known as "Colourland Paints" on the ground that its business name is so nearly resembles the name of the Applicants that it is likely to be mistaken for the Applicants. Colourland Paints was the original registered proprietor of the Respondents' mark. On 18 September 2008, the Registrar of Companies and Businesses directed that Colourland Paints change its name and it did so to "Petty Paints". Petty Paints subsequently assigned the Respondents' mark to "Toto Paint Pte Ltd". The Respondents' current corporate name has been changed to "Toto Group Pte Ltd". "Colourland Paints", "Petty Paints" and "Toto Paint Pte Ltd" are all related companies or businesses because the registered addresses of all these entities are the same. The sole-proprietor of Colourland Paints and Petty Paints is one Tan Keong Jin and he is a director of Toto Paint Pte Ltd. The said Tan Keong Jin is also a director of the Respondents according to the ACRA business profile.

71 The Applicants state that the Respondents are having a business relationship with one Malaysian company known as "Colourland Paints Sdn. Bhd" ("**Colourland Malaysia**") and Colourland Malaysia's website stated that they were incorporated in Johore Barhu, Malaysia in 1999. Colourland Paints (the previous name of the Respondents) were appointed the Singapore distributor for "Colourland Brand of Products" with immediate effect by way of a letter dated 14 July 2008 by Colourland Malaysia. ACRA's official letter dated 2 July 2008 informing the Applicants that ACRA had directed the target business, "Colourland Paints" to change its business name. After the Respondents had been directed by ACRA to change its business name, in the letter dated 14 July 2008 from Colourland Malaysia to the Respondents, Colourland Malaysia still addressed the Respondents as "Colourland Paints" when they were well aware that the said business name would be changed. The Applicants state that it can be inferred that the purported appointment of "Colourland Paints" to be the distributor of the Malaysian products "Colourland" paint was a sham and it was an attempt to overcome the change of name complaint which the Applicants had successfully lodged and obtained.

72 The Applicants had warned Colourland Malaysia in 2008 through one of its shareholders, a Mr Hu Mong Hong, not to sell their products in Singapore as Colourland Malaysia's brand "Colourland" was confusingly similar to the Applicants' COLORLAND Marks. The fact of the warning given by the Applicants to Colourland Malaysia is corroborated in the Applicants' letter dated 16 June 2008 to ACRA. Despite being warned about the possibility of being sued for trade mark infringement by the

Applicants before the date of the Respondents' application to register their mark on 27 May 2008, the Respondents still proceeded to file the application.

73 The Applicants state that it can be inferred from the conduct of Colourland Malaysia and the Respondents that the incorporation of the Respondents was primarily to facilitate the application to register the Malaysian "Colourland" Mark in Singapore on behalf of Colourland Malaysia. Colourland Malaysia had knowledge of a prior registration of a similar mark by the Applicants. The Respondents were merely acting as an agent on behalf of or being used as a platform for Colourland Malaysia to apply for a registration of a confusingly similar mark in Singapore knowing that Colourland Malaysia could not do so themselves after having been warned by the Applicants. The Applicants state that the Respondents' multiple changes of name are repeated attempts of the Respondents and Colourland Malaysia to hide the identity of the actual applicants of the Respondents' mark in order to avoid proceedings under the Act on the ground of bad faith. The Applicants believe that this is the Respondents' and Colourland Malaysia's plan to illegitimately ride on the goodwill and reputation of the Applicants' COLORLAND Marks in Singapore.

74 The Applicants point out that the Respondents' Statutory Declaration states that their application to register Colourland Malaysia's mark was "*with the consent and at the request of Colourland Malaysia*". The Applicants allege that this fact further evinces the Respondents' and Colourland Malaysia's illegitimate scheme as this arrangement is clearly not within ordinary business behaviour. It did not make commercial and common sense that the Respondents, as the appointed distributor be the registered proprietors of Colourland Malaysia's mark; the latter losing all the rights in their brand in Singapore.

75 There is no evidence in the Respondents' Statutory Declaration to show use of the Respondents' Colourland COLOUR YOUR HOME and device mark. The sale invoices exhibited are merely delivery orders for "MESA" products bearing a MESA mark which is a Singapore registered trade mark belonging to Colourland Malaysia. The Applicants have shown in their evidence that Colourland Malaysia and MESA Paint Manufacturing Pte Ltd ("MESA") are related companies. According to the ACRA business profile of MESA, Colourland Malaysia is a shareholder of MESA. Hu Mong Hong whom the Applicants had warned not to infringe the Applicants' Marks in 2008 is a director of MESA.

Respondents Submissions

76 The Respondents state the principles in the Valentino case are instructive and anything short of direct evidence will not suffice in proving this ground of invalidation. The Respondents submits that the Applicants have failed to distinctively prove that the Respondents' mark was registered in bad faith. The fact that the application to register the trade mark was made before the Accounting and Corporate Regulatory Authority had written to request the Respondents to change their name does not support the Applicants' contention that the application was made in bad faith. In any event, the Respondents' mark is sufficiently distinctive from the Applicants' mark such that it is impossible to

infer that the Respondents had acted in bad faith. It is easier to infer that the Respondents had registered their mark because it became the distributor of Colourland Malaysia; and there can be no bad faith as Colourland Malaysia has itself operated a very successful business in Malaysia since 1999.

77 The Respondents has deposed in their statutory declaration that they were given the right to register the Respondents' mark by virtue of the distributorship agreement with Colourland Malaysia; and hence this is a continuation of the legitimate business arrangement between the Respondents and Colourland Malaysia. *Weir Warman Ltd v Research & Development Pty Ltd* [2007] 2 SLR(R) 1073 at [49]

78 With respect to allegation of bad faith by the Applicants against the Respondents for pasting the sticker bearing the "Mesa" mark over the "Colourland" mark on the Respondents' tins of paint, this could be a commercial strategy to market the goods under the Mesa mark until the resolution of the invalidation action. The Respondents who are acting as distributors for Colourland Malaysia should not be called upon to explain the decisions of Colourland Malaysia.

Decision on Section 7(6)

79 The test for bad faith under section 7(6) of the Act is that enunciated in the Court of Appeal case of *Valentino Globe BV v Pacific Rim Industries Inc* [2010] 2 SLR 1203 ("*Valentino*") at [29].

In *Wing Joo Loong*, this court observed at [105] that "[t]he test for determining the presence of bad faith, in the context of the English Trade Marks Act, was settled by the English Court of Appeal" [emphasis in original]. It would be useful to set out in full the observations of this court at [105]–[106] which are as follows:

105 The test for determining the presence of bad faith, in the context of the English Trade Marks Act, was settled by the English Court of Appeal in *Harrison v Teton Valley Trading Co Ltd* [2004] 1WLR 2577, where Sir William Aldous, with whom Arden and Pill LJ agreed, expressed the test as follows (at [26]):

The words 'bad faith' suggest a mental state. Clearly when considering the question of whether an application to register is made in bad faith all the circumstances will be relevant. However the court must decide whether the knowledge of the applicant was such that his decision to apply for registration would be regarded as [being] in bad faith by persons adopting proper standards.

This test, which was referred to by Sir Aldous (*id* at [25]) as the "combined" test of bad faith, contains both a subjective element (*viz*, what the particular applicant knows) and an objective element (*viz*, what ordinary persons adopting proper standards would think).

[106] Recently, this combined test of bad faith was succinctly explained in *Ajit Weekly Trade Mark* [2006] RPC 25 as follows (at [35] and [41]):

35 ... Bad faith is to be judged according to the combined test of dishonesty for accessory liability [for] breach of trust set out by the majority of the House of Lords in *Twinsectra Ltd v Yardley* [2002] 2 A.C. 164, with *Gromax Plasticulture* ([103] *supra*) ... providing the appropriate standard namely, acceptable commercial behaviour observed by reasonable and experienced persons in the particular commercial area being examined.

...

41 ... [T]he upshot of the Privy [Council's] decision in [*Barlow Clowes International Ltd v Eurotrust International Ltd* [2006] 1 WLR 1476] is: (a) to confirm the House of Lords' test for dishonesty applied in *Twinsectra*, i.e. the combined test; and (b) to resolve any ambiguity in the majority of their Lordships' statement of that test by making it clear that an enquiry into a defendant's views as regards normal standards of honesty is not part of the test. The subjective element of the test means that the tribunal must ascertain what the defendant knew about the transaction or other matters in question. It must then be decided whether in the light of that knowledge, the defendant's conduct is dishonest judged by ordinary standards of honest people, the defendant's own standards of honesty being irrelevant to the objective element ...

This court in *Wing Joo Loong* then applied at [107]–[117] the combined test of bad faith which, to reiterate, contains both a subjective element (*viz*, what the particular applicant knows) and an objective element (*viz*, what ordinary persons adopting proper standards would think). It is therefore apparent to us that bad faith as a concept is **context-dependent**. In the final analysis, whether bad faith exists or not hinges on the **specific factual matrix of each case**. [emphasis mine]

80 As the test to determine whether there was bad faith is very much dependant on the facts of the matter, it is therefore important to first ascertain what the Respondents knew at the date of application of their mark, that is, on 27 May 2008. Once this has been ascertained, the question is whether the Respondents in applying for registration of the mark with that knowledge in hand, would be regarded as having done so in bad faith by ordinary persons adopting proper standards.

81 The Applicants have in evidence stated that the Respondents must have known of the Applicants' business name at the time of the application for registration of the Respondents' mark. The Applicants state that they had lodged a complaint about the Respondents with ACRA via email on the 29 May 2008. ACRA followed up on the complaint with a letter dated 12 June 2008, seeking some clarification and information from the Applicants, and the Applicants replied ACRA's letter on the 16 June 2008. In a

subsequent letter dated 2 July 2008, ACRA wrote to the Applicants mentioning that they had "written to the target business ... They [the Respondents] have been given up to the 4th week of July to respond". The letter did not mention the date that the Respondents were formally notified by ACRA about the complaint concerning the Respondents' business name nearly resembling the name of another corporation as to be likely to be mistaken for it. From the dates of the correspondence provided, the notification to the Respondents was likely to have been given sometime between the 16 June 2008 and the 2 July 2008. The exhibits mentioned above are all found in Exhibit G of the Applicants' First Statutory Declaration.

82 The final letter from ACRA to the Applicants was a letter dated 18 September 2008 informing them that the Respondents had been issued a direction on the 27th August 2008 to change its business name. The Respondents had responded to the direction by changing their name from "Colourland Paints" to "Petty Paints". The Enhanced Instant Search obtained by the Applicants via QuestNet shows that the date of change of name from "Colourland Paints" to "Petty Paints" as the 6 September 2008. This change of name was updated in the Trade Marks register via an amendment at the Intellectual Property of Singapore and the date of change in the register is indicated as the 9 September 2008.

83 The Applicants in their Statutory Declaration In Reply deposed that they had "in 2008" informed and warned Colourland Malaysia not to sell their products in Singapore. In particular, the evidence mentioned a "Mr Hu Mong Hong, a shareholder of Colourland Malaysia". The Applicants state that the fact is contained in the Applicants 16th June 2008 letter to ACRA. I now reproduce paragraph 5 of this letter to ACRA which says:

"Furthermore, there is a case of a Malaysian Company with similar name, "Colourland Paints Sdn. Bhd" We have also advised them not to sell their products in Singapore as we hold the registered trade mark brand of "Colorland" in Singapore. (a copy of the document is also attached for your reference)."

84 The copy of the document mentioned was not tendered in evidence. At the hearing of the matter, the Respondents also submitted that as this document was not tendered in evidence, they had no way to reply to this allegation. It would appear from this that the Respondents had no indication of the complaint until they received notice from ACRA which at paragraph 80 above appears to be sometime between the 16 June 2008 and the 2 July 2008). Although the fact of the warning is contained in the letter to ACRA, the date on which the warning to Colourland Malaysia was issued and to whom it was issued is not conclusive as it was not tendered in evidence. These gaps in the evidence do not allow a firm conclusion to be made as to whether that the Respondents know or ought to have known about the warning issued to Colourland Malaysia; or as the Applicants allege in their Statutory Declaration In Reply, that Colourland Malaysia would have informed the Respondents about the Applicants' registered trade mark "COLORLAND".

85 The Respondents do not deny that they have a business relationship with the Malaysian company, Colourland Malaysia. At the hearing, counsel for the Respondents painstakingly went through the Respondents' exhibits to impress upon parties at the

hearing that Colourland Malaysia is an entity of more than 20 years standing; it has an established commercial and financial standing, a strong clientele base in Malaysia; in short, it was submitted that the company has the ability to hold its own. The evidence lodged shows that Colourland Malaysia was incorporated in Johor Bahru, Malaysia in 1999 and there are numerous exhibits showing the many projects in Malaysia that Colourland Malaysia had completed, participated in or sponsored. The Respondents in their evidence (Exhibit C of the Respondents' Statutory Declaration) exhibited a letter dated 14 July 2008 written to them by Colourland Malaysia, appointing the Respondents as "Colourland Paints Distributor for Singapore and Asia Pacific Region". The letter also made reference to an earlier meeting between the parties at Colourland Malaysia's premises, however, the date of this meeting was not mentioned in the said letter.

86 The date of the letter – the 14 June 2008 - is oddly placed. It is a date after the Respondents made the application for registration (27 May 2008), and also a date after the presumed period (sometime between the 16 June 2008 and the 2 July 2008) where the Respondents might have been notified by ACRA of the Applicants' complaint. Yet it is a date that is well before the direction issued to the Respondents by ACRA to change their name (28 August 2008) and the date of the actual change of name (6 September 2008). This date is material because the Applicants have alleged that the Respondents were fully aware of and knew of the Applicants' COLOURLAND Marks at the time of the application to register the Respondents' mark; and that the conduct of the Respondents in applying the registration of their mark in Singapore falls short of the normally accepted standards of commercial behaviour. However, in light of the circumstances and the dates that do not tally, I am not able to conclusively determine that the Respondents were fully aware of and knew of the Applicants' COLOURLAND Marks at the time of the application to register the Respondents' mark.

87 The Applicants have further alleged that the several changes of the Respondents' business name at ACRA is tantamount to evading possible actions of bad faith levelled against them under the Trade Marks Act. The Applicants state that these actions are less than legitimate dealings where the Respondents are assisting or colluding with Colourland Malaysia to obtain registration of Colourland Malaysia's mark in Singapore. The Applicants also question the logic of Colourland Malaysia agreeing to give up rights to their mark to a party whom they have appointed as a mere distributor; and states that this potentially points towards bad faith or an illegitimate scheme. Although there is evidence lodged showing the Respondents' changes of name, I would be slow to agree that this is tantamount to actions of bad faith, these changes of name are clearly tracked on official records and it does not appear to be a ploy to "hide the identity of the applicant of the Respondents' mark" as alleged by the Applicants in their Statutory Declaration In Reply. These allegations are therefore merely inferences of bad faith which have not been distinctly proven. It is trite where the ground of bad faith under section 7(6) is pleaded, the allegation of bad faith is a serious claim to make and one that has to be distinctly proved. The Court in *Valentino* states at [30]:

Furthermore, it is pertinent to note that an allegation of bad faith is a serious claim to make and it must be sufficiently supported by the

evidence (see *Nautical Concept Pte Ltd v Jeffery Mark Richard and another* [2007] 1 SLR(R) 1071 at [15] which we reproduce below):

An allegation that a trade mark has been applied for in bad faith is a serious one. In *Royal Enfield Trade Marks* [2002] RPC 508, it was held (at [31]) that:

A plea of fraud should not be lightly made ... and if made should be distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the facts (see *Davy v. Garrett* [1878] 7 Ch.D. 473 at 489). In my judgment precisely the same considerations apply to an allegation of ... bad faith made under section 3(6) [of the UK Trade Marks Act 1994]. It should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctly proved and this will rarely be possible by a process of inference.

88 Finally, the Applicants state that there has not been any evidence that the Respondents' mark has been used on the Respondents' goods as all the invoices tendered in evidence by the Respondents show that the goods bear the mark of another entity ("MESA"). The Applicants also point out that the physical exhibit tendered at the hearing (Exhibit AE-1) the Respondents' can of paint with the trade mark "Colourland" pasted over with a "Mesa Paint and M device" sticker raises the suspicion that Colourland Malaysia and MESA Paint Manufacturing Pte Ltd were both clearly aware of the Applicants' COLORLAND trademarks in Singapore and were taking steps to circumvent any possible infringement action that might be levelled against them.

89 I have looked at the invoices tendered in evidence by the Respondents. Since all the invoices are dated 3 March 2009 onwards, I have generally separated them into 3 categories: invoices dated before the date of filing of the invalidation action on the 26 March 2009, those dated after the 26 March 2009 and those that are not dated. The 4 invoices that were dated before the 26 March 2009 mention the type of goods (for example "MM scraper", Painting Kit (Tray & Roller)", "Paint Brush", "Paint Remover") sold but do not name any trade mark belonging to either Applicants or Respondents. The invoices dated after the 26 March 2008 either indicate sales of MESA products, (for example, "MESA Zinc Chromate Primer", "MESA Weatherly Plus", to name a few) or have items that bear the name "Easy Care" or "Supreme". Neither the Applicants nor the Respondents have made any submissions or submitted evidence on whether these are names of products branded under the MESA mark or the Colourland Mark; or whether "Easy Care" or "Supreme" are separate trade marks in their own right. I therefore find that the evidence does not clearly and distinctly prove the allegation that the Applicants have raised. The Respondents have mentioned in evidence that since the on-going invalidation proceedings, the Respondents have stopped the sales of the products bearing the Respondents' products; this might well explain why the invoices after a certain date do not reflect sales of items with the Colourland mark.

90 Upon consideration of the evidence tendered and the submission of parties, I am not satisfied that the Respondents were fully aware of and knew of the Applicants'

COLOURLAND Marks at the time of the application to register the Respondents' mark, that is, as at 27 May 2008. In light of the Respondents' knowledge therefore, I find that the Respondents' conduct in filing the application for registration of their Colourland mark measured against the ordinary standards of normal people adopting proper standards, cannot be said to have been done in bad faith.

The ground of opposition under Section 7(6) therefore fails.

Ground of Invalidation under Section 23 read with Section 7(1) in particular Section 7(1)(a), (b) and (c)

91 Section 7(1) of the Act reads:

Absolute grounds for refusal of registration

7.—(1) The following shall not be registered:

- (a) signs which do not satisfy the definition of a trade mark in section 2 (1);
- (b) trade marks which are devoid of any distinctive character;
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services; and
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

Applicants' Submissions

92 The Applicants submit that Section 23(2) of the Act is not applicable in the present case as the Respondents have failed to show any evidence of use of their mark before the date of registration which in consequence of which would cause their mark to have acquired a distinctive character in relation to the goods for which it is registered. The Applicants also state that the respondents' sign is not a sign that is capable of distinguishing the Respondents' goods from the goods of other traders as laid down in the British Sugar decision. Further, the Respondents' mark is incapable of distinguishing the Respondents' goods as the Applicants have long established goodwill and reputation in the Applicants' COLORLAND marks.

93 By virtue of the goodwill and reputation, enjoyed by the Applicants in relation to their mark, the Respondents' mark which is confusingly similar to the Applicants' mark is devoid of distinctive character. The Respondents' mark "Colourland" and "colour your home" in a brush device, has a literal meaning and consists exclusively of signs or indications to designate the kind and intended purpose of the Respondents' goods.

Respondents Submissions

94 Counsel for the Respondents cited the High Court decision in Love & Co which laid down the test for assessing whether a trade mark is distinctive. Applying the said test, the Respondents state that the Applicants' claim that the Respondents' mark is not distinctive is without merit. The Respondents point out that the Applicants' mark which comprises only the word mark "COLORLAND" is even less distinctive and more devoid of distinctive character. The Applicants' allegation that the Respondents' mark does not satisfy the definition of a trade mark conveniently ignores the fact that their own word mark is much less distinctive.

Decision on Section 7(1)(a), (b) and (c)

95 Section 2(1) of the Act defines "sign" to include "any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape, colour, aspect of packaging or any combination thereof" and "trade mark" to mean any sign capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person;

96 Section 7(1)(a) of the Act requires that the mark satisfy the definition of a "trade mark" provided in section 2(1). The Respondents' mark "Colourland COLOUR YOUR HOME within the sweeping brush stroke and the device of a paintbrush is clearly a mark which satisfies the definition. It is capable of distinguishing; it is not a mark which is devoid of distinctive character as it has a distinctive device. It also does not consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services.

97 The Applicants submission that the mark is not distinctive because it does not distinguish the Respondents' goods from the Applicants' goods due to the Applicants' long established goodwill and reputation in their COLORLAND marks, is better dealt with under a different ground of objection.

98 I find that therefore that the ground of opposition under Section 7(1)(a), (b) and (c) therefore fails.

Conclusion

99 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that on the whole, the application for declaration of invalidation succeeds on section 23 read with section 8(2)(b) and on section 8(4)(a) read with 8(4)(b)(i). Accordingly, Trade Mark Registration No. T0806894F is declared invalid. The Applicants are also entitled to costs to be taxed, if not agreed.

Dated this 28th day of November 2011

Anne Loo

Principal Assistant Registrar of Trade Marks
Hearings and Mediation Division
Intellectual Property Office of Singapore