

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

Trade Mark Application No. T0802642I  
16 June 2011

**IN THE MATTER OF A TRADE MARK APPLICATION BY**

**STAYWELL HOSPITALITY GROUP PTY LTD**

**AND**

**OPPOSITION THERETO BY**

**STARWOOD HOTELS & RESORTS WORLDWIDE, INC AND SHERATON  
INTERNATIONAL, INC**

Hearing Officer: Ms Lee Li Choon  
Principal Assistant Registrar

Mr Prithipal Singh (with Gladys Mirandah, Nehajain and Premsai Chandra Sekaran)  
(Patrick Mirandah Co) for the Applicants


Ms Elaine Tan (with Serena Ong) (Amica Law LLC) for the Opponents

*Cur Adv Vult*

**GROUND OF DECISION**

1 The Applicants, Staywell Hospitality Group Pty Ltd, applied to protect the trade mark

 **PARK REGIS**

“ **PARK REGIS**” as a series of 2 marks (“the Application Mark”) in Singapore on 3 March 2008 under Singapore Trade Mark No. T0802642I in Classes 35 and 43 in respect of “Advertising, marketing, promotion and publicity services; business management; business

administration; office functions; provision of office facilities; administration of the business affairs of retail stores; advisory, information and consultancy services relating to all the aforesaid; all the aforesaid services also provided on-line from a computer database or via the global communications network; all included in Class 35" and "Services for providing food and drink; temporary accommodation; hotel services; resort hotel services; hotel accommodation services; hotel catering services; hotel reservation services; hotel restaurant services; provision of hotel venues for business exhibitions, business fairs, conferences, congresses, lectures and meetings; providing facilities [accommodation] for conducting conferences, conventions, exhibitions, fairs and holidays; rental of meeting rooms; hospitality services [accommodation]; hospitality suites [provision of accommodation, food or drink]; holiday information and planning relating to accommodation; inn keeping [bar, restaurant and accommodation]; restaurants; cafes; bar and catering services; advisory, information and consultancy services relating to all the aforesaid; all the aforesaid services also provided on-line from a computer database or via the global communications network; all included in Class 43" respectively.

2 The application was accepted and published on 7 May 2008 for opposition purposes. The Opponents, Starwood Hotel & Resorts Worldwide, Inc and Sheraton International, Inc filed their Notice of Opposition to oppose the registration of the Application Mark on 8 September 2008. The Applicants filed their Counter-Statement on 7 November 2008.

3 The Opponents filed evidence in support of the opposition on 8 October 2009. The Applicants filed evidence in support of the application on 2 December 2009. Subsequently, the Applicants filed further evidence in support of the application on 6 April 2010. The Opponents filed their evidence in reply on 14 December 2010. A Pre-Hearing Review was held on 13 January 2011, after which the matter was fixed for hearing on 21 April 2011. Subsequent to this, the Opponents sought leave to adduce further evidence on 17 March 2011. On 1 April 2011, the Opponents' request to file further evidence was granted and costs of \$400 was awarded to the Applicants. Pursuant to this, the Opponents filed further evidence on 7 April 2011. In response, the Applicants sought leave to file evidence in response to the further evidence of the Opponents and requested for a vacation of the original hearing date. The hearing was then re-fixed on 3 June 2011 and then subsequently postponed again to 16 June 2011 pursuant to parties' request. The Applicants' evidence in response to the Opponents' further evidence was filed on 19 May 2011.

### **Grounds of Opposition**

4 The Opponents rely on sections 8(2)(b), 8(4)(b)(i) and (ii), 8(7)(a), 7(4)(b) and 7(6) of the Trade Marks Act (Cap 332, 2005 Rev Ed) ("the Act") as their grounds of opposition.

### **Opponents' Evidence**

5 The Opponents' Statutory Declaration and Opponents' Statutory Declaration in Reply were executed by Michal Dojlidko, the Vice President and Assistant Secretary of Starwood Hotel & Resorts Worldwide, Inc, in New York, the United States of America on 4 August 2009 ("Opponents' 1<sup>st</sup> SD") and 18 December 2010 ("Opponents' SD in Reply") respectively. The Opponents' further evidence was via the Statutory Declaration executed by Kristen Prohl, Assistant Secretary of Starwood Hotel & Resorts Worldwide, Inc, in New York, the United States of America on 5 April 2011 ("Opponents' 2<sup>nd</sup> SD").

## **Applicants' Evidence**

6 The Applicants' Statutory Declaration was executed by their Executive Director and Corporate Counsel, Richard Robert Macfie Doyle, in Singapore on 26 November 2009 ("Applicants' 1<sup>st</sup> SD"). The Applicants' further evidence was via the Applicants' Statutory Declaration executed by the same Richard Robert Macfie Doyle in Sydney, Australia on 29 March 2010 ("Applicants' 2<sup>nd</sup> SD"). The Applicants' evidence in reply to the Opponents' further evidence was via the Applicants' Statutory Declaration which was executed by the same Richard Robert Macfie Doyle in Sydney, Australia on 12 May 2011 (Applicants' 3<sup>rd</sup> SD).

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

7 As referred to above, the applicable law is the Trade Marks Act (Cap 332, 2005 Rev Ed) ("the Act").

8 The undisputed burden of proof in an opposition under the Act falls on the Opponents. The decision below will follow the order of the grounds of opposition in the Opponents' written and oral submissions.

9 There is a preliminary issue with regard to the admissibility and probative value of certain evidence in both the Opponents' SDs and the Applicants' SDs. At the outset of the hearing, it was directed, and the parties were agreeable, that this issue will be dealt with in the course of parties' submission. As such, I will deal with this issue as it crops up in the course of my decision below.

## **Background**

10 The Opponents, Starwood Hotels & Resorts Worldwide, Inc is one the leading hotel and leisure companies in the world with 960 properties in 97 countries and 145,000 employees at its owned and managed properties. The Opponents owned many renowned brands for hotels including, St. Regis, Westin, Le Meridien, Sheraton and some others. The Opponents rely on their 13 earlier registrations, in particular, 4 of their 13 earlier registrations for "ST. REGIS" in T9512252I, T9512253G, T0511703B and T0511704J in Classes 41 (entertainment, casino, theme park services and the like), 42 (hotel, motel, resort, restaurant, bar, cocktail lounge, food and beverage services), 36 (real estate and real estate management and related services) and 37 (building construction services). T9512252I and T9512253G were registered in 1995 and T0511703B and T0511704J were registered in 2005.

11 The Opponents also owned trade mark registrations for "ST. REGIS" throughout the world (about 80 countries), including Australia, New Zealand, Malaysia, US, UK, Hong Kong, some countries in Europe, China and many more. In Singapore, the Opponents' ST REGIS Hotel opened in April 2008 and since then, the gross room revenue has exceeded S\$9 million. The annual worldwide revenue for the ST. REGIS chain of hotels and properties for 2006, 2007 and 2008 is more than USD200,000,000 per year. The Opponents also promote the ST REGIS brand widely and the advertising expenditure for 2006, 2007 and 2008 increases from USD20,000,000 to USD30,000,000. Prior to the official opening of the Opponents' ST REGIS Hotel in Singapore in April 2008, there was a fair degree of media

publicity and media promotion of the Opponents' ST REGIS Hotel from about November 2007.

12 The Applicants are a company incorporated in Australia. The Applicants' trade mark, "PARK REGIS" has been in use uninterrupted for hotels in Australia since 1962. The Applicants have a network of 24 properties in the Asia Pacific region with locations in Australia including Sydney, Melbourne, Brisbane, Cairns, Townsville, Hobart and Launceston as well as properties that were under development as at the time of the filing of the Applicants' 1<sup>st</sup> SD in countries like Singapore, Dubai, Morocco and New Zealand. The Applicants have an expansion plan underway in Australia and throughout Asia Pacific with future plans for European, American and Middle Eastern properties joining the network. The Applicants' first PARK REGIS Hotel opened in Sydney in 1972 and the Applicants have used the trade mark, "PARK REGIS" for their properties in Australia for over 40 years. Thus far and until recently, the Applicants have used "PARK REGIS" primarily for their properties in Australia. The annual expenditure on the brand promotion for "PARK REGIS" for 2006, 2007 and 2008 is USD165,688, USD150,295 and USD118,505 respectively. The annual worldwide revenue for the "PARK REGIS" brand for 2006, 2007 and 2008 is USD3,591,961, USD4,428,290 and USD4,318,173 respectively. The media announcement of the development of the Applicants' PARK REGIS Hotel in Singapore came around October 2007 and there was some media mention of the Applicants' PARK REGIS Hotel in Singapore in October, November and December 2007. From 1 July 2007 to 30 June 2008, 1231 Singaporeans have stayed or dined at the Applicants' PARK REGIS Hotels, mainly in Australia and the revenue from Singapore consumers was USD69,626.30. The Applicants' PARK REGIS Hotel opened in Singapore in the year 2010.

## MAIN DECISION

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

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

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

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

### *Opponents' submissions*

14 The Opponents submit that they have 13 relevant registrations which predate the Applicants' application, in particular, T9512252I, T9512253G, T0511703B and T0511703B are for the mark, "ST. REGIS" in Classes 41, 42, 36 and 37 respectively. The Opponents submit that under this ground of opposition, they are not restricted to the Application Mark in the form in which it is applied for registration. The Opponents' contention is that "Regis" is the dominant feature in the Opponents' mark and that goodwill can subsist in part of a mark, as long as it is the dominant feature of the mark and they cited *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 ("*Amanresorts*") wherein the court held that goodwill exists in the word "Aman" in the appellants' chain of hotels and properties that carry the word "Aman" as part of their name. The Opponents' argument is that the attractive force that attracts custom is in the name, "Regis", the prominent feature of the Opponents' "ST. REGIS" name or sign used in trade by the Opponents. This goodwill can be established

through the Opponents' revenue, third parties' comments on and the Opponents' promotion of the "ST. REGIS" brand. The Opponents submit that goodwill can be found even if only a very small segment of consumers recognise the name and cited *Amanresorts* case as authority for this.

15 The Opponents have 17 properties around the world. The gross room revenue for the "ST. REGIS" property in Singapore alone since it opened is in excess \$9 million and globally, it stands at \$270 million. The Opponents' mark is advertised extensively. The advertising expenses in 2008 and 2009 are in the region of \$28 million. The Opponents' "ST. REGIS" mark is also promoted extensively through the Starwood Preferred Guest Loyalty Programme which has in excess of 600,000 views from Singapore.

16 The Opponents submit that "Regis" not a common English word; it is a word with no meaning. A search on hotels in Singapore found only 2 hotels with the word, "Regis", and they are the Applicants' mark and the Opponents' mark. There is no other property, not even residential properties, which uses the word, "Regis".

17 On misrepresentation, the Opponents argued that what is important is the impression left in the minds of the consumers by the Opponents' sign and similarly, the impression in the minds of the consumers from the Applicants' sign. The Opponents argued that in assessing the question of misrepresentation, I should bear in mind that consumers do not have the luxury of comparing the marks side by side and that I have to allow for imperfect recollection. In this connection, the Opponents argue that, in relation to hotel services, the consumer is not able to look at the mark in his hand. When a customer makes a booking for a hotel room, he is not standing in front of the hotel and he is not able to recognize that there is the colour purple and there is the fleur de lis device in the Application Mark. Thus, the impression that he has in his mind is that the Opponents' mark is "ST. REGIS" and the Applicants' mark is "PARK REGIS". The Opponents submit that there is misrepresentation as both marks will be remembered as the "Regis" mark and consumers will be misled into thinking that they come from the same source.

18 On the fact that the Opponents do not have a registration for Class 35 services, the Opponents argue that for the purpose of passing off, the class distinction is irrelevant. The issue is whether the use of the "PARK REGIS" mark in respect of the services claimed are liable to passing off, looking purposefully at the specifications of services applied for. Further, the Opponents argue that the advertising and business management services applied for in Class 35 must relate to the advertising services for and business management of the PARK REGIS Hotel. Thus, they argue that if I find that use of the "PARK REGIS" name is liable to passing off, the entire application must fail.

19 On misrepresentation, the Opponents also say that it is not necessary to show actual confusion. The Opponents need only to show that there is a real probability of confusion. The Opponents further say that from the Opponents' 2<sup>nd</sup> SD, there is evidence to show that the public would likely think that there is a business connection between the "ST. REGIS" and the "PARK REGIS" property. On the Applicants' objection that this is hearsay evidence, the Opponents' response is that it is not hearsay if the evidence merely shows that certain statements have been made and the evidence is not sought to be admitted to prove the truth of those statements. The Opponents further submit that the finding of confusion is ultimately a finding of fact that I have to make.

20 The Opponents submit that it is clear from case law that parties need not be in direct competition for there to be misrepresentation. Thus, the fact that one is a 5-star hotel and one is a 4-star hotel does not mean that there can be no misrepresentation. The Opponents cited *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 2 SLR 550 ("*Milleniua*") for this principle.

21 On damage, the Opponents submit that a possibility of likelihood of damage is sufficient and damage can be proven by showing that there is a possibility of diversion of sales or tarnishment in the name. The Opponents submit that there is a real possibility that someone looking at the Applicants' "PARK REGIS" services would be mistaken with the Opponents' "ST. REGIS" services for they may be mistaken that that the "PARK REGIS" and "ST. REGIS" services are those of the Opponents but they target different segments just like the Grand Hyatt and Park Hyatt range of hotels which target different segments. The Opponents also submit that it is not uncommon for hotels to use, "park" in their name to signify that they are near a park. Through their search, the Opponents found 9 hotels in Singapore which has the word, "park" in their name. As the word, "park" does not add anything to the dominant feature, "Regis", the Opponents say that there is a risk that the consumers in Singapore would think that there is a connection between the two, resulting in damage to the Opponents.

#### *Applicants' submissions*

22 The Applicants say that their application was filed in 2008. The Opponents' opposition was filed on 8 Sep 2008. Since then, the Applicants have opened their first hotel in Singapore in 2010. Since their opening, the Applicants have been operating their hotel and using the mark, "PARK REGIS". However, no passing off action has been commenced by the Opponents since they became aware of the Applicants' mark in 2008. The Applicants argue that by not taking out any injunction or passing off action against the Applicants, the Opponents' case has been weakened considerably as their case for misrepresentation weakens by the day.

23 On the issue of misrepresentation, the Applicants rely on the case of *Wild Child TM* [1998] RPC 455, which laid down guidelines for finding misrepresentation. The Applicants argue that the Opponents' goodwill, if any, is in the name, "ST. REGIS" as a whole and not on "Regis" alone. They pointed to the evidence of use lodged by the Opponents and stressed that the Opponents have consistently used the name, "ST. REGIS" in full and never "Regis" alone. On the contrary, Applicants have shown evidence that they have used, albeit in relation to their other hotels elsewhere, the word "Regis". For instance, there are references such as, "At the Hotel Regis..", "Hotel San Regis", "Hotel Posada Regis" and "Super 8 St. Regis".

24 The Applicants submit that the reputation that the Opponents rely on which makes them world-renowned is outside Singapore. They point out that the Opponents only started in Singapore in 2008. The Applicants argue that the Opponents are known as "ST. REGIS" and not "Regis" alone. They say that the Opponents have never used "Regis" alone. The Applicants also pointed out that the Opponents began their expansion out of New York only in 1999.

25 The Applicants submit that with regard to the application in relation to Class 35 services, the services are in no way similar to hotel services. The Applicants sought to

distinguish the *Milleniua* case on the basis that the Defendants in that case did not have independent goodwill of their own, unlike in this case where the Applicants have their own goodwill in relation to "PARK REGIS" going back over 40 years worldwide. Just as the Opponents say they have goodwill in Singapore since 2008, the Applicants have goodwill in Singapore too, and this is since 2010. Just as the Opponents say they have an overseas reputation since 1902, the Applicants too have an overseas reputation since at least 1972, when the Applicants' hotel first opened in Sydney or since 1962, when they first used their name. As for the application in relation to class 43 services, the Applicants' contention is that whilst the Opponents are in the luxury hotel business, 5 star or higher, the Applicants provide a 3 or 4 star hotel business. The Opponents' hotels are of such a luxurious level that they have a fleet of customized Bentley limousine to ferry their hotel guests around. On the other hand, the type of customers who frequent the Applicants' 3 or 4 star hotels are used to public transport and they choose the Applicants' hotels as they are conveniently located next to public transport facilities. The Opponents' hotels are so luxurious that they provide a 24hour butler service, whereas the Applicants' guests are very happy to find kitchenette in their hotel. The Applicants contend that with such a big difference in the targeted customer segment, it cannot be argued that the parties are playing in the same field. The Applicants also sought to distinguish this case from *Amanresorts* and they say that in *Amanresorts*, it was established that the Plaintiffs had been using "Aman" as a house mark whereas in this case, the Opponents have not shown any evidence that they have been using "Regis" alone.

26 The Applicants pointed out the differences in the marks in use by both parties. The Applicants say that the Applicants' mark "PARK REGIS" is used with the purple colour combination and the fleur de lis device whereas the Opponents' mark is clearly just the words, "ST. REGIS" and sometimes, used with the device of the letter "R". The Applicants also argued that there is no likelihood of confusion as the Applicants have been using their mark since 1972 and there are many instances which show that the Applicants have been using "PARK REGIS" in the form of a house mark. For example, there are references to Park Regis Singapore, Park Regis City Quays, Park Regis North Quay, Park Regis Piermonde, Park Regis Anchorage, Park Regis Concierge Apartments, Park Regis Griffin Suites, Park Regis Southbank, Leisure Inn Park Regis Hotel Sydney, e.t.c. all of which show that "PARK REGIS" is associated with the Applicants. This is in contrast with the Opponents' use which has been "ST. REGIS" in full and never "Regis" alone. Furthermore, the Applicants and the Opponents have trade mark registrations that co-exist in Australia, Indonesia, United Kingdom and New Zealand.

27 Further, on the question of confusion, the Applicants relied on the statements in Exhibit B of the Applicants' 2<sup>nd</sup> SD which state there was no confusion at all. On these statements, the Opponents have raised the hearsay objection and taken the stand that these statements are not admissible because, firstly, they are hearsay and secondly, the deponent of the Applicants' 2<sup>nd</sup> SD to which the statements are exhibited cannot claim to have direct knowledge of the statements which are neither made by or to the deponent as the statements are addressed to the Registrar of Trade Marks. The Applicants say that the statements are made by senior people in reputable organisations in the industry – such as the Senior Manager of Chan Bros, the General Manager of Dynasty Travel, the Chief Operating Officer and so forth. These statements show the views of these senior people in the industry, that there is no confusion between the Applicants' "PARK REGIS" and the Opponents' "ST. REGIS", and are thus admissible.

28 On the issue of damage, the Applicants argue that as there is no evidence of actual or any likelihood of confusion, the Opponents have failed to show that there is a likelihood of damage.

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

29 The test for passing off is well established and not in dispute between the parties. The Singapore Court of Appeal in *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 (“*Amanresorts*”) (at [36]) applied the trite “classical trinity” test for establishing a case of passing off enunciated in *Reckitt & Colman Products Ltd v Borden Inc* [1990] All ER 873 at page 880 which I will paraphrase as follows:

- (b) First, the Opponents must establish a goodwill attached to the services which the Opponents supply in the mind of the purchasing public by association with the identifying brand name or indicia under which their services are offered to the public, such that the brand name or indicia is recognised by the public as distinctive specifically of the Opponents' services.
- (c) Secondly, the Opponents must demonstrate a misrepresentation by the Applicants to the public (whether or not intentional) leading or likely to lead the public to believe that the services offered by Applicants are those of the Opponents. Whether the public is aware of the Opponents' identity is immaterial, as long as the services are identified with a particular source which is in fact the Opponents.
- (d) Thirdly, the Opponents must demonstrate that the Opponents suffer or that they are likely to suffer damage by reason of the erroneous belief engendered by the Applicants' misrepresentation that the source of the Applicants' services is the same as the source of those offered by the Opponents.

30 In short, the three elements in this classical trinity test are namely, goodwill, misrepresentation and damage. I will now examine whether each of these elements has been satisfied by the Opponents in the present case.

***Goodwill***

31 It is clear that passing off protects the Opponents' business or goodwill and not the mark used to promote the Opponents' business or goodwill (see *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 2 SLR 550 at [45]) (“*Milleniua*”). Thus, it does not matter whether the Opponents have a trade mark registration for their mark, which it is noted, the Opponents have in this case. As stated above, the test for goodwill focuses on the degree of the public's recognition of the Opponents' mark and association of the mark with the Opponents' services.


32 On “goodwill”, the Court of Appeal in *Amanresorts* citing Lord Macnaghten in *The Commissioner of Inland Revenue v Muller & Co's Margarine, Limited* [1901] AC 217, stated this, “*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."* Thus, it is clear that goodwill is the association of a service or business on which the Opponents' mark or brand name has been applied with a particular source (which is in fact the Opponents in this case) and this association is an "attractive force which brings in custom". It is also clear that goodwill has to attach to a business that is within a particular jurisdiction and goodwill is different from reputation per se, as it has been stated by the Privy Council in *Star Industrial Co Ltd v Yap Kwee Kor* [1975-1977] SLR 20, a case on appeal from Singapore, that, "*Goodwill, as the subject of proprietary rights, is incapable of subsisting by itself. It has no independent existence apart from the business to which it is attached. It is local in character and divisible; if the business is carried out in several countries a separate goodwill attaches to it in each.*"

33 The question is whether the Opponents have shown that there is goodwill in the mark or indicia, "ST. REGIS" that is attached to their business in Singapore. A related question is, what is the relevant date to assess the question whether the Opponents have shown there is goodwill in the mark or indicia, "ST. REGIS"? The date would be the date on which the conduct complained of was carried out and that is the act of applying for registration for the



mark  by the Applicants. Thus, as at 3 March 2008, was the goodwill in the name "ST. REGIS" or "REGIS" for that matter associated with the business of the Opponents in Singapore? The Opponents pointed to the fact that the first "ST. REGIS" opened in 1902 in New York and that there are now 17 ST. REGIS properties worldwide. The Opponents also pointed to the fact that internationally, the net revenue earned by the Opponents for bookings in the Opponents' ST. REGIS hotels is in excess of USD\$270million and USD\$280million in 2007 and 2008 respectively. The Opponents also pointed out that the Opponents' hotels marketed under and by reference to the "ST. REGIS" name and trade mark can be found through the Opponents' Starwood Preferred Guest ("SPG") loyalty programme and that the advertising expenses in 2007 and 2008 were in excess of USD\$25million and USD\$30million respectively. On the SPG loyalty programme, the Opponents' evidence is that there are more than 30,000 persons from Singapore who are members of the programme and the Opponents estimated that Singaporeans had spent in excess of USD\$800,000 on room stays at various ST. REGIS properties worldwide. The Opponents also pointed to the fact that more than 690,000 views at the Opponents' [www.stregis.com](http://www.stregis.com) website originating from Singapore in 2008 alone.

34 I can also see from Exhibit D of the Opponents' 1<sup>st</sup> SD that prior to the opening of the ST. REGIS Hotel in Singapore, there was some promotion in various publications such as 'The Economist', 'Forbes Asia', 'Fortune', 'SWA Sembada', 'TTGmice', 'Business Traveller', 'Hong Kong Tatler', 'Lifestyle', 'Prestige', 'Billionaire Asia', 'Hospitality+', 'Affluent', 'Bella', 'Harper's Bazaar', 'CEI', 'Review Asia' and the like as well as advertisements taken out in various local newspapers in the months of November and December 2007. There was also an article titled, "St Regis Hotel to hold job fair for 400 posts" by Lim Wei Chean featured in The Straits Times on 20 August 2007 and various other articles making references to the ST. REGIS' opening in April 2008.

35 However, in my view, the most important piece of evidence is that the Opponents' ST. REGIS Hotel in Singapore opened on 20 April 2008, more than one month after the date of application for registration of the Application Mark. Thus, as at 3 March 2008, the ST. REGIS Hotel had not yet opened in Singapore, although the Hotel had already begun preparation for its opening and there was a fair bit of publicity on the ST. REGIS Hotel in various travel and wealth publications as well as in our local newspapers. Would the evidence looked at in totality be sufficient to establish that the Opponents have goodwill in the name "ST. REGIS" that is attached to the Opponents' business in Singapore as at the date of application for the Application Mark which was 3 March 2008? I think not. This is because, for a passing off action to be made out, the goodwill has to attach to the business in Singapore. I compare the instant case to the 2 recent cases involving goodwill in hotel business, the *Amanresorts* case and the *Millennia* case. I find that the evidence in this case is insufficient to show that the goodwill in the "ST. REGIS" name attaches locally. In the *Amanresorts* case, it was found that the local presence in Singapore was established in 1999, quite some years before the relevant date of 2006 in the case. The other difference is that whilst there was no "Aman" Hotels in Singapore, the headquarters of the business is in Singapore and there are two offices in Singapore and the evidence also shows that the business has an actual customer base here. Thus, in the *Amanresorts* case, Singaporeans who want to book Amanresorts' Hotels overseas will book through the local offices here and they know the Aman name belongs to that business. In the *Millennia* case, it was found that prior to the relevant date in that case which was October 1995, there was widespread media coverage of the opening of the Hotel and there were pre-opening brochures, advertisement and promotion. In addition, tenants for the property had been secured as early as July 1994 and the Hotel had already received bookings in April 1995. Therefore, the local public would associate the goodwill in the *Millennia* name with the business here in Singapore. In the instant case, whilst there was quite a fair bit of publicity in various travel magazines and publications prior to the opening of ST. REGIS Hotel in Singapore, it is not clear as to the extent of the reach achieved amongst the local public and it is also not clear that the goodwill is attached to the business here in Singapore since the Hotel had not yet opened as at the relevant date of 3 March 2008 and there is no evidence that the promotion and marketing was done out of a business located in Singapore. There is also no evidence of bookings for the Hotel prior to its opening. As for the reach achieved through the SPG loyalty programme, I have my doubts as prior to its opening, members of the Singapore public could only make bookings for ST. REGIS Hotels outside of Singapore and it is not clear that the bookings were done through a business carried out in Singapore. It would appear that Singapore consumers need to make direct bookings at the Hotels overseas through such programmes. If so, then there is no business within Singapore to which the goodwill in "ST. REGIS" attaches prior to the opening of the ST. REGIS Hotel in Singapore in April 2008.

36 In summary, unlike the evidence in the *Amanresorts* case and the *Millennia* case, the evidence in this case as to whether the Opponents have goodwill in the name ST. REGIS that is attached to their business here in Singapore as at the date of application for registration of the Application Mark is inconclusive. At this point, I would say again that goodwill is different from reputation. Whilst it is not doubted that the Opponents have a reputation as a luxurious hotel chain as at the date of 3 March 2008, the same cannot be said of the Opponents' goodwill to their business in Singapore. It may be that the goodwill is attached to the Opponents overseas but unfortunately, there is no goodwill here in Singapore because as at that date, there is no Hotel ST REGIS in Singapore. As the Opponents have the burden of proof, the Opponents therefore have not discharged their burden of proof with regard to this first element of goodwill.

37 Before leaving this issue of goodwill, I would like to elaborate on the date for assessing goodwill which I have said to be the date of the application for the registration of the Application Mark (the conduct complained of) and not a later date. Section 8(7)(a) uses the words, "its use in Singapore *is liable to be prevented* by....the law of passing off". As trade mark applications can be made on the basis of intention to use, when assessing passing off, we are looking at possibly the future use of the trade mark applied for to see if such future use is liable to be prevented by the law of passing off. Thus, at the point of filing their application for the registration of their trade marks, applicants should not be subject to the risk of future goodwill in similar trade marks of other traders that is acquired through use after the date of their application. Further, passing off protects unregistered trade marks or signs used in the course of trade. Thus, persons seeking monopoly through registrations should not be subject to the rights of other traders in relation to unregistered trade marks or signs in which the goodwill attaches after the date of application. Thus, in this case, it is irrelevant that the Opponents have admittedly accumulated a fair amount of goodwill to their business through the name "ST. REGIS" after their opening since this goodwill attaches after the date of application.

#### *Misrepresentation*

38 On this element, the Opponents' case is that the Applicants' application for the mark, "PARK REGIS" constituted a misrepresentation that the Applicants' services are rendered from the same source as the Opponents' ST REGIS Hotel or that the two are somehow connected. It is clear from the *Amanresorts* case (see [73]) that in assessing whether there is misrepresentation, the assessment is to be done from the perspective of the actual or potential customers of the Opponents. That is, the question to ask is, would those in Singapore with goodwill towards the ST REGIS Hotel believe that a PARK REGIS Hotel emanates from the same source as the ST REGIS Hotel or that the PARK REGIS Hotel is somehow connected with the source of the ST REGIS Hotel? And this question has to be assessed as at the relevant date of 3 March 2008. As I have already made a finding that as at the relevant date of 3 March 2008, the Opponents did not yet have sufficient goodwill attached to their business in Singapore, a fortiori, there would be no misrepresentation since there is insufficient evidence that those in Singapore have goodwill towards the ST REGIS Hotel.

#### *Damage*

39 On the element of damage, the Opponents must show that, as a result of the Applicants' misrepresentation, there is either actual damage or a likelihood of damage. On this element, a clear analogy can be drawn from the *Millennia* case. In that case, the plaintiff had promoted its Ritz-Carlton Millennia as a super-deluxe hotel. It was held that this exclusive and prestigious image would be undermined when the public associated Ritz-Carlton Millennia as one of the defendant's 4-star hotels and began to question the quality of the plaintiff's product. The Court of Appeal recognised that the name Ritz-Carlton Millennia could over time degenerate into nothing more than a name for a 4-star hotel with the result that the plaintiff would no longer be able to command a premium for its product. The same scenario can happen in this case. Thus, it is clear that there would be damage if the Opponents could prove that they have sufficient goodwill attached to their business in Singapore and there was misrepresentation, which is not the case here.

## *Conclusion*

40 As the Opponents have failed to discharge their burden of proof that the Singapore public has goodwill to the ST.REGIS Hotel that attaches to the Opponents' business here in Singapore, the ground of opposition under passing off fails.

### **Ground of Opposition under section 8(2)(b)**

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

#### **“Relative grounds for refusal of registration**

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

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public.”

#### ***Opponents' submissions***

41 The Opponents submit that they have 13 relevant registrations which predate the Applicants' application, in particular, T9512252I, T9512253G, T0511703B and T0511703B for the mark, "ST. REGIS" in Classes 41, 42, 36 and 37 respectively.

42 The Opponents submit that from the case of *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 ("*Festina*"), it is clear that the Applicants' mark will not be remembered as the "PARK REGIS" mark in the colour purple with the fleur de lis device. The Opponents say that the Applicants' mark will be referred to as the "PARK REGIS" mark and conceptually, what would remain in the minds of consumers is the "Regis" portion. Further, the use of purple is irrelevant as the application is for a series of marks which includes the mark in black and white which would confer protection on the Applicants' mark in any colour combination. The Opponents point to the Applicants' evidence and argue that the evidence does not show that the Applicants' mark is always used in purple and with the fleur de lis device. The Opponents rely on the case of *Spa Espirit Pte Ltd v Esprit International* [2005] SGIPOS 2 ("*Spa Espirit*") for the principle that adding matter to the distinctive portion of a mark does not render the two marks dissimilar. The Opponents' contention is that in this case, the distinctive portion is "Regis" and this is identical in both marks. The Opponents' case is that the addition of "Park" does not make the Applicants' mark dissimilar to the Opponents'.

43 The Opponents argue that there is no co-existence of marks that contain "Regis" in Class 43 in Singapore. The Opponents explain that the co-existence of registrations in Australia is unique to the circumstances in Australia as the Opponents do not have intentions to set up operations there. This is unlike the situation in Singapore where the Opponents have the ST. REGIS Hotel and the Opponents own registrations in Singapore. They argue that the co-existence of registrations elsewhere should not be taken to support the co-existence of the marks on the register in Singapore.

44 On similarity of services, the Opponents argue that there is also similarity in the Class 35 services and urge the Registrar to compare the services purposively and to consider that the services are likely to be used in relation to the Park Regis Hotel and are likely to be used to promote the hotel services. The Opponents urge that having regard to how the services are likely to be used, the Class 35 are also similar to the services covered by the Opponents' earlier "ST. REGIS" marks for hotel services. The Opponents submit that there is thus a real likelihood of confusion.

45 Further, the Opponents argue that as the date for the assessment of likelihood of confusion is the date the registration is sought, certain facts that have occurred since the date of application are to be taken into consideration and they all point to a likelihood of confusion. Such relevant facts include the fact that the Opponents have already opened in Singapore one month after the date of the application, the fact that the Opponents have generated a lot of revenue and goodwill in the name in Singapore and that, by virtue of such promotion and use of the "ST. REGIS" name in Singapore, "ST. REGIS" has become distinctive of the Opponents. The Opponents also argue that as "Regis" is not a common name and is highly distinctive, there is an increased chance of confusion.

### ***Applicants' submissions***

46 The Applicants submit that "Regis" is not inherently distinctive as it is a word with a few meanings. It is a surname and at the same time, it is also a common name. The Applicants point to their evidence showing an entry from Wikipedia which shows that there was a gentleman by the name of John Francis Regis who was beautified and conferred sainthood on 18 May 1716 and was thereafter known as "St. Regis". The Applicants thus say that even "St. Regis" is not unique to the Opponents, let alone "Regis" on its own.

47 Comparing the marks, the Applicants submit that visually, the marks are different as the Applicants' mark combines "Regis" with "Park" and a fleur de lis device. The word "Park" is in the same font and size as the word "Regis" and the device is also of the same size in the mark. The Applicants submit that all three elements have to be viewed as a whole in the Application Mark and the Application Mark and the Opponents' mark are therefore visually dissimilar. As to aural similarity, the Applicants submit that "Park Regis" is distinguishable from "Saint Regis". As to conceptual similarity, the Applicants' case is that, when one sees the mark, "ST. REGIS" one would think of the saint with the name Regis, especially in light of the fact that there is actually a person by the name Regis who was conferred sainthood in 1716, whereas when one looks at the mark Park Regis, no saint comes to mind. The idea or the concept that comes to mind is that of a park. The Applicants also say that the first syllable in a mark plays a predominant role in a mark. The Applicants therefore submit that the marks are very different.

48 On the comparison of the services, the Applicants submit that business management services are very different from hotel services. The Applicants therefore submit that because the Opponents' mark and the Application Mark are different and because the services are also different insofar as the Class 35 services are concerned, there is no likelihood of confusion.

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

#### ***Criteria under Section 8(2)(b)***

49 An “earlier trade mark” is defined in Section 2 as follows:

“*earlier trade mark*” means –

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

50 The Opponents have a few earlier trade marks, in particular, T9512252I, T9512253G, T0511703B and T0511704J are all registrations for "ST. REGIS" in Classes 41, 42, 36 and 37 respectively and these registrations were obtained in 1995 (Classes 41 and 42) and 2005 (Classes 36 and 37) (these will collectively be referred to as "the Opponents' registrations") respectively. These earlier registrations belonging to the Opponents definitely qualify as “earlier trade marks” within the definition of Section 2.

51 As for the requirements under section 8(2)(b), the test is that as enunciated by the Court of Appeal in the *The Polo/Lauren Co, LP v Shop-In Department Store Pte Ltd* [2006] 2 SLR(R) 690 ("*Polo/Lauren*") ([8]-[9]) for section 27(2)(b) of the Act (the requirements for infringement under section 27(2)(b) are the same as those under the relative grounds for refusal or registration in section 8(2)(b) (see also [15] of the *Polo/Lauren*)). The Court of Appeal adopted the test in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 ("*British Sugar*") and held that the following conditions must be present. First, the Application Mark, “PARK REGIS" must be shown to be similar to the Opponents' earlier registrations for "ST. REGIS". Second, the Application Mark and Opponents' mark must be used in relation to similar services. Third, on account of the presence of the first two conditions, there exists a likelihood of confusion on the part of the public. On the question of similarity, it is a matter of degree. The greater the similarity between the two marks, the greater the likelihood of confusion will be. However, 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. The Court of Appeal also said at [25]-[26] that it does not necessarily follow that just because the marks are similar and the goods or services are similar, confusion will automatically arise. In assessing the question of likelihood of confusion, regard must be had to extraneous factors such as trade practices. At [28], the Court of Appeal also pointed out other important factors such as steps taken by the *Applicants* to differentiate their services from those of the *Opponents* and the kind of customer who would be likely to use the services of the *Applicants* and *Opponents* also has to be taken into consideration in assessing whether there is a likelihood of confusion.

52 On similarity between the marks, the comparison is as to their visual, aural and conceptual similarities. The test to see if the services are similar is that as held in *British Sugar* ([296]) which has been followed in all our local cases. The following are factors that are relevant for this instant case and may be used to assess if the services are similar:-

- (a) the nature of the services;
- (b) the end users of the services;
- (c) the way in which the services are used; and
- (d) whether the respective services are competitive or complementary, and the trade channels through which the services reach the market;


53 I will now proceed to make a comparison of the visual, aural and conceptual similarities of the Application Mark and the Opponents' mark in T9512252I, T9512253G,

T0511703B and T0511704J (the other registrations of the Opponents are disregarded as they do not relate to the "ST. REGIS" mark).

### *Visual Similarity*

54 Visually, both marks contain the word, "REGIS". On the one hand, the Application



Mark  contains, in addition to the words, "PARK REGIS", a fleur-de-lis device (which the Applicants claimed is a stylised design of either a lily or an iris) at the left hand side next to the words, "PARK REGIS". The Application Mark is also a series of two marks, with the colour combination of the mark in a striking purple, black and white colour combination. On the other hand, the Opponents' "ST. REGIS" registrations are all word marks, containing the words, "ST. REGIS". Visually, other than the word, "REGIS", both the Application Mark and the Opponents' mark are quite different as the Application Mark contains visual elements such as the fleur-de-lis device and the coloured version of the Application Mark also contains colours as distinguishing features. Based on a visual comparison of the Application Mark and the Opponents' mark, there are some differences.

### *Aural Similarity*

55 Aurally, both the Application Mark and the Opponents' mark will be referred to as the "PARK REGIS" and "ST. REGIS" marks respectively. In both marks, "REGIS" would be aurally prominent. I note the observation of the learned Justice Tay Yong Kwang in *Festina* that even where the pictorial device forms the dominant element of a trade mark, it would be extremely rare for a customer to describe the product by its pictorial element because the description of say, the crest in *Festina*, is a much more difficult task, given its intricacy, as compared to the relatively easy articulation of the word element/brand name. Thus, the aural similarity, if any, between the Application Mark the Opponents' mark would militate against the visual dissimilarity, just as is the case in *Festina*. In *Festina*, the learned judge had to compare between the Opponents' "FESTINA" mark with the device of a coat of arms and crest and the Applicants' "J.ESTINA" mark with a small crown device above the word. In this case, the comparison I have to make is between the Opponents' "ST. REGIS" mark and the Application Mark, "PARK REGIS". As stated by Justice Tay Yong Kwang, although there is some degree of visual dissimilarity due mainly to the fact that the Application mark has a fleur-de-lis device, as it is extremely rare for a customer to describe the Applicants' hotel services by its pictorial element, the Application Mark will be described as the "PARK REGIS" hotel or the "Regis" hotel since "Regis" is the prominent component of the Application Mark aurally. Further, in the Application Mark, the other word, "PARK" is not very distinctive in relation to hotels. There are hotels with the word, "park", for example, the "Park Royal" hotel. The Opponents have also submitted a printout from the Hotels Licensing Board of Singapore showing that there are at least 9 hotels in Singapore with the word, "park" somewhere in their name. To my knowledge, the word "ST" (short for "Saint") is also used in the names of places, for example, "St. James Power Station". As both words, "park" and "saint" are used in the names of places, what strikes one when one considers both "PARK REGIS" and "ST. REGIS" is the "Regis" component. Thus, both the Application Mark and the Opponents' mark will be remembered as the "Regis" hotel aurally. Thus, although "PARK" in the Application Mark and "Saint" in the Opponents' mark are distinct words that

sound different aurally, the Application Mark and the Opponents' mark are on the whole, aurally similar.

### *Conceptual Similarity*

56 Conceptually, the marks both have the same name, that is, "Regis". The Applicants argue that the mark, "ST. REGIS" connote a person, specifically, a saint by the name of Regis but that the mark, "PARK REGIS" connote a place, more specifically, a place near a park. I disagree. It is not uncommon to think of a place with the word "Saint" in its name. One example is the "St. James Power Station". Of course, there are many examples of places connected with the Catholic community with the word, "Saint" in their names. Thus, I do not think that one thinks of a person when one hears "ST. REGIS" and one thinks of a place when one hears "PARK REGIS". I disagree that the Application Mark and the Opponents' mark are conceptually different. I think what strikes one when one hears the two names is the name or indicia "Regis" which is not a common name. Thus, as both the Application Mark and the Opponents' mark carry the same name, they are conceptually similar.

### *Comparison of the marks on the whole*

57 When comparing marks, the High Court in *Caterpillar Inc v Ong Eng Peng* ("*Caterpillar*") [2006 2 SLR 669 at [55] laid down the clear principle that marks must be compared as wholes and there should not be nitpicking for similarities in individual parts of the mark.

58 As stated by the learned judge in *Festina*, when describing a mark aurally, it is extremely rare for a customer to describe a mark by its pictorial elements if there are words in the mark. A mark is usually remembered by its words as there is a tendency for consumers to verbalise a trade mark rather than refer to visual elements in a mark. Thus, the differentiating visual elements in the Application Mark will not add much weight to differentiate the marks.

59 Further, when comparing marks, consumers do not have the luxury of comparing marks side by side. As stated by the High Court in *Johnson & Johnson v Uni-Charm Kabushiki Kaisha* [2007] 1 SLR 1082 at [10]-[11], the doctrine of "imperfect recollection" applies when comparing marks. It must be noted that consumers will not remember the finer details of a mark. What consumers will remember are the distinctive elements, the striking features. In this case, as the name, "Regis" is the prominent and distinctive feature in both the Application Mark and the Opponents' mark, consumers will remember both the Application Mark and the Opponents' mark as the "Regis" marks.

60 Bearing in mind the above principles, I find that the Application Mark and the Opponents' mark are on the whole similar.

### *Comparison of the services*

61 The test is as I have stated above. The Application Mark is for 2 classes of services. The Class 35 services relate generally to advertising, business management and administration of the business affairs of retail stores services. The Class 43 relate generally to hotel services, services related to the provision of facilities for conferences and restaurant services (these services were previously classified under Class 42). The Opponents' registration in T9512253G, obtained in 1995, relate to hotel and restaurant services. There are



overlapping services between the Class 43 of the Applicants' application and the Class 42 services of the Opponents' earlier registration in T9512253G. It is also clear that there is similarity between the services for the Applicants' application in Class 43 and the Opponents' earlier registration in T9512253G when comparing the services in terms of the nature of the services and taking into account that both the Applicants and the Opponents are in the same hotel industry. Thus, insofar as the services claimed by the Applicants in Class 43 are concerned, the Application Mark is sought to be registered in respect of similar services for which the Opponents' "ST. REGIS" trade mark has been registered, particularly, in T9512253G.

62 As for the services claimed in Class 35, it is first noted that the Opponents do not have a Class 35 registration. The Opponents' other registrations, in particular, TT9512252I, T0511703B, T0511704J are in Class 41 (entertainment, casino and gaming and amusement and theme park services), Class 36 (generally real estate and real estate management services) and Class 37 (building construction services). Comparing the services registered by the Opponents in TT9512252I, T0511703B, T0511704J by their nature, end users and industry with the services claimed by the Applicants in Class 35, it can hardly be said that the services are similar.

63 However, comparing the Class 35 services claimed by the Applicants and the Opponents' registered services in T9512253G, I am of the view that there are some similarities. It is likely that in claiming registration for the services in Class 35, the intention of the Applicants is to go into a business complementary to their hotel services. Thus, the business management services and administration of the business affairs of retail stores services are likely related to the services in relation to the Applicants' hotel business such as the running of a business centre within the hotel premises for their hotel users and the running of retail stores within their hotel premises, for example. It is quite common for traders in the hotel industry to render business management and corporate secretariat services for their hotel guests and for their customers who use their hotel premises for the hosting of events and conferences. Thus, there is an overlap between hotel services and such services in Class 35. The trade channels and the users are similar. As for advertising services, it is likely that the advertising services relate to the promotion of their hotels' business or the businesses within their hotel premises. In light of this and judging by the fact that such Class 35 services are likely to be intricately tied to the hotel services of the Applicants, and taking into account the fact that the nature of such services are similar and that such services compete within the hotel industry, I find that Class 35 services claimed by the Applicants and the Opponents' registered services in T9512253G are also similar.

64 Having assessed that the Application Mark and the Opponents' mark are aurally, conceptually and on the whole similar and that the services claimed in Class 43 and 35 are similar to the Opponents' registered services in T9512253G, I will now move on to examine whether there is a likelihood of confusion in the circumstances, applying the test as laid down by our High Court in *The Polo/Lauren Co, LP v Shop in Department Store Pte Ltd* [2006] 2 SLR® 690; [2006] SGCA 14 ("*Polo/Lauren*"). Simply put, the test requires me to look at the issue of likelihood of confusion globally, taking into account all the circumstances including the closeness of the services, the impression given by the marks, the possibility of imperfect recollection and the risk that the public might believe that the services come from the same source or economically-linked sources and other extraneous factors to the extent that they are relevant.

### *Likelihood of Confusion*

65 As a starting point, it is pertinent to note that the Court of Appeal in *Campomar SL v Nike International Ltd* [2011] SGCA 6 ("*Nike*") has made it clear that the Registrar, in considering an application to register a mark in the face of an opposition, is entitled to take into account all the circumstances prevailing on the day of hearing instead of viewing it as on the date of the application. As the *Nike* case was in relation to an earlier registration, I am of the view that this principle applies only in the context of an earlier registration. That is, in relation to an opposition based on an earlier registration, the Registrar should consider all the circumstances prevailing as at the day of hearing, including matters that have arisen after the date of application. I do not, however, think that this principle applies in relation to unregistered marks. For example, if the opposition is in relation to passing off by virtue of an earlier right in an unregistered mark, the date of assessment should remain as the date of application for the reasons I have alluded to above.

66 In the context of this case, on the question of the likelihood of confusion, since this is based on the Opponents' earlier registrations, I am entitled to look at circumstances that have arisen after the application date. I am also to look at the question of likelihood of confusion from the perspective of the relevant sector of the public. In this case, the relevant sector of the public would be tourists and the general Singapore public.

67 On this question of likelihood of confusion, it is also clear that evidence of actual confusion is not required: it is sufficient to infer a likelihood of confusion from the surrounding facts (see *Amanresorts* case at [77]). To show confusion, the Opponents have pointed to Exhibit A of the Opponents' 2<sup>nd</sup> SD (page 5) which is an article featured in the Weekly News section of the Travel Trade Weekly publication of 4 December 2010 wherein there was some reference to the Applicants' expansion plans across the world, including the Middle East and North Asia. Somewhere in the first paragraph of the said article, it was said, "*It has also opened a St Regis property in Singapore and has further plans in place in Europe, New Zealand, the US, Asia and the Middle East*" (emphasis mine). The Applicants tried to dismiss this piece of evidence by saying that this evidence shows sloppy reporting. In my opinion, at face value, the evidence points to one instance of confusion. At face value, the reporter had confused the Opponents' ST REGIS as emanating from the Applicants. This piece of evidence points to a case of inverse passing off; where the confusion is not that the Applicants' services are mistaken to emanate from the Opponents but that the Opponents' services are those of the Applicants. This piece of evidence shows that as late as 4 December 2010, there is this instance of mistaken association by this reporter. Given that this publication may be read by other consumers, this instance of mistaken association could have led or at least, potentially lead to more readers or consumers being misled.

68 There is another piece of evidence which has been submitted by the Opponents – Exhibit A of the Opponents' 2<sup>nd</sup> SD (page 8) where in a travel review website, "booking.com", there were the alleged comments from one "young couple from Kuala Lumpur, Malaysia". In commenting about the services of Sydney Park Regis, the comments alluded to this opinion, "*The standard is so well below that of St Regis*". The Applicants took issue with this piece of evidence as hearsay evidence and cited a statement that I made in *Singapore Street Festival Ltd v Tan Yueh Han Trading As Scc Square* [2007] SGIPOS 7

("Cosplay") in which I said that evidence through statements made by persons in online blogs of individuals are to be disregarded as they are firstly, hearsay evidence and inadmissible and secondly, it is hard to prove who made those statements and therefore, such evidence is clearly unreliable. In this case, this piece of evidence that I have just alluded to consists of comments from an unidentified couple on an online booking website. It is clear that if the evidence of statements is sought to be admitted to establish the truth of the statements, the introduction of such evidence would offend the hearsay rule and such evidence would then be inadmissible (see a previous decision made by this tribunal in *JM Collective Pte Ltd v Perlini's Pte Ltd* [2005] SGIPOS 4 at [28]-[30] ("*Perlini's*"). It will be different if the evidence was adduced to show the fact that certain statement was made by an unidentified person on a particular date. In such a case, such evidence would not constitute hearsay evidence and thus, would be admissible. In this case, it is arguable that this piece of evidence points to the fact that a certain statement was made and if that fact is a relevant fact, then such a statement would be admissible to show that fact. I would say that the fact that such a statement was made points to the fact of an instance of possible confusion between the PARK REGIS Hotel and the ST. REGIS Hotel and that fact is a relevant fact. Thus, the evidence is not hearsay and not inadmissible. Even so, I will not put much weight, if at all, on this piece of evidence as it is from an unidentifiable source and the nature of such internet entries is that it makes such evidence, even if admissible, not very reliable.

69 On the question of whether there is a likelihood of confusion, the Applicants have countered by lodging their evidence in the form of statements from 6 different persons attesting to the fact that there is no confusion in the market place in respect of the Application Mark and the Opponents' mark. These statements were in the letters exhibited in Exhibit B of the Applicants' 2<sup>nd</sup> SD. The Opponents objected to the evidence, saying that none of the persons who wrote the letters have made a statutory declaration to attest to the matters stated in the letters; that the letters are addressed to the Registrar of Trade Marks and as the letters came from persons other than the deponent of the statutory declaration in which the letters are annexed, the letters neither originate from the deponent or are received by the deponent and as such, the letters contain matters which the deponent has no direct knowledge of or which he cannot prove of his own knowledge.

70 In my view, as the writers of the statements in the letters did not make those statements under oath, it is clear the statements are hearsay evidence. The hearsay rule clearly differentiates between evidence which is sought to be admitted to prove the truth of what was said and evidence which is sought to be admitted to prove the fact that such statements were made. In this case, what the Applicants sought to admit was the statement that there was no confusion in the market place and it is clear that what was sought to be admitted was the truth of this – that is, whether there was, in the view of the writers, indeed no confusion in the market place. The evidence is clearly hearsay evidence and is inadmissible.

71 In any event, whether there is confusion in the market is largely a question of fact and it is "a matter of impression for the judge, and it is not a matter for the witness" (see *Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd* [1991] SLR 133, at 142). On this note, I will move on to assess the question of likelihood of confusion independent of the evidence submitted by both the Opponents and the Applicants.

72 It has already been noted that the common and dominant feature in both the Application Mark and the Opponents' mark is the word, "Regis" which is a name. From Exhibit M of the Applicants' 1<sup>st</sup> SD, it can be seen that "REGIS" is used in various ways,

from the name of a male, to the name of a place and educational institutions and so forth. The Applicants suggested that the "ST. REGIS" refers to Saint John Francis Regis who is considered one of the greatest saints in the world. From this, the Applicants' contention is that "Regis" is a common word and the Opponents cannot have monopoly rights over the same. On this point as to whether monopoly over "Regis" can be conferred on any one trader, it is clear that the fact that "Regis" is a name, even if it is a common name, does not hold relevance for there are many traders who have been conferred monopoly over names or even rather common names, for example, "Tiffany". Whilst "Regis" is a name, I do not agree that it is such a common name that there will be no or little likelihood of confusion between two marks with the name "Regis" by reason that the relevant sector would turn to other distinguishing features in the marks and know that they are two different marks. As I have said above, the respective preceding feature in both the Application Mark and the Opponents' mark, namely "ST." (for the word, "Saint") and "PARK", does not serve to differentiate the two marks. This is because it is not uncommon for the word, "Saint" or "St (short for "saint")" to be used as place names. Thus, when the word, "Saint" is used in connection or is associated with a place, the focus will not be on "Saint", but on the distinguishing name, be it "Regis", or "James", "Joseph" and so forth. Thus, it is fair to say that "ST REGIS" will be remembered as "Regis". Similarly, as the word, "park" is also not distinctive in relation to the name of a place, it is also fair to say that "PARK REGIS" will be remembered by its distinctive name, "Regis".

73 Then, both the Applicants and the Opponents are in the same industry. The Applicants argue that the Opponents and the Applicants target different segments of the market. They argue that those looking to be served with a 24 hour butler service and ferried around in the Opponents' suite of luxurious "Bentley" limousines would not be confused by the Applicants' "PARK REGIS" hotels which are marketed for their convenient locations (such as near tube stations) and often come with cooking facilities like kitchenettes. In the case of *Millenia*, the parties also targeted different segments – 6-star luxurious hotel as opposed to 4-star tourist class hotel. Yet, the Court of Appeal found that there was a risk that the public may perceive that the Ritz Carlton Millenia Singapore, Millenia Tower and Millenia Walk are associated with or related to the Millennium hotels which were of a lower class than Ritz Carlton Millenia Singapore. Indeed in *Amanusa*, notwithstanding that the target market segments were totally different – one running a chain of exclusive, luxurious hotels and the other a residential property development in suburban Singapore, the Court of Appeal found that there existed a likelihood that the public would think that the properties come from the same source or economically linked sources. In light of these two cases, I find that the fact that the Applicants and Opponents may be targeting different market segments presently does not negate the likelihood of confusion at all. There is a real likelihood that the public may be mistaken that the two hotels or hotels services are for different classes of tourists but they come from the same source.

74 To sum up, on the ground of opposition under section 8(2)(b), the Application Mark and the Opponents' mark are on the whole similar and the services of the Applicants and Opponents are similar, and further taking into account all the relevant surrounding circumstances, there is a real likelihood of confusion amongst the public as to the source of the Applicants' services if the Application Mark is allowed to proceed to registration.

75 Accordingly, the opposition under section 8(2)(b) is successful.

## Ground of Opposition under Section 8(4)

76 Section 8(4)(a) of the Act reads:

### “Relative grounds for refusal of registration

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."

### *Opponents' submissions*

77 The Opponents assert that similar to the finding in *Amanresorts*, it is clear that I must find the "ST. REGIS" mark of the Opponents to be well known in Singapore. The Opponents rely on their evidence on the revenue of the Opponents, reach of their SPG Programme, presence of the Opponents in many other countries, the many jurisdictions in which the Opponents have registrations for their "ST. REGIS" mark and so forth to support their case that the "ST. REGIS" mark is well known in Singapore.

78 The Opponents say that there is a risk that the public might think that the "PARK REGIS" Hotel is part of the Opponents' group of hotels; that "PARK REGIS" is a "ST. REGIS" Hotel in a different market; or that "PARK REGIS" is a "ST. REGIS" Hotel located near a park. The Opponents also pointed to various evidence such as printouts from the Internet that show that there is a perception amongst the public that there is a connection between the two parties and by virtue of that, there is a likelihood that the interests of the Opponents would be damaged.

79 The Opponents submit that there would be dilution of the "ST. REGIS" mark in this case, just like in the case of *Millenia* because consumers may be mistaken that "PARK REGIS" is a "ST. REGIS" targeted at a different market. For the Class 35 services, the Opponents' case is that the public might think that the Opponents could have licensed their 3 or 4 star hotel or entered into hotel administration services and thus, the fact that the parties are not in direct competition does not mean that there is no dilution. The Opponents cited *Amanresorts* and said that in that case, dilution was found even though the Aman name was used in connection with residential property because the court found that due to a trend of licensing of name for use in residential properties, loss of this licensing opportunity can cause dilution of the Aman name. The Opponents thus say that the use of the "Park Regis" name would deny the Opponents the opportunity to use the name "Regis" for a chain of hotels targeted at a different segment. Thus, the loss of such licensing revenue or opportunities can cause dilution to the "ST. REGIS" name.

### ***Applicants' submissions***

80 The Applicants' case is that this ground of opposition must fail since the marks are not similar. The Applicants further submit that there is no evidence to show that the Opponents are well-known for the mark "Regis". The Applicants stressed that the Opponents must show as at the date of the decision, the mark "Regis" not the mark "ST. REGIS" is well known to the relevant sector of the public which will cover actual consumers and potential consumer of the type of services which the Opponents supply. The Applicants say that the Opponents have not shown any evidence that they are well known for the name "Regis". The Opponents have always used their mark as "ST. REGIS".

81 The Applicants sought to distinguish the *Clinique Laboratories, LLC v Clinique Suisse Pte Ltd and another* [2010] SGHC 189 ("*Clinique Suisse*") by pointing out that unlike in that case where the Plaintiffs were known for the mark, "Clinique" and the addition of "Suisse" made no difference, here the Opponents are not known as "Regis" and the marks are visually and aurally dissimilar. On the issue of confusing connection, the Applicants reiterated the fact that the Applicants have been using their mark since 1972 and Opponents have been using their mark since 1902, albeit overseas and that there is no evidence of confusion after such long co-existence and usage by both parties.

82 On dilution, the Applicants say that the Opponents have not even shown that their mark is well known in Singapore, let alone that their mark is well known to the public at large. Further, the Applicants could not be said to have used the mark in an unfair manner or to have taken advantage of the Opponents' mark since they have been using their own mark since 1972. The Applicants say that they are not trying to take a free ride on the coat tails of the Opponents and they are merely seeking to continue the use of their own name.

### ***Decision on section 8(4)***

83 First, the whole or an essential part of the Application Mark has to be identical with or similar to the Opponents' mark, "ST. REGIS" (Opponents' earlier trade mark). On this requirement, I have already found above that the Application Mark is on the whole, similar to the Opponents' mark under section 8(2)(b). The essential part of the Application Mark is the word, "Regis". The word "Regis" is identical to the word, "Regis" in the Opponents' "ST REGIS" mark. As stated by the Court of Appeal in *Amanresorts* ([229]), "*In recognition of the fact that many trade marks are potentially 'well known in Singapore', Parliament has granted such trade marks only one advantage over ordinary trade marks, namely, the former are protected from registration and/or the use of identical or similar trade marks on dissimilar goods or services – such protection takes the form of protection covered by the 'damaging connection' condition in s 8(4)(b)(i) and s 55(3)(a) of the current TMA*", Section 8(4)(a) and (b)(i) is applicable where the marks are either identical or similar but in relation to dissimilar goods or services. In this case, the essential part of the Application Mark is similar to the Opponents' mark, "ST. REGIS". I have also found that the services are similar. Supposing I am wrong on this, especially between the services of the Application Mark in Class 35 and the services of the Opponents' earlier marks in T0511703B, T0511704J, T9512252I and T9512253G in Classes 36, 37, 41 and 42, then whether the Opponents' mark, "ST. REGIS" is well known in Singapore can become very material because, if the

Opponents' mark is well known in Singapore and deserve well known mark protection, the Application Mark cannot be registered even if the services in Class 35 are not similar to the Opponents' services in the hotel industry.

*Are the Opponents' "ST REGIS" marks well known in Singapore?*

84 Section 8(5) provides, "A trade mark shall not be refused registration by virtue of subsection (4) if the application for the registration of the trade mark was filed before the earlier trade mark became well known in Singapore, unless it is shown that the application was made in bad faith." From this provision, it is clear to me that I have to assess whether the Opponents' "ST. REGIS" mark was well known in Singapore as at the date of the application, that is, 3 March 2008 as section 8(4) only blocks registration of a trade mark vis-a-vis an earlier trade mark that is already well known in Singapore at the time of the filing of the said trade mark.

85 In assessing whether a trade mark is "well known in Singapore", the matters in section 2(7) may be relevant. Section 2(7) 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.

86 It is clear that the factors listed in section 2(7) above are not an exhaustive list as section 2(7) makes it explicit that it shall be relevant to "take into account ***any*** matter from which it may be inferred that the trade mark is well known". The Court of Appeal in ***Amanresort*** at [137] said that the court is ordinarily free to disregard any or all of the factors listed in section 2(7) as the case requires (subject to one particular factor which will be elaborated on later), and to take additional factors into consideration. Thus, it is clear that the factors in section 2(7) (with the exception of the factor in section 2(7)(a) which has a deeming effect in section 2(8)) are merely a set of guidelines to assist the Registrar in determining whether the mark is a well known trade mark. Section 2(7)(a), however, has a special effect. This is because of section 2(8) which states that, "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." Thus, if the Opponents' "ST. REGIS" mark is well known to the relevant sector of the public in Singapore, the Opponents' "ST. REGIS" mark shall then be deemed to be well known in Singapore.

87 It shall first be considered as to the “degree to which [the Opponents’ mark] is known to or recognised by any relevant sector of the public in Singapore”. As stated above and in *Amanresorts* ([140]), once it is determined that the trade mark in question *is well known to “any relevant sector of the public in Singapore”* (emphasis mine), the deeming provision in section 2(8) kicks in and *the mark is deemed to be well known in Singapore*. In section 2(9), “relevant sector of the public in Singapore” in section 2(7) and 2(8) includes any of the following:

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

As for the ambit of “all actual consumers and potential consumers in Singapore of the goods”, the *Amanresorts* has settled this issue as “the actual consumers and potential consumers of, specifically, the [*Opponents’*] services only (([142] to [154]), specifically, [154]). Applying the law to the facts of this case, the relevant sector of the public would be actual and potential consumers in Singapore of the Opponents’ services, that is, consumers who will stay in exquisite five-star hotels such as the “ST. REGIS”. The question is, is “ST REGIS” well known to this “relevant sector of the public”? And the relevant point in time to determine this question is 3 March 2008. The Opponents' evidence shows that the Opponents' ST. REGIS Hotel opened in Singapore on 20 April 2008. Prior to this, the first ST. REGIS Hotel opened in New York in 1902 and todate, the Opponents operate 17 ST. REGIS properties worldwide. The Opponents' evidence shows that the Opponents' ST. REGIS Hotel opened to much fanfare and a fair bit of media publicity from about November 2007. The media was abuzz about the opening of the Opponents' ST. REGIS Hotel, with promotion about the Hotel, news about its opening, personalities in the Hotel's senior management, job recruitment and even about its Bentley limousine services. Nonetheless, I can hardly conclude from the media publicity alone that the Opponents' "ST REGIS" mark is well-recognised by the above defined sector of the Singapore public as at March 2008.

88 I will now turn to the guidelines listed in section 2(7)(b)-(e). On the duration, extent and geographical area of the use and promotion of the Opponents’ mark, the Opponents have used the “ST. REGIS” mark in New York since 1902 and there are 17 ST. REGIS properties worldwide. The evidence shows that the Opponents have been promoting the “ST. REGIS” brand name through advertisements, features published in travel magazines, publications, television, the Internet and through the Opponents' SPG Programme which reaches out to more than 30,000 Singapore members. The Opponents said that in their estimation, Singaporeans have spent in excess of USD\$800,000 on room stays at various “ST REGIS” properties worldwide in each year of 2006 and 2007 and in excess of USD\$100,000 and USD\$110,000 in 2006 and 2007 respectively. As for registrations in Singapore and outside of Singapore, I note that the Opponents have registrations or pending applications for the Opponents' mark, “ST. REGIS” in almost 80 countries.

89 Weighing all the factors in section 2(7), my conclusion is that the Opponents' mark, “ST. REGIS” is well-known to the well-heeled and well-travelled consumers in Singapore who stay in luxurious hotels in the places they visit. These consumers are likely to be on the Opponents' Starwood Preferred Guest Programme and would likely have come across the famed ST. REGIS Hotel that started in New York long ago in travel magazines and



publications. In my opinion, as at March 2008, this small sector of consumers in Singapore would already know about the "ST. REGIS" brand and this is so even though the Opponents' ST. REGIS Hotel had not yet opened in Singapore at that time. Furthermore, this knowledge and recognition of the Opponents' "ST. REGIS" brand amongst this sector of consumers in Singapore was further boosted by the ongoing media publicity about the Opponents' ST. REGIS Hotel's opening in Singapore a few months before March 2008. At this point, I will quote the Court of Appeal in *Amanresorts* ([229]) that, "it will be recalled that it is not too difficult for a trade mark to be regarded as "well known in Singapore" – essentially, the trade mark in question need only be recognised or known by "any relevant sector of the public in Singapore" [emphasis added] (see s 2(7)(a) of the current TMA), which sector could in certain cases be miniscule." As the threshold is not very high, I can safely say that the Opponents' mark are well-known to the relevant sector of the public in Singapore and therefore, well known in Singapore. At this point, let me say that in determining whether the Opponents' mark is well known in Singapore, I can take into account the Opponents' overseas reputation as long as I am convinced that this reputation has reached or reaches the relevant sector of the public in Singapore.

#### *Damaging connection between the Applicants' services and the Opponents*

90 Next, I will move on to the other elements that need to be established under this ground, namely, whether use of the Application Mark on the services sought to be registered would indicate a connection between the services claimed and the Opponents and whether the interests of the Opponents are likely to be damaged as a result.

91 The Court of Appeal in *Amanresorts* ([234]) held that the tests to be adopted for the purposes of the "connection" requirement and the "likely to damage the [Opponents'] interests" requirement would yield the same results as those obtained from applying the corresponding tests vis-à-vis the claim for passing off which are, whether the [Applicants] have made a misrepresentation to the relevant sector of the public...which causes that section of the public to mistakenly think that the services have the same source as or is connected with the Opponents' services, and whether such misrepresentation has resulted in or is likely to result in damage to the interests of the Opponents. The element of misrepresentation in a passing off claim is very similar to the element of likelihood of confusion under section 8(2)(b). As I have found the Application Mark and the Opponents' mark to be similar and that, taking into account all the surrounding circumstances, there is a likelihood of confusion, my conclusion on this ground of opposition is also that it is likely that potential customers would be misled into thinking that the Applicants' services originate from the Opponents or that there is some connection between the two parties. This is so even if the conclusion is that the services sought to be registered under the Application Mark in Class 35 are different from the Opponents' Hotel services. To elaborate on this point, even if it is to be considered that there is some degree of difference between the services claimed by the Applicants under Class 35 and those of the Opponents, there is still the likelihood that the relevant sector of the public may be mistaken there is a connection between the Applicants' services and the Opponents due to the Opponents' mark being well known in Singapore. Consequently, there is also a real likelihood that the interests of the Opponents would be damaged as a result. The elements of "connection" and "likelihood of damaging the Opponents' interests" under section 8(4)(a) and (b)(i) are thus made out.

92 Accordingly, the ground of opposition under section 8(4)(a) read with section 8(4)(b)(i) is also successful.

93 However, in relation to the ground of opposition under section 8(4)(a) read with section 8(4)(b)(ii), it will be a different story. Under this ground, the Opponents' mark must be shown to be "well known to the public at large in Singapore". There is no legislative definition of what constitutes, "well known to the public at large in Singapore". As stated by the Court of Appeal in *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier [2010] 1 SLR 382 ("Louis Vuitton")* ([87]), there is also no guidance from the explanatory notes to the "Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks" to which our section 8(4) is supposed to give effect to. The Court of Appeal, however, made this observation at [94]:

*"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. This approach would be in line with the US approach in determining famous marks."*  
(emphasis mine).

*Is the Opponents' mark well known to the public at large in Singapore?*

94 I have already looked at the factors in section 2(7) and concluded that the Opponents' mark is well known in Singapore. The question is, is the Opponents' mark recognised by **most sectors** of the Singapore public? I do not think so. Unlike marks that are "well known in Singapore", where the threshold is not that high and relatively easy to cross, the category of marks that are "well known to the public at large in Singapore" are reserved for the "*rare and exclusive class*" (see Court of Appeal's remarks in *Amanresorts* at [233] and in *Louis Vuitton* at [88]). Whilst I am satisfied that the Opponents' mark is known to the small segment of the public who are well-heeled and well-travelled, I am not convinced that the Opponents' mark is known to the general public, let alone most sectors of the public, bearing in mind also that this assessment has to be made as at the date of the application for the Application Mark, i.e., March 2008. The Opponents have not submitted any concrete evidence to show that their mark is recognised by most sectors of the public. As such, the ground of opposition under section 8(4)(a) and (b)(ii) necessarily fails. It is therefore unnecessary for me to move on to determine if either of the elements of "unfair dilution" in section 8(4)(b)(ii)(A) or "unfair advantage" in section 8(4)(b)(ii)(B) required under this ground of opposition has been made out.

95 The ground of opposition under section 8(4)(a) and (b)(ii) therefore fails.

### **Ground of Opposition under section 7(6)**

96 Section 7(6) reads:

#### **Absolute grounds for refusal of registration**

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

### ***Opponents' submissions***

97 The Opponents cited the case of ***Rothmans of Pall Mall Ltd v Maycolson International Ltd*** [2006] 2 SLR® 551 and say that the Applicants have the positive duty to check the trade marks register before applying for registration. As there is no evidence to show that the Applicants have discharged their duty of bona fides before registering for their mark in Singapore, the application was made in bad faith. The Opponents' case is that if the Applicants had done a search, they would have noticed that at least in Class 43, which is the Class of main concern to the Applicants, the Opponents already have existing registrations. They would also have noticed that there are no other "Regis" marks other than the ones owned by the Opponents. Co-existence in Australia does not by itself make Applicants bona fide.

98 The Opponents say that as it has not been shown that the duty to investigate has been discharged, there is a lack of good faith on the part of the Applicants when filing for registration for "PARK REGIS".

### ***Applicants' submissions***

99 The Applicants referred to the case of ***PT Swakarya Indah Busana v Dhan International Exim Pte Ltd*** [2009] SGHC 280 for the test to be applied for this ground of opposition. The Applicants pointed out that firstly, an allegation of bad faith is a serious matter which should not be lightly inferred and that secondly, the concept of bad faith includes dishonesty and behaviour that falls short of acceptable commercial behaviour of a reasonable man in the particular area under examination. Both the subjective element which is the mental state of the Applicants and the objective element of the behaviour of a reasonable and experienced man have to be satisfied. The Applicants say that what I have to ask is whether the knowledge of the Applicants was such that their decision to apply for registration of the opposed mark for services in classes 35 and 43 would be regarded as in bad faith by reasonable and experienced men adopting proper standards. The relevant point in time for this assessment of the mental state of the Applicants from the perspective of a reasonable and experienced man is the date of application, i.e., 3 March 2008. The Applicants say there cannot be bad faith as the name "PARK REGIS" is a name they came up with and they have been using the name for some 40 years. Further, the Applicants have hotels in numerous countries and they have numerous registrations as well. In addition, the Opponents' mark is also "ST. REGIS" and not "Regis". Therefore, in applying for "PARK REGIS", the Applicants cannot be said to have copied the Opponents' mark "ST. REGIS". The Applicants argue that as bad faith is a serious allegation and bad faith has to be distinctly alleged and proven and as the Opponents have not discharged this burden of proof, this ground of opposition must necessarily fail.

### ***Decision on section 7(6)***

100 Section 7(6) states that a trade mark shall not be registered if or to the extent that the application is made in bad faith. The test for "bad faith" has been clearly enunciated in the case of ***Wing Joo Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd and Anor and Another Appeal*** [2009] 2 SLR 814 (hereinafter, ***Wing Joo Ginseng***) at [102] to [107] and I will follow closely the test as laid down therein. First, as stated in the aforesaid case, the concept of bad faith under section 7(6) was first reviewed by the Singapore courts in ***Rothmans of Pall Mall Limited v Maycolson International Ltd*** [2006] 2

**SLR 551** wherein Lai Siu Chiu J endorsed the formulation as follows, “*It would be fair to say that the term “bad faith” embraces not only actual dishonesty but also dealings which would be considered as commercially unacceptable by reasonable and experienced persons in a particular trade, even though such dealings may otherwise involve ‘no breach of any duty, obligation, prohibition or requirement that is legally binding’ upon the registrant of the trade mark*”. The Court of Appeal in **Wing Joo Ginseng** then went on to detail the test as a combined test comprising the subjective element of the knowledge of the Applicants and an objective element of judging that knowledge against the ordinary standards of honest people. In summary, the question as to whether the Applicants’ application to register “PARK REGIS” as a trade mark in Singapore in relation to services in Class 35 and Class 43 was made in bad faith is to be determined based on what the Applicants know about the facts of the case and judging that knowledge against the standards of an ordinary honest person to see if what the Applicants did would be regarded as breaching those standards.

101 In this case, the Applicants' evidence shows that the Applicants have been operating their PARK REGIS Hotels in various parts of Australia and later in various other countries. The Applicants' first PARK REGIS Hotel opened in Sydney, Australia in 1972. The Applicants have been using their "PARK REGIS" brand for their properties in Australia consistently for over four decades and they have also expanded to various parts of the world and used their "PARK REGIS" brand for their properties therein. It is clear that the Applicants have a legitimate claim to the "PARK REGIS" brand by virtue of their long adoption, honest and continuous use of their "PARK REGIS" mark for their hotels and properties. Even if I conclude that the Applicants would have known about the Opponents' "ST. REGIS" brand, judging this knowledge against the standards of an ordinary honest trader, there is clearly no bad faith as the Applicants had merely applied to register in Singapore a mark they had been using for quite a long while, albeit outside of Singapore. In arriving at this finding, I would reiterate this pertinent point made in the case of *McDonald's Corp v Future Enterprises Pte Ltd [2005] 1 SLR 177* where the Court of Appeal said at [78] that: “*An allegation of bad faith is a serious matter and should not be lightly inferred.*”

102 The ground of opposition under section 7(6) of the Act therefore fails.

#### **Ground of Opposition under section 7(4)(b)**

103 Section 7(4) reads:

##### **Absolute grounds for refusal of registration**

**7.** – (4) A trade mark shall not be registered if it is –

(a)..

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

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

103 The Opponents' case is that the public may be misled into thinking that "PARK REGIS" and "ST. REGIS" are from the same or related undertakings or that "PARK REGIS" originates from the Opponents and in that sense, the trade mark is of such a nature as to deceive the public and its registration is therefore prohibited under Section 7(4) of the Act.

### *Applicants' Submissions*

104 The Applicants argue that the Opponents' reliance on section 7(4) of the Act is totally misconceived as this ground of opposition is intended to prevent the registration of descriptive marks or marks that bear a direct reference as to the descriptive nature of the goods or services in question. As the Application Mark does not fall into that category of marks, this ground is not applicable. The Applicants' case is that in any event, there is no evidence of any such deception or confusion.

### *Decision under section 7(4)*

105 Section 7(4) is meant to prevent the registration of a trade mark on the premise that the mark itself is of such a nature that is prohibited from registration under section 7(4) – that is, the mark is of a deceptive nature. Section 7(4) provides an absolute ground for refusal. In a case such as this where the objection to the registration stems from another mark or earlier right, the relevant grounds of objection are under section 8 and section 7(4) is not applicable at all. I agree with the Applicants that in any event, the Opponents did not adduce any evidence that shows that the mark, "PARK REGIS" is deceptive to the public by its very name itself.

### **Conclusion**

106 On the whole, the opposition succeeds, but only on the grounds under section 8(2)(b) and section 8(4)(b)(i). Accordingly, Trade Mark Application T0802642I shall therefore be refused registration. The Opponents are entitled to costs to be taxed if not agreed.

Dated this 19th day of July 2011

Lee Li Choon  
Principal Assistant Registrar  
Hearings and Mediation Division  
Intellectual Property Office of Singapore