

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

Trade Mark Application No. T1002212E
22 August 2012

IN THE MATTER OF A TRADE MARK APPLICATION BY

BRITISH AMERICAN TOBACCO (BRANDS) INC

AND

OPPOSITION THERETO BY

PHILIP MORRIS PRODUCTS S.A.

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

Mr Foo Maw Jiun with Mr Bernard Chua (Rodyk & Davidson LLP) for the Applicants

Ms Lim Hui Nan with Ms Elaine Tan (Amica Law LLC) for the Opponents

Cur Adv Vult

GROUND OF DECISION

1 British American Tobacco (Brands) Inc (“the Applicants”), applied to register the following trade mark:



(“the Application Mark”)

in Singapore on 23 February 2010 under Trade Mark No. T1002212E in Class 34 in respect of “Cigarettes; tobacco; tobacco products; lighters; matches; smokers' articles” (“the Goods”).

2 The application was accepted and published on 7 May 2010 for opposition purposes. Philip Morris Products S.A. (“the Opponents”) filed their Notice of Opposition to oppose the registration of the Application Mark on 7 July 2010. The Applicants filed their Counter-Statement on 6 September 2010.

3 The Opponents filed evidence in support of the opposition on 4 May 2011. The Applicants filed evidence in support of the application on 4 November 2011. The Opponents filed evidence in reply on 2 March 2012. The Case Management Conference was held on 9 May 2012, after which the opposition was heard on 22 August 2012.

Grounds of Opposition

4 The Opponents rely on Sections 7(1)(a), 7(1)(b), 7(1)(c) and 7(1)(d) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”) in this opposition.

Opponents’ Evidence

5 The Opponents’ evidence comprises a Statutory Declaration made by Maria del Mar Oliva Galvan, Senior Counsel of Philip Morris International Management S.A., on 19 April 2011 in Switzerland; a Statutory Declaration made by Peng Jiaen Joshua, Senior Investigator of Commercial Investigations LLP, on 18 April 2011 in Singapore as well as a Statutory Declaration in Reply made by Viorica Zorita Pop, who handles trade mark matters, under the employment of Philip Morris International Management S.A., on 27 February 2012 in Switzerland.

Applicants’ Evidence

6 The Applicants’ evidence comprises a Statutory Declaration made by Stuart Paul Aitchison, Authorised Attorney of the Opponents, on 28 October 2011 in England.

7 The Applicants also tendered evidence in the form of a cigarette with its cross-section exposed at the hearing. This was admitted in evidence with no objection from the Opponents.

Applicable Law and Burden of Proof

8 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

9 Both the Opponents and Applicants are among the largest tobacco companies in the world, respectively owning the Marlboro and Lucky Strike tobacco brands, which are among others in their stables of brands.

10 It is discernible from the Opponents' submissions that the underlying concerns of this opposition pertain to the freedom of tobacco manufacturers to use the stylistic device of concentric circles in their cigarette packaging without fear of infringement.

MAIN DECISION

Ground of Opposition under Section 7(1)(a)

11 Section 7(1)(a) of the Act reads:

7. —(1) The following shall not be registered:
(a) signs which do not satisfy the definition of a trade mark in section 2(1);

12 The definition of a "trade mark" in Section 2(1) is:

any sign capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person.

Opponents' Submissions

13 The Opponents rely on *Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd* [2009] 2 SLR(R) 814 ("*Wing Joo Loong*") for the requisite test under this ground of opposition.

14 The Opponents' arguments under this ground are two-pronged and centre on the criteria for "capacity to distinguish".

15 First, they submit that the Application Mark comprises solely of a pictorial representation of a cigarette, particularly the mere shape of a cigarette's cross-section or when a cigarette is viewed from the tip. There is also no addition whatsoever to this mere pictorial representation of a cigarette, which is the shape of all cigarettes as manufactured by other traders in the tobacco industry, that makes the Application Mark capable of distinguishing the Applicants' cigarettes from those sold by other traders. Particularly, the white circle in the Application Mark depicts the white paper encasing the tobacco, which is in turn denoted by the black circle in the Application Mark. Just as "*a sign taking the form of a picture of cordyceps is not likely to have the capacity to distinguish*" one trader's cordyceps from those of other traders as was recognised by the Court of Appeal in *Wing Joo Loong* at [100], and a sign being a two-dimensional drawings of pipe fittings is not capable of distinguishing one trader's pipe fittings from the others (as in *Nation Fittings (M) Sdn Bhd v Oystertec plc and another suit* [2006] 1 SLR(R) 712 ("*Nation Fittings*") at [136]), a

sign taking the form of a pictorial representation of a cigarette cross-section is similarly not likely to have the capacity to distinguish one trader's cigarette products from those of other traders in the industry.

16 Second, the Opponents submit that the Application Mark is not capable of distinguishing the Goods as it is a mere geometric shape with no distinguishing feature. As a device merely comprising concentric circles, the Application Mark is incapable of distinguishing one trader's goods from another because it is common for simple geometric shapes to be used as mere borders or outlines in trade marks.

17 The Opponents have successfully opposed the registration of the Application Mark in Thailand and, more importantly, another Commonwealth country, New Zealand. It was submitted that the New Zealand decision is of particular significance as the trade mark laws are similar to Singapore's, particularly in relation to the assessment of inherent distinctiveness of a mark.

Applicants' Submissions

18 The Applicants' position is that the Application Mark satisfies both criteria in the definition of a "trade mark" under Section 2(1). The Application Mark is capable of being represented graphically (which the Opponents do not dispute). It is also capable of distinguishing the Goods from those of other traders.

19 Like the Opponents, the Applicants refer to the Court of Appeal decision in **Wing Joo Loong** for the test to apply to determine "capacity to distinguish" under Section 7(1)(a) of the Act.

20 The Applicants contend that the Application Mark is not as simplistic as the Opponents make it out to be. The variations in width of the four concentric circles, contrast in the shades of black, grey and white of the concentric circles and the inner central disc, as well as the graduated colour effect found on the innermost central disc and third concentric circle, were deliberately created and designed as part of the features which make the Application Mark unique and distinctive. The Application Mark does not resemble the cross-section of a cigarette, the latter comprising only one circular outline.

21 Further, the Applicants point out that their Application Mark has been accepted for registration in over 47 countries, including jurisdictions where the registrability criteria is similar to Singapore's, such as the United Kingdom and the European Community.

22 The Applicants cited examples of trade marks primarily consisting of circles which have been registered by the Registrar of Trade Marks in Class 34 as well as in other classes in Singapore. They conclude that the Application Mark should not be refused on the basis that it is non-distinctive and not a trade mark because it comprises primarily of concentric circles.

Decision on Section 7(1)(a)

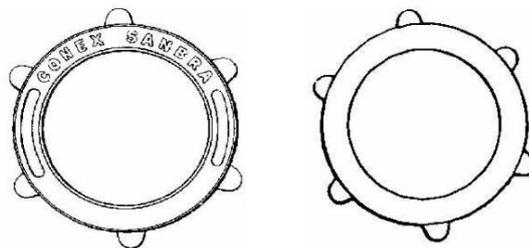
23 As there is no dispute that the Application Mark is "capable of being represented graphically", the outstanding issue under this ground of opposition pertains to "capacity to distinguish".

24 The test for "capacity to distinguish" to be applied under Section 7(1)(a) is undisputed between the parties, having regard to the Court of Appeal decision in **Wing Joo Loong** at [96] to [97]:

96 ... the requirement encapsulated in the expression "capable of distinguishing" in the definition of a "trade mark" in s 2(1) of the current TMA is a *threshold* requirement, and appear to accord with the view of Andrew Phang Boon Leong J in *Nation Fittings (M) Sdn Bhd v Oystertec Plc* [2006] 1 SLR(R) 712 ("*Nation Fittings*"), where he stated that the "capable of distinguishing" requirement stipulated in s 2(1) was a "relatively low *threshold criterion*" [emphasis added] (at [136]). Such an analysis is also consistent with the thesis of the learned author of Ng-Loy's *Intellectual Property* ([52] *supra*), who states (at para 21.3.5) that there are three thresholds of distinctiveness *vis-à-vis* trade marks, with the *first threshold* being found in the statutory definition of "trade mark" itself (specifically, in the requirement that a mark or sign must have the requisite capacity to distinguish before it can constitute a "trade mark" as defined in s 2(1) of the current TMA (see the passage reproduced at [84] above))...

97 ... for the purposes of assessing whether a sign or mark satisfies the definition of a "trade mark" as required by s7(1)(a) of the current TMA, the capacity to distinguish of that sign or mark must arise from the inherent features or characteristics of the sign or mark itself, and must not be the result of the use of it...

25 The Opponents refer to the High Court decision in **Nation Fittings**, where invalidation of two registrations were sought under Section 7(1)(a). The two trade marks consisted of two-dimensional drawings of pipe fittings in a simple plan view:



and were registered in Class 6 in respect of "pipe fittings".

26 The learned Andrew Phang J (as he then was) found that the above marks did not "*pass even the relatively low threshold criterion set out in the definition of a trade mark in s2(1)*" of the Act.

27 In **Wing Joo Loong** at [100], the Court of Appeal opined that "*A sign consisting of the word 'cordyceps' or a sign taking the form of a picture of cordyceps is not likely*

to have the capacity to distinguish" and found that "In contrast, the Rooster sign, looked at on its own, is conspicuously capable of distinguishing one trader's cordyceps from other traders' cordyceps".

28 In the present case, I consider whether the Application Mark, in respect of the Goods, is in the same category as the marks in *Nation Fittings* in respect of "pipe fittings" and as the Court of Appeal's example of "a sign taking the form of a picture of cordyceps" in respect of cordyceps, such as to fall short of being a trade mark as defined in Section 2(1).

29 The inherent features of the Application Mark are concentric circles represented in a particular form. The Application Mark does not, at first impression, look like the cross-section of a cigarette, though the Opponents submit otherwise. In contrast, there is a direct and immediate correlation between the marks in *Nation Fittings* and pipe fittings; and between a picture of cordyceps and the intended goods, cordyceps. In the latter two instances, the features and characteristics of the marks are highly representative of the goods they are meant to identify – the more a mark is so, "the less likely will it be found to be 'capable of distinguishing' those goods and services dealt with or provided in the course of trade by a trader from another because the mark is becoming more and more synonymous with the goods it is meant to distinguish", *Love & Co Pte Ltd v The Carat Club Pte Ltd* [2009] 1 SLR(R) 561 ("*Love & Co*") at [42].

30 The Application Mark is, therefore, not in the same category as the examples above.

31 With regard to the Opponents' second argument that the Application Mark is not capable of distinguishing the Goods as it is a mere geometric shape with no distinguishing feature, I would be slow to accept this proposition under Section 7(1)(a) – though the point on circles will arise for consideration again under Section 7(1)(b). First, I do not accept that the Application Mark is a "mere geometric shape" – it comprises concentric circles represented in a particular form. To my mind, a "mere geometric shape" would be, for example, a simple, plain, single-lined circle with no other feature. Second, it is theoretically possible that certain signs comprising geometric shapes or features may do the job of distinguishing the goods or services of a trader from those of others (though it may take substantial evidence of use to demonstrate thus).

32 Thus, I am persuaded that the Application Mark is minimally able to distinguish (in the sense that it is not incapable of distinguishing) the Goods of the Applicants from those of other traders.

33 The ground of opposition under Section 7(1)(a) therefore fails.

Ground of Opposition under Section 7(1)(b)

34 Section 7(1)(b) of the Act reads:

7. —(1) The following shall not be registered:
 - (b) trade marks which are devoid of any distinctive character;

Opponents' Submissions

35 The Opponents submit that a trade mark's distinctiveness must be assessed by reference to (1) the goods or services in respect of which registration is sought; and (2) the perception of the relevant persons, namely the consumers of the goods or services, who are reasonably well informed and reasonably observant and circumspect. In considering the perception of the relevant customers, the market place and environment are relevant.

36 In view of the mechanism of sale in Singapore and the mandatory health warning requirement, the average consumer would rely more on the aural cues (such as the brand names of the cigarette) in asking for the particular tobacco product which he wishes to purchase. Even where the pictorial device forms the dominant element of a trade mark, it would be extremely rare for a consumer to describe the product by its pictorial element because the description of a device is a much more difficult task as compared to the relatively easy articulation of the word element/brand name.

37 Hence, in assessing the distinctive character of the Application Mark in the context of the market place and environment of the tobacco industry, the assessment should be made in the context of such a highly regulated market place where advertising and promotion are strictly prohibited and where, given the mechanism of sale in Singapore, the significance of verbalising a mark (word or device) has a major impact in a sign's ability to perform its function of indicating trade origin. There is also little opportunity to educate the average consumers of the trade mark significance in such concentric circle devices due to the prohibition against advertising and promotion of tobacco products.

38 Further, concentric circle devices are commonly used by other traders as decorative borders to "frame" their respective brands or as decorative motifs adorning their cigarette packs, and the average consumers are unlikely to perceive or understand that such concentric circle devices on their own as being used as trade marks.

Applicants' Submissions

39 For this ground of opposition, the Applicants repeat their submissions made under Section 7(1)(a) of the Act.

Decision on Section 7(1)(b)

40 In *Nutricia International B.V. v Societe Des Produits Nestle S.A.* [2009] SGIPOS 6 ("*Nutricia*"), the Principal Assistant Registrar set out the test under Section 7(1)(b) at [20] as follows:

In the High Court decision of "*the Love case*" (at [53]), Chan Seng Onn J enunciated the test as such, "The object of the assessment for "inherent distinctiveness" in relation to ss7(1)(b), 7(1)(c) and 7(1)(d) is to determine whether the trade mark has *intrinsic or inherent features or characteristics* that are sufficiently unique to enable the intended mark to *immediately*

function (and not potentially function in the future through subsequent use by the promoter of the mark) as a readily obvious and reliable badge of origin in the eyes of the average discerning consumer when it is used in relation to the particular trader's goods or services to differentiate that trader's goods or services from those originating from other traders, who are operating in the same market place and environment in which that trade mark is supposed to function. If such intrinsic or inherent features or characteristics exist, then the trade mark escapes the objection to registration in ss7(1)(b), 7(1)(c) and 7(1)(d) because it will then have an "inherent distinctive character". I re-emphasise that the assessment is made by examining the trade mark and its meaning (if any) **absent any consideration of its use, promotion or marketing by the promoter of the trade mark**, as will be reasonably perceived and understood at the relevant date by the average discerning consumer of that category of goods or services in the market place and environment that exists again as at the relevant date." Chan Seng Onn J also went on to quote the test as enunciated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 at 306, "**What does devoid of any distinctive character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark?**"

41 On the point of use, *Love & Co, Nutricia* and *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 ("*British Sugar*") bear out that while the use of the mark in issue is not taken into consideration here, the marketplace and environment for the category of goods on which the mark is used or to be used is germane to the inquiry.

42 In the present case, the average consumer of the Goods would be a member of the smoker population in Singapore, who can reasonably be presumed to be discerning of cigarette brands.

43 I am to consider whether the Application Mark would "*immediately function ... as a readily obvious and reliable badge of origin in the eyes of the average discerning*" smoker in Singapore. Conversely, is the Application Mark the sort of mark "*which cannot do the job of distinguishing without first educating the public that it is a trade mark?*"

44 In *Love & Co*, the High Court also considered, at [54], whether the "distinctive character" of the mark in question "*can be drowned by the distractions and the 'din and noise' in the market place*" of the relevant trade in Singapore.

45 From the perspective of other traders, I am also to consider whether "*other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods*", *W & G du Cros Ltd's Application* 30 RPC 660, 672.

46 These various considerations dovetail cleanly towards my finding under this ground of opposition.

47 The Opponents' evidence discloses a huge number of images of cigarette packs containing circle devices and/or concentric circle devices. While these images are drawn from an independent third party website www.cigarettespedia.com and do not specifically pertain to the state of the marketplace in Singapore, the Applicants have not objected to the evidence as such. I am also prepared to use the evidence in my consideration of the state of the tobacco marketplace. The images of cigarette packs tendered in evidence demonstrate a wide range of provenance, spanning the US, Europe, South America, Middle East, China, Indonesia and other origins. Thus, I am prepared to consider this compilation representative of the state of the tobacco marketplace in general (representing that there is a very large number of cigarette packs from different tobacco manufacturers that use circles and or concentric circles in their design), and indicative of the tobacco marketplace in Singapore. It is not the Applicants' position that the state of the tobacco marketplace in Singapore differs in any significant respect from that demonstrated by the Opponents' voluminous compilation of cigarette packs. Instead the Applicants sought to distinguish the Application Mark from the circle and/or concentric circles used on the cigarette packs, on the premise that all these signs are distinguishable from each other and can all co-exist, to bolster their submission that the Application Mark is not devoid of any distinctive character.

48 From the above evidence, it is apparent that many tobacco manufacturers use circles and concentric circles on their cigarette packs as design features. The question arises whether a sign can in principle perform dual functions of heightening aesthetic appeal as a design feature and of signalling to the prospective purchaser that the goods in issue emanate from a particular source (that is, function as "*a readily obvious and reliable badge of origin*"). I would think so, and several trade marks unrelated to the present case readily come to mind.

49 In the present case, the Opponents' evidence discloses that when tobacco manufacturers use circles and concentric circles on their cigarette packs, they almost always use such circles as a border element to frame a visual element (such as a crown; a crest; a rider on a horse) and/or a word or numerical element (such as "BMW"; "Brunette"; "CT"; "22"; "77"; "111"). A notable exception to this use of circles and concentric circles as borders is when a device of concentric circles is depicted in colour as a target with a bull's eye in the centre. Incidentally, the name of that brand of cigarettes is "TARGET". I do not think there arises any issue of non-distinctiveness in the latter context as the target device is directly linked to the meaning of the brand.

50 In the main, however, circles and concentric circles are used by many tobacco manufacturers as border elements framing visual, word or numerical elements in the cigarette pack design. The elements of the cigarette pack design that serve as badges of origin are, practically, the words or numbers that denote the brand of cigarettes (which may be positioned within or above the circles), together with, at times, the visual element enclosed by the circular border.

51 Hence, while in principle a sign could perform dual functions as an aesthetic feature and as a badge of origin, in light of the evidence on the way many tobacco manufacturers use circles and concentric circles on their cigarette packaging, one is

inclined to infer that these circles and concentric circles mostly function as aesthetic design features and not as badges of origin as well.

52 The Application Mark comprises a series of concentric circles of certain proportions in width to each other. To be specific, the Applicants' evidence details that the second circle is approximately twice the width of the first, innermost circle; and the third circle is approximately twice the width of the second circle. There is also a fourth, outermost circle whose width is not described but, as perceived from the representation of the Application Mark, is about the width of the first, innermost circle. There are also details on the relative darkness and lightness of the circles and centre disc, as seen below:



53 The parties have argued at length the significance of the gradation in the centre disc and the third circle. However, the point is not pivotal in my decision here. Viewing the Application Mark holistically as it would be fairly and notionally used on a cigarette pack, I think that it is similar in concept (from the buyer's perspective) to the concentric circles used by many tobacco manufacturers as border designs (framing words, numbers or pictures) on their cigarette packaging.

54 The Application Mark is filed in black and white, meaning that it can be used in any colour or combination of colours and no particular colour combination is claimed. This tilts the balance against a finding of distinctiveness, as the Applicants cannot claim that the colour combination is a distinguishing feature of the Application Mark. Without a consistent and specific colour combination, it is rather more difficult to establish that the Application Mark is anything more than a design feature that does not denote the Goods of the Applicants specifically. In this case, on the balance, the same inference drawn at [51] above applies to the Application Mark, that it functions as an aesthetic design feature and not as a badge of origin as well.

55 The paraphrased question, whether the Application Mark is the sort of mark "*which cannot do the job of distinguishing without first educating the public that it is a trade mark*", should be answered in the affirmative. The smoker population which has been exposed to a tableau of cigarette packs at the point of sale is likely to perceive a device of concentric circles as a design feature without any meaning. There are also "*distractions and the 'din and noise' in the market place*", such as the constant bombarding on the buyer's perception by tobacco manufacturers with similar circles and concentric circles functioning as borders and frames; and the consistent use of other verbal, numerical or pictorial elements by tobacco manufacturers on their cigarette packaging, which overshadow the concentric circles (framing these words, numbers or pictures) in terms of impact on the average discerning smoker. Thus, it would take some education before the average discerning smoker is able to perceive the Application Mark as a trade mark.

56 The Applicants have gone to great lengths to detail why the Application Mark is distinctive and not just an ordinary set of concentric circles. However, with "*the distractions and the 'din and noise' in the market place*", and with words, pictures and

circles all squeezed onto a small area of the cigarette pack which already mandatorily carries a health warning and a picture showing the physical consequences to the human body of smoking, I do not think the average cigarette purchaser will pay much attention to the minutiae of the Application Mark and think that it significantly differs from the circular borders used on other cigarette packs as mere design features.

57 The reference to the mandatory health warning and picture on cigarette packs sold in Singapore reminds one that the tobacco marketplace is highly regulated. The Opponents point out that tobacco advertising and promotion are strictly prohibited and the means of sale of cigarettes in Singapore is closely prescribed. It is a term of the tobacco retail licence issued by the Health Sciences Authority that customers do not have direct access to the tobacco products. Additionally, the showcase displaying the cigarettes must be placed in only one show area, either behind, on or above the sales counter where the cigarettes are sold. Therefore, the average discerning smoker is required to articulate the brand of cigarettes he wishes to purchase to the salesperson. It is trite to say that marks speak in words. All the more in the tobacco marketplace where the retail mechanism is controlled, the brand of the cigarettes as spoken aurally will be prominent in the minds of the average discerning smoker. As expressed in the Principal Assistant Registrar's decision in *N.V. Sumatra Tobacco Trading Company v British American Tobacco (Brands) Inc* [2008] SGIPOS 2 at [58], "*In view of the mechanism of purchase and the mandatory health warning, the visual cues of the cigarette packet are not as important as the aural cues*". Thus, again, it is more likely than not that the smoker population purchasing cigarettes would perceive the Application Mark as a design feature and not as a badge of origin. This is not to say that visual elements on a cigarette pack can never be registered as trade marks just because visual cues are not as important as aural cues. Neither is it the case that devices containing circles or concentric circles can never be registered as trade marks. It is simply that in the present factual matrix, the black-and-white Application Mark as sought to be registered in respect of the Goods, in the light of all the foregoing circumstances, is the sort of mark "*which cannot do the job of distinguishing*" without prior education of the purchasing public.

58 From another perspective, that of other traders', the Opponents' evidence also shows that "*other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods*". Numerous tobacco manufacturers use circles and concentric circle devices as part of their cigarette pack design, and these co-exist together in the tobacco marketplace because in themselves, they are not distinctive. There is no issue raised of tobacco manufacturers using something that they are not entitled to in this context.

59 The Applicants have referred me to other trade marks registered in Singapore in Class 34, the relevant class in the present case, that consist of circles. It necessitates me to state that the objection is not against circles or even concentric circles *as a matter of principle*. Each of the earlier registered marks cited by the Applicants comprises different stylistic features (for example, circle with asterisk; circle with arrowhead / triangle; elided circles within one circle; concentric circles with broken circumferences forming a "X" sign) and each was assessed and accepted under different circumstances (for example, advertised before acceptance). In assessing the registrability of the Application Mark in this opposition, I did not have any pre-

conceived notion that circles and concentric circles are not inherently registrable. What I had regard to, as required under Section 7(1)(b), are the marketplace and environment for the Goods in respect of which registration of the Application Mark is sought, and the perception of the average consumer of the Goods, who is reasonably discerning of cigarette brands.

60 I should also add that the fact that the Registrar accepted the Application Mark after the standard examination process does not preclude the Registrar from reassessing the registrability of the same mark under an opposition procedure, and coming to a different conclusion. The material before the Registrar is different at examination and during opposition. Because an opposition is an *inter partes* procedure, there is always the possibility that the opposing party adduces evidence that would not have been before the Registrar at the earlier examination stage, which is *ex parte* in nature.

61 The Applicants have also referred me to trade marks registered in other classes in Singapore. However, as a consideration under Section 7(1)(b) must take into account the goods in respect of which the trade mark is claimed, trade marks registered in other classes in respect of different categories of goods than the present Goods do not provide guidance.

62 The Applicants also rely on their United Kingdom and European Community registrations for the same Application Mark in support. While the registrability criteria may be similar across these jurisdictions and ours, there could still be differences in their application. Hence, these precedents are persuasive at best. The Registrar cannot register the Application Mark as a matter of course once it is registered in the United Kingdom and the European Community but must determine its registrability in light of evidence before him. In any case, the circumstances of each registration, of which we are not aware, could differ. For example, it is not known whether the examining authority in the United Kingdom and the European Community had access to evidence such as that adduced by the Opponents in the present case, demonstrating that numerous tobacco manufacturers use devices of circles and concentric circles to frame words, numbers or pictures as part of the cigarette pack design.

63 For the reasons aforesaid, the ground of opposition under Section 7(1)(b) succeeds.

Ground of Opposition under Section 7(1)(c)

64 Section 7(1)(c) of the Act reads:

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

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services;

Opponents' Submissions

65 The Opponents submit that there are already traders apart from the Applicants who have used concentric circles of similar proportions to denote a cigarette's cross-section. This shows that concentric circles that are similar in design to the Application Mark are capable of being used for the purposes of representing cigarettes.

66 It is also common ground that a device may lack distinctiveness if it is common to the trade or descriptive of the goods and services in question. A visual mark depicting items which are either the goods applied for or goods which are to be used with them may therefore be refused registration under this sub-section. Some examples of devices that are unregistrable as a result are grapes and vine leaves for wine, flowers for perfumery, pine trees for deodorizers, cats and dogs for pet food, lightning flashes for electrical apparatus, stars for alcoholic drinks, orchard scenes for fruit, clothed models for clothing, women's heads for beauty products, chevrons for certain food products (labels in this shape being commonly applied to bottle necks), devices of ingots in respect of joss paper, where it is a practice by the Chinese community to fold joss paper into, *inter alia*, the shape of an ingot.

67 Additionally, even if the tobacco industry has not used a sign comprising the cross-section of a cigarette in a descriptive or functional manner, which is not admitted, it is reasonably foreseeable that the traders will use such a sign in time or should have the right to do so without obstacles.

68 As the Application Mark depicts the cross-section of a cigarette, or is reasonably likely to be used in such a descriptive fashion (in view of such existing use in trade), the Opponents submit the Application Mark is not registrable under Section 7(1)(c) as such.

Applicants' Submissions

69 The Applicants deny that the Application Mark resembles the cross-section of a cigarette.

70 They point out that the Application Mark consists of four concentric circles and an inner central disc, while the cross-section of a cigarette has only one circle (formed by the white paper encasing the crushed tobacco). The Application Mark also contains a contrasting gradation in shades of white and black to create a design/pattern unique to the Applicants, while the centre of the cross-section of a cigarette consists of a distinctive pattern of crushed tobacco leaves.

Decision on Section 7(1)(c)

71 In *Love & Co* at [70], the High Court considered the rationale behind Section 7(1)(c) as follows:

... The purpose of this ground of objection is to prevent the registration of signs which are descriptive of the goods or some characteristic of them. These descriptive marks are excluded from registration because they consist of signs

or indications which honest traders either use or may wish to use without any improper motive

72 The High Court decision of *Cheng Kang Pte Ltd and others v Sze Jishian (a firm)* [1992] 1 SLR(R) 716 ("*Cheng Kang*") made clear that "*a description may be in words or by picture*", see [64]. Hence, the Opponents' contention that the Application Mark is descriptive of the Goods, being a representation of the cross-section of a cigarette, is not immediately untenable on this basis.

73 In *Cheng Kang*, the High Court dealt with the issue of descriptiveness of a trade mark, albeit under the old Trade Marks Act of 1985. Nevertheless, it is helpful to note the findings. The trade mark in issue is a two-dimensional representation of an ingot, a hoof-shaped unit of silver or gold used as currency in China historically (called "*yuan bao*"). This trade mark was registered in respect of joss paper. The proprietor's evidence was that "*yuan bao*" commonly referred to joss paper and sometimes, it may mean a particular type of joss paper. There was undisputed evidence that one of the ways of folding joss paper is in the form of "*yuan bao*". It was held at [67] that the mark is "*not inherently adapted to distinguish their product*" and at [69] that "*the design of the mark is no more than a sketch of the typical 'yuan bao' and is most certainly common to the trade*".

74 In the UK decision of *O2 Holdings Ltd's Trade Mark Application* [2011] RPC 22 ("*O2 Holdings*"), the trade mark in issue was a two-dimensional stylised representation of a SIM card. The Appointed Person rejected the Applicant's submission that it is a stylised, minimalist but nonetheless distinctive representation of a SIM card, registrable for all goods and services. One of his reasons given at [17] was: "*the mark represents an immediately recognisable way, albeit not the only way, in which SIM cards are presented to the public. It is the outline of a SIM card as it appears in ordinary sale.*" Hence, the trade mark was held to be "*unregistrable in respect of goods and services which either used or were likely to involve the use of a SIM card. Among these goods and services are SIM cards themselves and SIM-only mobile telephone services*", see [100].

75 I am persuaded that there are certain marks that indeed steer too close to the goods or the characteristics of the goods in respect of which their registration is sought. Such marks, exemplified in the above two decisions, should not be registered and conferred the attendant monopoly rights to the exclusion of other traders who may legitimately wish to depict their goods in the same or similar fashion.

76 However, I do not think the Application Mark is such a mark. It does not, to borrow the words of the Appointed Person in *O2 Holdings*, represent "*an immediately recognisable way*" in which the Goods (cigarettes in particular) are presented to the public. Even giving room for stylisation, I agree with the Assistant Commissioner of Trade Marks in the New Zealand decision *British American Tobacco (Brands) Inc. v Philip Morris Products* [2012] NZIPOTM 20 ("*New Zealand decision*") – which incidentally deals with the same mark and the same parties – at [39] that to say the Application Mark represents the cross-section of a cigarette "*would be a particularly strained meaning to give the opposed mark in the absence of pictorial context*". I do not think the Application Mark describes anything about the Goods. Otherwise

concluding that the Application Mark is the cross-section of a cigarette is a couple of steps too far removed.

77 As the Opponents have not established that the Application Mark consists exclusively of signs or indications which may serve, in trade, to designate the kind or other characteristics of the Goods, the ground of opposition under Section 7(1)(c) fails.

Ground of Opposition under Section 7(1)(d)

78 Section 7(1)(d) of the Act reads:

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

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

Opponents' Submissions

79 The Opponents submit that the generic nature of the Application Mark and its inherent unregistrability due to its customary use in the trade is demonstrated by the fact that :

- (1) there are many trade mark registrations by third party proprietors incorporating circles and/or concentric circles devices in their marks; and
- (2) there are many cigarette packs offered by third party traders in the market which contain circle devices and/or concentric circle devices.

80 In support of the above proposition, the Opponents refer to the Statutory Declaration made by Maria del Mar Oliva Galvan, Exhibits B and C. These comprise trade mark details of marks containing circle devices and/or concentric circle devices in Class 34 as well as images of cigarette packs containing circle devices and/or concentric circle devices.

81 Accordingly, the Opponents conclude that such concentric circle devices are customary in the bona fide and established practices of the trade.

82 The Opponents point out that the majority of these third party proprietors and traders (whose marks and cigarette labels were tendered in evidence) incorporated concentric circle devices as decorative borders for their brands, i.e. use in a non-trade mark sense. Likewise the Applicants' evidence of use in support of the Application Mark, which shows the words "LUCKY STRIKE" framed by concentric circles.

83 To the Applicants' argument that the Application Mark and the marks and cigarette labels tendered in evidence by the Opponents are all distinctive and distinguishable from each other such that the Application Mark is not customary in the trade, the Opponents respond that the incorporation of other distinctive device or word elements in the marks and cigarette labels exhibited reaffirms the non-

distinctive nature of the concentric circle devices in them. Some the marks contain specific colour combinations (such as red and gold; blue and green) which are features of the marks but the black and white of the Application Mark are not.

Applicants' Submissions

84 The Applicants submit that the Application Mark consists of many stylistic and unique elements. The selection and use of concentric circles of specific widths, shades of grey, the gradation of the central disc and the size and position of the central disc itself, creates the image of a stylised bull's eye. This differentiates the Application Mark from the registered marks and cigarette labels exhibited by the Opponents. These stylistic and unique elements make the Application Mark capable of distinguishing the goods of the Applicants from the goods of others. Further, the Applicants point out that since the Application Mark is more than just circles or concentric circles, its registration will not deprive other traders from using circles or concentric circles.

85 Just as other traders have differentiated their marks containing circle devices such that each is distinguishable from the others, the Applicants' position is that the Application Mark is sufficiently differentiated such as not to be customary of the trade.

Decision on Section 7(1)(d)

86 The provision under Section 7(1)(d) addresses trade marks which consist exclusively of signs or indications that have become customary in the current language or in the bona fide and established practices of the trade. Since the Application Mark is a device mark with no word element, the latter consideration, whether it has "*become customary ... in the bona fide and established practices of the trade*" is more pertinent. The parties' submissions have proceeded along these lines.

87 In *Nutricia*, the Principal Assistant Registrar stated at [43] to [44]:

43 In *Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd and Another and Another Appeal* [2009] SGCA 9 ("**the Rooster case**"), Chao Hick Tin JA, delivering the judgement of the Court of Appeal, said there is little authority on what the phrase "customary in the current language or in the bona fide and established practices of the trade" in section 7(1)(d) of the Act means. He then went on to quote the English High Court in *Hormel Foods Corp v Antilles Landscape Investments NV* [2005] RPC 28 which held that the essence of the objection embodied in the provision was as follows (at [72]): "...[Art3(1)(d)(*in pari material with our section 7(1)(d)*)] was to be interpreted as only precluding registration of a mark where the signs or indications of which the mark was exclusively composed had become customary in the current language or in the bona fide and established practices of the trade [for designating] the goods or services in respect of which registration of the mark was sought. It also held that it was immaterial for this purpose whether or not the sign in question was descriptive. Thus, the essence of the objection is that the sign is generic either amongst the general public or amongst the trade."

44 The Court of Appeal in “*the Rooster case*” then went on to state that use made of the trade mark in question can be taken into account for the purposes of determining whether that trade mark has become customary. The Court of Appeal also quoted *Kerly’s* (at [83]) which stated that, “*the essence of the objection is that the sign is generic, with the primary focus usually being on the perception of the mark amongst consumers, although the perception in the trade may be important in certain circumstances. Each case will turn on its own facts and evidence. The challenge with these grounds is to compile a sufficiently convincing body of evidence (emphasis mine).*”

88 In *Wing Joo Loong* at [100], the Court of Appeal further referred to comments in Lionel Bently & Brad Sherman, *Intellectual Property Law* (Oxford University Press, 2nd Ed, 2004) as follows (at p833):

While the scope of the section has yet to be fully explored, it seems that it will cover so-called "generic" marks. A mark, particularly a name mark, is generic if though when it was first adopted it was distinctive, over time it has come to designate a genus or type of product rather than a particular product originating from a particular source ... One of the features of a generic mark is that it is no longer capable of distinguishing the goods or services of different traders. Where a word comes to describe a class of products, it can no longer be relied upon to separate the products in the class from each other.

[emphasis added]

89 The Opponents themselves acknowledge “*the challenge with these grounds is to compile a sufficiently convincing body of evidence*”. Their evidence includes marks containing circle devices and/or concentric circle devices in Class 34 as well as images of cigarette packs containing circle devices and/or concentric circle devices.

90 I have earlier found under Section 7(1)(c) that the Application Mark is not descriptive of the Goods. Now, I consider whether the Application Mark is nevertheless customary in the bona fide and established practices of the trade, because it is immaterial under the present ground whether or not the Application Mark is descriptive, see *Nutricia* and *Wing Joo Loong* quoted above at [87].

91 While the Opponents have diligently compiled a large number of marks and images of cigarette labels containing circle devices and/or concentric circle devices, the evidence falls short of establishing that a sign comprising concentric circles such as the Application Mark designates cigarette products (as a genus) rather than a particular cigarette product originating from a particular trader. There is also no evidence on the public perception of the Application Mark as being generic to the tobacco industry in Singapore.

92 In *Love & Co*, the High Court found at [88] that:

Whilst the use of the 'LOVE' is very prevalent in the advertising and promotion practices of jewellery traders so that, even prior to the defendant's registration of the simple "LOVE" mark there were already many traders promoting their wares using the word "love" ... it is still an overstatement to

claim that "love" is a generic term for jewellery or to assert that it has become customary usage.

93 Likewise in *Nutricia*, the Principal Assistant Registrar found, at [45], that:

...indeed I find it far-fetched to say that "PROTECT" has become a generic term for milk, foodstuff and dietetic substances in the way that "yo-yo", "cellophane" and "aspirin" have.

94 I am thus mindful of the high threshold to cross for the burden to "*compile a sufficiently convincing body of evidence*" to be discharged. In the instance, it cannot be said that the Application Mark is customary in the bona fide and established practices of the trade.

95 The ground of opposition under Section 7(1)(d) therefore fails.

Whether Distinctiveness Acquired under Section 7(2)

96 Having found the Application Mark devoid of any distinctive character under Section 7(1)(b), I consider whether it may nevertheless be registrable because of the application of Section 7(2).

97 Section 7(2) of the Act reads:

A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

98 The question to be determined here is whether, through the use made of it, the Application Mark has acquired a distinctive character in respect of the Goods.

99 It is well established that this question must be asked through the eyes of the average consumer who is reasonably well informed and reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV* Case C-342/97 [1999] ECR I-3830 paragraph 26).

100 Also, I take heed to Jacob J's words of caution in *British Sugar* at p 302, ln 24 to 40:

Now it is all too easy to be beguiled by such evidence. There is an unspoken and illogical assumption that "use equals distinctiveness". The illogicality can be seen from an example: no matter how much use a manufacturer made of the word "Soap" as a purported trade mark for soap the word would not be distinctive of the goods. He could use fancy lettering as much as he liked, whatever he did would not turn the word into a trade mark... [In *The Canadian Shredded Wheat Co. Ltd. v Kellogg Co. of Canada Ltd.* (1938) 55 RPC 125 in the Privy Council] Lord Russell said:

A word or words to be really distinctive of a person's goods must generally speaking be incapable of application to the goods of anyone else.

and also at p 303, ln 27 to 28:

... recognition does not necessarily mean recognition as a trade mark.

Use in Singapore

101 After a careful assessment of the Applicants' purported evidence of use, one is struck by the paucity of evidence that is Singapore-specific. The Applicants' evidence of use consists essentially of information pertaining to the advertisement and turnover of cigarettes under the "LUCKY STRIKE" brand. Advertisement expenditure, sales figures and revenue figures for "LUCKY STRIKE" are given on a worldwide basis. The only exception are the following revenue figures for "LUCKY STRIKE" cigarettes sold in Singapore in 2005, 2006 and 2010:

Year	Approximate Revenue (S\$)
2005	3,385,106.25
2006	753,108.57
2010	367,580.52

102 The Applicants claim to have sold cigarettes under the "LUCKY STRIKE" brand in Singapore since at least 1994, though their documentary evidence in the form of sample invoices only date from 2006. The paucity of Singapore-specific evidence of use is not an insignificant difficulty as the focus of the enquiry is whether the Application Mark has acquired a distinctive character as a result of the use made of it in Singapore, and not elsewhere in the world.

103 The lack of revenue figures for the years 2007, 2008 and 2009 is also curious. Leaving this aside, the revenue figures for 2005, 2006 and 2010 are on the low side and show a falling trend. This raises the question whether the sales were sufficient for the Application Mark to have acquired distinctiveness at the time the application was made on 23 February 2010.

104 In addition, another section of the Applicants' evidence of use is headlined "*Use of the Mark as a distinguishing element of the "LUCKY STRIKE" brand, in advertising the Applicant and its tobacco products in connection with Formula 1*". The purported use of the Application Mark in this context includes use of the "LUCKY STRIKE" brand architecture on the race cars, team uniforms, promotional materials connected with the British American Racing ("BAR") team, and clothing range and associated merchandise sold to fans and followers. During the Applicants' time as primary sponsors and co-owners of the BAR Formula 1 team (1997-2005), the Applicants spent over £100m in relation to promotional activity on behalf of the BAR Formula 1 team.

105 The Applicants point out that Formula 1 is a massive worldwide television event with a global reach. However, there is no evidence to link the purported use of

the Application Mark, during their sponsorship and co-ownership of the BAR Formula 1 team from 1997 to 2005, to Singapore.

106 Apart from the above reservations, I turn to another consideration, one that relates to the use of the Application Mark.

Use of the Application Mark

107 When the Applicants refer to the use of the Application Mark in evidence, it is almost always in connection with the “LUCKY STRIKE” brand. For example, at Paragraph 9 of Mr Aitchison’s statutory declaration, he states “*The Applicant has spent an enormous amount of revenue on advertising **the Mark and the “LUCKY STRIKE” brand.** The following are approximate figures from 1997 to 2010 of the Applicant’s advertising expenditure, spent on advertising **the Mark and the “LUCKY STRIKE” brand on a worldwide basis...***” [emphasis in bold added].

108 The Applicants have attempted to conflate the use of their trade mark “LUCKY STRIKE” with the Application Mark. At Paragraph 15 of Mr Aitchison’s statutory declaration, he states “*From these registrations for the “LUCKY STRIKE” brand, it is clear that whilst there have been various evolvments and historic changes of the appearance of the “LUCKY STRIKE” brand due to changes in marketing and business strategies, the Mark has always remained the key distinguishing feature of the Applicant’s products sold under the “LUCKY STRIKE” brand.*”

109 However, it appears from the sample advertisements, marketing and promotion material (not proven to be specific to Singapore, as addressed above) that the "Mark" referred to in the preceding paragraph has not always remained the same through the "*various evolvments and historic changes of the appearance of the “LUCKY STRIKE” brand*". It is not the Application Mark as filed, whose allegedly distinguishing features have been clearly described at Paragraph 5 of Mr Aitchison’s statutory declaration in terms of relative widths of each concentric circle, shadowed texture effect in the central disc and so on. In the "Mark" referred to in the preceding paragraph, the relative widths of the concentric circles differ from the Application Mark and, where colour printouts are provided, the central disc is consistently a solid red, with no shadowed texture.

110 The invoices that evince sales of "LUCKY STRIKE" cigarettes in Singapore also do not demonstrate the Application Mark in use at all. The closest reference in these invoices is the description in plain words "Lucky Strike Original Red" under the heading "Brand".

111 It is also regrettable that notwithstanding the revenue figures for “LUCKY STRIKE” cigarettes sold in Singapore in 2005, 2006 and 2010, there is no accompanying evidence to show the design of the cigarette pack that was in use in these three years before the application date. In particular, it has not been shown how the Application Mark as filed was actually used in Singapore before the application date of 23 February 2010.

112 Quite apart from the observation that there is no direct evidence showing that the Application Mark has been used on the Goods in Singapore (and how it is so

used), the majority of the Applicants' evidence (which is not Singapore-specific) shows the words "LUCKY STRIKE" in the centre of concentric circles similar to (but, as elaborated at [109] above, not the same as) the Application Mark.

113 In *Nation Fittings*, one of the registered marks in issue was a 2-dimensional drawing that was, in one instance, incorporated as part of the letter “o” in “Conex” and, in another instance, formed the frame, so to speak, within which the “Conex” brand was advertised. Andrew Phang J (as he then was) opined at [122]:

One key question raised in the present proceedings therefore seems to me to be this: To what extent can a registered trade mark be said to be used if it is incorporated into another mark or is surrounded by other elements and used in conjunction with them?

114 After assessing the purported evidence of use, Phang J concluded at [124] that “*the key or primary focus appears to be on the “Conex” brand (and other related words) rather than the mark itself*”. The learned judge went on to observe at [125]:

... the general principle to the effect that there comes a point when the mark concerned has been subsumed within the other elements to such an extent that it can no longer be considered to have been used in the context of s 22(1) of the TMA. As I have already pointed out in the preceding paragraph, this was indeed the situation in the present case.

115 One may protest that the above consideration whether a registered trade mark has been put to genuine use in a revocation action is irrelevant to the present question of whether the Application Mark has acquired a distinctive character as a result of the use made of it. However, the High Court’s observations in *Nation Fittings* are applicable here. At a later part of the same decision, dealing with the application for invalidation, the High Court found that the trade marks in issue contravened Section 7(1)(b) and went on to consider whether they could be saved by acquired distinctiveness under Section 7(2). As clearly seen below, the High Court expressly used the same reasoning and finding on use at [137]:

...PW1, instead of referring to TM 113 and TM 114, had referred to other items instead, comprising items which bore the marks that were incorporated within other elements. Without even going so far, it is clear that if, as I have found, both these marks do not even satisfy the definition of a “trade mark” under the TMA in the first instance, it would follow that they would fall foul of s 7(1)(b) as well. And, *following from my analysis with regard to the issue of use in an earlier part of this judgment (see especially above at [121]-[125]), it would follow that the plaintiff could not avail itself of the argument (pursuant to s 7(2) of the TMA) that the relevant marks had “in fact acquired a distinctive character as a result of the use made of it”*.

[emphasis added]

116 In the present case, leaving aside the concerns over whether the Application Mark was in fact used *in Singapore*, I consider whether the evidence of use (described at [112]) shows that the Application Mark on its own merit has come to denote, to the customer, the Applicants' Goods. It is possible, where a mark is “*used in conjunction*

with what is obviously taken as a trade mark" (*British Sugar* at p 302, ln 46) for the former mark to acquire distinctiveness, and thus in *British Sugar*, Jacob J considered whether the mark "TREAT", notwithstanding that it was used in conjunction with "Silver Spoon", did in fact become distinctive after some years of use (it did not).

117 However, this may just be a case where the main trade mark, which is the cigarette brand "LUCKY STRIKE", is so dominant in the Applicants' branding, marketing and promotion; and education to the public that the Application Mark is used as a badge of origin is not correspondingly extensive, if at all existent, that the Application Mark reaches the "*point when the mark concerned has been subsumed within the other elements to such an extent that it can no longer be considered to have been used*".

118 In the *Love case*, the High Court additionally observed at [104] that:

The more common or laudatory or descriptive the trade mark, the more compelling will the evidence have to be before the court will be convinced that the trade mark has become *de facto* distinctive of the defendant's jewellery, especially since the use, in this case, of the simple "LOVE" mark has been accompanied by a far more distinctive and recognizable "the LOVE Diamond" trade mark. The defendant has also not adduced any evidence that a significant number of consumers in Singapore recognize its simple "LOVE" mark as being the defendant's badge of origin.

119 In the present case, the Opponents have shown that it is not uncommon in the tobacco industry in general for circles and concentric circles to be used as borders that frame words, numbers or pictures on cigarette packs. Thus, the Applicants' evidence of distinctiveness acquired through use in Singapore needs to be all the more compelling. However, from the evidence described above, I am unable to conclude that the Application Mark has been used in Singapore to such an extent that a significant proportion of the smoker population in Singapore would recognise it as the Applicants' badge of origin, and that accordingly, the Application Mark is incapable of application to the goods of anyone else.

Opponents' market investigation

120 The Opponents conducted a market investigation which sought to establish (1) how the "LUCKY STRIKE" brand is in fact used in the Singapore market; and (2) whether the Application Mark is used in trade on its own as filed. The investigation found that out of the forty retail outlets investigated, only one sold "LUCKY STRIKE" cigarettes at all. At the sole outlet retailing "LUCKY STRIKE" cigarettes, the Opponents obtained an example of how the "LUCKY STRIKE" brand is currently used in the Singapore market, i.e. "LUCKY STRIKE" & "power button" device (a circular device which looks like the on/off button on some electrical appliances), which does not incorporate the concentric circles device found in the Applicants' evidence nor the Application Mark as filed.

121 In coming to my decision here, I did not accord much weight to the above market investigation as it pertains to circumstances after the relevant date of 23 February 2010, when the application to register the Application Mark was filed.

Thus, the outcome of the investigations showing that "LUCKY STRIKE" cigarettes are only sold by one out of the forty retailers investigated in Singapore and that the Application Mark is not used in the Applicants' current cigarette packaging did not affect my inquiry and conclusion that the Application Mark had not acquired distinctiveness on 23 February 2010.

New Zealand decision

122 In these proceedings, while the Applicants rely on the United Kingdom and European Community registrations of the same Application Mark (on which I have commented at [62] above), the Opponents likewise rely on the *New Zealand decision* where the Opponents succeeded in opposing the same Application Mark.

123 It is incidental that the outcome here is the same as that in the *New Zealand decision*. I have not considered myself bound by that decision and note that the overall onus of proof is different in New Zealand (on the applicants) and Singapore (on the opponents).

Conclusion

124 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition fails under Section 7(1)(a), 7(1)(c) and 7(1)(d) and succeeds under Section 7(1)(b). Accordingly, the Application Mark is refused registration. The Opponents are also entitled to costs to be taxed, if not agreed.

Dated this 22nd day of November 2012

See Tho Sok Yee

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