

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

Trade Mark Application Nos. T0803761G and T0803762E
29 February 2012

IN THE MATTER OF A TRADE MARK APPLICATION BY

ECLECTIC EDGE INC

AND

OPPOSITION THERETO BY

VICTORIA'S SECRET STORES BRAND MANAGEMENT, INC.

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

Mr Foo Maw Jiun (Rodyk & Davidson LLP) for the Applicants
Ms Isaac Tung (Allen & Gledhill LLP) for the Opponents

Cur Adv Vult

GROUND OF DECISION

1 This is a consolidated opposition to the registration of 2 trade marks T0803761G and T0803762E ("the Application Marks"), the particulars of which are as follows:

TM No. T0803761G in Class 25

Application Date: 24 March 2008

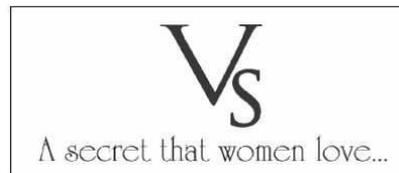


Aprons [clothing]; ascots; babies' diapers of textile; babies' napkins of textile; babies's pants; bandanas [neckerchiefs]; bath robes; bath sandals; Bath slippers; Bathing caps; Bathing drawers; Bathing suits; Bathing trunks; Beach clothes; Beach shoes; Belts [clothing]; Belts (Money-) [clothing]; Berets; Bibs, not of paper; Boas [necklets]; Bodices [lingerie]; Boot uppers; Boots; Boots for sports; Boots (Heelpieces for-); Boots (Iron fittings for-); Boots (Non-slipping devices for-); Boots (Ski-); Boots (Welts for-); Braces for clothing [suspenders]; Brassieres; Breeches for wear; Camisoles; Cap peaks; Caps [headwear]; Caps (Shower-); Chasubles; Chemisettes [shirt fronts]; Clothing; Clothing for gymnastics; Clothing of imitations of leather; Clothing of leather; Coats; Coats (Top-); Collar protectors; Collars [clothing]; Combinations [clothing]; Corselets; Corsets [underclothing]; Costumes (Masquerade-); Cuffs; Cyclists' clothing; Detachable collars; Diapers (Babies'-) of textile; Drawers [clothing]; Dress shields; Dressing gowns; Ear muffs [clothing]; Esparto shoes or sandals; Fishing vests; Fittings of metal for shoes and boots; Football boots; Football boots [shoes] (Studs for-); Football shoes; Footmuffs, not electrically heated; Footwear; Footwear (Tips for-); Footwear uppers; Frames (Hat-) [skeletons]; Frocks; Fur stoles; Furs [clothing]; Gabardines [clothing]; Gaiter straps; Gaiters; Galoshes; Garters; Girdles; Gloves [clothing]; Goloshes; Gowns (Dressing-); Gymnastic shoes; Half-boots; Hat frames [skeletons]; Hats; Hats (Paper-) [clothing]; Headbands [clothing]; Headgear for wear; Heelpieces for boots and shoes; Heelpieces for stockings; Heels; Hoods [clothing]; Hosiery; Inner soles; Jackets [clothing]; Jackets (Stuff-) [clothing]; Jerseys [clothing]; Jumpers [shirt fronts]; Knitwear [clothing]; Lace Boots; Layettes [clothing]; Leather (Clothing of-); Leather (Clothing of imitations of-); Leggings; Linen (Body-) [garments]; Linings (Ready-made-) [parts of clothing]; Liveries; Maniples; Mantillas; Masks (Sleep-); Masquerade costumes; Miters [hats]; Mitres [hats]; Mittens; Money belts [clothing]; Motorists' clothing; Muffs [clothing]; Napkins (Babies'-) of textile; Neckties; Non-slipping devices for boots and shoes; Outerclothing; Overalls; Overcoats; Pajamas (Am.); Pants; Paper clothing; Paper hats [clothing]; Parkas; Peaks (Cap-); Pelerines; Pelisses; Petticoats; Pocket squares; Pockets for clothing; Pullovers; Pyjamas; Ready-made clothing; Ready-made linings [parts of clothing]; Robes (Bath-); Sandals; Saris; Sashes for wear; Scarfs; Scarves; Shawls; Shields (Dress-); Shirt fronts; Shirt yokes; Shirts; Shoes; Shoes (Heelpieces for-); Shoes (Iron fittings for-); Shoes (Non-slipping devices for-); Shoes (Welts for-); Shoulder wraps; Shower caps; Singlets; Ski Boots; Skirts; Skull caps; Sleep masks; Slippers; Slips [undergarments]; Smocks; Sock suspenders; Socks; Soles for footwear; Spats; Sports (Boots for-); Sports jerseys; Sports shoes ; Stocking suspenders; Stockings; Stockings (Heel pieces for-); Stockings (Sweat-absorbent-); Stoles (Fur-); Straps (Gaiter); Studs for football boots [shoes]; Stuff jackets [clothing]; Suits; Suits (Bathing-); Sun visors; Suspenders; Sweat-absorbent underclothing [underwear]; Sweaters; Swimsuits; Teddies [undergarments]; Tee-shirts;

Tights; Tips for footwear; Togas; Top hats; Topcoats; Trousers straps; Trousers; Trunks (Bathing-); Turbans; Underclothing; Underclothing (Anti-sweat-); Underpants; Underwear; Underwear (Anti-sweat-); Uniforms; Uppers (Footwear-); Veils [clothing]; Vests; Vests (Fishing-); Visors [hatmaking]; Waistcoats; Waterproof clothing; Welts for boots and shoes; Wet suits for water-skiing; Wimples; Wooden shoes; Wristbands [clothing]; Yokes (Shirt-); all included in International Class 25

TM No. T0803762E in Class 25

Application Date: 24 March 2008



Aprons [clothing]; Ascots; Babies' diapers of textile; Babies' napkins of textile; Babies' pants; Bandanas [neckerchiefs]; Bath robes; Bath sandals; Bath slippers; Bathing caps; Bathing drawers; Bathing suits; Bathing trunks; Beach clothes; Beach shoes; Belts [clothing]; Belts (Money-) [clothing]; Berets; Bibs, not of paper; Boas [necklets]; Bodices [lingerie]; Boot uppers; Boots; Boots for sports; Boots (Heelpieces for-); Boots (Iron fittings for-); Boots (Non-slipping devices for-); Boots (Ski-); Boots (Welts for-); Braces for clothing [suspenders]; Brassieres; Breeches for wear; Camisoles; Cap peaks; Caps [headwear]; Caps (Shower-); Chasubles; Chemisettes [shirt fronts]; Clothing; Clothing for gymnastics; Clothing of imitations of leather; Clothing of leather; Coats; Coats (Top-); Collar protectors; Collars [clothing]; Combinations [clothing]; Corselets; Corsets [underclothing]; Costumes (Masquerade-); Cuffs; Cyclists' clothing; Detachable collars; Diapers (Babies-) of textile; Drawers [clothing]; Dress shields; Dressing gowns; Ear muffs [clothing]; Esparto shoes or sandals; Fishing vests; Fittings of metal for shoes and boots; Football boots; Football boots [shoes] (Studs for-); Football shoes; Footmuffs, not electrically heated; Footwear; Footwear (Tips for-); Footwear uppers; Frames (Hat-) [skeletons]; Frocks; Fur stoles; Furs [clothing]; Gabardines [clothing]; Gaiter straps; Gaiters; Galoshes; Garters; Girdles; Gloves [clothing]; Goloshes; Gowns (Dressing-); Gymnastic shoes; Half-boots; Hats; Hats (Paper-) [clothing]; Headbands [clothing]; Headgear for wear; Heelpieces for boots and shoes; Heelpieces for stockings; Heels; Hoods [clothing]; Hosiery; Inner soles; Jackets [clothing]; Jackets (Stuff-) [clothing]; Jerseys [clothing]; Jumpers [shirt fronts]; Knitwear [clothing]; Lace Boots; Layettes [clothing]; Leggings; Linen (Body-) [garments]; Linings (Ready-made-) [parts of clothing]; Liveries; Maniples; Mantillas; Masks (Sleep-); Miters [hats]; Mitres [hats]; Mittens; Motorists' clothing; Muffs [clothing]; Neckties; Non-slipping devices for boots and shoes; Outerclothing; Overalls; Overcoats; Pajamas (Am.); Pants; Paper clothing; Parkas; Pelerines; Pelisses; Petticoats; Pocket squares; Pockets for clothing; Pullovers; Pyjamas; Ready-made clothing; Sandals; Saris; Sashes for wear; Scarfs; Scarves; Shawls; Shirt fronts; Shirt yokes; Shirts; Shoes; Shoes (Heelpieces for-); Shoes (Iron fittings for-); Shoes (Non-slipping devices for-); Shoes (Welts for-); Shoulder wraps; Singlets; Ski Boots; Skirts; Skull caps; Slippers; Slips [undergarments]; Smocks; Sock suspenders;

Socks; Soles for footwear; Spats; Sports (Boots for-); Sports jerseys; Sports shoes; Stocking suspenders; Stockings; Stockings (Sweat-absorbent-); Studs for football boots [shoes]; Suits; Sun visors; Suspenders; Sweat-absorbent underclothing [underwear]; Sweaters; Swimsuits; Teddies [undergarments]; Tee-shirts; Tights; Togas; Top hats; Trousers straps; Trousers; Turbans; Underclothing; Underclothing (Anti-sweat-); Underpants; Underwear; Underwear (Anti-sweat-); Uniforms; Veils [clothing]; Vests; Visors [hatmaking]; Waistcoats; Waterproof clothing; Welts for boots and shoes; Wet suits for water-skiing; Wimples; Wooden shoes; Wristbands [clothing]; all included in international Class 25.

2 The Applicants are Eclectic Edge Inc (the “Applicants”) and the Opponents are Victoria's Secret Stores Brand Management, Inc. (the “Opponents”).

3 Trade Mark Application No. T0803761G was accepted and published on 28 November 2008 in the Trade Marks Journal for opposition purposes. The Opponents opposed this application on 30 March 2009 and the Applicants filed their Counter-Statement on 29 May 2009.

4 Trade Mark Application No. T0803762E was accepted and published on 2 January 2009 in the Trade Marks Journal. The Opponents opposed this application on 30 April 2009 and the Applicants filed their Counter-Statement on 26 June 2009.

5 The Opponents filed evidence in support of both the opposition on 29 March 2010. The Applicants filed evidence in support of both the applications on 29 September 2010. No further evidence was lodged and the parties attempted to negotiate settlement after the close of pleadings, failing which both the oppositions were consolidated and heard on 29 February 2012.

Grounds of Opposition

6 The Opponents rely on Sections 8(2)(b), 8(4) and 8(7) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”) in this consolidated opposition.

Opponents’ Evidence

7 The Opponents’ evidence in respect of T0803761G comprises a Statutory Declaration affirmed by Carol M. Matorin, Senior Vice President of the Opponents on 8 March 2010 in New York City, USA. Similarly, the Opponents’ evidence in respect of T0803762E comprises a Statutory Declaration affirmed by Carol M. Matorin, Senior Vice President of the Opponents on 8 March 2010 in New York City, USA.

Applicants’ Evidence

8 The Applicants’ evidence in respect of T0803761G comprises a Statutory Declaration affirmed by Amaliha Lase S.H., General Counsel of the Opponents on 28 September 2010 in Indonesia. Similarly, the Applicants’ evidence in respect of

T0803762E comprises a Statutory Declaration affirmed by Amaliha Lase S.H., General Counsel of the Opponents on 28 September 2010 in Indonesia.

Applicable Law and Burden of Proof

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

Background

10 The Applicants first launched their marks in July 2008 in relation to retail of intimate women's apparel and lingerie. The words "Valentine" and "Secret" originate from the use by the Applicants as part of their brand development story. The letters "V" and "S" in T0803762E are derived from and stand for "Valentine" and "Secret". The element "Valentine" is derived from the stories of Valentine of Terni and Valentine of Rome, the inspiration behind the Applicants' brand story. The Applicants view the reference to "Valentine" as a symbolism of love and its brand story relates this symbolism to its product of intimate women's apparel and lingerie.

11 The Applicants' derivation of the element "Secret" and the catchphrase "A secret that women love" is borne out in the excerpt of the Applicants' Brand Story below, which is also found on their website at <http://www.valentine-secret.com/>:

"The echo of Love's compelling stories from the past will never fade, and it never fades indeed. Stories of Valentine of Terni & Valentine of Rome are witnesses to Compassion & Love.

And, their life's stories are the inspiration to echo and express this thing called Love.

Love is an experience, and each woman is called to this intimate personal experience.

Valentine Secret is born of Love... its creation inspires Love. It is the secret to embrace a loving relationship within yourself, and with your beloved.

A Secret that women love..."

12 The Applicants operate a fashion boutique bearing the name "Valentine Secret" at Pacific-Place, 1st Floor, 29 & 35, SCBD Jl. Jend. Sudirman Kav 52-53 Jakarta Pusat 12190 INDONESIA, an up-scale shopping centre in Jakarta. The Applicants have on the 22 January 2008, lodged applications for registration of the 2 marks in Class 25 in Indonesia and the applications are pending. The Applicants' sales of the Marks in Indonesia from 2008 to August 2010 amount to IDR157,190,000, IDR 1,186,188,500 and IDR2,265,264,800 respectively. The Applicants state that they have extensively advertised their marks in Indonesia through brochures, magazines and television advertisements, including AMICA, ELLE, BAZAAR, WEDDING, COSMOPOLITAN, DEWI, MARIE CLAIRE, METRO TV, FASHION TV, WEDDINGKU REGISTRY and

SPICE. The advertisement expenditure for 2009 and 2010(August) amount to IDR646,625,000 and IDR850,000,000 respectively.

13 The Applicants have not started operations in Singapore but intend to do so after its trade marks are registered in Singapore.

14 The Opponents are a subsidiary company of Limited Brands, Inc. and holder of the VICTORIA'S SECRET brands and sub-brands. Limited Brands, Inc. sells lingerie, personal care and beauty products, apparel and accessories through its Victoria's Secret, Pink, Bath & Body Works, C.O. Bigelow, La Senza, White Barn Candle Co. and Henri Bendel brands. The company's products are available in over 2,900 specialty stores in the United States of America, through the Victoria's Secret Catalogue and online at www.VictoriasSecret.com, www.BathandBodyWorks.com and www.LaSenza.com. Limited Brands, Inc. recorded sales of US\$10 billion in 2007 and US\$9 billion in 2008. Limited Brands, Inc. has been delivering consistent results in this range since 2004.

15 The Opponents' VICTORIA'S SECRET brand and its monogram variant "VS" was first used in the United States of America as early as the year 1977 by the Opponents' predecessor in interest. The Opponents are the proprietors of many trade marks worldwide (including Singapore) containing the words "VICTORIA'S SECRET" and its monogram variant "VS". The Opponents' world-wide advertising expenditure incurred on the VS Trade Marks are substantial amounting to :

Year	Advertising expenses (US\$)
2004	234,500,000
2005	250,200,000
2006	270,700,000

16 The Opponents' products are sold or supplied to customers all over the world through their highly successful mail order business. Their products are made available to customers worldwide through its website and catalogue. The orders are placed through telephone calls or facsimile; or order forms based on items in catalogues or on the Internet. The total figure for catalogues mailed throughout the world since 2002 to 2008 averages from 240,000,000 to 300,000,000. The total number of international catalogues mailed to Singapore from 2002 to 2008 total 881,889.

17 The sales turnover in Singapore for the Opponents' goods bearing the "VICTORIA'S SECRET" and its monogram variant VS Trade Marks are as follows:

Year	Sales Amount in Singapore (US\$)
2008	2,555,947
2007	1,752,206
2006	1,312,681
2005	1,063,599
2004	1,096,839
2003	1,082,611

MAIN DECISION

Preliminary Issue

18. Counsel for the Opponents in their submissions used the term "VS Trade Marks" to describe the Opponents' marks. Counsel when queried which marks this collective term "VS Trade Marks" referred to, confirmed that it included Singapore and world-wide registered/pending trade marks; and these had been included in the annexes to the Notice of Opposition and in exhibits A and B of the Opponents' 2 statutory declarations. As the marks which the Opponents rely upon are important for the determination of the grounds of opposition under section 8(2)(b) and section 8(4), I will list them accordingly.

19. The Notices of Opposition in respect of both trade mark applications have the same annexes which contain the same list of marks. These include in the Annex A, the Opponents' marks registered and pending registration at the Intellectual Property Office of Singapore. The Notice of Opposition also includes an Annex B which runs in alphabetical order the names of all countries where the Opponents have registered or applied for registration of their marks which contain the words "VICTORIA'S SECRET" plus another word or words. Examples of such marks include "Angels by VICTORIA'S SECRET", "Supermodel by VICTORIA'S SECRET", "VICTORIA'S SECRET Second Skin Satin", "English Lace by VICTORIA'S SECRET": to name a few.

20. In respect of T0803761G, the marks listed in exhibits A and B of the Opponents' statutory declaration are as follows:

Exhibit A

The title of the document is aptly named "VICTORIA'S SECRET Worldwide Class 25" as all the marks exhibited are marks bearing only the words "VICTORIA'S SECRET". These are marks from 116 countries, including a registration from Singapore. The Singapore registration in Class 25 bears the registration date 12 March 1991.

Exhibit B

This exhibit comprises certificates of registration from selected countries:

Country	Marks
Australia	Both marks from the Australia Intellectual Property Office are VICTORIA'S SECRET marks.
China	The certificates of registration from the Chinese Intellectual Property office (SIPO) are in the Chinese language and are not supported by translations
France	The documents and certificate lodged are in French and are not supported by translations.
Germany	The certificates from the German IP Office (Deutsches Patentamt)

	are in the German language and are not supported by translations.
Hong Kong	The marks exhibited are VICTORIA'S SECRET marks
Italy	The certificates and documents are in the Italian language and are not supported by translations. The only document which has been translated into the English Language appears to be a translation of a renewal certificate.
Japan	The mark in the translated certificate of registration relates to the VICTORIA'S SECRET mark. The other documents relate to a translation of the notice of completion of recordal of a trade mark and what purports to be a letter enclosing Notice of Registration and the Certificate of Registration.
Korea	The certificate relates to registration no. 254562 for VICTORIA'S SECRET
Singapore	The certificate of registration shows the mark VICTORIA'S SECRET
United Kingdom	The Certificate is for the registration of 1257685 in Class 25 for VICTORIA'S SECRET
United States	The document lodged is a Trademark assignment abstract of Title showing that title of the particular VICTORIA'S SECRET mark has properly passed to Victoria's Secret Stores Brand Management Inc.

21. In respect of T0803762E, the marks in exhibits A and B of the Opponents' statutory declarations are as follows:

Exhibit A

This exhibit shows 2 different lists, the first list is titled "Other VS Formative Marks Worldwide". The marks all bear the letters "VS" but not all relate to Class 25. It is not known nor submitted whether the different classes reflected against these other countries correspond to Class 25 as we know it in Singapore. These marks include "VS PRO", "VS HIM", "VS HER", "VS SPORT AND DESIGN", "VICTORIA'S SECRET VS SPORT AND DESIGN", "VS RUNWAY", "VS SEXY SPORT", "VS SPORT", "Denim Stitching (VS PINK Denim)", "MISCELLANEOUS DESIGN (VS DENIM STITCHING V DESIGN), VS (AND DESIGN)", "VS COTTON", "VS NAKED", "VS SLINKS", "VS SLINKY", "VS UNDIES" and "VS UPLIFT.

The second list is the same list as exhibited in Exhibit A of T0803761G. The marks in that list are VICTORIA'S SECRET marks in Class 25 from around 116 countries worldwide.

Exhibit B

The certificates which are annexed in Exhibit B are as follow:

Country	Mark
France	Copy of a certificate in French which is not supported by a translation

Hong Kong	An extract of the records from the Hong Kong Intellectual Property Department's register for the mark VS SPORT in classes 18 and 25; the date of registration of the marks is 4/9/98 and the marks have been renewed
Japan	The translation of the certificate of registration no 4307898 for VS SPORT, which was registered on August 20, 1999 for "Clothing, bands, belts, special sporting and gymnastic wear
Singapore	Certificate of registration in class 25 for the mark VS SPORT, the registration date is 17 September 1998. The goods of the registration include clothing and exercise wear, leotards, tights, leggings, etc.
Taiwan	The translation of the certificate of registration indicates registration for VS SPORT & DESIGN, the date of application being 1 May 2009. The goods of the registration include clothing and exercise wear, namely leotards, tights, legging, tops, sweatshirts, sweatpants, tank tops, T-shirts, sports bras, bra tops, shorts, biking shorts, jackets, sweat jackets, bodysuits, unitards, socks, hats, wristbands and headbands.
United States	(1) Certificate showing a mark comprised of letters "V" and "S", the letters are superimposed such that the mark in its entirety looks more like a device than the letters VS, for "Swimsuits, swim wear and cover-ups" in class 25 (2) Certificate showing the mark VS UPLIFT for "clothing, namely jeans in Class 25", the mark being registered on 29 July 2008

22. From the annexes in the notices of opposition and the exhibits in the statutory declaration, it is clear that the Opponents "VS Trade Marks" include the VICTORIA'S SECRET marks as well as the different variants of the VS monogram marks. I wish to state however that evidence which has been lodged in a language other than the English language and which are not supported by translations, will not be considered.

23. The Opponents have also included in their written submissions and have made oral submissions at the hearing about the Opponents' "highly successful runway fashion shows" featuring the Victoria's Secrets Angels models; and the purported connection between these shows and the Applicants attempts to ride on the popularity of the shows, by emulating the Opponents' marketing strategies. Several images from the Opponents' and the Applicants' websites were inserted into the written submissions. I regret that these submissions cannot be brought into evidence as it is not sworn and would constitute evidence from the bar. I will confine myself to the sworn evidence in the statutory declarations of the parties.

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

24. 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

25 The Opponents have the burden of proving that the Application Marks and the VICTORIA'S SECRET and VS Trade Marks are similar; that the goods claimed in the Application and those protected by the Opponents’ VICTORIA'S SECRET and VS Trade Marks are identical or similar; and there is a likelihood of confusion by virtue of the similarity of the marks and the goods.

26 The principles of comparison of marks which were clearly enunciated by Parker J in *Pianotist Co’s Application* at page 777:

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

27 The Opponents submit that the 3-step approach in the case of *The Polo/Lauren Co, LP v Shop-In Department Store Pte Ltd* [2006] 2 SLR 690 ("*Polo/Lauren*") is applicable in Singapore. This 3-step test was affirmed in the High Court decision of *Ferrero SPA v Sarika Connoisseur Cafe Pte Ltd* [2011] SGHC 176 ("*Ferrero*"). In considering the similarity of marks, the High Court in *Ferrero* at [50] sets out the principles.

28 The Opponents submit that any arguments made by the Applicants based on the stylisation of the Opposed Mark should be disregarded as the Opponents have registered a standard character word mark for “VICTORIA’S SECRET” under T9110680D in BLOCK LETTERS. When comparing a mark in BLOCK LETTERS against a stylized mark, the court in the Ferrero case held that it is trite law that word-only registered trade marks render infringing any offending use in any font or stylisation. *Kerly’s Law of Trade Marks and Trade Names* (Sweet & Maxwell, 14th Ed, 2005) (“*Kerly’s*”) at para 2-036 The passage from *Kerly’s* was cited with approval in *Richemont International SA v Da Vinci Collections Pte Ltd* [2006] 4 SLR(R) 369.

29 The Applicants have incorporated the word “Secret” from the Opponents’ mark “Victoria’s Secret” into the Opposed Mark. Instead of the nine letter word “Victoria’s”, the Applicants have replaced it with the nine letter word “Valentine”. In the first word of each mark, both words start with the letter “V” and contain 4 letters which are in common. The word “Secret” is very cleverly stylised and made it highly prominent in the overall mark, drawing the consumer’s eyes to the word “Secret” when he perceives the mark.

30 The Applicants have The Opponents state that the general impression created would be that of a mark with a word starting with the letter “V” on the left and with the stylised word “Secret”. If the reader were to focus the eye on the word “lingerie” in the marks, it is very difficult to tell the 2 marks apart without closer inspection. The word “lingerie” is descriptive and non- distinctive and it should be disregarded when making a comparison of the marks. Based on a mark for mark comparison whether in standard block letters or in stylised format, both marks are visually similar.

31 The Opponents' and the Application marks evoke a sense of mystery due to the use of the word “Secret”, and arguably have a measure of conceptual similarity. The Opponents argue that based on the long and substantial use of the Opponents’ VS Trade Marks in Singapore and elsewhere, those marks are now highly distinctive of the Opponents. As such, the modifications made to create the Application Marks are insufficient to render the marks dissimilar. *Ozone Community Corp v Advance Magazine Publishers Inc* [2010] 2 SLR 459 at [44].

32 There is no dispute that there are goods which are overlapping and the Opponents submit that the goods in question are identical and/or similar.

33 The guiding principles pertaining to likelihood of confusion are summarised by the court in the Ferrero case at [92] to [100]. The test for likelihood of confusion is "whether a substantial portion of the relevant public will be confused". The three different aspects of this test are (a) the meaning and nature of the "confusion" required; (b) the meaning and nature of the "relevant public"; and (c) the requirement of a "substantial portion" of the relevant public being confused. The court in Ferrero at [97] to [100] also set out other instructive principles relevant to the test for likelihood of confusion.

34 The relevant public are the buyers of the Opponents’ products (which can include men who purchase the products for their partners) who are reasonably well-informed, reasonably observant and circumspect, and will exercise ordinary care and intelligence when making purchases. From the mailing addresses of the Opponents’ customers, the Opponents’ customer base in Singapore comprises a wide section of Singapore society, ranging from landed property dwellers to public Housing Development Board flat dwellers; indicating that the Opponents’ customers arguably contain a good mix of sophisticated and non-sophisticated consumers.

35 With the high degree of similarity between the marks, the identical goods which are sold by both parties under their respective trade marks and the manner under which the Applicants are marketing their products, the Opponents submit that there is a real likelihood of confusion that can be caused to the relevant sector of the public in Singapore if the Application Marks are allowed to be registered in Singapore.

Applicants' Submissions

36 The Applicants submit that there is no visual, aural or conceptual similarity between the Applicants' word and heart device mark and the Opponents' VICTORIA'S SECRET mark. It is settled law that the use of different words, fonts and the inclusion of an extra device will satisfy the Court that two marks are visually dissimilar. *Pret A Manger (Europe) Limited v Ezaki Gico Kabushiki Kaisha* [2006] SGIPOS 13, at [27]. Also *Pacific Rim Industries Inc. v Valentino Globe B.V.* [2008] SGIPOS 6 at [75] and *Crown Confectionery Co Ltd v Morinaga & Co Ltd* [2008] SGIPOS 12 at [147]

37 Applying the principles established in the various cases, the marks are visually different from each other because the Applicants' mark contains the 3 words "Valentine", "Secret" and "Lingerie" as opposed to the Opponents' mark which contains 2 words, "Victoria" and "Secret", and there is only 1 common word between the two marks. The Applicants' mark contains a prominent and distinctive heart shaped device around the alphabets "e" and "t" (from the word "Secret") while the Opponents' VICTORIA'S SECRET mark does not contain any device. The Applicants' mark uses different fonts and comprises of 3 heavily stylised words "Valentine", "Secret", and "lingerie" whereas the Opponents' VICTORIA'S SECRET mark consists merely of the phrase "VICTORIA'S SECRET" in block letters of a single, standard font.

38 Further the beginnings of both marks are readily discernible because they are entirely different words; and even the only common word 'Secret' is presented in a different manner the Opponents' VICTORIA'S SECRET mark. The Applicants' mark emphasizes the word 'Secret' by having it in bold, underlined and in a large stylised font, whereas the Opponents' VICTORIA'S SECRET makes no such differentiation in the use of the words "Victoria's" and "Secret". The impression that is given by Applicants' mark as a whole is very different from the Opponents' VICTORIA'S SECRET mark.

39 The Applicants' mark and the Opponents' VICTORIA'S SECRET marks are also not aurally similar as the former 3 word mark reads "Valentine Secret lingerie" while the latter comprises 2 words and just reads "Victoria's Secret".

40 The Applicants submit that the present marks are an appropriate case where the first part of the mark is the part that leaves a stronger impression. As "secret" is a word common to marks in Class 25, the defining portion of the marks should therefore be "Valentine" and "Victoria's", two entirely different words with different pronunciations. In the case of *London Lubricants (1920) Ltd's Application* (1926) 42 RPC 264 at [279] ("*London Lubricants*") it was held that:

“(The) tendency of persons using the English language to slur the termination of words ...has the effect necessarily that the beginning of words is accentuated in comparison, and ...the first syllable of a word is, as a rule, far the most important for the purpose of distinction.”

And applying this principle to the marks, the 2 marks are again clearly different as the first syllable of the former is “Val” while that of the latter is “Vic”.

41 Conceptually, The Applicants' mark is again different from the Opponents' VICTORIA'S SECRET mark. The Opponents have not set out its concept behind their use of the words “Victoria's” and “Secret” whereas the Applicants have clearly articulated their Brand Story and why they have selected the words “Valentine” and “Secret”. The heart shaped device used in the Applicants' word and heart device mark connotes and embodies the Brand Story's theme of Love.

42 The Applicants submit that the word “Secret” is a common element in Class 25 marks, as of the date of this submissions, there are 126 trade marks registered under Class 25 in Singapore containing the word ‘secret’. In *Richemont International SA* it was also held that where a common word is included in the earlier trade mark, the tribunal should be wary of granting a monopoly in its use. The only common element between the Applicants' word and heart device mark and the Opponents' VICTORIA'S SECRET mark is the word "secret". The Opponents cannot be granted a monopoly over this word, especially in light of the common use of this word in the designated class.

43 Taken as a whole, the Applicants' Valentine Secret and heart device mark and the Opponents' VICTORIA'S SECRET mark is entirely different. This is because there are no visual, aural or conceptual similarities between Mark 1 and the Opponents' VICTORIA'S SECRET mark. Even applying the Imperfect Recollection Doctrine will not save the Opponents' case. There are no points of similarity which would even leave an impression on an individual with an imperfect recollection. Hence, without any similarity, there is no room for the public to be confused.

With respect to the Applicants' 2-letter VS mark and slogan vs VICTORIA'S SECRET

44 The words used in are different, the font and stylisation of the words are different. The Applicants' "VS A secret that women love" mark 2 consists of two bold alphabets, “V” and “S”, with the “V” being of a larger font than the “S” and positioned slightly higher up in the mark as compared to the “S”. Below the 2 alphabets, a slogan/phrase which reads “A secret that women love...” in a smaller font. The Opponents' Mark 1 consists of two words “VICTORIA'S” and “SECRET” in block letters of a single, standard font; and

- a. all the alphabets in the Opponents' VICTORIA'S SECRET are capitalized while only the letter “A” in “A secret that women love...” is capitalized
- b. Mark 2, has been registered as a whole and not only does the individual elements differ from the Opponents' VICTORIA'S SECRET, the impression that is given by Mark 2 as a whole is very much different from

the Opponents' VICTORIA'S SECRET mark.

45 The Applicants submit that there is a clear differentiation in the reading of the 2 marks because the words used are entirely different except for the common word "secret"; the Applicants' "VS A secret that women love" mark has 7 words with 9 syllables, compared to the Opponents' VICTORIA'S SECRET mark which has 2 words with 5 syllables. The first word of the Opponents' VICTORIA'S SECRET mark is a treble syllabic word ("Victoria's") while the first word of the Applicants' "VS A secret that women love" mark is a mono-syllabic letter ("V").

46 Conceptually, the Applicants' "VS A secret that women love" mark is again different from the Opponents' VICTORIA'S SECRET mark. The Opponents have not set out its concept behind their use of the words "Victoria's" and "Secret". On the other hand, the Applicants have clearly articulated their Brand Story and why they have selected the words "VS" and the phrase to represent "Valentine" and "Secret" and its Brand Story.

47 Taken as a whole, The Applicants' "VS A secret that women love" mark and the Opponents' VICTORIA'S SECRET are entirely different. This is because there are no visual, aural or conceptual similarities between The Applicants' "VS A secret that women love" mark and the Opponents' VICTORIA'S SECRET. Applying the Imperfect Recollection Doctrine, the Opponents' double-worded phrase ("Victoria's Secret") leaves a totally different impression from a mark with 2 distinct alphabets coupled with a substantially longer descriptive phrase.

48 Once again, apart from the 2 marks sharing the word 'Secret', there is no similarity between the 2 marks. The Opponents are again building their case around this common word "secret" and aiming for a monopoly of the word "secret".

49 Hence, without any similarity, there is no room for the public to be confused between The Applicants' "VS A secret that women love" mark and the Opponents' Valentine Secret with the heart device. The Opponents' case under Section 8(2)(b) of the Act must fail.

Decision on Section 8(2)(b)

50 Although this is a consolidated opposition, I propose to deal with the marks individually. For ease of reference, the Applicants' mark in T0803761G is referred to as "Valentine Secret and heart device"; and the Applicants' mark in T08037612E is referred to as the Applicants' 2-letter VS mark and slogan.

51 One of the criteria before the ground of opposition under Section 8(2) can be made out is that the Opponents must have an earlier trade mark. An "earlier trade mark" is defined in Section 2(1) of the Act as:

- (a) a registered trade mark or an international trade mark (Singapore), the application for registration of which was made earlier than the trade mark in

question, taking account (where appropriate) of the priorities claimed in respect of the trade marks; or

(b) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was a well known trade mark, and includes a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph (a) subject to its being so registered.

52 The Opponents made submissions that the marks listed in their Notice of Opposition and Statutory Declaration were well known trade marks and hence qualified as "earlier trade marks" under section 2(1)(b). With respect to the Applicants' Valentine Secret and heart device, the Opponents rely on the several registrations and applications that they have in Singapore of their marks bearing the words VICTORIA'S SECRET which are filed before the date of filing of the Application Marks.

53 As for the Applicants' 2-letter VS mark and slogan, the Opponents state that their unregistered VS marks (including the variants of the VS monogram which pre-date the Applicants' trade mark applications) are well known and hence qualify as earlier trade marks under section 2(1) of the Act. However, I note that the Opponents have a trade mark registration no. T98/09412G in Class 25 for the mark "VS SPORT". This mark bears the registration date 17 September 1998, which is an earlier date to 24 March 2008, the date of application of the Application marks. The Opponents' mark therefore qualifies as an earlier trade mark within the definition of Section 2 and hence is no necessity to decide the issue of whether the Opponents' marks are well-known under the section 8(2) ground of opposition.

Test to be applied under Section 8(2)(b)

54 As submitted by the Opponents' Counsel, the test for the determination under section 8(2)(b) is the three-step test set out by the Court of Appeal in *Polo/Lauren*. The three-step test requires that there must firstly be similarity of marks. Secondly, the marks must be used in relation to identical or similar goods or services. Thirdly, because it is established that the marks are similar and used in relation to identical or similar goods, there exists a likelihood of confusion on the part of the public.

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

Similarity of Marks

56 When examining the similarity of marks, the High Court in *Ferrero* at [47] states that the test to be adopted in determining whether 2 marks are similar is the test in *Ozone Community Corp v Advance Magazine Publishers Inc* [2010] 2 SLR 459 ("*Ozone*") where the

marks must be analysed to assess whether there is visual, aural and conceptual similarity between marks; and whether the Opponents' mark is distinctive. The High Court's decision in *Ferrero* also sets out further guiding principles in the consideration of similarity of marks at [50]:

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

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

(c) Third, when comparing the two signs/marks, what is relevant is the “imperfect recollection” of the customer (*MediaCorp* at [33], citing *Nautical Concept Pte Ltd v Jeffery Mark Richard* [2007] 1 SLR(R) 1071 at [30]). The court will not compare the two marks side by side and examine them in detail, because “the person who is confused often makes comparison from memory removed in time and space from the marks” (*MediaCorp* at [33], citing *Caterpillar* at [55]).

Visual Similarity

Opposition against T0803761G (Valentine Secret and heart device)

57 The comparison of here is essentially in relation to 2 word marks and the High Court in *Ferrero* at [51] states that in the determination of visual similarity, one must look at:

... (a) the length of the marks; (b) structure of the marks (*i.e.*, whether there are the same number of words); and (c) whether the same letters are used in the marks (*Ozone Community* at [49], citing Bently & Sherman, *Intellectual Property Law* (Oxford University Press, 3rd Ed, 2009) at 865 (“*Bently & Sherman*”)).

58 When comparing the Applicants' Valentine Secret and heart device and the Opponents' VICTORIA'S SECRET marks, I am reminded by the Opponents that their mark was lodged in block letters and as such, it should be regarded as protected in any font or stylisation. Counsel for the Opponents submitted the following paragraph 2-036 from Kerly's Law of Trade Marks and Trade Names (*Sweet & Maxwell, 14th Ed, 2005*) (“Kerly's”) where it states:

Consider a word-only registration. The graphical representation is the word in capitals in plain type. Such a registration covers the word in a very wide range of typefaces. The variation in presentation is permissible because the distinctive character of the mark resides in the word itself and that does not change.

59 Applying the guiding principles from *Ferrero*, the observation is that the Opponents' and the Applicants' marks are both word marks which are similar in length and the structure of the marks is quite similar. Both the marks are made up of 2 words which begin with the same letters "V" and "S"; and the second word in each mark is a common word: "Secret".

60 This observation however, does not bring about the immediate conclusion that the marks are visually similar. Although the registration of a mark in block letters may cover a wide range of typefaces, the visual effect of stylisation and particularly design in a mark has the ability of distinguishing two structurally similar marks. In the comparison of the 2 marks, it is the device of the heart and the curved flourish which underscores the word "Secret" that serves to visually distinguish the Applicants' mark from the Opponents' mark. The use of mixed stylisation of the words in the mark – the smaller-in-size word "Valentine" in plain font together with the word "Secret" in a larger cursive font – also play a part in differentiating the two marks. When the eye views objects, size does matter; hence it is the word "Secret" which is stylised and deliberately larger than the word "Valentine" and "lingerie" which first catches the eye. I do not find that the word "lingerie" necessarily accentuates the difference between the marks as this word describes the goods to which the mark is affixed.

61 I find that the Opponents' VICTORIA'S SECRET mark and the Applicants' Valentine Secret and heart device mark are not visually similar.

Opposition against T0803762E (2-letter VS mark and slogan "A secret that women love")

62 The marks in question here are the Opponents' "VICTORIA'S SECRET" marks, the Opponents' VS SPORT mark and the Applicants' 2-letter VS mark and slogan "A secret that women love". Applying *Ferrero's* principles to these marks, I find that the Opponents' VICTORIA'S SECRET marks are not aurally similar to the Applicants' 2-letter VS mark and slogan mark. In respect of the Opponents' VS SPORT mark and the Applicants' 2-letter VS mark and slogan, although both marks begin with the 2 letters "VS", the presence of the slogan "A secret that women love" in the Applicants' mark clearly distinguishes it from the Opponents' mark which only has the single word "SPORT" following the letters "VS". It is clear that the whole length of the Applicants' 2-letter VS mark and slogan is much longer than the Opponents' VS SPORT mark.

63 In terms of its structure, the Applicants' 2-letter mark is different in that its design is such that the letter marks are not of equal size: what the eye will first perceive is the letter "V" which is much larger in proportion to the letter "S".

64 Therefore I also find that the Opponents' VICTORIA'S SECRET and the VS SPORT marks are not visually similar to the Applicants' 2-letter VS mark and slogan.

Aural Similarity

65 There are several guiding principles in determining aural similarity such as the importance of first syllables, slurring of endings of words, and the device element in marks may not play as large a part in the comparison as words in marks “speak” louder than the devices.

Opposition against T0803761G (Valentine Secret and heart device)

66 In respect of the Opponents' mark VICTORIA'S SECRET and the Applicants' Valentine Secret and heart device these are essentially word marks which can be enunciated. There is a common element the word "secret" and an additional element, the word "lingerie", in the Applicants' mark. The difference in the marks lies in the words "Victoria's" and "Valentine" which are aurally very different, although both are 3-syllable words which begin with the same letter. The Applicants' mark also has the word "lingerie" which although a generic word, if enunciated by the customer will add to the aural difference between the marks.

67 I therefore find that the marks are not aurally similar.

Opposition against T0803762E (2-letter VS mark and slogan)

68 I do not find that the Opponents' VICTORIA'S SECRET and the Opponents' VS SPORT mark to be aurally similar to the Applicants' VS "A Secret that Women love" mark. The Opponents' VICTORIA'S SECRET mark is comprised of 2 words as opposed to the Applicants' letter mark "VS" followed by a slogan.

69 As for the Opponents' VS SPORT mark and the Applicants' VS "A Secret that Women love" mark, it is essentially a 3-syllable mark as opposed to a 9-syllable mark. The aural differences are clear.

70 I therefore find that there is no aural similarity in these marks.

Conceptual Similarity

71 The High Court in *Ferrero* at [66] states that:

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

Opposition against T0803761G (Valentine Secret and heart device)

72 Conceptually the Opponents' and the Applicants' marks share the similar word "Secret". The manner in which the word "Secret" is used and presented in the marks is that it is a person's secret (in the Opponents' mark, it is Victoria's secret) or it is a sort of secret (a valentine secret, as in the Applicants' mark). The tendency when reading the Applicants' mark is read it as "Valentine's Secret"; the idea being that it is a secret that belongs to

someone named "Valentine"; or it is a Valentine's (Day) secret. This idea appears consistent with the Applicants' brand story mentioned relating to how their mark was derived. There is therefore a strong conceptual similarity between the two marks, both evoking the idea of a secret which either belongs to a person or attaches to an event. The presence of the word "lingerie" in the Applicants mark will not detract from this conceptual similarity as it is a word that refers to the goods to which the marks are attached; and in this case, both the Opponents' and the Applicants goods are similar goods.

73 Thus I find that there is conceptual similarity in that the idea behind these two marks are similar.

Opposition against T0803762E (2-letter VS mark and slogan)

74 Although the Applicants letter mark and the Opponents' VS SPORT marks both contain 2-letters "V" and "S", the marks are not conceptually similar. The slogan in the Applicants' marks clearly sets it apart from the Opponents' mark. The Applicants' slogan "A Secret that Women Love" conveys a very different idea from that of the Opponents' "SPORT" theme.

Distinctiveness

75 The second step in the two-step approach in determining the similarity of marks as laid down in *Ozone* is the consideration of how distinctive the Opponents' marks are. The High Court in *Ferrero* at [71] states that "the factor of distinctiveness is important because it affects the question of whether marks are similar". Marks that are inherently more distinctive would generally receive better protection, for any modification of the said mark would have to be substantial before it can be said to be dissimilar to it.

76 The Opponents' earlier trade marks "VICTORIA'S SECRET" and "VS SPORT" used on items of clothing in class 25 goods are not such inherently distinctive marks that would fall within the category of marks which would be said to possess that degree of inherent distinctiveness. I do not find that the marks possess the relevant X-factor of high distinctiveness, which some invented words would have (eg. "Nutella"). The Opponents' marks are at best, moderately distinctive.

Conclusion on Similarity

77 Comparing the Applicants Trade Mark No. T0803761G and the Opponents' Mark "VICTORIA'S SECRET", I find that they are not visually or aurally similar; but are conceptually similar. With respect to the Applicants Trade Mark No. T0803762E however, I find that the mark is not visually, aurally and conceptually similar to the Opponents' Marks.

Likelihood of Confusion

78 If in the application of the three-step test in *Polo/Lauren* the similarity of marks has not made out by the Opponents, there is no need to proceed to the third step of determining likelihood of confusion. In this regard, as the Opponents have not been able to make out the

similarity of marks in respect of Trade Mark Nos.T0803762E, I will only proceed to assess whether a likelihood of confusion can arise from similarity between the marks as well as from the similarity between the goods in relation to the Opponents' VICTORIA'S SECRET mark and the Applicants' "Valentine Secret and heart device" mark.

79 In order to determine this, the Singapore Court of Appeal's case of ***Polo/Lauren Co, LP v Shop-In Department Store Pte Ltd***, provides guidance for the assessment of the likelihood of confusion. The Court of Appeal held that:

“... the question of likelihood of confusion has to be looked at globally taking into account all the circumstances including the closeness of the goods, the impression given by the marks, the possibility of imperfect recollection and the risk that the public might believe that the goods come from the same source or economically-linked sources... Steps taken by the defendant to differentiate his goods from those of the registered proprietor are also pertinent... So also is the kind of customer who would be likely to buy the goods”.

80 The Court of Appeal in ***Polo*** also held that:

“The fact that a sign is similar to a registered mark does not automatically mean that there will be likelihood of confusion on the part of the public. That is a question of fact to be determined by the court, taking into account all the relevant circumstances...Neither does it mean that if the mark and the sign are similar and they are used on similar goods that there will ipso facto be confusion in the minds of public...To determine the existence of confusion, the court is entitled to look outside the mark and the sign as well as the articles to assess whether there exists a likelihood of confusion”.

81 In order to assess the likelihood of confusion, it will also be necessary to consider other relevant surrounding circumstances, such as the nature of the goods, the nature of the industry, the price of the goods, the nature of the consumers and the respective trade channels.

82 The Applicants have not adduced any evidence of use or promotion of the goods in Singapore. In their evidence as well as in their submissions, they have unequivocally mentioned that they do not yet have a presence in Singapore and would prefer to wait until the trade marks issues have been settled before venturing to do so.

83 The Opponents too do not have a physical presence in the form of a shop front in Singapore. The Opponents however have adduced substantial evidence of use of their respective goods. The Opponents' business model in Singapore has been sales through mail order, and the orders are usually placed through telephone calls, facsimile and order forms based on items on the Internet. They have adduced evidence of their international catalogues mailed worldwide. Singapore is also on the recipient's list and the number of books mailed to Singapore from the year 2002 to 2008 totals 881,889 in number. They have also adduced

evidence of sales to customers in Singapore from the year 2003 to 2008. The year 2008 figures post an amount of USD 2,555,947-00 in sales. The evidence also shows excerpts from the catalogues and they have produced copies of their mail order only have a single invoice dated 26 November

84 The goods that the Applicants and Opponents trade in are very similar. In particular, the brochures filed by both parties indicate that they are heavily into sale of ladies' undergarments, intimate wear, sleep wear and swim wear. The Opponents' have numerous VICTORIA'S SECRET marks worldwide but also in Singapore. They have filed quite a number of registrations and applications as can be seen in their evidence and in the summary of the marks in paragraphs 20 and 21 of these grounds of decision.

85 In order to assess whether there will be likelihood of confusion, one of the matters to be assessed is how distinctive the Opponents' mark is and the degree of similarity between the Opponents' and the Applicants' marks. The Opponents' VICTORIA'S SECRET mark has been held to be moderately distinctive and the degree of distinctiveness will not clearly point to the conclusion that there can be a likelihood of confusion. However, in the assessment of the degree of similarity between the marks, the conceptual similarity between the marks might give rise to confusion, especially in light of the identity of goods and the niche area of goods the Opponents and the Applicants deal in.

86 This niche area relates to sales of women's undergarments and intimate wear. The similarity of marks can give rise to the possibility of confusion and the risk that the public might believe that the goods come from the same source or economically-linked sources. It may be argued that the Applicants have not begun selling their goods in Singapore, and that the matter is moot. The Applicants' evidence in the form of brochures however indicates that confusion could arise as the look and feel of the Opponents and Applicants brochures in relation to sale of women's undergarments and intimate wear are similar.

87 In relation to the kind of customer who would be likely to buy the goods, the Opponents have submitted that "...the Opponents' customer base in Singapore comprises a wide section of Singapore society, ranging from landed property dwellers to public Housing Development Board flat dwellers. This indicates that the Opponents' customers arguably contain a good mix of sophisticated and non-sophisticated consumers." Counsel suggests that there a possibility of confusion could arise. I am however inclined to disagree that the customers are likely to be confused. The Opponents' mail order business model from early 2000 (judging from the dates on the invoices lodged) allows customers to purchase their goods via mail order. The level of business transacted via this mail order business comes at a time where online shopping via the internet had not yet caught on; and clearly indicates that the Opponents' customers are likely to be sophisticated shoppers who know what they want, and who enjoy the convenience, the greater choices derived from mail order shopping. They would also be likely to be astute shoppers who do not want to purchase run-of-the-mill merchandise commonly found in departmental stores, preferring the more exclusive and specialised goods which are available only to the exclusive few on the Opponents' mailing list. These are the sort of customers who are not likely to be confused.

88 Taking into account all the factors and the evidence filed, I am of the view that there will be no likelihood of confusion. The ground of opposition under Section 8(2)(b) therefore fails in respect of both T0803761G and T0803762E .

Ground of Opposition under Section 8(4)

89 Section 8(4) 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

The Opponents submit that to succeed under this ground, they must first establish that the Opponents' VICTORIA'S SECRET Marks are well known in Singapore before the Opposed Mark's filing date of 24 March 2008.

90 The Opponents submit that the Opponents’ VS and VICTORIA'S SECRET Trade Marks are well known in Singapore. In the 3 years preceding the filing date of the Application, even though the Opponents do not have a physical store or distributors in Singapore, the sales achieved by the Opponents in Singapore are very impressive.

91 The Opponents submit that the use of the Application Marks in relation to the goods claimed in the Application would indicate a confusing connection between those goods and the Opponents because the Applicants have created a mark which visually looks very much like the Opponents’ “Victoria’s Secret” brand, have used the word “lingerie” and a heart device, both of which are elements incorporated into the main “Victoria’s Secret” brand. Further, the Applicants' mark contains a nine letter word starting with the letter “V” as well as the word “secret” which is a deliberate and calculated attempt by the Applicants to cause the member of the public who perceives the mark applied on the goods to immediately make a mental connection between the Opponents and the goods. The Applicants did not take steps to differentiate their goods from those of the Opponents, and have sought to create confusion in the minds of the

consumers into thinking that the goods on which the Opposed Mark is applied originates from the Opponents.

92 Where members of the public are confused into thinking that the goods sold under the Opposed Mark is connected to the Opponents, the interests of the Opponents will likely be damaged as a result of the loss of potential sales as well as damage to the reputation of the Opponents should the quality of the Applicants' goods be less than that expected of the Opponents.

93 The Opponents submit that under the Section 8(4)(b)(ii)(A) ground of opposition, there is the requirement that the earlier trade mark be well known to the public at large in Singapore, and that use of the Application Marks in relation to goods which it is sought to be registered would cause dilution in an unfair manner of the distinctive character of the VICTORIA'S SECRET and the VS Trade Marks.

94 The Opponents submit that the Opponents' VICTORIA'S SECRET and VS Trade Marks qualify to be considered to be well known to the public at large. In 2008, sales of the goods under the VS Trade Marks in Singapore were valued at US\$2,555,947. Given that clothing and lingerie are not only purchased by ladies but also by men for their partners as gifts, we submit that the VS Trade Marks are well known not only to ladies in Singapore but also men.

95 There is dilution in an unfair manner of the distinctive character of the Opponents' earlier trade mark. The term "dilution" is defined in s 2(1) of the Act and the court in *Amanresorts* at [225] states that it is clear that "dilution" in the context of the Act refers to both dilution by *blurring* and by *tarnishment*. In the *Amanresorts* case at [180], the court said that dilution by tarnishment occurs when a trade mark is used in a negative way which affects the positive associations that consumers had previously made with the mark. The Opponents submit that there is dilution by tarnishment of the Opponents' VS Trade Marks because the Applicants have not produced any specific information on the pricing of their products, the Opponents' lingerie products are pitched at a much higher price range than the Applicants', there is a clear attempt at free-riding by the Applicants on the Opponents' branding by their choice of a name "Valentine Secret" and the customers in Singapore are likely to associate the Opponents' Trade Marks or business with the images of cheaper and perhaps poorer quality goods as evoked by the Applicants' use of their marks in Singapore. .

96 The Opponents also submit that the Application must be refused under Section 8(4)(b)(ii)(B) in that the Applicants have taken unfair advantage of the distinctive character of the Opponents' earlier trade marks. *Ferrero* case at [183-186]

97 The Opponents submit that when the Opposed Mark is used on Class 25 goods, the Opponents' VICTORIA'S SECRET and VS Trade Marks will immediately be brought to the mind of the consumer perceiving the Applicants' goods. The Opponents submit that the Applicants are attempting to ride on the Opponents' coat-tails by selling identical or highly similar goods and using the highly similar name "Valentine Secret"

Applicants' Submissions

98 The Opponents' case under Section 8(4) must fail as there are no similarities between the Applicants' Marks and the Opponents' Marks and it is further submitted that the Opponents' VS monogram mark and VICTORIA'S SECRET marks are not "well known" in Singapore for the purposes of the Act.

99 In the High Court decision of *Amanresorts Ltd and another v Novelty Pte Ltd* [2008] 2 SLR(R) 32 ("*Amanresorts HC*"), Tay Yong Kwang J equated the requirements of "indicate a connection" and "likely to damage the interests of the proprietor of the earlier trade mark" with the elements of misrepresentation and damage under the tort of passing-off; which was upheld on appeal in *Amanresorts* at [234].

100 In *Amanresorts*, the Court of Appeal took the view that protection as a "*well known mark to the public at large in Singapore*" is a "coveted status" which forms a "*rare and exclusive class*". *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 ("*City Chain*") the Court of Appeal also held at [94]

101 It is submitted that the Opponents' VS Mark is not "well known" to the public at large in Singapore. With respect to the Opponents' VICTORIA'S SECRET Mark, it is submitted that this mark also does not meet the high threshold of being a mark that is "well known to the public at large". This is because the Opponents' marketing and advertising efforts are limited to a small group of persons in Singapore who receive their catalogues or visit their websites. This limited group certainly cannot form the "public at large" for the Act; and the Opponents' evidence does not have any other evidence that the Opponents' VICTORIA'S SECRET Mark is recognised by the "public at large" in Singapore. The Opponents have not even bothered to set out its marketing figures with respect to the VICTORIA'S SECRET Mark in Singapore, the number of the Opponents' products sold under the VICTORIA'S SECRET Mark in Singapore, the market situation of the Opponents' products bearing the VICTORIA'S SECRET Mark in Singapore; and the Opponents' brand recognition of the VICTORIA'S SECRET Mark.

102 On the issues of "dilution" or "unfair advantage", the Applicants cite from paragraphs 6.58 to 6.60 of the *Law of Trade Marks and Passing Off in Singapore (2nd Edition)* by Tan Tee Jim S.C. ("*Tan Tee Jim*") and Ng Loy Wee Loon's *Law of Intellectual Property of Singapore (2009)* ("*Ng-Loy*") Applying the relevant principles, it is submitted that there is no dilution by blurring of the Opponents' Marks. The Opponents have not shown how the Applicants' Marks will cause the Opponents' Marks to lose its distinctiveness. In fact, the Applicants are also seeking to use the Applicants' Marks on products which similar to that which the Opponents' Marks are applied. There is no dilution by tarnishing because the Opponents have not provided a shred of evidence that the Opponents' Marks would be tarnished by the Applicants' Marks. There is no allegation in the Grounds of Opposition or the evidence that the products/services which the Applicants intend to use the Applicants' Marks on would, degrade the reputation of positive image of the Opponents' Marks.

103 The Opponents have not taken any advantage of the Opponents' Marks. The Opponents have proffered no evidence to support a finding of an unfair advantage being taken by the Opponents. In contrast, the Applicants have explained their choice of the Applicants' Marks clearly in their evidence. The Applicants are a small business, with only one boutique in Indonesia. They have successfully built their brand in Indonesia and are now trying to grow their brand and expand their operations to Singapore. The Applicants have created their brand from scratch and their concept behind their mark is unique to them. They have invested heavily and gone to great lengths to create their brand and distinguish their products from the many other products on the market including that of the Opponents.

Decision on Section 8(4)

104 The first requirement under section 8(4) is that the whole or an essential part of the Application Mark has to be identical with or similar to the Opponents' mark. It is decided under the section 8(2) ground of opposition that the Applicants' Valentine Secret and heart device mark are similar to the Opponents' VICTORIA'S SECRET mark and as such this requirement is fulfilled.

105 I will first proceed to deal with the ground of opposition under section 8(4)(b)(i) which requires the earlier trade mark to be well known in Singapore. Following which, I will deal with the ground of opposition under section 8(4)(b)(ii) which requires the earlier trade mark to be well known to the public at large in Singapore.

Section 8(4)(b)(i)

106 Having established that the Application Mark T0803761G for the Applicants' mark for "Valentine Secret and heart device is similar to the Opponents' VICTORIA'S SECRET mark, the elements that have to be established before registration shall be refused under section 8(4)(b)(i) are:

- (a) that the Opponents' VICTORIA'S SECRET mark is well known in Singapore,
- (b) that the Applicants' use of the "Valentine Secret and heart device" mark in relation to Class 25 goods would indicate a *connection* between the Applicants' products and
- (c) the Opponents and is *likely to damage* the interests of the Opponents.

Is the Opponents' "VICTORIA'S SECRET" mark well known in Singapore?

107 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."

108 From the reading of Section 8(5), I have to assess whether the Opponents' VICTORIA'S SECRET mark was well known in Singapore as at the date of the Applicants' "Valentine Secret and heart device" mark, that is, at 24 March 2008.

109 In assessing whether a trade mark is "well known in Singapore", I will have regard to Section 2(7) which lists factors that may be considered in determining whether the mark is a well known trade mark. The Court of Appeal in *Amanresorts* at [137] has said that the factors in Section 2(7) are not an exhaustive list and 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 the factor in section 2(7)(a)) and to take additional factors into consideration. The factors are more a set of guidelines that can assist in the determination whether the mark is a well-known mark, they are not pre-conditions for reaching that determination.

110 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;

the duration, extent and geographical area of –
any use of the trade mark; or

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.

111 The Court of Appeal in *Amanusa* at [139] states that s 2(7)(a) is arguably the most crucial factor when determining whether a trade mark is well known in Singapore due to s 2(8) of the Act which states that "[w]here 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." And at [140]:

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

112 Hence, if the Opponents' VICTORIA'S SECRET mark is well known to the relevant sector of the public in Singapore, then the Opponents' "VICTORIA'S SECRET" mark shall be deemed to be well known in Singapore.

113 Section 2(9) defines the "relevant sector of the public in Singapore" in section 2(7) and 2(8) as including any of the following:

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

114 "All actual consumers and potential consumers in Singapore of the goods" has been settled in *Amanresorts* at [154] to mean "the actual consumers and potential consumers of, specifically, the [Opponents'] goods only".

115 Applying the law to the facts of this case, the relevant sector of the public would be the actual and potential consumers in Singapore of the Opponents' goods; that is to say the consumers who purchase the Opponents' goods. The question then is, at the relevant date of 24 March 2008, was the Opponents' VICTORIA'S SECRET mark well known to this "relevant sector of the public"?

116 The Opponents do not have a physical business presence, a physical shop front in Singapore. However the Opponents' evidence in terms of sales amounts to the following:

Year	Sales Amount in Singapore (US\$)
2008	2,555,947
2007	1,752,206
2006	1,312,681
2005	1,063,599
2004	1,096,839
2003	1,082,611

117 The volume of sales judging from the above is quite high. In an example given by the Opponents' Counsel, he gives a rough estimate of the likely volume of sales in terms of number of pieces of clothing sold. He submitted:

"From a quick review of the bra section on the Opponents' website www.VictoriasSecrets.com, a piece of bra can cost between US\$48-78. Panties and other clothing items often cost much less. Assuming an average per piece price of US\$78, the sales figures in 2008 represent sales per day of about 90 pieces of bra each day of the year. Such sales figures were achieved without the benefit of local stores and were transacted purely through mail order and the Opponents' website."

118 The Opponents' evidence shows the earliest order summary exhibited in their evidence is dated 22 May 2000. The number of catalogues mailed to Singapore over a period of 7 years from 2002 to 2008 amounts to 881,889 catalogues. The amount of sales to customers in Singapore doubled over a period of 6 years: in 2003 it was USD1,082,611 and in 2008 the sales figure was USD2,555,947.

119 I am satisfied that the Opponents' "VICTORIA'S SECRET" mark is well known to the relevant sector of the public who have purchased any of the Opponents' "VICTORIA'S SECRET" undergarments or intimate wear from their mail order service,. Thus, applying section 2(7)(a) read with section 2(8), the Opponents' mark is deemed well known in Singapore; since it is so deemed once I have established that the Opponents' mark is well known to the *relevant sector* of the public, being actual and potential consumers in Singapore of the Opponents' goods.

120 Considering all the factors in section 2(7), I conclude that the Opponents' "VICTORIA'S SECRET" mark is well known in Singapore. The Court of Appeal in *Amanresorts* ([229]) has said 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."

Is there a damaging connection between the Applicants' goods and the Opponents

121 The other requirements that need to be established under this ground of opposition in section 8(4)(b)(i), is whether use of the Applicants' "Valentine Secret and heart device" mark on the goods sought to be registered (Class 25 articles) would indicate a connection between the goods claimed and the Opponents and whether the interests of the Opponents are likely to be damaged as a result.

122 The term "connection" under this ground of opposition in section 8(4)(b)(i) does not mean mere connection, but a connection which is likely to give rise to confusion. The question here is whether the people in Singapore with goodwill towards [Opponents'] mark be confused into thinking that the Applicants' "Valentine Secret with the heart device " women's clothing comes from the same source as the Opponents' "VICTORIA'S SECRET" clothing?

123 Under the ground of opposition in Section 8(2)(a), the issues of similarity of marks and confusion have been considered and I have found that the Opponents' VICTORIA'S SECRET mark is similar to the Applicants' Trade Mark Nos. T0803761G, I have found no reasonable likelihood of confusion under Section 8(2)(a) in respect of the marks. I conclude therefore that the use of the Opponents' VICTORIA'S SECRET mark and the Applicants' "Valentine Secret and heart device" mark on the goods claimed does not indicate a confusing connection between those goods and the Opponents. In conclusion, there is no damaging connection as it is unlikely that the Applicants' use of

"VICTORIA'S SECRET" on articles of clothing for women would indicate a connection between the Applicants' goods and the Opponents.

Conclusion

124 Accordingly, the ground of opposition under section 8(4)(b)(i) fails.

Decision on section 8(4)(b)(ii)

125 Under this ground of opposition, the Opponents must prove the following elements:

- (a) That the Opponents' "VICTORIA'S SECRET" mark is "well known to the public at large in Singapore"
- (b) That the Applicants' "Valentine Secret and heart device" mark is similar to the Opponents' "VICTORIA'S SECRET" mark;
- (c) That the Applicants' " Valentine Secret and heart device " mark used in relation to the goods in question, being articles of clothing for women, would either:
 - (i) cause dilution in an unfair manner of the distinctive character of the Opponents' "VICTORIA'S SECRET" mark; or
 - (ii) take unfair advantage of the distinctive character of the Opponents' "VICTORIA'S SECRET" mark

Is the Opponents' "VICTORIA'S SECRET" mark well known to the public at large in Singapore?

126 The Trade Marks Act does not define what constitutes "well known to the public at large in Singapore" and case of *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 ("*City Chain* ") offers guidance as to the test that is to be used. In *City Chain*, the Court of Appeal at [94] states:

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.

127 Having considered the factors in section 2(7), I have concluded that the Opponents' "VICTORIA'S SECRET" mark is well known in Singapore. The question asked in relation to Section 8(4)(b)(ii) is whether the Opponents' mark is recognised by *most sectors* of the Singapore public? In a more recent case where "well known to the

public at large in Singapore" was considered, the High Court in *Ferrero* at [155] found the "Nutella" marks to be well known to the public at large in Singapore by virtue of its widespread use in Singapore and the results of a survey where the majority of 410 respondents surveyed affirmed that they were either familiar with or knew of the mark "Nutella" for more than 5 years. There was also evidence of the print media having featured the mark "Nutella" or making reference to the "Nutella" spread in at least twenty independent articles.

128 In this present case, Counsel for the Opponents in their submissions made allusion to television shows of some fame that had purportedly made the Opponents' VICTORIA'S SECRET well known to the public in Singapore. This unfortunately is not sworn evidence and I am not able to consider the same. Without any more evidence than invoices of sale, the number of mail-order catalogues mailed to Singapore over the period of 7 years, I am unable to conclude that the Opponents' VICTORIA'S SECRET is well known to most sectors of the public. I therefore conclude that the evidence does not show that the Opponents' "VICTORIA'S SECRET" mark is well known to the public at large in Singapore.

129 As the evidence does not show that the Opponents' "VICTORIA'S SECRET" brand is well known to the public at large, the ground of opposition under section 8(4)(b)(ii) fails and I will not need to analyse the other elements.

Conclusion

130 Accordingly, the ground of opposition under section 8(4)(b)(ii) fails.

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

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

“Relative grounds for refusal of registration

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

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

Opponents' Submissions

132 The elements of passing off have been confirmed in the English House of Lords case of *Reckitt & Colman Products Ltd v Borden Inc & Ors* [1990] 1 All ER 873.

133 The Opponents have acquired goodwill and reputation in the Opponents' VICTORIA'S SECRET and VS Trade Marks through long and continuous use in Singapore since as early as 2005 and continuous advertising and promotion of the services provided by the Opponents and the regular mailing of catalogues to Singapore based recipients. As the Opponents' Class 25 products are sold via direct orders through mail catalogues and its website, the acquired goodwill and reputation in the VICTORIA'S SECRET and VS Trade Marks is very distinct and exclusive to the Opponents.

134 If the Application is allowed registration, it is likely to cause the relevant public to be deceived into thinking that the Applicants' goods are those of the Opponents' or be misled into thinking that there is some sort of business connection between the Opponents and the Applicants when there is in fact none, given the fact both the Opponents' VS Trade Marks and the Opposed Mark contain the word "Secret" and both parties retail lingerie goods under their respective marks. The relevant public may think that the Opponents have launched another separate line of lingerie products under its Victoria's Secret family of trade marks.

135 The Opponents submit Kerly's 14th edition at paragraphs 15-192 where it states that "[i]n the common case the court must be satisfied that the defendant's conduct is calculated to pass off other goods as those of the claimant, or, at least, to produce such confusion in the minds of probable customers or purchasers or other persons with whom the claimant has business relations as would be likely to lead to the other goods being bought and sold for his".

136 A misrepresentation that the Applicants' business is those of the Opponents' is intrinsically likely to damage the Opponents if the fields of business are reasonably close. Hence, even in the absence of any proof of actual damage, damage can be presumed by virtue of the close similarities between the marks and services provided by both the Applicants and the Opponents. Wadlow on Passing off, 3rd Edition, Sweet and Maxwell 2004

Applicants' Submissions

137 The Applicants state that it is trite that in order to establish a cause of action under passing off (and thus s 8(7)(a)), the plaintiff must establish all of the following elements (*Novelty Pte Ltd v Amanresorts Ltd* [2009] 3 SLR(R) 216 ("*Amanresorts*") at [36])

138 The Applicants cite *Amanresorts* at [39], where the Court of Appeal considered Lord Macnaghten's ratio in *The Commissioners of Inland Revenue v Muller & Co's Margarine Limited* [1901] AC 217 at 223-224 ("*IRC v Muller*") as the authoritative definition of goodwill. They submit that whether or not there is goodwill attached to a name also depends on whether or not there are any actual and/or potential customers of the goods, services or business marketed under that name.

139 The Applicants further state that in *Amanresorts* [61], the Court of Appeal held that an association with a source is not "[an] attractive force which brings in custom" where the well-known good is unavailable for sale, the Court of Appeal cited the case of *Anheuser-Busch Inc v Budejovicky Budvar NP* [1984] FSR 413, which concerned the "Budweiser" beer. Although the "Budweiser" beer was widely known throughout the UK because of the plaintiff's publicity efforts and was sold in a limited number of outlets in the UK on a duty-free basis, it was not available to the general market in the UK. In view of this, the English Court of Appeal reasoned (at 464) and concluded (at 469) that there could be no goodwill in any relevant sense if the reputation was associated with a product which, for practical purposes, nobody could buy. Court of Appeal in *Amanresorts* at [62], *Star Industrial Co Ltd v Yap Kwee Kor* [1974-1976] SLR(R) 581 at [8] ("*Star Industrial*") and Court of Appeal in *CDL Hotels International Ltd v*

Pontiac Marina Pte Ltd [1998] 1 SLR(R) 975; [1998] SGCA 23. *800-Flowers Trade Mark* [2002] FSR 697 at 705

140 The Opponents do not have goodwill as the Opponents do not have a business in Singapore and their products are not generally available to the general public in Singapore. They only operated a mail order business outside of Singapore and took online purchases from customers in Singapore using a non-Singapore based website. This is an even lower level of business activity than in the “Budweiser” case where they had limited outlets in the UK selling its products. Hence, when goods are purchased by Singapore customers, these goods are in fact transacted by the Opponents’ United States business. Applying *Amanresorts* and the principles in *Star Industrial*, goodwill if any would not rest in any non-existent Singapore business but the Opponents’ business in the United States.

141 The fact that the Opponents operate a mail order business and website cannot mean that they are operating on a global basis for the purposes of trade mark law or passing law. Consideration must be had to the actual circumstances and the intent of the Opponents. In this regard, it is submitted that there is no evidence by the Opponents to suggest that they are operating in Singapore. The Opponents may have a large global presence but they do not have goodwill in Singapore. Hence, without any goodwill in Singapore, the Opponents’ claim for passing off and consequently any claim under Section 8(7), must fail.

142 There is no misrepresentation by the Applicants as there is no similarity between the marks in question and there is no likelihood of confusion from which an inference of misrepresentation can be drawn. *Volvo Trade Mark Holdings AB v Hebei Aulion Heavy Industries Co Ltd* [2011] SGIPOS 1 at [93] Even assuming that there is some similarity, the Opponents cannot show misrepresentation. The test for misrepresentation is whether a substantial portion of ordinary sensible members of the public who are probably purchasers of the goods or services of the kind in question would in fact be confused (as per *Nation Fittings (M) Sdn Bhd v Oystertec Plc* [2006] 1 SLR 712 at [168] (“*Nation Fittings*”). The target audience of the misrepresentation is also relevant. From the case of *Amanresorts* at [73] [BOA Tab 11], the Court of Appeal held 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. From the Opponents' statutory declaration, these customers would be persons who had purchased the Opponents’ products from its websites or through its mail order catalogue.

143 As the Opponents have provided no actual evidence of any evidence of confusion, the Court will have to consider whether “*the average reasonable person, with characteristics reflective of the relevant section of the public as identified under the examination of goodwill is likely to be confused by the Defendants’ misrepresentation*” as per the approach endorsed in *Amanresorts* at [80].

144 From the bare facts provided by the Opponents to support their case, it is submitted that there cannot be misrepresentation as the “relevant section of the public” are persons who must be very familiar with the Opponents’ goods as they would have to

proactively subscribe to the Opponents' catalogues and visit the Opponents' website; they are not the typical consumers but well informed consumers who are familiar with the Opponents' products and its branding strategy; and these persons will not be easily misled or confused into thinking that the Applicants' goods come from the Opponents because of the Applicants' Marks which are markedly different and contain different elements from the Opponents' Marks.

The Opponents have not pleaded the form of damage that the Opponents have suffered or proved any damage in their evidence. The proof of damage must be established as a matter of probability, not mere possibility (*Nation Fittings* at [176]) In the present case, the Opponents have not even set out a case or any evidence that shows a mere possibility of damage, much less a probability of damage.

Decision on Section 8(7)

145 The test for passing off is well established and J. Chan in the High Court in *Ferrero* sets this at [193] as follows:

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

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

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

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

The three elements in this classical trinity test that will need to be examined and determined whether each of the elements has been satisfied by the Opponents are goodwill, misrepresentation and damage.

Goodwill

The Court of Appeal in *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 ("*Amanresorts*") at [39] describes goodwill as follows:

Like that other great force of attraction which we call "love", "goodwill" is ephemeral and hard to define. To date, Lord Macnaghten's speech in *The Commissioners of Inland Revenue v Muller & Co's Margarine, Limited* [1901] AC 217 ("*IRC v Muller & Co*") at 223-224 remains, in our view, the clearest exposition of what goodwill is:

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.

The above passage highlights two essential features of goodwill. First, it is the association of a good, service or business on which the plaintiff's mark, name, labelling, etc (referred to generically as the plaintiff's "get-up") has been applied with a particular source. Second, this association is an "attractive force which brings in custom" (id at 224).

146 From the above, it is clear that goodwill is the association of a business on which the Opponents' mark or brand name ("VICTORIA'S SECRET") has been applied with a particular source and this association is an "attractive force which brings in custom". The source in question here is the Opponents, that is, Victoria's Secret Stores Brand Management, Inc. It is also clear that goodwill has to attach to a business that is within a particular jurisdiction, in this case, in Singapore. The Privy Council in *Star Industrial Co Ltd v Yap Kwee Kor* [1975-1977] SLR 20, states 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*.

[emphasis mine]

147 In this case, the Opponents have no physical presence in Singapore and operate on a business model where sales are generated via a mail-order system. Customers deal with the Opponents via this mode. It is difficult to conclude therefore that the goodwill in the mark, "VICTORIA'S SECRET" is attached to a business in Singapore. Therefore, the first element of goodwill for passing off is not established.

Misrepresentation and Damage

148 As the first element of goodwill has not been established, I will not have to deal with the other elements of misrepresentation and damage. In any event, with respect to misrepresentation, I have earlier found under Section 8(2)(b) that there is no confusing similarity between the Applicants' mark and the Opponents' Mark. Applying similar reasoning, I find that there is no misrepresentation by the Applicants leading or likely to lead the public to believe that the goods offered by them are the goods of the Opponents. Once the Opponents have failed to prove misrepresentation that gives rise to a likelihood of confusion, and it is not likely that there will be either actual damage or a likelihood of damage.

Conclusion

149 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that:

- a. the opposition in respect of T0803761G fails on all grounds. Accordingly, the Application Mark no. T0803761G shall proceed to registration; and
- b. the opposition in respect of T0803762E also fails on all grounds. Application Mark no. T0803762E shall proceed to registration.

The Applicants are entitled to costs to be taxed, if not agreed.

Dated this 29th day of May 2012

Anne Loo

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