

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

Trade Mark Application No. T1204840G
29 April 2014

IN THE MATTER OF A TRADE MARK APPLICATION BY

KIMANIS FOOD INDUSTRIES SDN BHD

AND

OPPOSITION THERETO BY

ROVIO ENTERTAINMENT LTD

Hearing Officer: Ms Sandy Widjaja
Principal Assistant Registrar of Trade Marks

Mr Paul Teo (Ravindran Associates) for the Applicants

Ms Tasneem Haq (HS Legal LLP) for the Opponents

Cur Adv Vult

GROUND OF DECISION

1 This is an opposition to the registration of the following trade mark T1204840G ("Application Mark"):



in relation to the following goods in Class 30:

Flour based savoury snacks; food products containing (principally) flour; cereal based snack food; snack food products made from maize flour; snack food products made from potato flour; snack food products made from rice flour; snack food products made from soya flour; rice based snack foods; flour confectionery; sesame snacks.

2 Kimanis Food Industries Sdn Bhd (“the Applicants”) applied to protect the Application Mark in Singapore on 5 April 2012. The application was accepted and published on 6 July 2012 for opposition purposes. Rovio Entertainment Ltd (“the Opponents”), filed their Notice of Opposition to oppose the registration of the Application Mark on 6 September 2012. The Applicants filed their Counter-Statement on 22 October 2012. On 28 January 2013, at the Case Management Conference (“CMC”), the Applicants applied for security for costs. This was duly furnished on 15 February 2013. Similarly, an amended grounds of opposition ("**Amended Grounds of Opposition**") was filed on 15 February 2013 pursuant to a direction made at the said CMC.

3 The Opponents filed evidence in support of the opposition on 20 May 2013. The Applicants filed evidence in support of the application on 3 September 2013. The Opponents subsequently filed their evidence in reply on 31 October 2013. The Pre-Hearing Review letter was issued on 22 November 2013 after which the opposition was heard on 29 April 2014. Following the hearing, on the same afternoon, the Opponents objected to the Applicants having submitted written submissions in reply and authorities at the hearing itself and requested that they (the Opponents) be allowed to file further written submissions in reply, should the Registrar deem necessary. As such, the Registrar responded on 16 May 2014 that he is of the view that this is not necessary. The Opponents responded to the Registrar's letter on 20 May 2014, enclosing their further written submissions in reply and the relevant authorities, submitting in particular that they did not have an ample opportunity to respond at the hearing itself. The Registrar wrote to the Applicants on 22 May 2014 indicating that he will accept the Opponents' submissions, unless he hears from the Applicants. The Applicants wrote in on 22 May 2014, arguing that the Opponents already had an opportunity to respond at the hearing and thus should not be allowed to submit any further documents. The Opponents wrote in on 23 May 2014 stating that, in particular, the list of authorities provided by the Applicants at the hearing are not new and that there is no reason why they could not have provided earlier. After further consideration of the matter, the Registrar wrote to the parties on 3 June 2014 allowing the Opponents' further written submissions in reply but

only those parts which are strictly in reply to the Applicants' written submissions in reply. In light of the above, the decision for the current case is due on 19 August 2014.

Grounds of Opposition

4 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 opposition.

Opponents’ Evidence

5 The Opponents’ evidence comprises a Statutory Declaration by Mr Harri Koponen dated 25 April 2013 (“the Opponents’ 1st evidence”) as well as a Statutory Declaration in Reply by Ms Kati Levoranta dated 16 October 2013 (“the Opponents’ 2nd evidence”).

Applicants’ Evidence

6 The Applicants’ evidence comprises a Statutory Declaration made by Mdm Huang Len Len dated 16 July 2013 (“the Applicants’ evidence”).

Applicable Law and Burden of Proof

7 As the applicable law is the Act, there is no overall onus on the Applicants either before the Registrar or in opposition proceedings. The undisputed burden of proof in the present case falls on the Opponents.

Background

8 The Opponents are a video game development and entertainment company based in Espoo, Finland. The Opponents were founded in 2003 as a mobile game development studio. The Opponents are best known for their game franchise *Angry Birds*.

9 *Angry Birds* was first released in December 2009 as an iPhone game on Apple's App Store. It is now one of the most popular mobile games. The game provides for players to shoot birds with a slingshot to destroy pigs. Each bird character has a special ability and distinctive features of knitted brows and frowns suggesting an angry face or furious expression. Various versions of the game have since been released and *Angry Birds* had reached 350 million downloads worldwide by October 2011.

10 The Opponents relied on the following earlier marks (“collectively the Opponents’ Earlier Marks”):

S/N	Mark	Classes
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1	 T1111886Z (“the Opponents’ Earlier Mark T1111886Z”)	Classes: 3, 9, 14, 16, 18, 20, 21, 24, 25, 27, 28, 29, 30, 32, 33, 34, 35, 36, 38, 41 and 43.
2	 T1113897F (“the Opponents’ Earlier Mark T1113897F”)	Classes 3, 9, 14, 16, 18, 20, 21, 24, 25, 27, 28, 29, 30, 32, 33, 34, 35, 36, 38, 41 and 43.

11 The Applicants have been in the snack food manufacturing business since 1987. The Applicants initially began their business with a single product and this has grown to the current range of more than forty products. The Applicants through their great tasting, high quality products and successful marketing and promotion have established their brands "D-Jack" and "Jimbo" in the snack food market in Malaysia and abroad.

Preliminary Comment

12 At the outset, it is noted that the Applicants have provided in their evidence that they were inspired by the *Angry Birds* Game (more details of this below). My view is that there is nothing objectionable in being "inspired" *per se* in that, not everything "inspired" by an existing work is necessarily objectionable. To decide otherwise would confer excessive protection on owners of registered trade marks, and would set too high a threshold for potential new market entrants to enter the market. In practice, it is common to have "look alike" in the market place. Whether or not a mark "inspired" by an existing work or whether such "look alike" can ultimately be regarded as objectionable will depend on whether an opponent can establish one of the grounds of opposition in the Act, which in turn is very much dependent on the particular facts of each case.

MAIN DECISION

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

13 The relevant provisions of the Act are Section 2 and 8(2)(b), which provide as follows:

2. —(1) *In this Act, unless the context otherwise requires —*

“earlier trade mark” means —

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

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

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

“well known trade mark” means —

(a) any registered trade mark that is well known in Singapore; or

(b) any unregistered trade mark that is well known in Singapore and that belongs to a person who —

(i) is a national of a Convention country; or

(ii) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in Singapore;

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

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

Opponents’ Submissions

14 The Opponents submitted that the three step test is applicable in this instance and the authority for the three- step test is ***British Sugar PLC v James Robertson & Sons Ltd [1996] RPC 281 (“Treat”)*** which was further endorsed recently by the Singapore Court of Appeal in ***Starwood Hotels & Resorts Worldwide Inc., Sheraton International, Inc v Staywell Hospitality Group Pty Ltd [2013] SGCA 65 (“St. Regis”)***.

15 The Opponents submitted that although separately registered the Opponents use a combination of both the Opponents' Earlier Mark T1111886Z and the Opponents' Earlier Mark T1113897F on their products as a composite mark. By way of example, the Opponents referred to the Opponents' 1st evidence at Exhibits 3, 6, and 7.

16 The Opponents submitted that the distinctiveness of the Opponents' Earlier Marks namely, the Opponents' Earlier Mark T1113897F and the Opponents' Earlier Mark T1111886Z is an important factor in a similarity analysis. The dominant or most prominent elements in the Application Mark are the words "ANGRY BITE" and the device of the angry eyes. These are also the elements similar to the Opponents' Earlier Marks. The distinctive and memorable components of the mark are those that tend to stand out in the consumer's imperfect recollection. This explains why the Court is entitled to have special regard to the distinctive or dominant components of the mark, even while it assesses the similarity of the two marks as composite wholes.

17 The Opponents concluded that they have satisfied the marks similarity requirement.

18 In relation to the issue of similarity of goods, the Opponents submitted that the concept of notional fair use applies here. The Applicants' goods and services must be compared with all the goods and services of the Opponents' Earlier Marks and not only with those the Opponent uses. That is the basis of comparison as per *St Regis* at [47], [53] and [60].

19 The Opponents submitted that the relevant factors for assessing similarity of goods/services are set out in *Treat*.

20 The Opponents made a comparison of the goods covered under the Application Mark in Class 30 with the goods registered by the Opponents also in Class 30. The Opponents submitted that the specifications overlap and in some instances, are identical.

21 The Opponents submitted that the Applicants' goods are identical or if not closely similar to the goods of the Opponents.

22 The Opponents submitted that the principle for assessing likelihood of confusion is found in the Court of Appeal decision in *St Regis*.

23 The Opponents then referred to *St Regis* at [81] to [83] where the Court indicated whether, and if so, the extent to which, the extraneous factors will be applicable at each stage of the inquiry. The Opponents then referred to *St Regis* at [96] for the non-exhaustive list of factors which the Court regarded as admissible at the confusion inquiry stage.

24 In terms of a likelihood of confusion, the Opponents submitted that the following are to be taken into account:

- (i) The dominant part of the Opponents' word mark is the word "ANGRY". It is distinctive as it is unusual and unique as a description for a bird. The Applicants have taken this distinctive word "ANGRY" and combined it with "BITE".
- (ii) There is some phonetic similarity between "bird" and "bite" as both have the same starting syllable.

- (iii) The Applicants’ evidence that they were inspired by the Opponents’ mark when they created the Application Mark.
- (iv) The Applicants have taken the dominant and memorable features as submitted earlier.
- (v) Applying the test of a reasonable man, likelihood of confusion exists. The Opponents submitted that consumers of these competing products are mostly children. Snacks are inexpensive, generally purchased without close inspection and would be placed in same location as other snacks, including the Opponents’ snacks.

25 The Opponents submitted that the “**D-Jack**” brand is not prominent on the Applicants’ packs or in their promotional material (Exhibits 1 and 3 of the Applicants’ evidence).

26 In the light of all the circumstances, the Opponents submitted that there exists a likelihood of confusion as consumers are likely to be confused as they may think that the parties are related or have business links.

27 The Opponents submitted that the use and application to register the Application Mark are likely to cause confusion to the public if the Application Mark is permitted to register in Singapore. The similarity arising from the use of the similar “ANGRY BITE” combination of words with the similar “angry face device” inspired by the Opponents’ *Angry Birds* characters on identical or closely similar goods provides ample ground for finding there is a sufficient likelihood of confusion. The Opponents claimed that the Application Mark should be refused registration pursuant to Section 8(2) (b) of the Act.

Applicants’ Submissions

28 The Applicants submitted that to examine the issue of similarity of marks, one does not take into account any external added matter or circumstances and the comparison should be **mark for mark** (*Origins Natural Resources Inc v Origin Clothing Ltd* [1995] FSR 280).

29 It has been held in *The Infamous Nut Co Ltd's Trade Marks* [2003] RPC 7 at [36] that:

where the opponent relies on proprietorship of more than one earlier trade mark, the registrability of the applicant's mark must be considered against each of the opponent's earlier trade marks separately

30 Therefore, in this case, the Applicants submitted that the Opponents should not be permitted to combine both their marks in the comparison test under Section 8(2)(b). The marks ought to be compared on a “mark for mark” basis as follows:

S/N	Application Mark	Opponents’ Earlier Mark T1111886Z
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1.		
2.		Opponents' Earlier Mark T1113897F 

31 The test for assessing the similarity of marks was recently restated by the Court of Appeal in *St Regis* at [26]:

When speaking of the assessment of a mark as a whole, it may be noted that the cases have consistently stated that the "visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components" (Sabel v Puma at 224, Matratzen Concord GmbH v OHIM, Case T -6/01 [2002] ECR II-4335 ("Matratzen"), Doctor's Associates Inc v Lim Eng Wah (trading as SUBWAY NICHE) [2012] 3 SLR 193 ("Subway Niche") at [19] and Bently & Sherman at p 864).

32 The Applicants submitted that in comparing the Application Mark with the Opponents' Earlier Mark T1111886Z ie S/N 1 above, the device portion of the Application Mark does not have a beak and does not look like a bird at all. In addition, the Opponents' Earlier Mark T1111886Z does not have any words unlike the Application Mark.

33 For the Opponents' Earlier Mark T1113897F ie S/N 2, the Applicants submitted that there is some visual similarity due to the presence of the common word ANGRY. However, the similarity ends there. As marks have to be compared as wholes, apart from the word ANGRY, there are other elements in the Application Mark which distinguish it from the Opponents' Earlier Mark T1113897F (e.g. the D-jack mark, the word 'Bites', the device of a creature biting on something etc).

34 The Applicants submitted that as the Opponents' Earlier Mark T1111886Z has no aural component, the comparison will be between the aural component of the Application Mark and the Opponents' Earlier Mark T1113897F. The Applicants submitted that the pronunciation for BITE is easily distinguishable from the word BIRDS. The "I" in the word "BITE" has a strong "EYE" sound. This is in contrast to the "I" in BIRDS which is pronounced with an "URH" sound. This distinction, coupled with the fact that BITE ends with "T" compared to an "S" for birds, further distinguishes the 2 marks.

35 Conceptually, the Applicants submitted that the Application Mark conveys the dominant impression of a creature biting angrily on something. The adjective angry describes the bite. The Opponents' Earlier Marks do not convey the same impression. At best, the Opponents' Earlier Marks convey some form of anger. However, this concept of anger is related to birds both for the Opponents' Earlier Mark T1111886Z and the Opponents' Earlier Mark T1113897F. This concept is distinct from the Application Mark.

36 Considering the different "*overall impression given by the marks*", it must follow that the marks cannot be considered similar. In the premises, the Applicants submitted that taking into account the principles of comparison, the Application Mark is not similar to the Opponents' Earlier Marks.

37 It was held in ***Richemont International SA v Goldlion Enterprise (Singapore) Pte Ltd*** [2006] 1 SLR 401 at [22] that:

the identity or similarity requirement in respect of both the marks as well as the goods or services are "threshold" requirements which have to be met before one may proceed to consider whether or not there is a likelihood of confusion on the part of the public

The Applicants thus submitted that as the mark similarity requirement under Section 8(2)(b) has not been met, the matter ends here.

38 The Applicants does not dispute some of the goods overlap and are similar.

39 For completeness and out of an abundance of caution, the Applicants proceeded to consider whether a likelihood of confusion will arise.

40 Turning to consider whether there is a resultant likelihood of confusion, ***St Regis*** at [96], set out a non-exhaustive list of factors which the Court regarded as admissible in the confusion inquiry.

41 The average purchasing public has been described in ***McDonald's Corp v Future Enterprises Pte Ltd [2004] SGCA 50 ("McDonald's")*** at [64]:

With widespread education and a public which is constantly exposed to the world, either through travel or the media, one should be slow to think that the average individual is easily deceived or hoodwinked

42 Given that the Applicants' goods are sold in supermarkets, the relevant public will be ordinary sensible members of the general public who are not easily deceived or hoodwinked.

43 The Applicants submitted that, taking into account the greatly dissimilar marks (compared individually) without any added matter, there is no risk of likelihood of confusion.

44 In the premises, the opposition under Section 8(2)(b) must accordingly fail.

Decision on Section 8(2)(b)

Step-by-step approach

45 It is clear that the most recent authority in relation to this section is *St Regis*. In *St Regis*, the Court upheld the 3-step test approach in relation to an objection under section 8(2)(b) and rejected the proposal that the threshold of marks similarity is a low one as follows at [15] to [20]:

[15]...Since this court’s decision in Polo (CA), our courts have given effect to this statutory wording by applying what is now known as the “step-by-step” approach, as opposed to the competing “global appreciation approach” applied in Europe after Sabel BV v Puma AG, Rudolf Dassler Sport [1998] RPC 199 (“Sabel v Puma”). Under the step-by-step approach, the three requirements of similarity of marks, similarity of goods or services, and likelihood of confusion arising from the two similarities, are assessed systematically. The first two elements are assessed individually before the final element which is assessed in the round...

[16] However we do not agree with the Opponents’ approach to the extent that it suggests that any particularly or notably low threshold of marks-similarity applies...

[17] More fundamentally, the minimal threshold approach is inconsistent with the reality that the similarity of marks is ultimately and inevitably a matter of impression rather than one that can be resolved as a quantitative or mechanistic exercise (see Polo (CA) at [35] and Wagamama Ltd v City Centre Restaurants Plc [1995] FSR 713 at 732)...The court must ultimately conclude whether the marks, when observed in their totality, are similar rather than dissimilar. The three aspects of similarity are meant to guide the court’s inquiry but it is not helpful to convert this into a checkbox exercise in which a tick, however faint it might be, in any one box must compel the court to find that the marks are similar when a sensible appraisal of the marks as a whole would show otherwise.

*[18] We observed this in Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd [2013] SGCA 26 (“Hai Tong”) at [40(a)]. Congruously, there is no prescribed requirement that all three aspects of similarity must be made out before the marks can be found to be similar: MediaCorp News Pte Ltd v Astro All Asia Networks plc [2009] 4 SLR(R) 496 (“MediaCorp”) at [32] and Sarika Connoisseur Café Pte Ltd v Ferrero SpA [2013] 1 SLR 531 (“Sarika”) at [16]. **In short, the criteria of visual, aural and conceptual similarities do not invite a formulaic***

consideration; rather, they are signposts towards answering the question of whether the marks are similar. Trade-offs can occur between the three aspects of similarity in the marks-similarity inquiry: *Ozone Community Corp v Advance Magazine Publishers Inc* [2010] 2 SLR 459 (“Ozone”), see also *Bently and Sherman, Intellectual Property Law* (Oxford University Press, 3rd Ed, 2009) (“Bently & Sherman”) at p 864.

[19]...A productive and appropriate application of the step-by-step approach necessitates that the court reach a meaningful conclusion at each stage of the inquiry...

[20] Finally, on this issue, we reiterate that the assessment of marks similarity is **mark-for-mark** without consideration of any external matter: see *Mediacorp* at [33], *Sarika* at [17] and *Hai Tong* at [40(b)]. This means that at the marks similarity stage this even extends to not considering the relative weight and importance of each aspect of similarity having regard to the goods. This does not mean that the court ignores the reality that the relative importance of each aspect of similarity might vary from case to case and will in fact depend on all the circumstances including the nature of the goods and the types of marks, as we observed at [40(b)] of *Hai Tong*. Rather, such considerations are properly reserved for the confusion stage of the inquiry, because that is when the court is called upon to assess the effect of objective similarity between the marks, on the perception of consumers. We recognise that this reflects a slight departure from the approach taken by the High Court in *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 at [55]–[56], and by this court in *Sarika* at [38]. We think that this is conceptually clearer because it recognises that the issue of resemblance between the competing marks is distinct from the question of the effect of such resemblance...

[Emphasis in bold and underlined mine.]

Similarity of Marks

46 In relation to similarity of marks, the Court has this to say at [25], [26] and [30]:

[25] Technical distinctiveness is an integral factor in the marks-similarity inquiry (see *Sarika* at [20], *Ozone Community* at [47] and *Polo (CA)* at [36]); a mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it (*Sarika* at [36]). **While the components of a mark may be inherently technically distinctive, ultimately the ability of the mark to function as a strong badge of origin must be assessed by looking at the mark as a whole.** Conversely, the components of a mark may not be inherently distinctive, but the sum of its parts may have sufficient technical distinctiveness...

[26] When speaking of the assessment of a mark as a whole, it may be noted that the cases have consistently stated that the “visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components” (Sabel v Puma at 224, Matratzen Concord GmbH v OHIM, Case T-6/01 [2002] ECR II-4335 (“Matratzen”), Doctor’s Associates Inc v Lim Eng Wah (trading as SUBWAY NICHE) [2012] 3 SLR 193 (“Subway Niche”) at [19] and Bently & Sherman at p 864).

...

[30] We reiterate, as was held in *Sarika* (at [20]) and in *Hai Tong* (at [26]), that distinctiveness (in both its technical and non-technical senses) is a factor integrated into the visual, aural and conceptual analysis as to whether the competing marks are similar. It is not a separate step within the marks-similarity inquiry.

[Emphasis in bold and underlined mine.]

47 Further, the Court provided the following principles in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] SGCA 26 at [40] (“*Hai Tong*”):

[40] (c) Although the focus of this part of the inquiry is on the marks in question, it is necessary to set out the viewpoint the court should assume. This viewpoint is that of the average consumer who would exercise some care and a measure of good sense in making his or her purchases, not that of an unthinking person in a hurry (see *Polo (CA)* ([16] *supra*) at [34]).

(d) Furthermore, it is assumed that the average consumer has “imperfect recollection” (see *MediaCorp* at [33], citing *Nautical Concept Pte Ltd v Jeffery Mark Richard* [2007] 1 SLR(R) 1071 (“*Nautical Concept*”) at [30]). As such, the two contesting marks are not to be compared or assessed side by side and examined in detail for the sake of isolating particular points of difference. Instead, the court will consider the general impression that will likely be left by the essential or dominant features of the marks on the average consumer (see *Saville Perfumery Ld v June Perfect Ld and FWWoolworth & Co Ld* (1941) 58 RPC 147 (“*June Perfect*”) at 161–162).

[Emphasis as underlined mine].

48 Before I proceed to analyse the Application Mark against the Opponents' Earlier Marks based on the above principles, there is an important issue to be resolved and that is how the marks are to be compared. A table in this regard will aid the analysis. The question is, would the proper approach to the analysis be the approach as per Table 1 below (as submitted by the Applicants):

TABLE 1		
S/N	Application Mark	Opponent's Earlier Mark T1111886Z
1.		
2.		Opponent's Earlier Mark T1113897F 

Or Table 2 below (as submitted by the Opponents):

TABLE 2		
S/N	Application Mark	Opponent's Earlier Mark T1111886Z
		
		Opponent's Earlier Mark T1113897F
		

This issue is important as it will determine the way in which the principles propounded above are applied.

49 My view is that the approach should be that of Table 1. In addition to the Applicants' submissions, importantly, section 8(2)(b) reads as follows:

A trade mark shall not be registered if because —

...

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

50 It is also to be recalled that the Court in *St Regis* at [20] provided that:

[20] Finally, on this issue, we reiterate that the assessment of marks similarity is mark-for-mark without consideration of any external matter...

It is clear that the method for comparison is mark-for-mark or to put it another way, it is [a] mark-for-[a] mark.

51 In light of the above, it is not appropriate to compare the Application Mark as against the Opponents' Earlier Marks together, as submitted by the Opponents on the basis that while separately registered, the Opponents uses a combination of the Opponents' Earlier Mark T1111886Z and the Opponents' Earlier Mark T1113897F on their products as a composite mark. It is the Opponents' mark as registered, which is in question here.

52 It is the Opponents' prerogative as to the marks which they wish to seek protection. However, each registered trade mark, which is a property right and is granted the rights and remedies under the Act in itself, should be treated separately on its own.

53 With the above approach in mind, I proceed to analyse the marks. As a starting point, I note that the Application Mark is, as submitted by the Applicants, a composite mark while the Opponents' Earlier Mark T1111886Z consists only of a device, while the Opponents' Earlier Mark T1113897F is a word only mark.

Visual Similarity

54 In terms of visual similarity, I am of the view that there is no visual similarity in this regard. This is because, looking at Table 1, it is clear that the only possible aspect of similarity that can be said to be shared between the Application Mark and the Opponents' Earlier Mark T1111886Z would be the "angry eyes device".

55 It is important to note that the Opponents' Earlier Mark T1111886Z, does not simply consist of a device of a pair of angry eyes. The Opponents' Earlier Mark T1111886Z, consists of a device of a bird with angry eyes. Therefore, it is not right simply to focus on the "angry eyes device" alone. Even if the angry eyes device can be considered as the dominant component of the Opponents' Earlier Mark T1111886Z, the Court in *St Regis* reiterated at [163 (c)]:

The marks are to be assessed as composite wholes but bearing in mind and having due regard to distinctive and dominant elements (see [25]–[26] above)

[Emphasis as underlined mine].

Paragraphs 25 and 26 have been reproduced above.

56 The Application Mark on the other hand, contains several elements which are clearly absent from the Opponents' Earlier Mark T1111886Z. The Application Mark is a

composite mark which consists of an angry face of a creature, whatever it may be, biting angrily into something and the words "ANGRY BITE" as well as the words "D-Jack" on the left hand corner of the Application Mark.

57 In light of all of the above, I am hard pressed to find similarity between the Application Mark and the Opponents' Earlier Mark T111886Z.

58 Turning to Opponents' Earlier Mark T1113897F, which is a word mark, it is clear that the only similarity shared between the Application Mark and the Opponents' Earlier Mark T1113897F is the word "ANGRY" and the letters "BI". I have already commented above that the Application Mark, being a composite mark, contains other elements, such as the "angry eyes device", the face of a creature biting angrily into something, as well as the word "D-Jack" amongst others, which are clearly absent from the Opponents' Earlier Mark T1113897F.

Aural Similarity

59 With regard to aural similarity, I note the Court in *St Regis* stated at [31] and [32] that there are two approaches in this regard. One approach is to consider the dominant component of the mark and the other is to undertake a quantitative assessment as to whether the competing marks have more syllables in common than not. I am of the view that the second approach, which was also adopted by the Opponents in their submissions, can be easily applied as follows.

60 It is clear that there can be no comparison between the Application Mark and the Opponents' Earlier Mark T111886Z as the Opponents' Earlier Mark T111886Z, being a device mark, has no aural component to speak of.

61 Of more relevance in this instance is a comparison between the Application Mark and the Opponents' Earlier Mark T1113897F, which is a word mark. It is quite apparent that the two competing marks have more common syllables than not. The Application Mark is read as "AN-GRY BITE" while the Opponents' Earlier Mark T1113897F is read as "AN-GRY BIRD". I am of the view that the two marks have more syllables in common than not. Therefore I conclude that there is some aural similarity between the Application Mark and the Opponents' Earlier Mark T1113897F.

Conceptual Similarity

62 The Court in *St Regis* expounded at [35] and [36] as follows:

Unlike the aural analysis, which involves the utterance of the syllables without exploring the composite meaning embodied by the words, the conceptual analysis seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole (Bently & Sherman at p 866). Greater care is therefore needed in considering what the conceptually dominant component of a composite mark is,

because the idea connoted by each component might be very different from the sum of its parts.

[Emphasis as underlined mine]

63 In light of the above, it is not correct to focus simply on the "angry eyes device" in relation to Opponents' Earlier Mark T1111886Z nor is it correct to similarly simply focus on the word "ANGRY" in relation to Opponents' Earlier Mark T1113897F as per the Opponents' submissions.

64 I will proceed to apply the above principles to the current case.

65 In relation to a comparison between the Application Mark and the Opponents' Earlier Mark T1111886Z, I am of the view that there is no conceptual similarity for the following reasons. The Opponents' Earlier Mark T1111886Z, consists of a device of a bird with angry eyes. On the other hand, the Application Mark being a composite mark, taken as a whole (ie both the device as well as the words "Angry Bite"), conveys an idea of a creature, whatever it may be, biting angrily. At this point, I think it is important to state that while it may be helpful to refer to the Mark Index of the different Intellectual Properties Offices, it is not critical to the analysis. At the end of the day, what is important is the impression of the average consumer as alluded to above. In the event that there is a need to refer to the Mark Index, then I am of the view that it should be that of IPOS which is relevant in the current case since the opposition proceedings is before IPOS. In this regard, I note that the Mark Index at IPOS states as such:

Mark Index

Words in Mark: D-Jack angry bite

Device in Description: eyes mouth cartoon

In light of the above, at most, the idea of the emotion of anger is common to the two marks. But as cautioned by the Court in *St Regis* above, each mark must be considered as a whole. I find the Application Mark not to be conceptually similar to the Opponents' Earlier Mark T1111886Z.

66 A comparison between the Application Mark and the Opponents' Earlier Mark T1113897F encompasses a comparison between the Application Mark which, as mentioned above, taken as a whole (ie both the devices as well as the words "Angry Bite"), conveys an idea of a creature, whatever it may be, biting angrily and the Opponents' Earlier Mark T1113897F, which is a purely word mark "ANGRY BIRD". Thus, at most there is the common word "angry" and as such, the emotion of anger is also common to the two marks. But comparing the marks as wholes, I am of the view that the Application Mark and Opponents' Earlier Mark T1113897F are not conceptually similar.

Conclusion on the similarity of marks

67 It is to be recalled following *St Regis* at [17] above,

[17] ... The court must ultimately conclude whether the marks, when observed in their totality, are similar rather than dissimilar...

[18] ... In short, the criteria of visual, aural and conceptual similarities do not invite a formulaic consideration; rather, they are signposts towards answering the question of whether the marks are similar. Trade-offs can occur between the three aspects of similarity in the marks-similarity inquiry...

68 Further, the average consumer has an “imperfect recollection” and there is a need to consider the general impression that will likely be left by the essential or dominant features of the marks. However, it is also important to remember that the average consumer is one who would exercise some care and a measure of good sense in making his or her purchases, not that of an unthinking person in a hurry. In this regard, I am of the view that snacks are bought by consumers of all ages, and are not necessarily confined to those of the younger generation.

69 In light of the analysis above, I am of the view that the marks are dissimilar visually and conceptually although there is some degree of aural similarity. Therefore, on the whole, I am of the view that the marks are more dissimilar than similar in totality.

70 As I have found that the marks are not similar, there is no need for me to delve into the other elements of Section 8(2)(b).

71 However, in the event I am wrong, I am also of the view that there is no likelihood of confusion for the following reasons (I note that the Applicants do not dispute that some of the goods overlap and are similar).

72 The relevant principles for the likelihood of confusion are expounded by the Court in *St Regis* at [60] (actual and notional uses), [83] and [96]:

[60] Accordingly in opposition proceedings the inquiry must take into account the full range of the competing monopoly rights that are already enjoyed on the one hand, namely the actual and notional fair uses to which the incumbent proprietor has or might fairly put his registered trade mark, and compare this against the full range of such rights sought by the applicant by reference to any actual use by the applicant (assuming there has been prior use) as well as notional fair uses to which the applicant may put his mark should registration be granted...

83 On the effect of the foregoing on the relevant segment of the public – extraneous factors may be considered to the extent that they inform the court as to how the similarity of marks and goods will likely affect the consumer’s perception as to the source of the goods...

96 Based on these considerations, the following represents a non-exhaustive list of factors which we regard as admissible in the confusion inquiry:

(a) Factors relating to the impact of marks-similarity on consumer perception: the degree of similarity of the marks themselves (see *Hai Tong* at [85(c)(iii)]), the reputation of the marks (see *Polo (CA)* at [34]), the impression given by the marks (see *Polo (CA)* at [28]), and the possibility of imperfect recollection of the marks would all be relevant. Clearly, the greater the similarity between the marks, the greater the likelihood of confusion. As to the reputation of the mark, *Mobil Petroleum Co, Inc v Hyundai Mobis* [2010] 1 SLR 512 (“*Mobil*”) at [74] makes it clear that a strong reputation does not necessarily equate to a higher likelihood of confusion, and could in fact have the contrary effect as in *McDonald’s Corp v Future Enterprises Pte Ltd* [2005] 1 SLR(R) 177 (see at [64]).

(b) Factors relating to the impact of goods-similarity on consumer perception: it would be legitimate to take into account factors concerning the very nature of the goods without implicating any steps that are taken by the trader to differentiate the goods. This includes the normal way in or the circumstances under which consumers would purchase goods of that type (see [20] above, *Mystery Drinks* at [48], *Lloyd Schuhfabric Meyer v Klijsen Handel BV*, Case C-342/97 [1999] 2 CMLR 1343 at 1352; and *Philips-Van Heusen Corp v OHIM* [2004] ETMR 60 at [55]). This factor is not directly dependent on the marketing choices that the trader makes. As alluded to at [94] above, it would also be relevant to have regard to whether the products are expensive or inexpensive items, the nature of the goods and whether they would tend to command a greater or lesser degree of fastidiousness and attention on the part of prospective purchasers (see generally *Hai Tong* at [85(c)(i)]), and the likely characteristics of the relevant consumers and whether they would or would not tend to apply care or have specialist knowledge in making the purchase. We refer here to *In the matter of an Application by the Pianotist Company for the Registration of a Trade Mark* (1906) 23 RPC 774 (“*Pianotist*”) where it was observed that, having regard to the nature of the article in question (musical instruments), the (high) price at which it was likely to be sold, and the nature of the consumers who are likely to purchase such products (“generally persons of some education”), a man of ordinary intelligence was unlikely to be confused (at 778). The price of the type of product being sold is distinct from the issue of price disparity between the parties’ products. The former consideration directly impinges on the degree of care the consumer is likely to pay to his purchase and therefore his ability to detect subtle differences. As observed in *Reed Executive Plc v Reed Business Information Ltd* [2003] RPC 12 at [103], “a 50 pence purchase in the station kiosk will involve different considerations from a once-in-a-lifetime expenditure of 50,000 pounds”. On the other hand, superficial price disparity between the competing goods, which speak more about the trader’s marketing choices rather than differences in the nature of the goods themselves, is not a factor we find relevant to the inquiry.

[Emphasis as underlined mine].

73 In terms of the factors relating to the impact of marks-similarity on consumer perception, I note that in one example of use, the Opponents use both the Opponents' Earlier Mark T1111886Z (a device mark) and Opponents' Earlier Mark T1113897F (a word mark) together (see page 322 of the Opponents' 1st evidence). This will be regarded as one instance of the possible normal and fair uses of the Opponents' Earlier Marks (this is so as it is unclear as to the actual date of such use in Singapore). I also note one example of use of the Application Mark at page 4 of Exhibit 1 of the Applicants' evidence. This will also be regarded as one instance of the possible normal and fair uses of the Application Mark as, while the Applicants' evidence state that the Applicants have started selling products bearing the Application Mark in Singapore since April 2013, there were no invoices tendered to buttress this – the invoices tendered under Exhibit 1 of the Applicants' evidence were all issued to Malaysian entities). However, I am of the view that this only renders the marks somewhat more similar. The impression given by the marks differs. The Application Mark gives an overall impression of a creature angrily biting into something, the device and the words all taken into consideration. Both the Opponents' Earlier Mark T1111886Z and Opponents' Earlier Mark T1113897F, taken together, merely give an impression of an angry bird. Importantly, in relation to the reputation of the Opponents' Earlier Marks, following the Court in *St Regis* at [96a], I am of the view that the Opponents' reputation in the current case is likely to have an effect contrary to a likelihood of confusion, as the Opponents' ANGRY BIRDS brand could be sufficiently entrenched in the mind of consumers as to dispel any real possibility of confusion with the Application Mark.

74 In terms of the factors relating to the impact of goods-similarity on consumer perception, I am of the view that the relevant goods are self serve items such that the visual and conceptual aspects figure more prominently than the aural aspects at the point of selection and sale. It is to be recalled that I have concluded above that the marks are visually and conceptually dissimilar while there is some aural similarity (my holding stands even if the Opponents use their marks together in practice). Further, the relevant goods are food items, thus it is also reasonable to expect the purchasing public to exercise a certain degree of care in selecting such goods since they will be ingested. Pricewise, I note that the goods in question are generally inexpensive and as such the attention paid to such goods in this regard would be less than an expensive item like a piano. However, both these factors are on the whole outweighed by the above findings on the impact of goods-similarity on consumer perception, that is, the expectation that, as opined above, consumers would exercise a certain degree of care in the selection and purchase of food items for safety reasons.

75 Before I leave this ground, I would like to mention that the Opponents have not addressed the possibility of an earlier mark being an unregistered well-known mark (see the definition of "an earlier mark" in section 2 of the Act above) in their amended Statement of Grounds and there are no submissions in this regard. Therefore, there is no need for me to address this possibility.

76 The ground of opposition under Section 8(2)(b) therefore fails.

Ground of Opposition under Section 8(4)

77 Section 8(4) of the Act reads:

(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

78 The Opponents referred to Section 2(7) and (8) of the Act as well as the **WIPO Joint Recommendation Concerning Provisions on the Protection of Well-known Marks**; Article 2 (1) (b).

79 The Opponents submitted that the Opponents' Earlier Mark T1113897F and the Opponents' Earlier Mark T1111886Z are protected and registered because of the time, effort and money which have been expended on their respective development and promotion. The Opponents referred to the Opponents' 1st evidence at paragraph 4 where it is shown that the Opponents first launched the *Angry Birds* mobile game in December 2009.

80 The Opponents submitted that the game became an astronomical success, gaining popularity worldwide. By October 2011, less than 2 years since its release there were over one million downloads of the game in Singapore alone. The *Angry Birds* characters started to feature more prominently on other items such as crafts, clothing, cakes, toiletries and other forms of merchandise. Among the many forms of merchandise which

became popular especially with children are snacks (such as sweets, drinks, chips and crisps) and cakes.

81 The Opponents referred to Exhibit 1 of the Opponents' 1st evidence which consists of copies of the registration certificates for Opponents' Earlier Mark T1113897F and Opponents' Earlier Mark T1111886Z filed by the Opponents in several jurisdictions.

82 The Opponents also referred to Exhibit 2 as well as paragraph 7 of the Opponents' 1st evidence which tabulates a large number of newspaper articles and online articles referring to the launch in December 2009 and the success of *Angry Birds* games and merchandise.

83 The Opponents also referred to paragraph 9 of the Opponents' 1st evidence where the Opponents refer to the amount spent in promoting *Angry Birds* themed products and services worldwide which escalated from 80,000 euros in 2009 (the year of launch) to 6 million euros in 2012. These figures were not just promotions and advertising for the game but also for all product ranges since these were profit-making items in their own right and were not put on the market simply to promote the game.

84 The Opponents also referred to the extent of use of the Opponents' Earlier Mark T1113897F and Opponents' Earlier Mark T1111886Z in Singapore as referenced in the Opponents' 1st evidence:

- (i) paragraph 10 and Exhibit 4 - reference to the promotion of *Angry Birds* games with SingTel at the Formula 1 Night Race in 2011;
- (ii) paragraph 11 and Exhibit 5 - reference to a special Finnair *Angry Birds* themed flight on 21 September 2011;
- (iii) paragraph 15 and Exhibit 9 - reference to *Angry Birds* themed cable car rides held between June to December 2012;
- (iv) exhibits 6, 7, 8 and 10 demonstrate use of the Opponents' Earlier Mark T1113897F and Opponents' Earlier Mark T1111886Z "outside the scope of the gaming industry."

85 The Opponents submitted that the end result of this mass of local publicity, promotions and merchandising is that the Opponents' Earlier Mark T1113897F and the *Angry Birds* characters which include the Opponents' Earlier Mark T1111886Z became well known and popular among fans of the *Angry Birds* game and those who may not play the game but still enjoy other items with the *Angry Birds* endorsements such as the chips, snacks and crisps because of the popularity of the characters.

86 The Opponents submitted that use of the *Angry Birds* typeface logos are also well known trade marks.

ANGRY BIRDS

ANGRY BIRDS

87 The Opponents submitted that the well-known nature of the Opponents' Earlier Marks are shown in the following exhibits of the Opponents' 1st evidence:

- (i) Exhibit 3 – *Angry Birds* typeface logo on wine gums, lollipops, chewing gum, donuts and cakes, packaging for sweets and snacks as shown in the Facebook pages, fruit gummies and fruit snacks, drinks and milk shakes, the game “The Hunt of Golden Pistachio”;
- (ii) Exhibit 4 – on SingTel website and on local promotions;
- (iii) Exhibit 6 - on general merchandise in Singapore;
- (iv) Exhibit 7 - *Angry Birds* typeface logo on packaging for sweets sold in Singapore;
- (v) Exhibit 9 - on cupcakes provided at the *Angry Birds* Cable Car theme rides at Mount Faber in Singapore; and
- (vi) Exhibit 10 - *Angry Birds* themed cakes and moon cakes.

88 The Opponents submitted that the Opponents' Earlier Mark T1113897F and Opponents' Earlier Mark T1111886Z achieved significant market presence for games, technology and communication but also in markets outside the gaming world such as toys, home wear, everyday consumer goods, food, snacks and drinks. The Opponents submitted that the Opponents' Earlier Mark T1113897F and Opponents' Earlier Mark T1111886Z are well-known to the public at large and are also well-known to specific sectors of the industry in Singapore.

89 The Opponents submitted that in light of the evidence furnished by the Opponents demonstrating use worldwide and also in Singapore and the successful enforcement actions in the USA and the European Union, they submitted that the Opponents' Earlier Mark T1113897F and Opponents' Earlier Mark T1111886Z are well-known in Singapore and also well-known to the public at large in Singapore.

90 The Opponents then turn to the issues of “connection” and “damage”, namely that the use of the Application Mark in relation to the goods would indicate a connection with the Opponents' Earlier Mark T1113897F and Opponents' Earlier Mark T1111886Z and is likely to damage the interests of the Opponents.

91 The Opponents submitted that the connection between the Application Mark and the Opponents' Earlier Mark T1113897F and Opponents' Earlier Mark T1111886Z goes beyond mere association or that the Application Mark might evoke thoughts of the Opponents' Earlier Marks in the subconscious mind of the consumer. The connection is made because the parties' trade marks are similar and they use their respective marks on their goods in an identical or similar manner.

92 The Opponents submitted that connection as to source and quality could exist in so far as the public expects chips bearing the Application Mark to be linked or to emanate from the same source as snacks bearing the Opponents' Earlier Marks or be of comparable quality because of this mistaken association. The connection also imports the misapprehension of an economic relationship between the Applicants' products and those of the Opponents'. The Opponents have several licensees who produce snack food, food products and beverages under the range of their *Angry Birds* branding. A business connection between the goods of the respective parties may also be adduced because of the possible misapprehension of an economic relationship between the parties.

93 The Opponents submitted that the requirements of establishing "damage" were discussed in detail in *Pensonic Corporation Sdn Bhd v Matsushita Electric Industrial Co. Ltd* [2008] SGIPOS 9 and submitted that the following instances of damage would arise. The consumer may have bought the snack bearing the Application Mark thinking they are buying something associated with the famous *Angry Birds* game and related merchandise, only to find out later after purchase, that this snack has nothing to do with the Opponents' famous *Angry Birds* products. The interests of the Opponents are likely to be damaged and these interests would include loss of pecuniary interests such as sales and profits.

94 Further, a consumer may buy the snack bearing the Application Mark thinking that there is a connection between the goods and the products bearing Opponents' Earlier Mark T1113897F and Opponents' Earlier Mark T111886Z or that these goods are *Angry Birds* themed snacks. If after consumption, the consumer finds that the taste of the snacks bearing the Application Mark differs from the Opponents' *Angry Birds* themed snacks, this would diminish his or her perception of the Opponents' goods.

95 The Opponents submitted that the Application Mark should be refused registration pursuant to Section 8(4)(b)(i) of the Act.

96 In *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2009] SGCA 53 ("*City Chain*"), the Court emphasised that the test "*well known to the public at large in Singapore*" must mean more than just "*well known in Singapore*"; to come within the former test, the trade mark must necessarily enjoy a much higher degree of recognition (*City Chain* at [94]). 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*" (*City Chain* at [94]).

97 The Opponents submitted that given the amount of publicity the Opponents' Earlier Mark T1113897F and Opponents' Earlier Mark T111886Z have achieved in Singapore, they would be well known to all sectors of Singapore society. The Opponents' Earlier Mark T1113897F and Opponents' Earlier Mark T111886Z are well known to those who enjoy playing the *Angry Birds* game as well as those who enjoy the other merchandise associated with them. The Opponents' Earlier Marks are well-known to the public at large.

98 The Opponents submitted that the use of the Application Mark in relation to the goods would cause dilution in an unfair manner of the distinctive character of the Opponents' Earlier Mark T1113897F and Opponents' Earlier Mark T1111886Z.

99 The Opponents referred to Section 2(1) of the Act in relation to the definition of dilution. The Opponents also referred to *Law of Trade Marks and Passing Off in Singapore* (Sweet & Maxwell, 2nd Ed, 2005) ("*Law of Trade Marks and Passing Off in Singapore*").

100 The Opponents submitted that the use and application to register the Application Mark would result in "blurring" of the Opponents' Earlier Mark T1113897F and Opponents' Earlier Mark T1111886Z, wherein the singularity or distinctiveness of the trade marks are impaired or eroded (*Law of Trade Marks and Passing Off in Singapore* at paragraph 6.58). The Opponents submitted that the distinctiveness of the Opponents' Earlier Mark T1113897F and Opponents' Earlier Mark T1111886Z would be eroded over time because the registration and use of the Application Mark could open the floodgates for other look-alike and sound-alike marks to be used and registered for similar goods.

101 The Opponents submitted that the following factors should be given due consideration in demonstrating that there is a real risk of dilution occurring:

- (i) the Opponents' Earlier Mark T1113897F and the Opponents' Earlier Mark T1111886Z can be said to be recognised by many in Singapore, including children, young adults, working professionals and parents who are the Opponents' target customers.
- (ii) it is important to recognise the distinctive quality of the Opponents' Earlier Mark T1113897F and Opponents' Earlier Mark T1111886Z given the invented nature of both signs.
- (iii) the close similarity between the distinctive Opponents' Earlier Mark T1113897F and Opponents' Earlier Mark T1111886Z and the Application Mark increases the likelihood that the relevant public will make a mental connection between the Application Mark with the Opponents' Earlier Marks.
- (iv) it is significant to note that the Applicants had admitted that the device in the Application Mark was inspired by the Opponents' *Angry Birds* game.
- (v) the goods of the Applicants are identical or at least closely similar to the goods of the Opponents and it is likely for consumers to draw a mental link between the trade marks of the respective parties. The focus is on whether the similarity causes consumers to form a mental association or link between the Opponents' Earlier Marks and the Application Mark.

102 Pursuant to the above, the Opponents submitted that the Application Mark should be refused registration in accordance with Section 8(4)(b)(ii)(A) of the Act.

103 The Opponents submitted that the use of the Application Mark in relation to the goods would take unfair advantage of the distinctive character of the Opponents' Earlier Mark T1113897F and Opponents' Earlier Mark T1111886Z.

104 In the case *Adidas-Salomon, Adidas Benelux v Fitnessworld Trading Ltd* [2004] 2 FSR 201 at [412] Advocate General Jacobs opined that the concept of taking unfair advantage of the distinctive character of a trade mark and that of taking unfair advantage of the repute of a trade mark encompassed "*instances where there [was] clear exploitation and free-riding on the coat-tails of a famous mark or an attempt to trade upon its reputation*" (*id at [39]*).

105 The Opponents submitted that consequently, the stronger the trade mark's distinctive character and reputation, the more likely the unfair advantage would be established. This section requires an inquiry into the benefit to be gained by the applicant from the use of his mark. When determining whether there is "free-riding", these factors may be taken into consideration:

- (i) the third party's intention behind the choice of the mark in question (whether it was deliberately chosen to establish an association with the special well-known trade mark);
- (ii) the impact on the economic behavior of the consumer (whether the third party's goods/ services sell because of the reputation of the special well-known trade mark).

106 The Opponents submitted that the Applicants' choice of "ANGRY BITE" and the device of an angry face is a relevant factor. The Applicants' angry face device was inspired by the *Angry Birds* game, as admitted at paragraph 6 of the Applicants' evidence. The choice to use the word combination "ANGRY BITE" in association with the Applicants' snack foods is unusual. The similarities between "ANGRY BITE" and "ANGRY BIRDS" have already been argued. The Opponents submitted that the Applicants have not furnished any legitimate basis for their choice of "ANGRY BITE" and the device of the angry face character other than to establish an association with Opponents' Earlier Mark T1113897F and Opponents' Earlier Mark T1111886Z and to profit from that association.

107 The Opponents submitted that there is a risk that the image of the Opponents' Earlier Mark T1113897F and Opponents' Earlier Mark T1111886Z are transferred to the goods of the Applicants, with the result that the marketing of those goods are made easier by the association with the Opponents' Earlier Marks. The advantage for the Applicants is a substantial saving on investment and promotion and publicity of their products bearing the Application Mark since these would benefit from the goodwill and reputation of the well-known Opponents' Earlier Mark T1113897F and Opponents' Earlier Mark T1111886Z.

108 The Opponents submitted that it is clear from the Opponents' 1st evidence that the Opponents' Earlier Mark T1113897F and Opponents' Earlier Mark T1111886Z as trade marks are well known to the public at large in Singapore not just for mobile gaming applications. These trade marks are also known for everyday consumer merchandise

spanning a wide range of goods. The Applicants' choice to combine "ANGRY BITE" with an angry face device and to use the same for snacks is no coincidence. They are seeking to benefit from the ready market held by the Opponents, one which spans a full spectrum of merchandise including snacks, and take unfair advantage of the Opponents' Earlier Mark T1113897F and Opponents' Earlier Mark T1111886Z.

109 The Opponents referred to the *ANGRY BAND* decision **OHIM Opposition No. B 1909657** at pages 9 to 10 (Exhibit 4 of the Opponents' 2nd evidence). The Opponents relied on these same arguments in respect of the subject opposition.

110 The Opponents submitted that the Application Mark should be refused registration pursuant to Section 8(4)(b)(ii)(B) of the Act.

Applicants' Submissions

111 As above, the Applicants submitted that the Application Mark is not identical or similar to the Opponents' Earlier Marks.

The Applicants submitted that the Opponents have not adduced cogent evidence in support of their contention that the Opponents' Earlier Marks are well-known in Singapore.

112 The Opponents have at paragraph 9 of the Opponents' 1st evidence listed down sales figures of their ANGRY BIRDS products and services worldwide. However, the Opponents have not adduced any evidence or attributed how much of those figures relate to Singapore. Further, the Opponents have not adduced any evidence of what mark these sales figures can be attributed to.

113 In this regard, the Applicants submitted that even if the Opponents' Earlier Marks are considered well-known in Singapore (which is not admitted), the establishment of any well-known status is only in relation to the words "ANGRY BIRDS" and this is only in relation to computer games.

114 The Opponents submitted that to be known to everyone is not to be known for everything, following Millet LJ in the case of *Harrods v Harrodian School Ltd* [1996] RPC 697. The reputation of a mark is not something that can exist on its own - it is always attached to the goods on which the mark is used.

115 It was held in *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2012] SGCA ("*Nutello*") that the test for the "connection" requirement was similar in substance to the test for the misrepresentation requirement in passing off, and the findings for the misrepresentation requirement were in turn based on the finding of a likelihood of confusion under s 27(2)(b) of the Act. The Applicants submitted that they have dealt at length with the issue of the likelihood of confusion in their submissions and adopt the same position.

116 The Applicants submitted that the Opponents merely asserted that there is a likelihood of damage to the Opponents' interests but have not expressly claimed under any of the heads of damage. No evidence whatsoever has been offered by the Opponents to suggest that the Opponents' interests are likely to be damaged through the use of the Application Mark.

117 The Applicants submitted that the Opponents have not established any of the 4 elements under Section 8(4)(b)(i), and that their opposition under this ground must accordingly fail.

118 In relation to the ground of objection under Section 8(4)(b)(ii), the Applicants submitted that the first element is the same as the first element under section 8(4)(b)(i). The Applicants repeat their submissions, that the marks are far from similar.

119 In relation to the term "well-known to the public at large" the Court in *City Chain* has held that:

the test "well known to the public at large in Singapore" must mean more than just "well known in Singapore". To come within the former test, the 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.

120 From the evidence adduced by the Opponents, the Applicants submitted that the Opponents have not established this. In this respect, the Opponents' *Angry Birds* game only took off at the end 2010, therefore at the date of application of the Application Mark, the Opponents' Earlier Marks were only 2 years old. As cited in *City Chain* at [91], in *Microsoft Corporation's Applications* [1997–1999] Information Technology Law Reports 361, the UK Trade Marks Registry held that the WINDOWS trade mark was not a well-known mark. Evidence of use was not enough and proof of actual recognition by the public had to be shown.

121 In the same vein, no survey was carried in Singapore to show actual recognition of the Opponents' Earlier Marks by the general public. The Opponents' Earlier Marks are not even listed in Interbrand Global Top 100 brands of 2013. The Opponents are far from a Microsoft (No. 5 on list) or Louis Vuitton (No. 17 on list).

122 The Applicants submitted that in view of the lack of any evidence, it would be a stretch of the imagination to consider the Opponents' Earlier Marks well-known to the public at large in Singapore.

123 The Applicants submitted that the Opponents have not adduced sufficient evidence to establish the first 2 elements required under Section 8(4)(b)(ii), Accordingly, this ground of opposition must fail.

Decision on Section 8(4)

Similarity of marks

124 In relation to this ground, it is clear that the first element that must be satisfied is that "the whole or essential part of the trade mark must be identical or similar to an earlier mark".

125 I note that the Opponents did not make any specific submissions in relation to this element under this objection. Therefore I will take it that it was the Opponents' intention that their submissions in relation to the similar element under Section 8(2)(b) applied.

126 In relation to this element, my view is primarily the same in relation to the similar element under Section 8(2)(b).

127 In short, I am of the view that this element has not been made out. As this finding is important in relation to the objection under all three limbs under Section 8(4), I will highlight the critical issues that led me to my decision.

128 First and foremost, the wording of Section 8(4) provides that the comparison is to be made mark-for -mark. The relevant excerpt of Section 8(4) of the Act reads:

...(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 ...

129 In light of the similarity of wording between Section 8(4) and Section 8(2)(b), whilst the comments made by the Court in *St Regis* relate to the mark for mark comparison under Section 8(2), an application of the same principles would be appropriate.

130 Therefore, I am of the view that the approach for comparison as per Table 1 above applies. For ease of reference, the table is as follows:

S/N	Application Mark (T1204840G)	Opponent's Earlier Mark T1111886Z
1.		
2.		Opponent's Earlier Mark T1113897F

	ANGRY BIRDS
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131 An application of the above approach is consistent with the wording of Section 8(4), which is, to assess if the whole or essential part of the Application Mark is identical or similar to the Opponents' Earlier Mark T1111886Z or Opponents' Earlier Mark T1113897F respectively.

132 It is clear that the whole or essential part of the Application Mark is not similar to the Opponents' Earlier Mark T1111886Z. As alluded to above, the Application Mark, being a composite mark, contains several essential elements, including the "angry eyes" device and the words "Angry Bite" amongst others. As opined earlier, if there is any area of similarity between the Application Mark and the Opponents' Earlier Mark T1111886Z, it would be, at most, the "angry eyes" device. This alone cannot render the Application Mark similar to the Opponents' Earlier Mark T1111886Z..

133 It is also clear that the whole or essential part of the Application Mark is not similar to the Opponents' Earlier Mark T1113897F. Again, as alluded to earlier, if there is any area of similarity between the Application Mark and the Opponents' Earlier Mark T1113897F, it would be the words "Angry Bi". However, that is hardly enough to render the two marks similar since the Application Mark, again being a composite mark, contains other essential elements.

134 In light of the above, I am of the view that the first element has not been made out under this ground, that is, it has not been shown that the whole or essential part of the Application Mark is identical with or similar to an earlier trade mark, whether it is in relation to the Opponents' Earlier Mark T1111886Z or Opponents' Earlier Mark T1113897F. As this element has not been met, there is no need for me to consider if the other elements under the objection pursuant to Section 8(4) have been satisfied.

135 However, in the event that I am wrong, I am of the view that, while the Opponents' Earlier Marks can be said to be well known in Singapore, there is no confusing connection established largely for the same reasons that I have found that there is no likelihood of confusion under section 8(2)(b).

Well-known in Singapore

136 The critical question is whether the Opponents' Earlier Marks are well known in Singapore as at the relevant date of 5 April 2012, which is the date of application of the Application Mark.

137 I note that the only evidence of any sales / promotional figures by the Opponents are those provided in paragraph 9 of the Opponents' 1st evidence which relates to all "Angry Birds" products and services worldwide, although as submitted by the Applicants, it is not clear as to the marks to which these figures relate:

Year	Amount spent in promotion (EUR)	Amount worth in sales (EUR)
2009	80,000	NA
2010	240,000	NA
2011	800,000	75.4M
2012	6000,000	152.2M

138 In relation to the instances of use of the Opponents' Earlier Marks in Singapore, it is noted that several cannot be taken into account as they are either after the relevant date of 5 April 2012 or it is not indicated when the goods or services were provided. A table will assist in this regard, with those items being relevant italicised:

S/N	Instances/Events	Field of business	Relevant "Get up"	Date of event/entry	Reference in the Opponents' evidence
1.	<i>Downloads</i>	<i>Games</i>	<i>Various, including the Red Bird and the words "ANGRY BIRDS" NB: there was no evidence tendered in this regard but the Registrar will take judicial notice of the same.</i>	<i>October 2011</i>	<i>Paragraph 4 of the Opponents' 1st evidence</i>
2.	<i>2011 Formula 1 Singtel Singapore Grand Prix</i>	<i>Unclear - Various including headgear, shirts</i>	<i>Various, including the Red Bird and the words "ANGRY BIRDS"</i>	<i>October 2011</i>	<i>Paragraph 10 of the Opponents' 1st evidence and Exhibit 4 of the same evidence at pages 241-246</i>
3.	<i>Heikiki Challenge</i>	<i>Unclear - Games (as per the</i>	<i>Various including Red Bird</i>	<i>September 2012 (as per the date on</i>	<i>Paragraph 10 of the Opponents' 1st evidence and</i>

S/ N	Instances/Events	Field of business	Relevant "Get up"	Date of event/entry	Reference in the Opponents' evidence
		description on the website at page 247 of the Opponents' 1 st evidence)	and the words "ANGRY BIRDS"	the website on page 247 of the Opponents' 1 st evidence)	Exhibit 4 of the same evidence at pages 247 - 250
4.	<i>Takashimaya Department Store</i>	<i>Unclear - Performance at the department store (as per the description in paragraph 10 of the Opponents' 1st evidence)</i>	<i>Various including Red Bird and the words "ANGRY BIRDS"</i>	<i>November 2011</i>	<i>Paragraph 10 of the Opponents' 1st evidence and Exhibit 4 of the same evidence at pages 251-253</i>
5.	<i>Finnair Helsinki - Singapore Flight</i>	<i>Unclear - Games / food etc as per paragraph 11 of the Opponents' 1st evidence</i>	<i>Various including Red Bird and the words "ANGRY BIRDS"</i>	<i>21 September 2011</i>	<i>Paragraph 11 of the Opponents' 1st evidence and Exhibit 5 of the same evidence at pages 256-275</i>
6.	<i>Angry Birds Space Promotion at Changi Airport Singapore</i>	<i>Unclear</i>	<i>Red Bird</i>	<i>22 November 2012 (as per page 276 of the Opponents' 1st evidence)</i>	<i>Opponents' 1st evidence at Exhibit 5 at pages 276 - 278</i>
7.	<i>MegaCorp / IT Show</i>	<i>Soft toys</i>	<i>Various including Red Bird</i>	<i>April 2011 NB: it is unclear as to the date in the month of April 2011 when the products enter the Singapore market.</i>	<i>Paragraph 12 of the Opponents' 1st evidence and Exhibit 6 of the same evidence at pages 284-285</i>

S/ N	Instances/Events	Field of business	Relevant "Get up"	Date of event/entry	Reference in the Opponents' evidence
				<i>Nevertheless, I am prepared to accept this as equivalent to 1 April 2014.</i>	
8.	<i>Watsons / Takashimaya Department Store / Popular Book Store / Seven - Eleven Stores</i>	<i>Various merchandise including Watches / tumblers / tissues etc</i>	<i>Various including Red Bird and the words "ANGRY BIRDS"</i>	<i>October 2011 (as per page 286 of the Opponents' 1st evidence)</i>	<i>Paragraph 12 of the Opponents' 1st evidence and Exhibit 6 of the same evidence at page 286-289</i>
9.	<i>Christmas Fantasy : Angry Birds at Takashimaya</i>	<u>Not specified</u>	<i>Various including Red Bird and the words "ANGRY BIRDS" (as per the website at page 290 of the Opponents' 1st evidence)</i>	<i>November 2011 – December 2011 (as per page 290 of the Opponents' evidence)</i>	<i>Exhibit 6 of the Opponents' 1st evidence at page 290</i>
10.	Qoo.10.sg NB: unclear if there were sales made in Singapore	Various	Various including Red Bird and the words "ANGRY BIRDS"	<u>Not specified</u>	Exhibit 6 of the Opponents' 1 st evidence at pages 291 -297
11.	<i>Seven – Eleven Stores</i>	<i>Mugs</i>	<i>Various including Red Bird and the</i>	<i>28 March 2012</i>	<i>Exhibit 6 of the Opponents' 1st evidence at pages 298- 302</i>

S/ N	Instances/Events	Field of business	Relevant "Get up"	Date of event/entry	Reference in the Opponents' evidence
			<i>words "ANGRY BIRDS"</i>		
12.	Kinokuniya Singapore	Books	Various including Red Bird and the words "ANGRY BIRDS"	Not specified	Paragraph 12 of the Opponents' 1 st evidence and Exhibit 6 of the same evidence at pages 303-307
13.	<i>Deal.com.sg</i> NB: unclear if there were sales made in Singapore	<i>Soft toys</i>	<i>Various including Red Bird</i>	<i>July 2011</i>	<i>Exhibit 6 of the Opponents' 1st evidence at page 313</i>
14.	BHG	Food - Sweets	Various including Red Bird and the words "ANGRY BIRDS"	August 2012	Paragraph 13 of the Opponents' 1 st evidence and Exhibit 7 of the same evidence at pages 316 – 319
15.	Shine Korea	Food - chips	Various including Red Bird and the words "ANGRY BIRDS"	Not specified	Paragraph 14 of the Opponents' 1 st evidence and Exhibit 8 of the same evidence pages 322 - 326
16.	<i>Angry Birds</i> Cable Car Ride	Various including food and merchandise	Various including Red Bird and the words "ANGRY BIRDS"	1 June 2012	Paragraph 15 of the Opponents' 1 st evidence and Exhibit 9 of the same evidence at pages 331 – 347
17.	<i>Polar Cakes</i>	<i>Food – regular cakes</i>	<i>Various including Red Bird and the words "ANGRY BIRDS"</i>	<i>November 2011</i>	<i>Paragraph 16 of the Opponents' 1st evidence and Exhibit 10 of the same evidence at Page 353</i>

S/ N	Instances/Events	Field of business	Relevant "Get up"	Date of event/entry	Reference in the Opponents' evidence
					<i>NB: page 354 has not been identified to be under Polar Cakes and is thus not to be taken into account.</i>
18.	Peony Jade etc	Food – regular cakes	Various including Red Bird and the words "ANGRY BIRDS"	Not specified	Exhibit 10 of the Opponents' 1 st evidence at page 355
19.	Peony Jade etc	Food - mooncakes	Various including Red Bird and the words "ANGRY BIRDS"	August 2012	Paragraph 16 of the Opponents' 1 st evidence and Exhibit 10 of the same evidence at pages 356 – 365

139 In relation to the instances which are listed in paragraph 8 and Exhibit 3 of the Opponents' 1st evidence, most of these instances are undated and thus cannot be taken into account. The only relevant pages of Exhibit 3 where the items are dated to be before the relevant date of 5 April 2012 are pages 222 and 223 which relate to fruit snacks (dated October 2011).

140 To the above, I add the articles which are referred to at paragraph 7 and enclosed at Exhibit 2 of the Opponents' 1st evidence. It is noted that these articles, which include newspaper articles and online articles, relate mainly to the *Angry Birds* Game App. Further, some articles are dated after the relevant date of 5 April 2012 and thus cannot be taken into account.

141 Last but not least, the Opponents referred to their registration certificates as provided under Exhibit 1 of the Opponents' 1st evidence as well as record of successful enforcement in the United States (paragraph 30 and Exhibit 3 of the Opponents' 2nd evidence).

142 The starting point for this limb is Sections 2(7), (8) and (9) of the Act.

Section 2(7) of the Act states:

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

- (a) the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;*
- (b) the duration, extent and geographical area of –
 - (i) any use of the trade mark; or*
 - (ii) any promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied;**
- (c) any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application;*
- (d) any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory;*
- (e) any value associated with the trade mark.*

Section 2(8) of the Act reads:

Where it is determined that a trade mark is well known to any relevant sector of the public in Singapore, the trade mark shall be deemed to be well known in Singapore.

Section 2(9):

In subsections (7) and (8), “relevant sector of the public in Singapore” includes any of the following:

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

143 Further, following **Novelty Pte Ltd v Amanresorts Ltd and another [2009] SGCA 13** ("**Amanusa**") at [137]:

...It appears that the court is ordinarily free to disregard any or all of the factors listed in s 2(7) as the case requires (subject to [Section 2(7)(a) of the Act]), and to take additional factors into consideration....

[Emphasis as underlined mine].

144 Section 2(7)(a) is arguably the most crucial factor when determining whether a trade mark is well known in Singapore due to Section 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", see also [139] of *Amanusa*.

145 Last but not least, it is to be remembered that the Court in *Amanusa* provided at [229]:

Finally, 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...

[Emphasis as underlined mine].

146 The court in *Amanusa* discussed the ambit of the phrase "all actual consumers and potential consumers in Singapore of the goods" at [152] and concluded that "the inquiry is much more focused and manageable if one looks only at the specific goods or services to which the [Opponents'] trade mark has been applied (that is, if one considers only the [Opponents'] goods or services)."

147 In light of all the above, I am prepared to hold that the Opponents' Earlier Marks are well known in Singapore.

Confusing connection

148 In this regard, the Court at *St Regis* provided as such at [120]:

...As for the third element, the detailed analysis in Amanresorts has put it beyond doubt that the connection requirement of s 8(4)(b)(i) and s 55(3)(a) of the Act will be satisfied where there is a likelihood of confusion (see Amanresorts at [226] and [233])....

149 Further, as submitted by the Applicants, in *Nutello*, the Court held that:

In the present case, there was the requisite confusing connection under s 55(3)(a) TMA. The test for the "connection" requirement was similar in substance to the test for the misrepresentation requirement in passing off, and the findings for the

misrepresentation requirement were in turn based on the finding of a likelihood of confusion under s 27(2)(b) TMA.

150 I am mindful of the Court in *St Regis* providing that there are some differences in approach between an opposition proceeding and an infringement proceeding, in particular at [163(f)] and [163(g)].

151 Having taken the above into consideration, I am of the view that there is no confusing connection here for largely the same reasons that I have provided for my conclusion in relation to the likelihood of confusion under Section 8(2)(b).

Well known to the public at large

152 In relation to this, the Court in *Amanusa* provided at [233]:

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

[Emphasis as underlined mine].

153 Further at *City Chain* the Court held:

In the context of s 55(3)(b)(i) of the Act, the test “well known to the public at large in Singapore” had to mean more than just “well known in Singapore”. To come within the former test, the mark had to necessarily enjoy a much higher degree of recognition. It had to be recognised by most sectors of the public though the court would not go so far as to say all sectors of the public.

[Emphasis as underlined mine].

154 In light of the fact that such trade marks form a "rare and exclusive class", I am unable to conclude that the Opponents' Earlier Marks are well known to the public at large based on the evidence tendered as described above, my comments of which are as follows:

- (i) The strongest evidence is the sales / promotional figures which relate to a broad spectrum of products and services in Singapore and overseas. However, I note that there are figures for the promotional expenses over a period of 4 years only from 2009 to 2012. Further, for sales, there are only figures for the period from 2011 and 2012 ie 2 years only. There is also no elaboration as to (i) what these countries are; (ii) what products and services

- are included; and (iii) what the marks are. Last but not least, there are also no invoices appended to support these sales / promotional figures.
- (ii) In relation to instances of provision of products and services in Singapore, some of these instances are "one off" instances, like the performance at Takashimaya Department Store (item 4). For many, in fact, for most instances, there are no invoices to substantiate any sales.
 - (iii) In relation to instances of overseas use, the majority of the exhibits under Exhibit 3 cannot be taken into account due to the fact that most of them are undated. In fact, only 2 pages out of the whole Exhibit 3 are relevant (as commented above). Similarly, these instances of use are not substantiated by any invoices.
 - (iv) Instances of articles relate mainly to the *Angry Birds* Game.
 - (v) Registration certificates in different jurisdictions: this is taken into account. However, it is noted that this is only one of the factors enumerated under Section 2(7).
 - (vi) In relation to enforcement, in many instances the applicant in the cases relied upon simply "abandoned" their application. This alone does not go anywhere towards proving the "well-known-ness" of the Opponents' Earlier Marks for the applicants in those cases could have given up the fight due a myriad of reasons, including economic reasons.

155 In short, I am of the view that the evidence tendered is not sufficient to prove that the Opponents' Earlier Marks are well known to the public at large in Singapore. This is not to say that survey evidence is a pre-requisite for a finding that a mark is well known to the public at large. Nor am I saying that some sort of third party report like the InterBrand report as submitted by the Applicants is required. But what I am saying is that substantial evidence is required.

156 I refer to paragraph 31 of the Opponents' 2nd evidence, referring to the successful opposition of the Angry Band Community Trade Mark Application No. 0100063907 in the European Union. I am of the view that it is not helpful to the current case. To begin with, the relevant marks were "Angry Birds" versus "Angry Band". They are both word marks. As alluded to above, the Application Mark is a composite mark while the Opponents' Earlier Marks are a device only mark and a word only mark respectively.

157 Before I leave this ground, I note, as mentioned above as well, while it is possible to claim that the Opponents' earlier marks consists of an unregistered trade mark that is well known in Singapore, this has not been pleaded in the Amended Statement of Grounds of the Opponents and no submissions have been put forth in this regard. Therefore, there is no need for me to address this possibility.

158 I note that the Opponents have submitted above the use of the "Angry Birds" typeface logos" as well known marks. The Opponents have not clarified if they are claiming this as part of the Opponents' Earlier Mark T1113897F (since registration in capital font includes all fonts) or as an unregistered trade mark which is well known in Singapore. Regardless of the above, my view is that it cannot be said that the whole or

essential part of the Application Mark is identical or similar to the "Angry Birds typeface logos" as shown above.

159 The ground of opposition under Section 8(4) therefore fails.

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

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

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

(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

161 The Opponents submitted that the definitive statement on the requirements of a passing off action was by Lord Oliver of Aylmerton's in ***Reckitt & Colman Products Ltd v Borden Inc [1990] 1 WLR 491*** ("the ***Jif Lemon*** case"), and quoted in ***Amanusa*** at [36].

162 The Opponents submitted that the above unequivocally articulates three clearly identifiable core concepts which are fundamental to a passing off action, namely:

- (i) goodwill;
- (ii) misrepresentation; and
- (iii) damage.

163 The Opponents further referred to the ***Amanusa*** at [39] wherein reference was made to ***The Commissioners of Inland Revenue v Muller & Co's Margarine, Limited [1901] AC 217*** ("***IRC v Muller & Co***"):

“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.”

164 The above passage highlights two essential features of goodwill.

(i) First, it is the association of a good, service or business on which the Opponents' mark, name, labelling etc. (generically referred to as the Opponent's "get-up") has been applied with a particular source.

(ii) Second, this association is an attractive force which brings in custom.

165 The Opponents submitted that the Opponents' Earlier Mark T1113897F and Opponents' Earlier Mark T1111886Z are distinctive indicia capable of being the vessels of goodwill. As previously submitted, the Opponents' Earlier Mark T1113897F and Opponents' Earlier Mark T1111886Z are well-known trade marks in Singapore, well known to the public at large and to the relevant market sectors in Singapore. The Opponents submitted that based on the evidence filed by the Opponents in these proceedings and the submissions made herein, the Opponents' Earlier Mark T1113897F and Opponents' Earlier Mark T1111886Z enjoy significant goodwill and reputation.

166 In relation to misrepresentation, the Opponents referred to *Law of Trade Marks and Passing Off in Singapore* paragraph 17.75 onwards and submitted that as long as members of the public (not just the targeted consumer group) are led to believe that there is some business connection between the businesses of the party complaining of the passing-off and that of the party defending the claim owing to the latter's use of the offending trade mark or sign or trade name, it matters not that the misrepresentation was innocent. The misrepresentation does not have to be fraudulent. However, the question why the defendant chose to adopt a particular trade mark is relevant. It is "*a question which falls to be asked and answered*".

167 The question whether there is misrepresentation is a matter for the judge who, looking at the documents and the evidence before him, must come to his own conclusion.

168 Further, the Opponents submitted that in *Amanusa* at [84], it was held that another factor to consider in assessing whether misrepresentation in question has led to confusion between the business, goods or services of the plaintiff and those of the defendant is "*whether the parties are in the same field or closely related fields of business*".

169 Misrepresentation may be express or implied and deceives either by diverting customers from the Opponents to the Applicants or by occasioning a confusion between the parties' businesses such as by suggesting that the Applicants' business is an extension, brand or agency of or otherwise connected with the business of the Opponents.

170 In the present case, the Opponents claimed the Application Mark constitutes a misrepresentation as the parties are engaged in a common field of activity, namely, the snack product market and both parties cater to the same target audience or consumer market.

171 The Opponents submitted that misrepresentation can occur as the Applicants have taken very few steps to distinguish their product from those of the Opponents. "D-Jack" is not prominently displayed.

172 The Opponents submitted that the second limb of passing-off, namely, misrepresentation has been met.

173 The Court in *Amanusa* referred to the test for damage in passing off cases as either “*actual or probable damage*” to the plaintiff’s goodwill at [94]. The Opponents submitted that there are several forms of damage to be considered. In *Law of Trade Marks and Passing Off in Singapore* at paragraph 17.117, the author states that “*if the plaintiff and the defendant are in competition with each other, the Court will readily infer damage or the likelihood of damage*”. It is not necessary to show that the defendant’s goods or services are inferior.

174 The Court in *Amanusa* at [97] referred to one of the possible heads of damage to goodwill being the “blurring” of the plaintiff’s get-up. In the context of assessing damage to the Opponents’ goodwill, the Opponents submitted that customers are drawn by the attractive force of the Opponents’ Earlier Mark T1113897F and the Opponents’ Earlier Mark T1111886Z and they may be drawn to the business and goods of the Applicants’ instead of the Opponents’ because the Application Mark consists of the similar “attractive” features which makes up the Opponents’ Earlier Marks. The goodwill attached to the Opponents’ business and their goods becomes spread out to a business and products which are not the Opponents’ or products produced by the Opponents’ authorized licensees.

175 The Opponents also claimed, amongst others the following:

- (i) Loss of exclusivity and erosion of the distinctiveness of the Opponents’ Earlier Mark T1113897F and Opponents’ Earlier Mark T1111886Z;
- (ii) Loss of sales when consumers are being diverted from the Opponents to the Applicants in respect of chips bearing the Application Mark;
- (iii) Loss of licensing opportunity/revenue when third parties in Singapore begin to use “ANGRY BIRDS” or any of the *Angry Birds* characters freely without seeking the appropriate trade mark licence from the Opponents.

176 The Opponents submitted that the three elements for determining passing-off have been made out and they submitted that the Application Mark should be refused registration pursuant to Section 8(7)(a) of the Act.

Applicants’ Submissions

177 The Applicants also submitted that the three elements required in establishing passing off are:

- (i) goodwill;
- (ii) misrepresentation;
- (iii) damage.

178 In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (i) the nature and extent of the reputation relied upon;
- (ii) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (iii) the similarity of the mark, name, etc used by the defendant to that of the plaintiff;
- (iv) the manner in which the defendant makes use of the name, mark, etc complained of and collateral factors; and
- (v) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

179 In this connection, the Applicants submitted that the situation with the Opponents is different. The Opponents' business is not in snack foods. It is a maker of computer games. The Opponents license 3rd parties to use their marks on various goods. This is also known as character merchandising.

180 The Applicants submitted that as mentioned above, the Opponents' business and hence goodwill is in computer games. There is no evidence tendered by the Opponents on the goodwill they have, in relation to class 30 goods in Singapore, or the licences they have entered into with parties for manufacture and supply of such goods to Singapore. Further, apart from Exhibit 8 of the Opponents' 1st evidence which in any event post-dates the date of application, no further relevant evidence of the sale of snack foods has been tendered.

181 The Applicants submitted that the Opponents must show that that there has been a misrepresentation which has resulted in damage. Due to the large dissimilarities of the marks as mentioned above, there is no likelihood of confusion between the marks. In any event, the Opponents have not adduced any evidence showing that persons who purchased the ANGRY BIRDS snack product purchased the item because the purchaser knew or believed the product to have been manufactured under licence from the Opponents instead of merely being attracted to the images found on the packaging.

182 For damage, the Applicants submitted that the Opponents will have to show that, as a result of the Applicants' actions, the Opponents have lost licensing revenue or opportunity. In view that such evidence is entirely lacking, the Applicants submitted that this element is not made out.

Decision on Section 8(7)(a)

183 In relation to this ground, it is clear from the parties' submissions that there are 3 elements to be established and they are:

- (i) Goodwill;
- (ii) Misrepresentation; and
- (iii) Damage.

184 The definition of goodwill has been provided above and it bears repeating as follows (see *IRC v Muller & Co*):

“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.”

[Emphasis as underlined mine].

185 It is important to note that the plaintiff must establish that he has acquired goodwill as at the relevant date and this date is the date on which the defendant's conduct complained of started (see *Law of Intellectual Property of Singapore (Sweet & Maxwell, 2009 Rev Ed)* ("**Law of Intellectual Property of Singapore**") at [17.1.1]). Applying the principle to the current case, the relevant date in this instance is 5 April 2012, which is the date of application of the Application Mark.

186 It is also important to note that passing off protects goodwill and not the mark used to promote it. I refer to *Law of Intellectual Property of Singapore* at [17.1.3]:

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

[Emphasis as underlined mine].

187 Having said the above, it is clear that under the law the "get up" can include various aspects of the business, including a mark, as per **the Jif Lemon case** above, and quoted in *Amanusa* at [36], the relevant except as follows:

"The law of passing off can be summarised in one short general proposition - no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the

mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services.

[Emphasis in bold and as underlined mine].

188 Importantly, in this instance, the Opponents' submissions specifically refer to the Opponents' Earlier Marks as distinctive indicia capable of being vessels of goodwill (see above). I note that there is no submission as to the other aspects of the Opponents' business to be considered as part of the Opponents' get-up. Therefore, my analysis below will only pertain to the Opponents' Earlier Marks as being the relevant vessels of goodwill in this case.

189 It is important to focus on goodwill in Singapore as the Court in *St Regis* at [136] and [137] has clarified that the local approach, unlike other jurisdictions like Australia, is still the "hardline" approach, albeit such an approach having been softened by *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR(R) 975 to include pre-trading activity:

[138] In CDL Hotels, this court identified two categories of activity relevant to the establishing of goodwill prior to the official commencement of trading in Singapore. The first was what the court termed "business activities which had gone into full swing and generated considerable income for the respondents" (at [61]). This included confirmed room reservations and retail tenants which the respondent had secured for the retail wing of its Singapore establishment. The finding that such actual trading activities are capable of generating domestic goodwill is uncontroversial and does not depart from the traditional hard-line approach. The importance of CDL Hotels was its recognition of a second category of non-income generating "pre-trading activities" as capable of contributing to goodwill. These were the respondent's "large-scale advertising" efforts costing around \$1m over one year, the steady stream of press-releases and media events, entering into an operating agreement with Ritz-Carton as to the running of the hotel facility, and widely-publicised promotional events such as two topping-up ceremonies (see CDL Hotels at [59]).

*[139] CDL Hotels however identified a third category of activity which would not suffice to generate goodwill, citing *Amway Corporation v Eurway International Limited* [1974] RPC 82 ("Amway"). In *Amway*, the plaintiff had initially conducted "minor trading activity" in the UK, before seeking to expand its UK operations by sourcing for premises and interviewing personnel to run the UK office. These activities were found inadequate to show that the plaintiff had business activity in the UK which was protectable under the law of passing-off. The latter activities were described as "mere preparations for trading" in *CDL Hotels* (at [58]).*

[Emphasis as underlined mine].

190 The Court at *St Regis* provided further clarification at [141] to [145]:

[141] First, pre-trading activity need not be revenue-generating. This stems from the understanding that goodwill does not focus on the income of the trader per se but the response of the consumer. The fact that income is generated is only a proxy for the attractive force of the business. This court's holding in CDL Hotels acknowledged that valuable demand may be created in a product or business prior to its being monetized.

[142] Second, the relevant pre-trading or pre-business activities should unequivocally evince the intention of the trader to enter into the Singapore market...

[145] Finally, the unequivocal intention to enter the local market is a necessary factor qualifying pre-trade activity for consideration in the goodwill inquiry, but it is not sufficient. It must be remembered that the ultimate question is whether the activity has generated an attractive force that will bring in custom when the business eventually materialises. If a trader has taken steps evincing his intention to trade in Singapore, such as securing premises or employees here, but has done nothing to put the business in the awareness of the public so as to create demand, then there clearly is no Singapore goodwill to be protected...Against this background, we return to the final question, which is whether the activity will then materialise into actual custom.

[Emphasis as underlined mine].

191 In relation to the proof required to show goodwill, there are two points to note in the current case.

192 Firstly, I note that it is possible for goodwill to be shared (see *Law of Intellectual Property of Singapore* at [17.4.1]). In the present case, it is possible for the goodwill to be shared by the Opponents and their licensees. Unfortunately, the Opponents did not make any substantial submissions in this regard except to orally submit that goodwill extends to licensees. Be that as it may, I note that the Applicants orally submitted that even if the Opponents have goodwill in Class 30 (this issue will be addressed later), there is no misrepresentation.

193 Secondly, what is normally accepted as proof of goodwill would be to show volume of sales, etc in relation to the mark in question (see *Law of Intellectual Property of Singapore* at [17.1.4]):

Since the test for goodwill focuses on the level of the public's awareness of the plaintiff's mark and association of the mark with the plaintiff's goods or services,

the plaintiff usually discharges his burden of proving goodwill by tendering evidence of his sales volume, and/or the extent and amount of advertisement and media coverage of his business conducted under that mark, and/or market surveys.

[Emphasis as underlined mine.]

194 Before I launch into an analysis of the evidence tendered in relation to the Opponents' goodwill, I note that for an action for passing off, it is not necessary for the area of business to be the same. However, I agree with the parties that the closeness of the respective fields of activity in which the plaintiff and defendant carry on their business will have an impact in relation to the element of misrepresentation. As we are dealing with the element of goodwill at this point, I will venture to list all instances of goodwill in the local context and will save the issue of "relevant fields of business" when I deal with the element of misrepresentation below.

195 Further, there is another issue to be addressed. There are several instances/events below where it is unclear what were the merchandise being sold. I note that the Opponents have attempted to submit as to what the merchandise were. However, there is a need to provide evidence to support their submissions. For the table below, where I state that the exact merchandise being sold is unclear, it means that I could not find any instance of the same whether in the main body of the evidence or in the exhibits included within the evidence.

196 The following are the instances where the Opponents have entered the Singapore market, regardless of (i) whether it is via licensees; (ii) the field of business; and (iii) the date of entry:

S/N	Instances/Events	Field of business	Relevant "Get up"	Date of event/entry	Reference in the Opponents' evidence
1.	<i>Downloads</i>	<i>Games</i>	<i>Various, including the Red Bird and the words "ANGRY BIRDS" NB: there was no evidence tendered in this regard but the Registrar will take</i>	<i>October 2011</i>	<i>Paragraph 4 of the Opponents' 1st evidence</i>

S/ N	Instances/Events	Field of business	Relevant "Get up"	Date of event/entry	Reference in the Opponents' evidence
			<i>judicial notice of the same.</i>		
2.	<i>2011 Formula 1 Singtel Singapore Grand Prix</i>	<i>Unclear - Various including headgear, shirts</i>	<i>Various, including the Red Bird and the words "ANGRY BIRDS"</i>	<i>October 2011</i>	<i>Paragraph 10 of the Opponents' 1st evidence and Exhibit 4 of the same evidence at pages 241-246</i>
3.	<i>Heikiki Challenge</i>	<i>Unclear - Games (as per the description on the website at page 247 of the Opponents' 1st evidence)</i>	<i>Various including Red Bird and the words "ANGRY BIRDS"</i>	<i>September 2012 (as per the date on the website on page 247 of the Opponents' 1st evidence)</i>	<i>Paragraph 10 of the Opponents' 1st evidence and Exhibit 4 of the same evidence at pages 247 - 250</i>
4.	<i>Takashimaya Department Store</i>	<i>Unclear - Performance at the department store (as per the description in paragraph 10 of the Opponents' 1st evidence)</i>	<i>Various including Red Bird and the words "ANGRY BIRDS"</i>	<i>November 2011</i>	<i>Paragraph 10 of the Opponents' 1st evidence and Exhibit 4 of the same evidence at pages 251-253</i>
5.	<i>Finnair Helsinki - Singapore Flight</i>	<i>Unclear - Games / food etc as per paragraph 11 of the Opponents' 1st evidence</i>	<i>Various including Red Bird and the words "ANGRY BIRDS"</i>	<i>21 September 2011</i>	<i>Paragraph 11 of the Opponents' 1st evidence and Exhibit 5 of the same evidence at pages 256-275</i>
6.	<i>Angry Birds Space Promotion at</i>	<i>Unclear</i>	<i>Red Bird</i>	<i>22 November 2012 (as per page 276 of</i>	<i>Opponents' 1st evidence at Exhibit 5 at pages</i>

S/ N	Instances/Events	Field of business	Relevant "Get up"	Date of event/entry	Reference in the Opponents' evidence
	Changi Airport Singapore			the Opponents' 1 st evidence)	276 - 278
7.	<i>MegaCorp / IT Show</i>	<i>Soft toys</i>	<i>Various including Red Bird</i>	<i>April 2011 NB: it is unclear as to the date in the month of April 2011 when the products enter the Singapore market. Nevertheless, I am prepared to accept this as equivalent to 1 April 2014.</i>	<i>Paragraph 12 of the Opponents' 1st evidence and Exhibit 6 of the same evidence at pages 284-285</i>
8.	<i>Watsons / Takashimaya Department Store / Popular Book Store / Seven - Eleven Stores</i>	<i>Various merchandise including Watches / tumblers / tissues etc</i>	<i>Various including Red Bird and the words "ANGRY BIRDS"</i>	<i>October 2011 (as per page 286 of the Opponents' 1st evidence)</i>	<i>Paragraph 12 of the Opponents' 1st evidence and Exhibit 6 of the same evidence at page 286-289</i>
9.	<i>Christmas Fantasy : Angry Birds at Takashimaya</i>	<i>Not specified</i>	<i>Various including Red Bird and the words "ANGRY BIRDS" (as per the website at page 290 of the Opponents' 1st evidence)</i>	<i>November 2011 – December 2011 (as per page 290 of the Opponents' evidence)</i>	<i>Exhibit 6 of the Opponents' 1st evidence at page 290</i>

S/ N	Instances/Events	Field of business	Relevant "Get up"	Date of event/entry	Reference in the Opponents' evidence
10.	Qoo.10.sg NB: unclear if there were sales made in Singapore	Various	Various including Red Bird and the words "ANGRY BIRDS"	Not specified	Exhibit 6 of the Opponents' 1 st evidence at pages 291 -297
11.	<i>Seven – Eleven Stores</i>	<i>Mugs</i>	<i>Various including Red Bird and the words "ANGRY BIRDS"</i>	<i>28 March 2012</i>	<i>Exhibit 6 of the Opponents' 1st evidence at pages 298- 302</i>
12.	Kinokuniya Singapore	Books	Various including Red Bird and the words "ANGRY BIRDS"	Not specified	Paragraph 12 of the Opponents' 1 st evidence and Exhibit 6 of the same evidence at pages 303-307
13.	<i>Deal.com.sg</i> NB: unclear if there were sales made in Singapore	<i>Soft toys</i>	<i>Various including Red Bird</i>	<i>July 2011</i>	<i>Exhibit 6 of the Opponents' 1st evidence at page 313</i>
14.	BHG	Food - Sweets	Various including Red Bird and the words "ANGRY BIRDS"	August 2012	Paragraph 13 of the Opponents' 1 st evidence and Exhibit 7 of the same evidence at pages 316 – 319
15.	Shine Korea	Food - chips	Various including Red Bird and the words "ANGRY BIRDS"	Not specified	Paragraph 14 of the Opponents' 1 st evidence and Exhibit 8 of the same evidence pages 322 - 326
16.	<i>Angry Birds</i>	Various	Various	1 June 2012	Paragraph 15 of

S/N	Instances/Events	Field of business	Relevant "Get up"	Date of event/entry	Reference in the Opponents' evidence
	Cable Car Ride	including food and merchandise	including Red Bird and the words "ANGRY BIRDS"		the Opponents' 1 st evidence and Exhibit 9 of the same evidence at pages 331 – 347
17.	<i>Polar Cakes</i>	<i>Food – regular cakes</i>	<i>Various including Red Bird and the words "ANGRY BIRDS"</i>	<i>November 2011</i>	<i>Paragraph 16 of the Opponents' 1st evidence and Exhibit 10 of the same evidence at Page 353 NB: page 354 has not been identified to be under Polar Cakes and is thus not to be taken into account.</i>
18.	Peony Jade etc	Food – regular cakes	Various including Red Bird and the words "ANGRY BIRDS"	<u>Not specified</u>	Exhibit 10 of the Opponents' 1 st evidence at page 355
19.	Peony Jade etc	Food – mooncakes	Various including Red Bird and the words "ANGRY BIRDS"	August 2012	Paragraph 16 of the Opponents' 1 st evidence and Exhibit 10 of the same evidence at pages 356 – 365

I note that at paragraph 8 of the Opponents' 1st evidence, which in turn refers to Exhibit 3 of the same, there are also references to the licensing arrangements which the Opponents have around the world in relation to food, beverage and snack products. I am unable to ascertain if these products have been made available to the Singapore market and if so, the relevant dates. Therefore, I am not able to take them into consideration.

197 It is to be remembered that the relevant date in this instance is 5 April 2012. Following *St Regis* at [130]:

It is well-established that such goodwill must exist in Singapore at the date of the application for the registration of the junior mark.

Therefore, only goodwill which exists as at 5 April 2012 can be taken into account. This being the case, the relevant evidence existing as at 5 April 2012 is italicised in the above table.

198 Before I leave this element, I note that there are no sales nor advertisement figures in Singapore provided at all. The only available figures are the worldwide sales and promotional figures provided at paragraph 9 of the Opponents' 1st evidence. However, the Opponents have not submitted as to the extent to which these sales and promotional figures relate to Singapore. Further, there are also no invoices etc tendered as evidence to buttress these figures. While it is possible, as shown above, to have goodwill generated without actual revenue generating activities in the local context, it is unclear what the Opponents' submissions are in this regard. This issue is particularly tricky in relation to several items listed in the table above.

199 For example, item 2 in the table relates to the event *2011 Formula 1 Singtel Singapore Grand Prix*. It is unclear exactly what merchandise were being sold at the said event. I note that the Opponents submitted, in relation to the ground of objection under section 8(4), that "the *Angry Birds* characters were featured on merchandise, costumed characters and the Opponents' Earlier Mark T1111886Z was featured on SingTel's website". However, it is unclear from the Opponents' 1st evidence what the merchandise were. The only clue is at Exhibit 4 of the Opponents' 1st evidence. Here, the evidence showed webpages with pictures of people wearing t-shirts and headgear bearing the devices of the different birds from the *Angry Birds* Games series (see page 245). However, there is nothing in the evidence to show that such merchandise were actually sold at the event. Having said the above, it will be shown below that, in any event, the above issue is a non issue for the purposes of this case.

Misrepresentation

200 I refer to ***Law of Intellectual Property of Singapore*** at [18.0.1] and [18.0.2]:

[18.0.1] The key element here is deception. The court is concerned with the following question: has the defendant made a false representation that led to, or is likely to lead, to deception or confusion amongst the public? The nature of the deception or confusion may relate to the trade source of the goods...or to the quality of the goods...Passing off aims to prevent such false misrepresentation, and in this sense, it protects the functions of a trade mark, as badges of origin and of quality.

[18.0.2] Although the key element is deception, it is not necessary to prove that the defendant has an intention to deceive or mislead the public. For this reason, it has been said that the state of mind of the defendant is immaterial;

rather, what matters is the impact on the persons to whom misrepresentation is addressed. If the impact on these persons is such that they would be deceived, the element of misrepresentation is made out and the defendant cannot avoid a finding of passing off by the mere fact that his goods are of as good or better quality than the plaintiff's, or that the misrepresentation was made innocently.

201 Critical to this element is whether, by virtue of paragraph 6 of the Applicants' evidence, the fact that the designer of the Application Mark was inspired by the *Angry Birds* Games, can be construed that there is intention to deceive. I am of the view that, being inspired *per se*, cannot be regarded as an intention to deceive. Therefore, in this current case, I am of the view that it has not been shown that there is fraudulent intention to deceive. However, in the event that I am wrong, I note ***Law of Intellectual Property of Singapore*** at [18.4.6]:

Proof of an intention to deceive is not a necessary ingredient in this second element, but if such an intention is established, the burden is on the plaintiff to show confusion is lessened.

Further, in ***Saga Foodstuffs Manufacturing (Pte) Ltd v Best Food Pte Ltd*** [1994] 3 SLR(R) 1013 it was observed that:

Where the defendant took care to introduce sufficient differences to reduce or eliminate confusion, even if there was an intention to deceive, that intention was not carried out.

202 This leads me to the next point. Critically, I note the following in relation to the submissions of the Opponents in relation to this limb:

- (i) The "get-up" of the Opponents being considered is only the Opponents' Earlier Mark T1111886Z and the Opponents' Earlier Mark T1113897F (see above); and
- (ii) The Opponents provided above that misrepresentation is made out in this case as parties are in the "common field of activity namely the snack product market".

203 I refer to the table above on the Opponents' goodwill. The items which can fall within the category of "snack product market" are:

- (i) Item 14 – sweets;
- (ii) Item 15 - chips;
- (iii) Item 17 and 18 – regular cakes; and
- (iv) Item 19 - moon cakes.

204 In relation to chips, there is no evidence as to the date of entry of Hai Tai into the Singapore market. The only dates which appear in the evidence in relation to this item

are 10 March 2013 (page 327) and 16 February 2013 (page 328) respectively at Exhibit 8 of the Opponents' 1st evidence. These dates are simply the dates when purchases were made; the Opponents' attempt to garner evidence of the fact that these chips are available for sale in Shine Korea Supermarkets and thus reflected on the receipts. These dates as such are not relevant.

205 In relation to sweets, it is clear that the date of entry, being August 2012, is after the relevant date of 5 April 2012 and as such, this item cannot be taken into account. Similarly, the date of entry of the mooncakes, being also August 2012, is similarly after the relevant date.

206 Finally, there are the regular cakes provided by Peony Jade as well as Polar Cakes. There is no evidence as to when Peony Jade started to sell the regular cakes in Singapore and thus this too cannot be taken into account. In relation to the regular cakes sold by Polar Cakes, these were on sale since November 2011 (as per paragraph 16 of the Opponents' 1st evidence). There is no further evidence provided to buttress this statement. However, I am prepared to accept it on the basis that during the *Finnair Helsinki - Singapore Flight* which took place on 21 September 2011, Polar cupcakes were served (see paragraph 11 of the Opponents' 1st evidence and at Exhibit 5 at page 265). The only relevant pictures that I have of the cakes are as follows:

- (i) Page 265 at Exhibit 5 of the Opponents' 1st evidence; and
- (ii) Page 353 at Exhibit 10 of the Opponents' 1st evidence.

In particular, I note that for item (i) the getup is the Opponents' Earlier Mark T1111886Z ie the device of the RED BIRD. For item (ii), the getup is the Opponents' Earlier Mark T1111886Z ie the device of the RED BIRD, the Opponents' Earlier Mark T1113897F ie the words "ANGRY BIRDS" whether respectively on its own, or whether in combination, or in various other combinations with other devices of the other bird characters.

207 I am of the view that misrepresentation has not been made out for largely the same reasons from which I draw my conclusions for the element of "likelihood of confusion" under Section 8(2)(b) as well as "confusing connection" under Section 8(4)(b)(i). My detailed reasons are as follows.

208 I refer to page 265 of the Opponents' 1st evidence. I note that there is a depiction of a "RED BIRD" cupcake at the top left hand corner of the picture. I am of the view that there is no misrepresentation for the same reasons above in relation to the objection under Section 8(2)(b). There are other elements in the Application Mark to differentiate between it and the "RED BIRD" cupcake such that there can be no misrepresentation.

209 I refer next to page 353 of the Opponents' 1st evidence. There are a few items which can be used for comparison in this instance. First of all, I refer to the cakes as presented on the pages. For the cakes on the left and in the centre, both the Opponents' Earlier Mark T1111886Z ie the device of the RED BIRD and the Opponents' Earlier

Mark T1113897F ie the words "ANGRY BIRDS" are present on the cake. However, both cakes also contain other features, namely, the other birds (aside from the RED BIRD) from the *Angry Birds* Game. On the other hand, in relation to the Application Mark, I am of the view that there are other elements on the Application Mark itself, as alluded to above, such that there can be no misrepresentation. It is the Application Mark in totality which must be taken into account and I am of the view that in totality, the Application Mark is not similar to the indicia on the cakes.

210 There are also three smaller cakes on the right most corner of the said page and I note that one of the cakes contains the device of the RED BIRD (ie Opponents' Earlier Mark T1111886Z as well as the words "ANGRY BIRDS" (ie Opponents' Earlier Mark T1113897F). However, I am of the view that there is no misrepresentation made out as there are sufficient features in the Application Mark as provided above such that in totality, the Application Mark is not similar to the indicia on the cake. The other two cakes contain solely of pictures of the devices of the other birds in the *Angry Birds* Game and thus cannot be taken into account.

211 I draw the same conclusion in relation to the poster which includes the device of the RED BIRD as well as the words "ANGRY BIRDS" on the lower left hand corner of page 353.

212 In addition to the main hurdle above, the following are the considerations which I have taken into consideration.

213 Firstly, the relevant products are bought at close range. For the goods under the Application Mark, which are essentially chips, they are self serve items which the consumers will be able to select at very close proximity. As for the regular cakes, while they are not self serve items, such items are usually displayed in clear glass refrigerators from which the consumers can identify the cakes, again at close range, and pick the cake of their choice. Secondly, and importantly, these are food items which are to be ingested and therefore I am of the view that the consumer would exercise a certain degree of care, for safety reasons, in making their choice. Thirdly, the relevant consumer in this case, includes both children and adults alike. In particular, it is usually the adults who would purchase any regular cakes. I note that these items are relatively inexpensive. However, I am of the view that, all of the above factors taken together, will outweigh this factor.

214 I am mindful of the words of the Court of Appeal in *Hai Tong* at [115] that:

... the relevant tests for the tort of passing off and a claim for trade mark infringement are not identical, and although in an action for passing off, the court is not constrained in the same way that it would be in a trade mark infringement action in identifying the factors it may take into account...

However, taking all of the above into account, I am of the view that misrepresentation has not been made out.

215 In light of all of the above, there is no need for me to address the element of damage. The ground of opposition under Section 8(7)(a) therefore fails.

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

216 Section 8(7)(b) of the Act reads:

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

(b) by virtue of an earlier right other than those referred to in subsections (1), (2) and (3) or paragraph (a), in particular by virtue of the law of copyright or any law with regard to the protection of designs.

Opponents' submissions

217 The Opponents claimed that they own the copyright in the artistic works for the angry face character and the ANGRY BIRDS (word) typeface logo. The Opponents claimed that their angry face character and the ANGRY BIRDS typeface logo are original artistic works. Pursuant to the Berne Convention, the Opponents' copyright in the angry face character and ANGRY BIRDS typeface logo are protected in Singapore.

218 The Opponents submitted that they are the owner of the copyright in the artistic work in the angry face character. The angry bird character was first published on 1 December 2009 in Finland. The owner is Rovio Mobile Oy. The Opponents submitted that they own copyright registrations in the United States and China for their angry face character. The copyright details are shown in Exhibit D of the ***Amended Grounds of Opposition***.

219 The Opponents listed the relevant artistic works from Exhibit D of the ***Amended Grounds of Opposition*** (reproduced below).

220 The Opponents submitted that the most distinctive feature of this artistic work is a pair of angry looking eyes with knitted eyebrows. The “angry” expression is a distinct characteristic of the angry face character. The Opponents submitted that the device in the Application Mark has substantially copied the angry eyes and knitted eye brows. The Opponents referred to the Applicants’ evidence at paragraph 6 where they provided that their device was inspired by the Opponents' *Angry Birds* Game. The Opponents submitted that the angry eyes and knitted eyebrows in the Application Mark infringe the copyright in the Opponents' angry face character.

221 The font and stylization of the Opponents' ANGRY BIRDS (word), was solely designed for the Opponents and they claim copyright in the artistic work in these stylised words. This work was first published in Finland on 21 October 2010. The owner is Rovio Entertainment Ltd. The copyright for the ANGRY BIRDS typeface logo is registered in China as shown in Exhibit C of the ***Amended Grounds of Opposition***.

222 The Opponents also own the copyright in a variation of the words ANGRY BIRDS as shown below.



223 The Applicants are using the words ANGRY BITE in their Application Mark in fonts and stylization similar to the Opponents' fonts and stylization as shown above:



224 The Opponents submitted that both signs appear in strong aggressive looking font for dramatic emphasis for the “angry” expression. The Opponents' ANGRY BIRDS typeface logo is used on their chips and snacks. The Opponents referred to the Opponents' 1st evidence at Exhibit 3 at pages 224 to 225 and Exhibit 8 at pages 322 to 326. Similarly, the Applicants use their stylised “ANGRY BITE” sign on the packaging of their chips and snacks.

225 The Opponents submitted that the Applicants' “ANGRY BITE” element in the Application Mark is in a similar font with the words bearing similar stylised outlines for emphasis. The Applicants' ANGRY BITE font and stylisation is a substantial copy of the Opponents' ANGRY BIRDS font and stylisation. The Opponents submitted that the Application Mark ought not to be registered as it infringes the Opponents' copyright in the stylised words ANGRY BIRDS.

226 The Opponents submitted that the above serves to demonstrate that the Application Mark is made of artistic features for which the Opponents claim copyright. When these features are used together as they are in the Application Mark, their use in Singapore infringes the copyright.

Applicants' submissions

227 The Applicants submitted that in order to succeed in a copyright infringement action, the Opponents will have to establish the following elements with regard to their artwork:

- (1) Subsistence of Copyright
- (2) Ownership of Copyright
- (3) Copying / Substantial taking by Third Party

228 The Applicants submitted that the Opponents have not particularised which artwork they claim to have been copied. Nevertheless, even assuming that items (1) & (2) can be established, the test for (3) ie. copying, is substantial reproduction and a side by side comparison must be made.

229 The Applicants submitted that from a side by side comparison of all the marks adduced by the Opponents at Exhibit D of their *Amended Grounds of Opposition*, none of the artworks even remotely resemble the Application Mark.

Decision on Section 8(7)(b)

230 It is noted that the Opponents did not make substantial submissions in relation to this ground. .

231 The Registrar at *Pt Lea Sanent v Levis Strauss & Co.* [2006] SGIPOS 6 ("*PT Lea Sanent*") provided guidance in relation to this ground as follows at paragraphs [69] to [72]:

[69] There are two necessary elements to be proven:

- (i) Whether there exists an earlier right (in this case, copyright); and*
- (ii) Whether, by virtue of the law of copyright, it is liable to be prevented.*

[70] A preliminary note on the language of this particular provision is the use of the phrase "use is liable to be prevented"...The placement of the word "liable" sets the level of inquiry at a speculative level...

[71] Under the law of copyright, the owner of the copyrighted work is entitled to certain exclusive rights, including the exclusive right to prevent copying...Further, since most of copyright infringement is enforced through civil proceedings, the minimal standard is the standard of proof in civil cases. In summary, the duty is to find out whether, on the balance of probabilities, there is copyright infringement.

[72] Having come to this interpretation, I will voice my apprehension about this provision. We are essentially determining the same issue as a court would have to determine in an action for copyright infringement, minus the advantage of

a strong discovery process, other pre-trial processes as well as strictly enforced civil procedure processes during the hearing, like the ability to easily summon witnesses and cross examining them under oath or declaration. As such, the Registry's finding on this ground should not form the whole of the basis of a copyright action that goes to a higher court, but should only form a part of the consideration, taking into account the process by which the Registry came to its decision.

232 In order to succeed under s 8(7)(b) of the Act, it is necessary for the Opponents to establish the existence of an earlier right. In this case, the Opponents are relying on the following:

S/N	Country	Depiction	Copyright Registration Number	Proprietor	Reference
1.	USA	Angry Bird (red bird)	VA 1-769-078	Rovio Mobile Oy (previous name of Rovio Entertainment Ltd)	Exhibit D of the <i>Amended Grounds of Opposition</i>
2.	China	Red Bird (7 positions)	00047998	Rovio Entertainment Ltd	Exhibit D of the <i>Amended Grounds of Opposition</i>
3.	China	Red Bird (6 positions)	00048701	Rovio Entertainment Ltd	Exhibit D of the <i>Amended Grounds of Opposition</i>
4.	China	Big Red Bird (7 positions)	00047997	Rovio Entertainment Ltd	Exhibit D of the <i>Amended Grounds of Opposition</i>
5.	China	ANGRY BIRDS typeface logo	00065332	Rovio Entertainment Ltd	Exhibit C of the <i>Amended Grounds of Opposition</i>

The above shall be referred to as "the Opponents' Earlier Rights". At this point, I note that the Opponents referred to another of the Opponents' typeface logo above, which was

not included in the *Amended Grounds of Opposition*. Thus, the particular artwork cannot be taken into consideration.

233 At the outset, there is a preliminary issue that needs to be addressed. It is clear from the above that the certificates were only appended as part of the *Amended Grounds of Opposition*. They were not tendered as evidence. Be that as it may, I refer to the Applicants' submissions and note that their main point of contention is that even if (i) subsistence of copyright; and (ii) ownership of copyright can be established, the test for copying has not been made out. In light of the above, I will accept the content of the certificates even though they were not tendered as evidence.

Subsistence / Ownership of Copyright

234 The relevant law in relation to the subsistence of copyright is section 27(2) of the Copyright Act (Cap 63, 2006 Rev Ed) ("*Copyright Act*"):

27. - (2) Subject to the provisions of this Act, where an original literary, dramatic, musical or artistic work has been published —

(a) copyright shall subsist in the work; or

(b) if copyright in the work subsisted immediately before its first publication, copyright shall continue to subsist in the work,

if, but only if—

(c) the first publication of the work took place in Singapore;

(d) the author of the work was a qualified person at the time when the work was first published; or

(e) the author died before that time but was a qualified person immediately before his death.

[Emphasis as underlined mine].

Thus, copyright will subsist in relation to an artistic work (in this case) only if the following requirements are met (i) it is original; (ii) it is first published in Singapore.

235 In this regard, the definition of "publication" is provided in Section 24(1)(a) of the *Copyright Act*:

24. —(1) Subject to this section, for the purposes of this Act —

(a) a literary, dramatic, musical or artistic work, or an edition of such a work, shall be deemed to have been published if, but only if, reproductions of the work or an edition of that work have been supplied (whether by sale or otherwise) to the public.

In relation to publication, I am prepared to accept that the Opponents' Earlier Rights as published on the same basis that Polar Cakes has been sold in Singapore since November 2011 (see above).

236 In relation to the need to show a connecting factor, it is also relevant to consider regulation 3 of the Copyright (International Protection) Regulations (2009 Rev Ed), which provides as follows:

2. —(1) *In these Regulations, unless the context otherwise requires —*

"Convention country" means a country, other than Singapore, which is a party to the Berne Convention or a member of the World Trade Organisation;

3. —(1)(a) *Subject to these Regulations, the Act shall apply in relation to —*

literary, dramatic, musical and artistic works and editions first published in a country that constitutes, or forms part of the territory of a Convention country...in like manner as those provisions shall apply in relation to literary, dramatic, musical and artistic works and editions first published, and cinematograph films made or first published, in Singapore.

[Emphasis as underlined mine].

It is clear that Finland is member of the World Trade Organisation ("**WTO**"). At this point, I am prepared to accept that the Opponents' Earlier Rights have been first published in Finland, a WTO country, and thus the connecting factor having been satisfied.

237 However, critically, there is still a need to show originality under Section 27(2) of the **Copyright Act**. Chao J in **Auvi Pte Ltd v Seah Siew Tee and another** [1991] 2 SLR(R) 786 ("**Re AUVI**") provided for the test for originality as follows at [32]:

[32] ...The law on this [originality] is clear. Originality in this regard does not mean novelty or uniqueness; nor does it necessarily involve inventiveness. All that needs to be shown is that the author created it and has not copied it from another, and that he has expended towards its creation a substantial amount of skill or labour. What will be the exact amount of skill, labour or judgment required cannot be defined in precise terms...

[Emphasis as underlined mine].

238 I note that there is no evidence nor submission by the Opponents in relation to the above elements in this regard. The Opponents merely referred to the certificates and asserted that they own the copyright in Singapore in the artistic works based on the certificates via the Berne Convention (see above).

239 The furnishing of certificates *per se*, does not show that the requirement in terms of originality has been satisfied. I note that the certificates in the current case provide the following information.

240 The certificates from China (for example, certificate number 0006533) indicate that (i) the documents filed by Rovio Entertainment Ltd satisfy the relevant requirements; (ii) Rovio Entertainment Ltd enjoys the copyright over the relevant work; (iii) the relevant work was first published in, in this case, Finland; and (iv) the relevant work has been examined by, in this instance, the Copyright Protection Center of China such that the registration of the copyright of the relevant work is approved. If it is the Opponents' intention to rely on the findings of the Copyright Protection Center of China, the Opponents should then make relevant submissions as to the relevant law of China. What does the Chinese copyright law entail? I note that there were no such submissions made.

241 I make the same comments in relation to the certificate from the United States. In relation to the registration certificate VA 1-769-078 which was issued by the Copyright Office in the United States the certificate indicates that (i) the relevant work was first published in Finland in December 2009; (ii) the author is Rovio Mobile Oy; and (iii) the copyright claimant is Rovio Mobile Oy. Similarly, should it be the Opponents' intention that I rely on the findings of the Copyright Office in the United States then there should be relevant submissions made in relation to the United States law in this regard. Again, I note that there are no submissions made in relation to this at all.

242 Further, I note that there are jurisdictions where there may not be a formal examination of the work before a registration certificate is issued. Therefore, short of submissions and evidence being tendered, the issuance of a registration certificate *per se*, does not show that the substantial requirements of registration, whatever they may be, having been met.

243 In light of the above, even if the certificates were tendered in evidence, the certificates *per se*, do not assist the Opponents' case very much.

Copying

244 In relation to this, the test is provided in the case of *Flamelite (S) Pte Ltd & Ors v Lam Heng Chung & Ors* [2001] 4 SLR 557 at [27] which was accepted by the Registrar in *PT Lea Sanent* at [77]:

[77] *Counsel for the Opponents has sought to persuade me with academic passages stating the law. With due respect to his submissions, I found the case of Flamelite (S) Pte Ltd & Ors v Lam Heng Chung & Ors [2001] 4 SLR 557 to be more instructive. In that case, a full bench of the Court of Appeal sat to determine if there had been copyright infringement by the two-dimensional reproduction of a three dimensional work...Chao J, delivering the judgment of the court, stated in relation to that "To succeed in copyright infringement, the plaintiffs must prove*

that copying has taken place. Such proof can come in the form of establishing similarity combined with proof of access to the plaintiffs' works."

[Emphasis as underlined mine].

245 At the outset, I am of the view that being "inspired" *per se* does not amount to copying. Being "inspired" is simply the starting point.

246 As it is easier to address the element of access, I will deal with it first. It is clear in this case that the Applicants have had access to the Opponents' Earlier Rights. The Registrar in ***PT Lea Sanent*** clarified at [78] that the relevant form of access in this regard is factual access:

[78] *I think it will be very hard for someone to deny that the Applicant had access to the Opponent's work. The Opponent had emblazoned their marks on shopfronts across Singapore and the world...*

It is clear that the Opponents have had access to the Opponents' Earlier Rights. In this regard, the Applicants' evidence at paragraph 6 states that:

[6] The Applicants' in-house designer...designed the picture. His drawing was inspired after he saw his nephew playing the Angry Bird's game on the mobile phone...

However, I am of the view that the relevance of this piece of evidence ends here.

247 In relation to similarity, the Registrar in ***PT Lea Sanent*** provided at [79]:

[79] *There is the further need of establishing similarity. In **Flamelite**, Chao J held that: "In considering whether there was substantial similarity ..., the whole of the work must be considered."*

248 In relation to this element, I note that at the outset the Opponents' Earlier Rights as identified in the table above are essentially the different facets of the RED BIRD as well as the words ANGRY BIRDS in the typeface as shown in the exhibits to the ***Amended Grounds of Opposition***.

249 Comparing items 1- 4 above, ie the different facets of the RED BIRD, I am unable to hold that there is substantial similarity between item 1 to 4 respectively when each item is compared to the Application Mark for the same reasons that I held that there is no similarity between the Opponents' Earlier Mark T1111886Z and the Application Mark.

250 Similarly, comparing item 5 with the Application Mark, I am of the view that there is no substantial similarity between the two items also for largely the same reasons that I held that there is no similarity between Opponents' Earlier Mark T1113897F and the Application Mark.

251 I note the Registrar's comments in *PT Lea Sanent* above that the level of inquiry under section 8(7)(b) is only at a speculative level. However, there is still a need to address each respective element under the objection, the burden of proof being borne by the Opponents. Unfortunately, most of the requirements were not adequately addressed in this instance.

252 In light of all of the above, the ground of opposition under Section 8(7)(b) therefore fails.

Conclusion

253 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition fails on all grounds. Accordingly, the Application Mark shall proceed to registration. The Applicants are also entitled to costs to be taxed, if not agreed.

Dated this 18th day of August 2014

Sandy Widjaja

Principal Assistant Registrar of Trade Marks

Hearings and Mediation Group

Intellectual Property Office of Singapore