

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

Trade Mark Application No. T0718802F
21 December 2010

IN THE MATTER OF A TRADE MARK APPLICATION BY

SEIKO ADVANCE LTD

AND

OPPOSITION THERETO BY

**SEIKO HOLDINGS KABUSHIKI KAISHA
(TRADING AS SEIKO HOLDINGS CORPORATION)**

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

Mr Prithipal Singh (PRITHIPAL & ASSOCIATES) for the Applicants

Mr Cheah Yew Kuin (WONG & LEOW LLC) for the Opponents

Cur Adv Vult

1 Seiko Advance Ltd (“the Applicants”), applied for registration of the following trade mark 株式会社 セイコーアドバンス (“the Application Mark”) on 17 Sep 2007 in Class 2 in respect of “Dyestuffs; pigments; coatings [paints]; printing ink; water colours [paints]”
Seiko advance Ltd.

other than children's paintboxes, oil colours [paints]; metal foil for painters, decorators, printers and artists and metals in powder form for painters, decorators, printers and artists; anti-rust greases".

2 The application was accepted and published on 21 May 2008 for opposition purposes. Seiko Holdings Kabushiki Kaisha (trading as Seiko Holdings Corporation), ("the Opponents"), filed their Notice of Opposition to oppose the registration of the Application Mark on 11 September 2008. The Applicants filed their Counter-Statement on 9 January 2009.

3 The Opponents filed evidence in support of the opposition on 3 August 2009 and 14 April 2010. The Applicants filed evidence in support of the application on 9 December 2009. The Pre-Hearing Review was held on 12 May 2010 and the opposition initially fixed to be heard on 26 August 2010. The Applicants sought leave to file further evidence on the 22 July 2010 which was granted and the Applicants filed their further evidence on 20 August 2010 and 18 November 2010. The Opponents filed their reply on the 5 October 2010. The opposition was heard on 21 December 2010.

Grounds of Opposition

4 The Opponents rely on Sections Section 8(2)(b), Section 8(4) and Section 8(7) of the Trade Marks Act (Cap 332, 2005 Rev Ed) ("the Act") in this opposition. Section 7(6) was earlier pleaded in the Notice of Opposition but the Opponents decided not to proceed with this ground.

Opponents' Evidence

5 The Opponents' evidence comprises a Statutory Declaration affirmed by Mr Hitoshi Murakami, Director of the Opponents on 24 July 2009 and filed on 3 August 2009; as well as 2 Statutory Declarations in Reply affirmed by Mr Akio Naito, General Manager of the Legal & Intellectual Property Department of the Opponents, the first of which was affirmed on 9 April 2010 and filed on 14 April 2010; and the subsequent Statutory Declaration affirmed on the 30 September 2010 and filed on the 5 October 2010.

Applicants' Evidence

6 The Applicants' evidence comprises a Statutory Declaration affirmed by Mr Tetsuo Hiraguri, President of the Opponents on 2 December 2009 and filed on 9 December 2009; as well as further evidence in the form of 2 Statutory Declarations; the first sworn by Mr Tetsuo Hiraguri on 5 August 2010 and filed on 20 August 2010 and the second by Mr Pang Toon Lam, General Manager of Elcontrol Trading, the Applicants' agent sworn on 16 November 2010 and filed on 18 November 2010.

Applicable Law and Burden of Proof

7 The applicable law is the Trade Marks Act (Cap 332, 2005 Rev Ed)("the Act"). Under the Act, 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

8 The Opponents, Seiko Holding Corporation, were founded in 1881 and have been selling a variety of products including watches, clocks, stopwatches, sports timing equipment, optical lenses and frames, golf clubs, musical accessories, system clocks, cyber time business, electronic devices, information related products, IC dictionaries, art and craft products, camera components, eyeglasses and jewellery. The holding company oversees the management of all its subsidiaries and affiliated companies located worldwide and which are engaged in a wide range of industries manufacturing and selling the diverse range listed of products listed above. The opponents are listed on the Tokyo stock exchange and its headquarters are in Tokyo. Some of the subsidiaries and affiliated companies have been established over the past 70 years and these include:

SEIKO INSTRUMENTS INC established in 1937;
SEIKO TIME SYSTEM established in 1970;
SEIKO CLOCK INC established in 1996;
SEIKO PRECISION INC established in 1996;
SEIKO OPTICAL PRODUCTS CO., LTD. established in 1996;
SEIKO SPORTS LIFE CO., LTD established in 2000;
SEIKO SERVICE CENTRE established in 1964; and
SEIKO WATCH CORPORATION established in 2001.

9 The Opponents' wholly-owned Singapore subsidiary, Seiko Singapore Pte Ltd ("SS") and Seiko Instruments Inc's subsidiary, Singapore Instruments Singapore Pte Ltd were incorporated in 1982 and 1973 respectively. The main business activity of SS from 1982 to 1988 were the conduct of research and marketing activities for the Singapore and Malaysia markets for the Opponents' products. SS also handled the wholesale and coordination of sales of the Opponents' products in Vietnam, Myanmar, Laos, Cambodia, India and Nepal.

10 The Opponents were established in 1881 and in 1892, began producing clocks under the name "Seikosha". The company expanded its product line by adding pocket watches in 1895, alarm clocks in 1899 and table clocks in 1902. The Opponents began to export their products to China and by 1912, China were receiving 70 percent of Japan's total export of timepieces. In 1913, the Opponents opened its first overseas branch in Shanghai, China. By 1924, the Seikosha plant produced the first wristwatches under the "SEIKO" brand. By 1936, the Opponents had marketed a total of 2.06 million clocks and watches under the "SEIKO" brand, the highest figure since the opening of its manufacturing plant. Japan's total watch and clock production came to 3.54 million.

11 By 1953, the Opponents had purchased a total of 2.64 million watches and clocks from group plants, representing 54.3% of Japan's total production and exported 101,000 watches and clocks under the SEIKO brand. By late 1950s, the company's watches were gaining international attention and the Opponents began marketing watches in the United States and other countries. In 1956, the company marketed its first domestic self-winding wristwatch under the SEIKO brand. Production of its watches reached 3 million per year in the beginning of 1950, when the company utilised the conveyer-belt production technology. In the 1960s, the Opponents became the official timer of the Olympic Games in Tokyo, supplying 1,278 stopwatches plus the world's first portable quartz chronometers. Its quartz technology allowed the Opponents to sponsor numerous sports events and be the official timer of more than 150 international sports events annually. By the early 1970s, the SEIKO brand had attained much popularity and the Opponents scored a publicity coup when it once again served as the official timer of the 1972 Winter Olympic Games held in Sapporo, Japan. In 1972, the Opponents also produced the world's first ladies quartz watch under the SEIKO brand. In 1973, it introduced the first liquid-crystal display (or LCD) digital watch under the SEIKO brand, which had built-in illumination and a 6-digit numerical readout displaying the time in hours, minutes and seconds.

12 In the 1970s, the Opponents had established and expanded into several jurisdictions including the United States (1970), Canada (1971), United Kingdom (1971), West Germany (1972), Brazil (1974), Panama (1977), Sweden (1979) and Hong Kong (1979). The Opponents also continued to introduce innovative products in 1990s, including a computerised diver's watch; the world's first quartz watch with a full automatic 1,100 year calendar; and a series of battery-free quartz watches. In July 2001, the watch business division of the Opponents was consolidated under the management of Seiko Watch Corporation and the Opponents, the holding company oversaw the business subsidiaries in Japan and abroad and focussed on providing the customers with reassurance and satisfaction of the quality of products bearing the SEIKO brand. With respect to Singapore, as early as 1963, the Opponents' products were marketed locally through its local distributor, Thong Sia Co (S) Pte Ltd ("Thong Sia"). To-date, Thong Sia remains a distributor of the Opponents' SEIKO products in Singapore.

13 In terms of their name, the Opponents were first established as a clock retailer in Tokyo by Mr Kintaro Hattori, who in 1892 also established a clock factory and named it "精工舎" ("Sei Ko Sha" as the Japanese Kanji characters are pronounced). Mr Hattori had intended that the name to reflect his goal of succeeding ("成功") in producing precision ("精巧") clocks; in the Japanese language, these Japanese Kanji characters that mean success ("成功") and precise workmanship ("精巧") are all pronounced as "Sei Ko". "Sha" means "house". The Opponents have over 1073 registrations for their SEIKO mark worldwide in many classes, including Class 2. They also have registrations for marks incorporating the word "SEIKO". The worldwide registrations include, but are not limited to countries such as Australia, Canada, the Peoples' Republic of China, France, Germany, Hong Kong, India, Korea, Malaysia, Singapore, Taiwan, United Kingdom, United Arab Emirates and the United States of America. In Singapore, the Opponents'

SEIKO mark is registered in Classes 1, 3, 4, 7, 8, 9, 14, 15, 18, 25, 37 and 41; and has many registrations for marks incorporating the word SEIKO ("SEIKO Variant Mark"). The Opponents have received extensive coverage in the worldwide media and earned numerous awards. The Opponents' SEIKO marks have also been in the international spotlight for frequent participation in major sporting events as the official timer; and have been recognised and associated with the leaders in timekeeping accuracy. In terms of marketing, advertising and promoting their SEIKO mark, the Opponents have spent the following:

Financial Year	Worldwide Marketing Expenditure (in Japanese Yen) (in excess of)	Marketing Expenditure in Singapore (in US Dollar) (in excess of)
2008	11 billion	720 thousand
2007	13 billion	590 thousand
2006	13 billion	617 thousand
2005	13 billion	477 thousand

14 The combined worldwide and the Singapore annual sales for the Opponents' products bearing the SEIKO mark are:

Year of Sales	Worldwide Turnover (in Japanese Yen) (in excess of)	Singapore Turnover (in US Dollar) (in excess of)
2008	174 billion	13 million
2007	213 billion	15 million
2006	209 billion	14 million
2005	213 billion	12 million

15 The Opponents have extensive use of the SEIKO mark as applied to a diverse range of goods and the absence of other third party registered marks in Singapore containing the word "SEIKO". The Opponents engaged the services of a market research company, Asian Strategies Pte Ltd, to conduct a market survey likelihood of confusion between the Application mark and the Opponents' SEIKO marks, and the extent of goodwill, if any, associated with SEIKO. The survey results showed that almost half the sample population surveyed associated the Application mark with a company that makes watches. The survey also showed that over 72% of the sample population had either owned or presently owned a SEIKO product, indicating that the Opponents' mark is well known to the public at large. The Opponents state that the survey also showed that there was a likelihood of confusion as 51% of the sample population from different age and socio-economic groups who were aware of the Opponents' mark, associated the Application mark with the Opponents or thought that the mark represented a range of products originating from the Opponents.

16 The Applicants state that the word "SEIKO" which existed before the Opponents were established in Japan is a very common word and has many different meanings attached to it depending on the Japanese Kanji characters used. The Opponents use "SEIKO" to mean "success" or "precise workmanship" but in the Applicants' case, it means "restoration and recovery from a devastation of war or a fire disaster". Both the Applicants' and the Opponents' marks are registered in Japan. The Applicants was originally incorporated as Seiko Paint Co Ltd in 1950 and changed its name in 1971 to Seiko Advance Co Ltd when it concluded a technical assistance agreement with Chicago based Advanced Process Supply Company. The Applicants have used the trade mark "Seiko Advance Ltd" in Singapore for more than 25 years and have exhibited invoices for the period 1984 to 1988 and the period 1997 to 2007 as evidence. The invoices show that the Applicants have used the mark "Seiko Advance Ltd" as early as 1984 to date.

17 The Applicants also tendered copies of registrations to show that many companies in Japan have the word "SEIKO" as part of their company names and have registered them as their trademarks in the same classes as the Opponents' mark. In Singapore, the Applicants are the registered proprietor of Trade Mark No. T0405795H for "ELCONTROL SEIKO SCREEN INK" in class 2. The Applicants adopted the Application mark in 2007 and the mark has been in use in Singapore since July 2008. The Applicants goods are different from the Opponents goods and all the Applicants' products are manufactured for entrepreneurs and businesses. These products are sold directly through an agency to a printing business. The products are used to further manufacture other products such as cellular phones and consumer electronic products, and sold to the consuming public as end products. The consuming public therefore does not see the Application mark as it is not visible in the end product. The distribution channels of the Applicants' products are hence very different from the Opponents whose goods are displayed on the market and clearly visible to the purchaser.

18 The Applicants' global sales figures are:

Sales (year)	Sales (in Japanese Yen)
2008	7.3 billion
2007	7.9 billion
2006	7.0 billion
2005	6.7 billion

19 The total amount of sales in Singapore by the Applicants' and its related companies are:

Sales (year)	Sales (in Japanese Yen)
2008	2.0 million
2007	4.5 million
2006	4.5 million
2005	6.3 million

20 The global advertising figures (including Singapore) are:

The fiscal year	Advertising expenditure (in Japanese Yen)
2008	18 million
2007	28 million
2006	22 million
2005	26 million

21 The Applicants clarified that they are known as Seiko Advanced Limited to the people in the trade, that is, to the people in the screen print industry. The Applicants annex two certificates from the President of the Japanese Association of Screen Printing Supplier and the president of the Japanese Screen & Digital Printers Association stating that both the trade mark and name of the Applicants are famous in the screen print industry. With international communications and international spill over of reputation, the reputation of the Applicants trade mark and name are not limited to Japan but extends overseas to other countries, including to Singapore, where there is a screen print business. The manager of Elcontrol Trading, the Applicants' agent in Singapore since 1996, states that the Applicants' products are very famous in Singapore in the screen printing industry.

MAIN DECISION

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

Section 8(2)(b) of the TMA reads:

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

...

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

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

Opponents' Submissions

22 It is trite law that in considering whether two marks are similar, the court will consider whether there is conceptual, visual and aural similarity between the registered mark and the applicant's mark. The doctrine of imperfect recollection must be taken into account and the mark must be assessed as a whole and not for its individual similarities or differences because the person who is confused often makes comparison from memory removed in time and space from the marks. *Caterpillar Inc. v. Ong Eng Peng [2006] 2 SLR(R) 669*

23 The Opponents submits that the Application Mark and the Opponents' Seiko Marks are visually similar as the word "SEIKO" is the predominant and distinctive element in the Application Mark, and this element is associated exclusively in Singapore with the Opponents and/or the SEIKO Group of companies. The Opponents' SEIKO Word Mark is also wholly reproduced in the Application Mark as the other components of the Application Mark – the word "advance" and "Ltd" and the Japanese words "Kabushiki Kaisha" (which mean literally "company") - are generic elements which do not serve to distinguish the Application Mark from the Opponents' SEIKO Marks. The Intellectual Property Office of Singapore's Trade Marks Register as at 10 July 2009 shows that there is only one other registered trade mark which contains the word "SEIKO". This mark was registered in 16 April 2004 by the Applicant in Class 2 for the very limited specification of "Printing Ink". All other registered trademarks on the Trade Marks Register which incorporate or are for the word "SEIKO" belong to and/or are registered to the Opponents. The mark "SEIKO" is therefore distinctive of the Opponents.

24 The Opponents submits that the Application Mark is also aurally similar to the Opponents' SEIKO Marks as the Japanese characters appearing on top of the words Seiko advance Ltd are not words that would be recognisable or pronounceable by the general public in Singapore (who would be unfamiliar with the Japanese language). The members of the public are likely to refer to the Application Mark by the readable English words, i.e. "Seiko advance Ltd.", which begins with the Opponents' distinctive Mark, "SEIKO". The Japanese Kanji and Katakana characters in the Application Mark are transliterated literally as "Kabushiki Kaisha Seiko Adovansu", meaning "Seiko Advance Ltd." "Kabushiki Kaisha" means literally "company" in the Japanese language and "Seiko Adovansu" is the phonetic equivalent of "Seiko Advance". The word "advance" is a very generic word in the English language that also has a laudatory meaning and connotes an intention to improve. The acronym "Ltd." is commonly accepted as the acronym for the word "Limited". The Opponents submits that the Application Mark is conceptually similar to the Opponents' SEIKO Marks as the generic elements which the Applicant is seeking to use to distinguish the Application Mark from the SEIKO Marks are *de minimis* and as such the overall presentation of the Application Mark is similar to the Opponents' mark. Other than the word "SEIKO", the other elements are either generic terms or in a language unfamiliar and not pronounceable by the general public in Singapore. As the Application Mark wholly reproduces the Opponents's SEIKO Word Mark. Indeed, the predominant and distinctive element in the Application Mark, both aurally and visually, is the word "SEIKO", which element is associated exclusively in Singapore with the Opponents and the SEIKO Group of companies. Therefore, we submit that the Application Mark is both aurally, visually and conceptually similar to the Opponents' SEIKO Marks

25 The Opponents submit that the Application Mark is being registered in relation to goods that are similar to the goods the Opponents' SEIKO Marks and cite *British Sugar Plc v. James Robertson & Sons Ltd [1996] RPC 281* at pages 296 to 297 ("*British Sugar*") for the factors which are relevant in an assessment of similarity of goods or services. These factors are not be regarded as requirements that must all be satisfied

before the goods/services can be treated as similar *Johnson & Johnson [2006] SGHC 241* at paragraph 18. While the Class 2 goods for which the Applicant Mark is seeking registration, are not identical to the Opponents' business activities, they are nevertheless similar. The Applicant's area of business is closely associated with the Opponents' registration for the SEIKO Word Mark for industrial materials in Classes 1 and 4 (i.e. adhesives used in industry and industrial oils and greases). Some of the goods which the Application Mark is applied to be registered for, such as printing ink, are goods that can be used in the course of manufacturing the Opponents' products. By virtue of the Opponents' extensive registrations for the SEIKO Marks in diverse fields of business, coupled with the high level of recognition of the SEIKO Marks in Singapore, customers of the Applicants' goods are likely to make the inference that the Opponents have simply licensed the Applicants to conduct business under the SEIKO Marks or that the Opponents has diversified its business to deal in the goods for which the Application Mark is applied for.

26 Further, one of the Opponents' affiliated companies, Seiko Epson Corporation, has trade mark registrations for their mark "EPSON" in Class 2 goods such as paints; dyestuffs; pigments; toner for computer printers, ink for computer printers, printing inks, colors, ink cartridges; nonferrous metals in foil or powder form for painters, decorators, printers and artists; precious metals in foil or powder form for painters, decorators, printers and artists; anti-rust greases; etc.

27 The question of whether there is a likelihood of confusion should be addressed globally, taking into account all the circumstances of the case 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. *City Chain Stores (S) Pte Ltd v. Louis Vuitton Malletier [2010] 1 SLR 382* at paragraphs 52 – 60(*Louis Vuitton*) The Opponents have numerous trade mark registrations and has a very wide coverage of trade mark registrations for and/or incorporating the SEIKO Word Mark, which span a wide and varied range of goods and services. The SEIKO Word Mark is also used in varied forms and sometimes together with other elements; hence the average consumer would therefore be exposed to the SEIKO Marks as applied to a wide range of goods and services. Further, given the Opponents' extensive use of the SEIKO Marks in a diverse range of goods and the absence of other third party registered trade marks in Singapore containing the word "SEIKO" as a standalone word, it is a natural conclusion that the Opponents' customers and trade partners may be confused into thinking that there is a business relationship between the Opponents and the Applicants or that there is a licensing or trading agreement under which the Opponents exercise some control over the goods of the Applicants. The Opponents' local subsidiaries in Singapore are Seiko Singapore Pte Ltd and Seiko Instruments Singapore Pte Ltd, and in light of this naming convention that has been used by SEIKO in relation to the naming of its various subsidiary and/or affiliated companies, members of the public that view the Applicants' mark (where the words "Seiko advance Ltd" appear prominently), would inevitably associate the Applicants with the Opponents.

28 The Opponents engaged the services of a market research company, Asian Strategies Pte Ltd, to conduct a market survey to show likelihood of confusion, if any, between the Application Mark and the Opponents' SEIKO Mark; and to assess the perceptions and image of the company amongst Singapore residents, as well as the extent to which the "SEIKO" mark is well known to members of the Singapore public. When interviewees were shown the Application Mark, and asked what products or services they would associate with the Application Mark, almost half the sample (49 per cent) associated the name "Seiko advance Limited" with a company that makes watches, a brand of watch, Seiko watches, a clock or a Japanese watch company. 51% interviewees who were aware of the SEIKO Word Mark (i.e. 37% of the entire sample of interviewees) associated the Application Mark with the Opponents and thinking that the Applicants, Seiko advance Ltd, is a company that is associated with the Opponents, or thinking that the mark represents a range of products originating from the Opponents.

Applicants' Submissions

29 The Applicants state that the Opponents have to fulfill the 3 step approach as laid down by the Court of Appeal in *The Polo/Lauren Co. LP v. Shop In Department Store Pte Ltd* [2006] 2SLR(R) 690 ("*Polo/Lauren*") in order to succeed under Section 8(2)(b). The 3 steps are firstly, a comparison of the Opponents' earlier trade mark(s) with the Opposed Mark to assess whether the marks are similar; secondly, a comparison of whether the Opponents' and the Applicant's goods are identical or similar goods, and thirdly, an assessment whether there exists a likelihood of confusion on the part of the public if the Opponents' and the Applicants' marks are similar and the goods of the Applicants are similar or identical to the Opponents. The Applicants cite the guiding principle as enunciated by Parker J. at page 777 in the *Pianotist Co.'s Application* (1906) 23 RPC 774 at 777 ("*Pianotist*") when dealing with comparison of marks.

30 The Applicants say that the marks are visually very different. The Opponents' mark consists merely of the word "SEIKO". The Application mark contains the words "Seiko advance Ltd" and the Japanese characters "株式会社 セイコーアドバンス". Even if the Opponents' arguments that the public will not understand the meaning of the Japanese characters hold true, these characters would at best be considered to be stylized and form a device element in the Application mark that is more than sufficient to distinguish the Applicants' mark from the Opponents' mark. *Carita v. Pardaco Trading Pte Ltd* [2009] SGIPOS 10 ("*Carita*") As in the case of *Carita*, the Applicants' mark is a composite mark and the device element in the mark will play an important role in distinguishing the Applicants' mark from the Opponents' mark. The device element cannot be ignored in the visual analysis of the mark as taking the mark as a whole and considering the size and position, the device element is placed prominently on top and makes up 50 % of the mark as a whole; whereas the word "Seiko" occupies less than a quarter of the mark and is tucked away in the left corner of the mark. The Opposed Mark also contains the words "Advance Ltd" which cannot be ignored. Visually, the word "Advance" as an added element in the Applicants' word and device mark provides greater contrast between the marks since the Opponents' mark comprises only a single word "SEIKO".

31 The Applicants state that in assessing aural similarity it is accepted that the device element may not play such a large part. The Application mark however, consists of the added elements “Advance Ltd” which when read through as the words “Seiko Advance Ltd”, is aurally different from merely the Opponents' word mark “Seiko”. The marks are not aurally similar.

32 The marks are also not conceptually similar as the Application Mark consists of many other elements besides the word “Seiko”. The words “Advance Ltd” and the Japanese characters add significantly to the distinctiveness of the mark and make it conceptually dissimilar from the Opponent's mark.

33 The goods covered by the Opponents' and the Applicants' marks are clearly dissimilar. The Application Mark is sought to be registered in respect of “Dyestuffs; pigments; coatings [paints]; printing ink; water colors [paints] other than children's paintboxes, oil colors [paints]; metal foil for painters, decorators, printers and artists and metals in powder form for painters, decorators, printers and artists; anti-rust greases”. The Opponents' marks are registered in classes 1 & 4 for “adhesives use in industry” and “industrial oils and greases” respectively. “Adhesives for use in industry” and “industrial oils” are not similar to any of the goods covered by the Application Mark.

34 The Applicants submit that there is also no likelihood of confusion even if it is found that the marks are similar and the goods are similar. The Applicants' evidence shows that all products produced by the Applicants are manufactured for entrepreneurs and businesses. The Applicants sell the products to its agent in Singapore (Elcontrol Trading) who in turn supplies the products to the screen printers directly. The screen printers are aware of the brand of the product they are buying as they can clearly see the Applicant's mark thereon. Once the screen printer uses the product in the screen printing process and gives the end product to the public consumer, the public consumer will never know that it was a Seiko Advance Ltd screen ink that was used on the product. All that the end consumer sees is the final product. There is absolutely no room for any confusion with the Opponents' products which are sold in totally different trade channels and outlets. The Applicants' Singapore agent since 1996, Mr Pang Toon Lam, has deposed that the trade mark “Seiko” alone is totally unknown in Singapore in the screen printing industry in relation to the Opponent. The Applicants state that this is why there has not been any instance of confusion in Singapore despite the fact that the Applicants have been selling their products under the name “Seiko Advance Ltd” since 1971. Further, the Applicants' mark is also registered in Japan, Thailand and the Philippines and co-exists with the Opponents' registrations.

35 The Applicants are also the owner of the registered trade mark T040579H in class 2 for the mark “ELCONTROL/SEIKO SCREEN INK” which the Opponents allege that they were unaware of the registration and that was why it was not opposed. It is submitted that the mark is clearly distinguishable from the Opponents' mark and that is why no action is being taken.

36 The Applicants also submit that the Opponents' survey evidence is not reliable and does not show the likelihood of confusion for the following reasons. First, the conclusion of the market survey draws the conclusion that there is a significant level of perceived association between "Seiko Advance Limited" and the Seiko company and brand that is well established in the minds of the Singapore's consumers as a Japanese manufacturer of quality watches and clocks." Mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 8(2). *Sabel BV v. Puma AG* [1998] R.P.C 199 at page 224. Secondly, the survey concluded with the words "In our opinion...". The originators of the survey are not expert witnesses qualified to give opinion evidence and for this reason their opinion is inadmissible. Thirdly, the surveyors interviewed random members of the public, and these end consumers will never see the Applicants' products or trade mark as the products are very specialized and sold only in certain channels.

Decision on Section 8(2)(b)

37 The Opponents must satisfy the criteria under Section 8(2)(b) in order to succeed under this ground; and the first criteria is that the Opponents must have an "earlier trade mark". This is defined in Section 2(1) of the Act:

"earlier trade mark" means —

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

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

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

38 The Opponents are relying on 2 registered trademarks - T9500064D for "adhesives used in industry" in class 1 and T8002252C for "industrial oils and greases" in class 4 as the earlier trademarks. These marks are for the word mark "SEIKO" and the Applicants do not dispute that these marks satisfy the criteria of an "earlier trade mark" under Section 2(1). It bears noting that in the Opponents' evidence, several other marks which would qualify as earlier trade marks were listed; these are marks registered in classes 3, 7, 8, 9, 14, 15, 18, 25, 37 and 41. Some of these registrations are for the word mark "SEIKO", others for variant marks which are combinations of the word "Seiko" and another word.

39 In determining the criteria that has to be satisfied under Section 8(2)(b), I take guidance from the Court of Appeal case of *Polo/Lauren* ([8]) where the Court endorsed the three-step approach enunciated in *British Sugar*:

“It seems to us that there will be infringement of if three conditions were 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. ”

- 40 The Opponents therefore have the burden of proving:
- i. that the Application mark and the Opponents' earlier trade marks are similar;
 - ii. that the goods of the application mark and of the earlier trade marks are identical or similar; and
 - iii. there is a likelihood of confusion by virtue of the similarity of the marks and the goods

41 Professor Ng-Loy Wee Loon in the revised edition of her book, **Law of Intellectual Property of Singapore at page 283, [21.5.11]** has neatly encapsulated the different guidelines gleaned from cases and which the Courts have used in the comparison of marks. She states:

"When the comparison is for the purpose of determining if the marks are similar, the following are some guidelines given by the courts. Firstly, the comparison is a 'mark for mark' comparison and must not take into account any extra added matter. Further the mark must be taken as a whole, and there should not be nitpicking for similarities in the individual parts of the mark. The doctrine of 'imperfect recollection' applies in the comparison, and thus the marks must not be compared side by side. The comparison is for visual, aural and conceptual similarities... " (emphasis mine)

42 For the purpose of Section 8(2) and for the comparison of marks and determination of whether a likelihood of confusion can arise, the *Pianotist* is instructive. Parker J at page 777 states:

"You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion – that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods – then you may refuse the registration or rather you must refuse the registration in that case."

Comparison of Marks

Visual Similarity

43 I find that the marks are not visually similar. The marks in question are :

Application Mark

株式会社 セイコーアドバンス
Seiko advance Ltd.

Opponents' Mark

SEIKO

44 In deciding visual similarity, one has to look at the marks as they are and as wholes. In the present case, the Application mark is a composite mark as opposed to the Opponents' mark which comprises a single word, "SEIKO". The Opponents' submissions that the Application mark wholly reproduces the Opponent's mark and contain foreign characters and generic words will not be useful considerations here. It is unlikely that the eye will be discerning enough to focus solely on the word "Seiko" in the Application mark, and disregard the other components. There should not be a dissection of the Application mark into its different portions – the English portion and the Japanese character portion – instead, a reasonable visual assessment of the Application mark will show that the word "Seiko" is not the prominent feature nor is it the only feature in the mark. The position of the Japanese Kanji and Katakana characters and the words 'Seiko advance Ltd' are equally balanced in the whole mark. This makes the Application mark visually very different from the Opponents' single word mark.

Aural Similarity

45 I also do not find the marks aurally similar. I agree with the Opponents who have correctly pointed out that the members of the public will be more likely to refer to the composite Application mark by the readable portion which contains English words. The tendency is to refer to that portion because English is the working language in Singapore, is spoken by the majority as a first language and people in general will gravitate towards the language most familiar to them. The Application mark will be read through and verbalised as "Seiko advance Limited"; or for those unaware that "Ltd" is the abbreviation of "Limited", "Seiko advanced L-T-D". This is aurally different from the Opponents' mark which is enunciated as "Seiko". Again, the considerations of whether the words "advanced" and "limited" are generic or laudatory are of little weight in the assessment of how the marks sound when enunciated.

Conceptual Similarity

46 Conceptually, however, I find that the marks are similar. The word "Seiko" to the majority would be viewed either as a foreign (Japanese) or an invented word. I agree with the Opponents that as the Opponents' mark "Seiko" is wholly reproduced in the Application Mark, the conceptual similarity is enhanced.

Comparison of the marks on the whole

47 I have found that there is no visual and no aural similarity between the Opponents' and the Application marks; only conceptual similarity. On the whole therefore, I find that the marks are not similar.

Comparison of the goods

Similarity of Goods

48 In assessing and determining the similarity of goods, the decision in **British Sugar** states the relevant factors to consider. They are:

- i. the nature of the goods or services;
- ii. the end users of the goods or services;
- iii. the way in which the services are used;
- iv. whether the respective goods or services are competitive or complementary, how those in the trade classify the goods and the trade channels through which the goods or services reach the market; and
- v. in the case of self-serve consumer items, whether in practice they are respectively found or likely to be found on the same or different shelves.

49 The Opponents in their evidence have shown that they have numerous registrations for their SEIKO or "Seiko-variant" marks in classes other than Classes 1 and 4. The goods of these other registrations include:

Class	Goods / Services
3	Bleaching preparations and other substances for laundry use.
7	Machines and implements all operated hydraulically or pneumatically, machine tools, motors (not for land vehicles), machine couplings, machine beltings, Industrial assembly robots, grinding machines, vane rotary compressors and turbomolecular pumps, parts and fittings for all the aforesaid goods
8	Hand tools and instruments and cutlery, shaving instruments; safety razors, electric and non-electric shavers and parts thereof
9	Scientific, surveying, electrical, wireless, photographic, cinematographic, optical, weighing, measuring, signalling and checking (supervision) apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers; calculating machines, data processing equipment and computers; fire-extinguishing

Class	Goods / Services
	apparatus; electronic dictionaries; electronic spell-checkers; spelling verifiers; electronic pocket translators; electronic translating apparatus, computer program for translating; reference apparatus and software; gramophones, gramophone records; metronomes; tape recording apparatus and record players; batteries and cells, hand-held computers and software therefore; desk-type electronic computers, and electric or electronic calculating machines; computers, electronic machines and apparatus and television apparatus; eyeglasses, eyeglass lenses, eyeglass frames, eyeglass cases.
14	Watches, clocks, stopwatches, horological and chronometric apparatus and instruments; watch cases, watch boxes; parts and fittings of these goods
15	Musical instruments and parts and fittings of these goods
18	Leather, imitation leather and articles made from all the aforesaid materials; trunks, travelling bags, umbrellas, parasols and walking sticks.
25	Articles of clothing, but not including boots, shoes or slippers.
37	Customized construction and repair of watches and clocks.
41	Educational services relating to watches and clocks.

50 For the purposes of the opposition under Section 8(2)(b) however, the Opponents have indicated that they are proceeding with the Class 1 and 4 registrations as the earlier trade marks. In any event, applying the principles in *British Sugar*, the goods listed in the table above are not goods that are similar to the Applicants' Class 2 specification of goods. With the exception of the Class 3 specification, the other goods classes relate to finished products such as machines, tools, scientific apparatus, spectacles, watches, leather items, clothing, etc. Class 37 and 41 relate to repair and awareness services which primarily support the Opponents' main business activity of selling watches. The Opponents' Class 3 goods relate to bleaching and other preparations for laundry use, goods that are used by different users, for different uses and which would move in different trade channels from the Applicants' Class 2 goods which are pigments, paints, colorants and preparations used for the protection against corrosion.

51 Closer to the heart of the matter are the Opponents' goods in Classes 1 and 4 which the Opponents say are goods similar to those within the specification of the Application Mark. For ease of reference, the Opponents' and the Applicants' specification of goods are as shown:

Applicants' Specification of Goods	Opponents' Specification of Goods
Dyestuffs; pigments; coatings [paints]; printing ink; water colours [paints] other than children's paintboxes, oil colours [paints]; metal foil for painters,	Adhesives used in industry. (Class 1)

decorators, printers and artists and metals in powder form for painters, decorators, printers and artists; anti-rust greases	Industrial oils and greases. (Class 4)
--	--

52 Once again, applying the test in *British Sugar*, it can be seen that the Opponents' Class 1 and the Applicants' Class 2 goods are not similar. The Opponents' Class 1 goods are adhesives, clearly not the same kind of goods as the Applicants' paints, pigments, and grease which is used to prevent corrosion. The Applicants' goods are consistent with the evidence that it is used by the screen printing industry.

53 In respect of the Opponents' Class 4 and the Applicants' Class 2 goods, there is an overlap in one of the items, that is, "grease". The Applicant's Class 2 item is an "anti-rust grease" whereas the Opponents' class 4 item is "industrial greases". The Opponents submit that these items are fundamentally the same since greases are essentially used for both lubricating and anti-corrosion purposes. I would agree that to the ordinary man in the street, grease is grease however one looks at it; whether it is to be used for prevention of corrosion or used as a lubricant. I could not find in the Opponents' evidence any indication as to how this class of goods is used in their business, which would have been useful to show the extent to which the Opponents' and the Applicants' goods are competitive or complementary. I have however found the explanatory note of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks instructive. Although this is a guide and used for administrative purpose of classification, it sheds some light and gives some hint as to the purpose and use of the goods, as well as gives an indication how the trade might classify the goods. In respect of Class 4 goods, the note states that these goods are essentially products that go to the making of products belonging to others. This shows that the single overlapping item appears to be complementary in the sense that greases may be used as components in the manufacture of consumer products.

54 The rest of the items in the Applicants' Class 2 and the Opponents' Class 4 specifications are however distinctly different in terms of their nature and uses. The literature in the Applicants' evidence shows quite clearly how their goods are used and have stressed that the industry that uses their goods is the screen printing industry. The Applicants submit that their goods are not sold openly to the public; rather, they sold directly to the screen printers and are used by the screen printing industry on products. The Opponents on the other hand have ample evidence of their consumer products but no evidence showing use of the Class 1 and 4 goods. Some of the Opponents' registrations for the other classes include "parts and fittings" which the Opponents argue will also not be sold directly to the public. However, these "parts and fittings" are items that a consumer of the Opponents' goods (such as watches, clocks, etc) would regard as "spare parts" or necessarily be items that complement the Opponents' services of repair and education in Class 37 and 41. The Opponents' Class 4 goods and the Applicants' class 2 goods therefore will have different uses, users and follow different trade channel into the markets.

55 Before leaving the topic of similarity of goods, it bears noting that the Opponents' raised the issue of one of their affiliate companies having registration for and use of goods in Class 2. In assessing the evidence however, it is clear that the marks in question are not "SEIKO" marks, rather they are "EPSON" marks. The marks are registered by Seiko Epson and not the Opponents. The "EPSON" marks are not within the ambit and scope of this opposition under Section 8(2), hence I need not consider them.

56 I find therefore that the goods of the Application mark and those of the Opponents are not similar goods.

Likelihood of Confusion

57 The wording in Section 8(2)(b) is clear: the likelihood of confusion must stem from similarity between the Application Mark and the Opponents' earlier trade marks, **and** there must be either identity or similarity between the goods. In *Polo/Lauren*, it has been held that similarity between the goods is essential for an opposition brought under Section 8(2), in other words the finding that the goods are not similar will cause the opposition to fail. The Court of Appeal stated:

“First, the alleged offending sign must be shown to be similar to the registered mark. Second, both the sign and the mark must be used in relation to similar goods or services. Third, on account of the presence of the first two conditions, there exists a likelihood of confusion on the part of the public...,if either of the first two conditions is not satisfied there will not be any need to go into the third question of determining whether there exists a likelihood of confusion.”

58 In light of the fact that I have found that the Opponents and the Applicants marks are not similar and there is a lack of identity or similarity between the Opponents' and the Applicants' goods, no likelihood of confusion will arise.

59 I would add that this same outcome would have been reached even if the third step of the approach in *Polo/Lauren* – "whether there is a likelihood of confusion on the part of the public" - were determined by assessing the evidence and submissions lodged. For completeness of the matter, I shall look at the assessment whether there is a likelihood of confusion on the part of the public.

60 *Polo/Lauren* at ([28]) states that "[t]he 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..."

61 The question of likelihood of confusion in this matter really hinges on the type of goods and the consumers of those goods. The Applicants' evidence shows that there will be no confusion because their goods will never appear on the market for sale to the general public: the goods are not sold through retail channels, nor are they found in shops – not even hardware shops or printing shops. The consumers of the Applicants' goods are the screen printers in the screen printing industry, a fairly specialised set of consumers and it would be expected that this consumer base is more knowledgeable about the goods and the brands. In fact, the Opponents' evidence relating to an investigation they had conducted to determine the extent of use of the Application Mark in Singapore confirms that the Applicant's trade in Singapore is limited to a very small and select group of businesses. The evidence showed that the Applicants' Corporate name was not listed in any of the major commercial business listings in Singapore. The investigation included a survey of over 40 business outlets, including those businesses in the paint and inks industry, but none of the representatives of these outlets had any knowledge of the Application Mark.

62 Although the Opponents' goods in Classes 1 and 4 are also not the finished products, I find that most of the Opponents' evidence lodged alludes to watches, sales and promotions for watches. The survey which was commissioned by the Opponents confirms that the majority of the interviewees surveyed were of the impression that the Opponents' mark related to watches or clocks. The Opponents submitted that when interviewees were shown the Application mark, and asked what products or services they would associate with the Application mark, almost half the sample (49 per cent) associated the name “Seiko advance Limited” with a company that makes watches, a brand of watch, Seiko watches, a clock or a Japanese watch company. The strong impression amongst the public that the Opponents are a watch company lessens the risk that the consumers might believe that the goods come from the same source or economically-linked sources.

63 As I have found that the marks are not similar; that the goods are also not similar; and that there is no likelihood of confusion, the opposition under Section 8(2)(b) therefore fails.

Decision on Section 8(4)(a)(b)(i)

Section 8(4) of the Act reads:

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

- (a) the earlier trade mark is well known in Singapore; and*
- (b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered—*

(i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark; 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.

The definition of an “earlier trade mark” has been set out above in paragraph 37.

The definition of a “well known trade mark” in Section 2(1) means:

(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.

Opponents’ Submissions

64 The Opponents submit that essential part of the Application Mark is clearly identical with, or similar, to the Opponents’ earlier SEIKO Marks. The Application Mark wholly reproduces the Opponents’ SEIKO Word Mark “SEIKO”, and the word “SEIKO” is the predominant and distinctive element in the Application Mark. The other components of the Application Mark are made up of generic words, being “advance”, “ltd” and the Japanese words “Kabushiki Kaisha” (which mean literally “company”). These generic elements do not serve to distinguish the Application Mark from the SEIKO Marks.

65 Under section 2(8) of the Trade Marks Act, a trade mark is deemed to be “well known” in Singapore as long as it can be shown to be “*well known to any relevant sector of the public*”, and the relevant sector of the public is defined under section 2(9) of the Trade Marks Act to include “*all actual and potential consumers in Singapore of the goods or services to which the trade mark is applied, all persons in Singapore involved in the distribution of the goods or services which the trade mark is applied and all businesses and companies in Singapore dealing in the goods or services to which the trade mark is applied*”. Section 2(7) of the Trade Marks Act sets out a list of non-exhaustive factors to be taken into account when considering whether a mark is well known in Singapore.

66 The Opponents have a well known and established history in the horological and precision equipment industry both globally and in Singapore, particularly in relation to watches and timepieces. In particular, the SEIKO Marks have been used in Singapore in

relation to the Opponents' products from as early as 1963 and is registered in many classes (including Class 2) in Singapore and worldwide. The Opponents have received extensive exposure for its SEIKO Marks in the worldwide media, earned numerous awards throughout the world and the SEIKO Marks have been continuously in the international spotlight by maintaining frequent participation in major sporting events as the official timer. The Opponents have also invested heavily in the promotion of its products under the SEIKO Marks and spent significant amounts in marketing, advertising and promoting the SEIKO Marks in Singapore and worldwide, resulting in significant sales of products under the SEIKO Marks both in Singapore and worldwide.

67 The well-known status of the SEIKO Marks have been recognised by courts and trade mark offices in many jurisdictions in the world including China, Taiwan, Korea, Hong Kong, Philippines and Italy. The Market Survey is also a clear indication that the Opponents' SEIKO mark is well known to the public at large in Singapore where over 72% of all interviewed subjects indicated that they either presently own a SEIKO product; had previously owned a SEIKO product; or is at least aware of SEIKO even if they do not own or have not previously owned a SEIKO product. The Opponents' evidence therefore clearly demonstrates that the "SEIKO" name and mark is very well known not only to the relevant sector of public, but indeed to the public at large. It enjoys widespread goodwill both in Singapore and worldwide. The name and mark "SEIKO" and its variant "SEIKO" marks, are associated distinctively with the Opponents and/or the SEIKO Group of companies.

68 The use of the Application Mark would indicate a connection with the Opponents. *Mobil Petroleum Company, Inc. v. Hyundai Mobis [2010] 1 SLR 512* ("Mobil") at paragraphs 48 - 54) The Opponents submit that the use of the Application Mark would result in a confusing connection as to origin being made by members of the public, as clearly evident from the results of the Market Survey. The Opponents also submit that there is a confusing connection as to business because the Application Mark suggests that the Applicants are an extension, branch, agency or related entity given the similarity of the Application Mark and the Opponents' SEIKO Marks; and/or the Applicants were taken to be under some trading arrangement or commercial relationship with the Opponents. *Clinique Laboratories, LLC v Clinique Suisse Pte Ltd and another [2010] SGCH 189* ("*Clinique*") (at paragraph 42) The use of the Application Mark would result in the confusing connection arising from the incorporation of the Opponents' distinctive "SEIKO" mark in the Application mark. Such confusion arising in the market by the entrant of a new entity making use of the distinctive "SEIKO" mark would result in a whittling away and/or dispersion of the identity and the strong hold that the Opponents' SEIKO Marks have upon the public mind. If the Application Mark is allowed to proceed to registration, it would also restrict the Opponents from expanding into future business areas. *Novelty Pte Ltd v. Amanresorts Ltd & Anor [2009] 3 SLR 216* ("*Amanresorts*") (at paragraphs 116 - 118) and *Mobil* (at paragraph 99)

69 As the Opponents have extensive registrations for the SEIKO Marks in wide fields of business and the high level of recognition of the SEIKO Marks in Singapore, customers of the Applicants' goods are likely to make the inference that the Opponents

has simply licensed the Applicants to conduct business under the SEIKO Word Mark or that the Opponents has diversified its business to deal in the goods for which the Application Mark is applied for. The Opponents have an affiliated company, Seiko Epson Corporation, which is already in the business of providing inks and toners for electronic printers, and have registered two trade marks in Class 2 for the word mark “EPSON” hence it is therefore not unforeseeable that it may be possible that the Opponents would want to extend their business into marketing Class 2 goods under the “SEIKO EPSON” mark instead of just under the “EPSON” mark.

70 For the Opposition under Section 8(4)((b)(ii), the Opponents’ position is that in order to establish dilution, it would not be necessary to show a likelihood of confusion, nor would it be necessary to show that the goods or services that the prior mark is registered for, is similar or identical to the goods or services the later mark is sought to be registered for. In *Amanresorts* (at paragraph 225), the Court of Appeal expressly held that “dilution” under the Trade Marks Act refers to dilution by both “blurring” and “tarnishment”.

71 The Opponents cite *Intel Corporation Inc v. CPM United Kingdom Ltd Case C-252/07 [2009] RPC 15* (at paragraph 29) where the concept of dilution by “blurring” has been held to refer to the weakening of the mark’s ability to identify the goods or services for which it is used as coming from the proprietor of that mark, since use of the later mark leads to dispersion of the identity and hold upon the public mind of the earlier mark. The concept is also held to refer to the reduction or erosion of the strong capacity of the well-known mark to exclusively identify the goods/services of its proprietor. [21.5.29(e)] *Law of Intellectual Property in Singapore, Prof Ng-Loy Wee Loon*).

72 The Opponents cite from Prof Ng-Loy Wee Loon's textbook that “*in dilution, the value of the special well-known trade mark is diminished, that is, there is a negative impact on its goodwill*”. [21.5.29(g)] *Law of Intellectual Property in Singapore, Prof Ng-Loy Wee Loon*) for some guidance on when a subsequent mark “would cause dilution in an unfair manner”. The Opponents state that the Market Survey clearly shown that the registration of the Application Mark would cause dilution in an unfair manner to the Opponents’ SEIKO Marks. The Opponents has spent a significant amount of time and resources in building up the brand equity in their SEIKO Marks and in relation to its range of products. If the Application Mark were to be registered, it would result in the unfair dilution of the Opponents’ SEIKO Marks by allowing distinctiveness of the Opponents’ SEIKO Marks in Singapore to be eroded by a subsequent mark which at the time of the Application has minimal goodwill in Singapore.

73 The concept of “taking unfair advantage of the distinctive character of a trade mark” encompasses instances of clear exploitation and free-riding on the coat-tails of a famous mark or an attempt to trade upon its reputation. [21.5.29(g)] *Law of Intellectual Property in Singapore, Prof Ng-Loy Wee Loon*). In order to show that an advantage had been taken, it is sufficient to demonstrate that the sign used by the defendant had a particular attraction for the consumer due to the fact that the sign is associated with positive qualities of the well-known mark in such as way as to induce the consumer to buy

the defendant's goods. (*L'Oreal SA, Lancome parfums et beaut & Cie and Laboratoire Garnier & Cie v Bellure NV, Malaika Investments Ltd and Starion International Ltd Case C-487/07[2010] RPC 1* at paragraphs AG[104] - AG[109])

74 The Opponents have cultivated their SEIKO mark as having the positive qualities of a Japanese heritage; long existence of over 40 years in Singapore, a reputation for quality products and high standards of manufacture; worldwide availability and a perceived popularity in Singapore. The Application Mark will inevitably ride on the positive qualities as a result of the perception on the part of the public that the Applicant's Mark (and even the Applicants' corporate name "Seiko advance Ltd") are associated with, or originate from the Opponents. The Opponents' Market Survey shows that 49% of all interviewees who were shown the Application Mark had associated the Application Mark with goods produced by the Opponents and with 51% of the interviewees who were aware of the Opponents thinking that the Applicant, Seiko advance Ltd, is a company that is associated with the Opponents, or thinking that the mark represents a range of products originating from the Opponents. Once it can be shown that the Applicants' use of a mark will lead to a blurring between the Applicants' and Opponents' products and services, even if no business would be diverted away from the Opponents to the Applicants, the Applicants' free-riding on the Opponents' coat-tails would still amount to an unfair advantage taken by the Applicants of the distinctive character of the Opponents' marks *Clinique* (at paragraph 45)

Applicants' Submissions

75 The Applicants state that under this ground of opposition, the Opponents have to prove that the Application mark is identical or similar to the Opponents' marks, the Opponents' mark come under the definition of an "earlier trade mark", the Opponents' earlier trade mark is well known in Singapore, that use of the Application mark in relation to the goods for which it is sought to be registered would indicate a connection between the goods of the Opponent and is likely to damage the Opponent's interests; or if the Opponent's earlier trade mark is well known to the public at large in Singapore, it would cause dilution in an unfair manner of the distinctive character of the Opponent's earlier trade mark or it would take unfair advantage of the distinctive character of the Opponent's earlier trade mark.

76 The Applicants state that the Applicants' and the Opponents' marks are not identical. The trade marks listed by the Opponents at paragraph 28 of the Opponent's Statutory Declaration dated 24 July 2009 are all registered trade marks in Singapore and would qualify as earlier trade marks. The Opponent has to prove that their SEIKO marks are well known in Singapore. *Amanresorts* per V K Rajah JA ([135]) In assessing whether a trade mark is "well known in Singapore", the Applicants cite *Amanresorts* ([136 to 141]). In the light of *Amanresort*, the Opponents must therefore show that at the relevant date (i.e. 17 September 2007), their "Seiko" marks were well known in Singapore to the "relevant sector of the public in Singapore". The Court of Appeal held that "relevant sector of the public in Singapore" in Section 2(9)(a) of the TMA covered

the actual consumers and potential consumers of the type of goods or services to which the plaintiff's trade mark was applied. *Amanresorts* ([142 to 154]).

77 The Applicants are prepared to concede that the Opponent's trade marks in classes 9, 14, 37 & 41 may be well known trade marks. However, the Applicants do not concede that the Opponents' trade marks in the other classes (in particular classes 1 & 4) are well known because no evidence at all has been lodged by the Opponents to show that the "Seiko" mark registered in classes 1 & 4 has in fact been used in Singapore and that it is recognized by the actual consumers in Singapore of the goods to which the class 1 & class 4 mark is applied, the evidence of sales and marketing lodged by the Opponents is a lump sum global figure which does not show the revenue or marketing in respect of the class 1 & class 4 products and Applicants' Singapore agent, Mr Pang Toon Lam, has deposed that the Opponents are not known at all in the screen printing business. The Opponents "Seiko" mark may be well known for watches and electrical equipment, it is not well known in Singapore for the goods that the Opponents deal in.

78 The use of the Application Mark does not and will not indicate any connection between the goods of the Opponents. The Applicants cite *Clinique*, where a connection was established because the defendant's "Clinique Suisse" marks were visually, aurally and conceptually similar to the plaintiff's "Clinique" mark, the goods were also packaged in a very similar fashion and the fields of business were also related. The word "Suisse" did not add much to the mark as it could indicate a geographical source of the goods. In the present case, the Applicants' mark is visually, aurally and on the whole held to be different; the goods that the Applicants are dealing in are totally different from the Opponents' goods. The Applicants' goods are only sold to a very select industry and not to the general public who would also be buying the Opponents' goods. The use of the Application mark in relation to the goods for which it is sought to be registered does not and will not indicate any connection between the goods of the Opponents. There has been no evidence adduced by the Opponents of any damage caused to the Opponents since the Applicants use of their mark "Seiko Advance Ltd" in 1971.

79 In relation to Section 8(4)(a) read with 8(4)(b)(ii), the Opponents have to prove that their "Seiko" mark is well known to the "public at large". The Opponents may be well known for watches and electrical equipment but there is no evidence that the "Seiko" mark is well known in respect of "screen printing". Further the Opponents have to prove that the use by the Applicants would cause dilution in an unfair manner or would take unfair advantage of the distinctive character of the Opponent's mark. The Applicants are merely using its own name since 1971, and is not trying to take a free ride on the coat-tails of the Opponents. There is no unfair advantage being taken by the Applicants as they have been using their own name for 30 over years and merely wants to continue to do so.

Decision

80 I will deal with the Section 8(4) opposition in the following manner: firstly, with section 8(4)(a) and read with Section 8(4)(b)(i) and secondly, with section 8(4)(a) read Section 8(4)(b)(ii).

Decision on Section 8(4)(a) and Section 8(4)(b)(i)
Section 8(4)(a) and (b)(i) of the Act reads:

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

81 At the very outset, section 8(4)(a) makes it clear that the assessment of whether registration ought to be granted to the Application mark or whether the Opponents' earlier trade mark is a well known mark only follows *if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark*. Under the section 8(2)(b) ground of opposition, I had decided that the Opponents' and the Applicants' marks are not similar, hence, it would follow that the ground of opposition under Section 8(4)(a) and (b)(i) would also fail. However for completeness of the matter, I will deal with the other requirements under this Section to determine whether the Opponents' SEIKO mark is "well known to the public in Singapore."

Whether the Opponents' SEIKO Marks are well known in Singapore

82 The determination of what is a well known mark under section 2(1) of the TMA and the definition of the “relevant sector of the public” as defined in sections 2(7) to 2(9) of the TMA, is well guided by the Court of Appeal’s decision in *Amanresorts*. The Court of Appeal dealt extensively with the issue of well known marks and explored the development of the well known mark provisions in the Act. Section 2(7) of the Act which provides the considerations that are relevant in deciding whether the mark is well known states:

Subject to subsection (8), in deciding, for the purposes of this Act, whether a trade mark is well known in Singapore, it shall be relevant to take into account any matter from which it may be inferred that the trade mark is well known, including such of the following matters as may be relevant:

- (a) the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;*
- (b) the duration, extent and geographical area of—*
 - (i) any use of the trade mark; or*
 - (ii) any promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied;*

- (c) any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application;
- (d) any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory;
- (e) any value associated with the trade mark.

83 Of all the factors in Section 2(7), emphasis is given to Section 2(7)(a) as the most important factor due to the deeming provision in Section 2(8) which states:

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.

84 The Court in *Amanresorts* at [140] also had this to say about the Section 2(8) deeming provision:

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

85 Section 2(9) provides the definition of the “relevant sector of the public in Singapore” as including all actual consumers and potential consumers in Singapore of the goods or services to which the trade mark is applied; all persons in Singapore involved in the distribution of the goods or services to which the trade mark is applied; and all businesses and companies in Singapore dealing in the goods or services to which the trade mark is applied. In *Amanresorts*, the Court decided that the relevant sector of the public in Singapore was “the **actual and/or potential consumers** Respondents’ good and services.” Applying this construction of the phrase “all actual and potential consumers” to the present matter, it is the actual consumers and potential consumers of the Opponents’ watches, who form the relevant sector of the public. Although in their submissions, the Applicants were ready to concede that the Opponents’ trade marks in Classes 9, 14, 37 and 41 might well be well known marks, I note that the evidence lodged by the Opponents relate primarily to watches. I have looked through the invoices filed in support of the Opponents SEIKO marks, and almost every invoice indicated under the item “Description” (of the goods sold), the words “SEIKO WATCHES”. (the exception was a single invoice dated 20 August 2007 which was for “SEIKO watches and boxes”) All the invoices lodged show impressive sales figures running into the tens and hundreds of thousands of US dollars. The Opponents have also lodged evidence showing that they have advertised their watches extensively in magazines and newspapers in Singapore, on buses and MRT platform screens, at bus shelters, on panels along underpasses and on wall wraps on buildings. However, the sales and advertising figures were given as a

single figure and not differentiated and as such, it would be difficult to conclude that the Opponents are also well known for the Class 9 goods. The Opponents' Class 9 contains a large number of goods ranging from electrical goods to sporting equipment to spectacles.

86 From the evidence therefore, it can be concluded that the Applicants' Marks are well known to the relevant sector of the public and therefore well known in Singapore, in respect of watches.

Whether use of the Application Mark would indicate a connection between the goods and the Opponents and is likely to damage the interests of the Opponents

87 Tay Yong Kwang J in the High Court decision of *Amanresorts Ltd and another v Novelty Pte Ltd* [2008] 2 SLR(R) 32, held that the requirements of “indicate a connection” and “likely to damage the interests of the proprietor of the earlier trade mark” in Section 8(4)(b)(i) were the same as the elements of misrepresentation and damage under the tort of passing-off. He held at [74]:

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

88 The Court of Appeal upheld this and in *Amanresorts* at [234] stated:

"...we agree with the Judge's finding...that the tests to be adopted for the purposes of the "connection" requirement and the "likely to damage the [plaintiff's] interests" requirement in s 55 (3)(a) of the current TMA would yield the same results as those obtained from applying the corresponding tests vis-à-vis the Respondents' claim for passing off (which tests are, respectively, whether the Appellant has made a misrepresentation to the relevant sector of the public ... which causes that section of the public to mistakenly think that the Project has the same source as or is connected with the Respondents' resorts, and whether such misrepresentation has resulted in or is likely to result in damage to the goodwill attached to the "Aman" names)."

89 I do not find that the Applicants have misrepresented to the public (that is, the actual customer and potential customers of the Opponents' watches) in any way that has caused the public to think that the Applicants' goods are connected with the Opponents. As pointed out earlier, the Opponents' evidence only shows use of the SEIKO mark on watches and their sales invoices all relate to watches. The global and local sales and advertising figures do not indicate the difference between the different classes of goods sold. The Opponents' numerous registered trade marks clearly show that they have diverse business activities and the literature shows that the business relates to consumer products like sporting equipment (S-yard golf clubs), musical equipment, electronic dictionaries and computer peripherals, horological and chronometric equipment, etc.; but there is no evidence lodged of such trade in Singapore. There is also no evidence of the Opponents trading in Class 1 or 4 products. Over and above this, I have also found the

Opponents' mark and the Application Mark to be dissimilar and there is no likelihood of confusion.

90 Taking all these into consideration, it is not likely that the actual or potential customers of the Opponents' watches would be misled into thinking that the Applicants' goods originate from the Opponents or that there is some connection between the two parties. Hence, although SEIKO is well known to the public in Singapore for their watches; because a connection cannot be established between the Applicants' mark and the Opponents' goods, it is not likely that the interests of the Opponents would be damaged if the Application mark were allowed registration. As the Opponents have not shown the elements of "connection" and "likelihood of damaging the Opponents' interests", the ground of opposition under Section 8(4)(a) read with Section 8(4)(b)(i) would fail.

Decision on Section 8(4)(a) and (b)(ii)

Section 8(4)(a) and (b)(ii) of the Act reads:

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

- (a) the earlier trade mark is well known in Singapore; and*
- (b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered—*
 - (i)...*
 - (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."*

Decision on Section 8(4)(a) and (b)(ii)

91 As discussed under the Section 8(4)(a) and (b)(i) ground of opposition, this ground of opposition similarly requires the Opponents to have an earlier trade mark, to show that there is identity or similarity between the Application mark and the earlier trade marks, before moving on to consider whether the Opponents' mark is well known to the public at large. If it is established that the Opponents' mark is *well known to the public at large*, then whether it would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or take unfair advantage of the distinctive character of the earlier trade mark. In the earlier consideration under Section 8(4)(a)(b)(i), the Opponents' earlier trade mark has been found to be dissimilar to the Application mark and as such, the ground of opposition is not made out. However, again for the completeness of the matter, I will consider the other factors under this ground.

Whether the Opponents' earlier trade marks are "well known to the public at large"

92 In the consideration of Section 8(4)(a)(b)(i), it was established that the Opponents' SEIKO mark is well known to the public in Singapore in respect of their watches. Although the Opponents' Seiko marks are "well known to the public", it remains to be determined whether the Opponents SEIKO marks fall within the "rare and exclusive class" (see *Amanresorts* at [233]) of marks that may be regarded as "well known to the public **at large** in Singapore". The Court in *Amanresorts* concluded that it was "*relatively easy for trade marks (whether or not registered in Singapore) to be considered "well known in Singapore" so as to be entitled to the protection set out in the current TMA.*" The threshold for proving that the mark is "well known to the public at large" however is much higher for the Court describes the protection accorded to these marks as a:

"... much more extensive level of protection ... granted to trade marks which have attained the coveted status of being "well known to the public at large in Singapore". These trade marks, which form a rare and exclusive class, are entitled to protection from use of the defendant's trade mark on dissimilar goods or services even in the absence of a likelihood of confusion; that is, such trade marks are entitled to protection against the unfair dilution and the taking of unfair advantage of their distinctive character."

93 It is noted that the term "well known to the public at large" is not defined in the Act, and I rely on the Court of Appeal in *Louis Vuitton* ([92]), where it was held:

"In determining whether a trade mark is "well known to the public at large in Singapore" under s 55(3)(b)(i) and s 55(4)(b)(i) of the Act, one must certainly have regard to s 2(7) of the Act which provides that in deciding whether a trade mark is well known in Singapore:.."

94 The Court of Appeal in *Amanresort* ([94]) also gives some guidance:

*"The expression "well known to the public at large" should be given a sensible meaning, bearing in mind that by virtue of s2(8) of the Act, where 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. Thus 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 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.** ..."* [emphasis mine]

95 The criteria in Section 2(7) have been considered when reaching the decision that the Opponents' Seiko marks are well known to the public. However, the threshold is higher here and the Opponents must show that their marks are recognised by most sectors of the public. The evidence beyond the invoices and the historical literature does not sufficiently show this. The Opponents have lodged documentary evidence of their registrations in many jurisdictions, a 2007 listing showing the Opponents' Seiko mark is one of Asia's top 1000 brands, an extract stating that Seiko is one of Japan's famous trade

marks, cases decided in other jurisdictions in the Opponents' favour. These relate to how known the Opponents' mark is out of Singapore. Based on the evidence, I am not able to conclusively find that the Opponents' Seiko marks were well known to the public at large.

96 In any event, the criteria of similarity of marks that must be satisfied before Section 8(4)(a) and (b)(ii) can be considered has not been met. The Opponents have also not shown that their mark to be well known to the public at large, and hence, it will not be necessary to decide whether the elements of "unfair dilution" in Section 8(4)(b)(ii)(A) or "unfair advantage" in Section 8(4)(b)(ii)(B) are made out. The ground of opposition under Section 8(4)(a) and (b)(ii) therefore fails.

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

Section 8(7)(a) of the Act reads:

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

48 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;

49 ...

Opponents' Submissions

97 The Opponents state that the registration of the Application Mark should be refused on the basis that the use of the Application Mark in Singapore is liable to be prevented by the law of passing off. The Opponents cite state ***Amanresorts*** at paragraphs 36 to 37 for the principle that a claim under the law of passing off requires three elements - the presence of goodwill, misrepresentation causing a likelihood of confusion and the likelihood of damage to goodwill - to be established. It should be beyond dispute that goodwill exists in the SEIKO Marks given its extensive exposure and the significant level of sales of goods bearing the SEIKO Marks in Singapore

98 It has been clearly established that general members of the public at large, upon seeing the Application Mark, would be confused into thinking that there is a business relationship between the Opponents and the Applicant or that there is a licensing or trading agreement under which the Opponents exercises some control over the goods of the Applicant. Such confusion as to origin of goods bearing the Application Mark would be sufficient to satisfy the requirement of a misrepresentation to the members of the public that goods bearing the Application Mark originate from, or are somehow associated with, the Opponents (when they do not). The Applicant's assertion that there has been no confusion to date and there can therefore be no likelihood of confusion in future is flawed since the Applicant has, in the first place, failed to establish any significant use of the Application Mark in Singapore.

99 As for damage, the type of damage that is likely to be caused by the use of the Application Mark would be a result of the confusing connection arising from the incorporation of the Opponents' distinctive "SEIKO" mark. Such confusion arising in the market by the entrant of a new entity making use of the distinctive "SEIKO" mark would result in a whittling away and/or dispersion of the identity and the strong hold that the Opponents' SEIKO Marks have upon the public mind. If the Application Mark is allowed to proceed to registration, it would also restrict the Opponents from expanding into future business areas using its SEIKO Marks such as in the business of the sale or manufacture of printing inks, another head of damage recognised in both the case of *Amanresorts* and the *Mobil* case.

Applicants' Submissions

100 The Applicants state that in order to succeed under Section 8(7)(a) of the TMA, the Opponents have to prove that the Opponents can prevent the use of the Applicants' Opposed Mark by virtue of an action for passing off. The Applicants cite the recent Court of Appeal case of *Amanresorts* ([36 and 37]) for the principles of passing off. The Applicants also cite *Amanresorts* ([39]) which had succinctly set out what "goodwill" is. The Applicants do not dispute that the Opponents have goodwill in the Seiko mark in respect of watches in Singapore.

101 The Opponents have to prove that the use of the Application Mark by the Applicants would constitute a misrepresentation that the goods of the Applicants had the same source as the Opponent's goods or that the two were somehow connected. The target audience of the misrepresentation would be the actual or potential customers of the Opponents and the misrepresentation must give rise to confusion or a likelihood of confusion. The evidence (or lack of it) submitted by the Opponents does not prove this element of misrepresentation. The Opponents have not been able to adduce even a shred of actual confusion despite the fact that the Applicants have been using the name and mark "Seiko Advance Ltd" since 1971 in Singapore. The Applicants and the Opponents have been co-existing in Japan, Thailand and Philippines for many years now and despite this there is no evidence at all of any actual confusion. The Applicants respectfully submit that the Opponents' market survey is not relevant.

102 The Applicants' products are manufactured for entrepreneurs and businesses. The Applicants sell the products to their agent in Singapore (Elcontrol Trading) who in turn supplies the products to the screen printers directly. The screen printers are aware of the brand of the product they are buying as they can clearly see the Applicants' mark thereon. But once the screen printer uses the product in the screen printing process and gives the end product to the public consumer, the public consumer will never know that it was a Seiko Advance Ltd screen ink that was used on the product. All that the end consumer sees is the final product. Hence there is absolutely no room for any confusion with the Opponent's products which are sold in totally different trade channels and outlets. It is clear that the Applicants are merely using their own name (which they have done since 1971) to sell their own products. The Applicants have not in any way passed off their products as being made by the Opponents who are not known in the screen printing

business. The Applicants have their own reputation and goodwill in the screen printing business and cannot by any stretch of the imagination be said to be passing off its products as originating from the Opponents.

103 There is a lack of evidence on the part of the Opponents to prove that the misrepresentation has caused or is likely to cause damage, even though the Applicant has been using the name/mark "Seiko Advance Ltd" since 1971 in Singapore. Neither has the Opponent shown any such damage to have occurred in Japan, Thailand or Philippines. The Opponents therefore have not discharged the burden of proving this ground of opposition.

Decision on Section 8(7)(a)

104 It is trite law that the 3 elements which must be present before an opponent can succeed in an action for passing off are goodwill, misrepresentation and damage as a result of the misrepresentation; this "classical trinity" has been endorsed in the decisions submitted by the Opponents and the Applicants. Lord Oliver of Aylmerton's reformulation of the requirements of an action for passing off in ***Reckitt & Colman Products Ltd v Borden Inc [1990] 1 WLR 491*** ("the ***Jif Lemon case***") at 499, states:

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

105 In order to succeed under this ground of opposition therefore, the Opponents must establish goodwill in his goods and services in the minds of the purchasing public in that

the public must associate the SEIKO mark with the Opponents' goods and services or recognise that the SEIKO mark as being distinctive of the Opponents' goods and services. The Opponents have to demonstrate there is misrepresentation by the Applicants to that public (whether or not intentional) leading the public to believe that the goods or services offered by the Applicants are the goods and services of the Opponents. Finally, the Opponents have to show that they have suffered damage by reason of that misrepresentation.

Goodwill

106 The Court of Appeal in *Amanresorts* at [39] likened goodwill to “love”, both being ephemeral and hard to define; and stated that Lord Macnaghten’s speech in *The Commissioners of Inland Revenue v Muller & Co’s Margarine, Limited [1901] AC 217 (“IRC v Muller & Co”)* remained in their view, the clearest exposition of what goodwill is. Lord Macnaughten at 223–224 stated:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation, and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has a power of attraction sufficient to bring customers home to the source from which it emanates."

107 In the *Law of Intellectual Property of Singapore*, (Sweet & Maxwell, Rev Ed, 2009), *Ng-Loy Wee Loon*, at paragraph 17.1.3 (footnotes omitted) states:

*"Passing off protects the plaintiff's business of goodwill, and not the mark used to promote it. The mark is merely a tool used by the plaintiff to educate their customers who identify which goods or services originate from his business. Although it is important to bear in mind that the proper subject-matter of protection in an action for passing off is the plaintiff's business or goodwill, and not the mark, the role of the mark is crucial when proving the element of goodwill. This is because that test that has been used by the courts to determine whether the plaintiff's business has goodwill is this: **has the mark adopted by the plaintiff become distinctive of his goods or services in the sense that it is associated or identified exclusively with his goods or services?**"*
(emphasis mine)

108 There is ample evidence of the substantial and significant sales and promotion of the Opponents’ watches in Singapore. The evidence set out very clearly that the Opponents' SEIKO mark entered into Singapore in 1963 and the advertising literature submitted clearly supports the Opponents' prominent use of the Mark "SEIKO" in respect of watches, horological and chronometric equipment in Singapore over the last 40 years and more. Similarly, the Applicants in their submissions do not dispute that the Opponents have goodwill in the "SEIKO" mark but only in respect of watches. Going by

the evidence, it can be said that the mark "SEIKO" which has been adopted by the Opponents has become distinctive of the Opponents' goods, in particular watches, horological and chronometric equipment, and is associated and identified exclusively with these goods. The Opponents has goodwill in the SEIKO mark in relation to watches, horological and chronometric equipment.

109 It bears mentioning again however that the evidence does not show that the breakdown of figures (whether sales or advertisement figures) relating to any of the other classes of goods and services that the Opponents have registrations. The numerous invoices lodged in the Opponents' 1st Statutory Declaration also relate only to "Seiko watches".

Misrepresentation

110 The Court of Appeal in *Amanresorts* ([69]) states that :

"[i]n order to establish an actionable tort of passing off, the plaintiff, apart from proving that it has goodwill in the goods, services or business in question, must also show that:

(a) the defendant has made a misrepresentation to the relevant sector of the public; and

(b) such misrepresentation has resulted in or is likely to result in damage to the plaintiff's goodwill.

The elements of misrepresentation and damage are very closely linked, and it is crucial to appreciate that both the misrepresentation and the damage must relate to the plaintiff's goodwill. A misrepresentation is actionable as a tort of passing off only if it causes (or is likely to cause) damage to the plaintiff's goodwill.

Is there a misrepresentation by the Applicants leading the public to believe that the goods or services offered by the Applicants are the goods and services of the Opponents?

111 The key element for misrepresentation is deception. The Opponents must show that the Applicants' use of their mark would cause the public to be misled into thinking that the goods provided by the Applicants come from the same source as the Opponents' goods; or that the goods of the Applicants are somehow connected to the Opponents. The Opponents maintain that there will be confusion as the Application mark and the Opponents' marks are similar and used on similar goods. However, under the Section 8(2)(b) ground of opposition, I have found that the marks are not similar and the goods are also not similar; hence, there is no likelihood of confusion amongst the public that the Applicants' goods and the Opponents' goods originate from the same source.

112 The Opponents have not established that the use of the Application Mark in connection with the Applicants' goods has represented that the goods are produced by the

Opponents, and as such have not discharged the burden of proving that there is misrepresentation. It follows therefore that as the Opponents have not succeeded in proving misrepresentation, the element of damage is not made out.

113 The ground of opposition under Section 8(7) therefore fails.

Conclusion

114 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 21st day of March 2011

Anne Loo

Principal Assistant Registrar of Trade Marks

Hearings and Mediation Division

Intellectual Property Office of Singapore