

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

Trade Mark Nos. T1111745F and T1111870C
(International Reg. Nos. 1086558 and 1086557)
Hearing Date: 23 July 2014

IN THE MATTER OF A TRADE MARK APPLICATION BY

TAYLORS WINES PTY LTD

AND

OPPOSITION THERETO BY

TAYLOR, FLADGATE & YEATMAN LIMITED

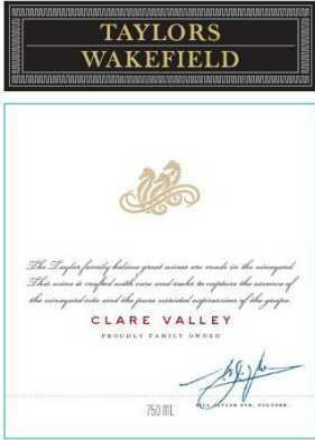
Hearing Officer: Ms Diyanah Binte Baharudin
Assistant Registrar of Trade Marks

Mr Dominic Tan (Joyce A. Tan & Partners) for the Applicants
Mr Chua Shang Li (Donaldson & Burkinshaw) for the Opponents

Cur Adv Vult

GROUND OF DECISION

1 Taylors Wines Pty Ltd (the "**Applicants**") applied to protect the following marks (collectively, the "**Application Marks**") in respect of the following classes, on 17 June 2011:

Singapore Trade Mark Registration No.	Mark	Class	Specification
T1111745F	TAYLORS WAKEFIELD	33	Wines, excluding fortified wines.
(the " Applicants' Word Mark " / " T1111745F ")			
T1111870C		33	Wines, excluding fortified wines.
(the " Applicants' Device Mark " / " T1111870C ")			

2 T1111745F was accepted and published on 11 November 2011 for opposition purposes, whilst T1111870C was accepted and published on 9 December 2011. Taylor, Fladgate & Yeatman Limited (the "**Opponents**"), filed their Notices of Opposition to oppose the registration of the Application Marks on 8 March 2012 (in respect of T1111745F) and on 3 April 2012 (in respect of T1111870C) respectively. The Applicants filed their Counter-Statements on 14 September 2012 (in respect of T1111745F) and on 26 September 2012 (in respect of T1111870C) respectively. Both matters were consolidated at a second Case Management Conference on 19 December 2012.

Grounds of Opposition

3 The Opponents rely on Sections 8(2)(b), 8(4)(b)(i) and 8(4)(b)(ii) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (the "**Act**") in this opposition. The Opponents initially relied on Section 8(7)(a) and Section 7(6) of the Act in their Notices of Opposition but later dropped these grounds of opposition at the Pre-Hearing Review on 4 March 2014.

Opponents' Evidence

4 The Opponents filed the following evidence in support of their position in the present opposition proceedings:

- i) 1st Statutory Declaration of Ian Cuming dated 10 July 2013 (filed on 16 July 2013) in respect of T1111745F ("**1st Cuming**");

- ii) 1st Statutory Declaration of Ian Cuming dated 10 July 2013 (filed on 16 July 2013) in respect of T1111870C; and
- iii) 1st Statutory Declaration of Julie Kleis dated 3 February 2014 (filed 5 February 2014).

Applicants' Evidence

5 The Applicants filed the following evidence in support of their position in the opposition proceedings:

- i) 1st Statutory Declaration of Mitchell Taylor dated 12 December 2013 (filed on 16 December 2013) ("**1st Taylor**"); and
- ii) 2nd Statutory Declaration of Mitchell Taylor dated 20 March 2014 (filed 1 April 2014).


Applicable Law and Burden of Proof

6 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

7 The Opponents regard themselves as one of the oldest and best port wine producers and have been making port in the Douro Valley, Portugal, since their founding in 1692. The Opponents became known as "Taylor, Fladgate & Yeatman" after the names of its founding members in a partnership in 1838. They ship almost all types of port, including vintage, tawny, ruby, late-bottled vintage, and white, and are particularly well regarded for their vintage port. Their website states that they are "dedicated entirely to the production of Port wine" (1st Cuming, p 11) and "remains entirely focused on Port production" (1st Cuming, p 18). The Opponents' port wine is produced in Oporto, in Northern Portugal, although the Opponents themselves are incorporated in the Channel Islands.

8 The Opponents are also the registered proprietors of the following trade mark in Singapore:

TM Number	Trade Mark	Class	Specification of Goods
T7461468F		33	Wines.

(the "**Opponents' Mark**")

9 The Opponents state that the Opponents' Mark was first used in Singapore in 1979 and that they have continuously used and promoted the said mark in Singapore since the date of first use. However, the Opponents' sales records before 2008 are no longer available. Between 2008 and

2011, the Opponents tendered samples of various invoices evidencing these sales (through their distributor, Bacardi-Martini Singapore Pte Ltd). The Opponents also tendered some examples of advertisements, brochures and promotional literature in a range of magazines and publications as evidence of their promotion and advertisement efforts in the media.

10 The Applicants, on the other hand, are a family-run company incorporated in Australia. They trace their history back to 1969, when the company's founding fathers located a site by the Wakefield River in Clare Valley, Australia, which they thought suitable for wine production, using Cabernet Sauvignon grapes (1st Taylor, Annex A). The Applicants are also members of a collective known as the "Australia's First Families of Wine", which comprises 12 family-owned wineries in Australia representing 16 Australian regions.

11 The Applicants state that they have used the Application Marks since the mid 1980s. Their exclusive distributor in Singapore is Auric Pacific Marketing Pte Ltd. The Applicants tendered evidence of their own local sales from 2004 to 2012 and their exclusive distributor's marketing plans for the years 2007, 2010, 2011 and 2012 as evidence of their marketing and promotion efforts in Singapore.

Trade Mark Registrations of the parties in other jurisdictions

12 From the Opponents' evidence, the Opponents have registered the mark "TAYLOR'S" for Class 33 "Ports" in Australia since 12 October 1977 (see 1st Cuming, p 39) and renewal of the mark is due on 12 October 2018. The Applicants have registered the mark "TAYLORS" (without embellishments) in Australia since 4 November 1975, with the next renewal date on 4 November 2016 in Class 33 for "Wines, not being fortified wines" and another registration for the same mark in Class 33 for "Table wines, not being fortified wines, produced in Australia", which was filed on 23 September 1982 with the next renewal date on 23 September 2023 (see 1st Taylor, Exhibit B). Therefore, from about 1977 to date (i.e. about 37 years), there appears to have been co-existence in Australia of the Opponents' "TAYLOR'S" mark and the Applicants' "TAYLORS" mark, both in Class 33.

13 In Hong Kong, the Opponents have registered the mark "TAYLOR'S" in Class 33 for "Port wine", the actual date of registration being 4 July 1983 and expiry date on 26 October 2013. The Applicants have registered the mark "TAYLORS" (without embellishments), with a filing date of 10 July 2003. From 2003 to date (i.e. about 11 years), there appears to have been co-existence in Hong Kong of the Opponents' "TAYLOR'S" mark and the Applicants' "TAYLORS" mark, although there is no evidence as to which class(es) the Applicants' "TAYLORS" mark was registered for.

14 In New Zealand, the Applicants submit evidence that they have some trade marks, including "TAYLORS", with a filing date of 21 January 1992. The evidence from the Applicants shows that the Opponents also have registered the mark "TAYLOR'S" in New Zealand since 21 October 1982, although there is no evidence of this from the Opponents' side. There is also no evidence as to the classes for which each of these respective marks was registered in.

PRELIMINARY DECISION

15 At the hearing, the Opponents tendered a 15-page document titled "Opponent's Additional Written Submissions", which consisted of a body of text (2 pages) that made reference to printouts from various web pages (13 pages). The Applicants objected to the admission of this document because it appeared to be a late attempt to submit further evidence. When queried on the nature of this document, the Opponents submitted that the document was not evidence, but "submissions with observations" that were "ancillary" to the present proceedings but "not directly relevant in this specific case." The Opponents described the contents of the document as "general knowledge on the wine industry."

16 The first two paragraphs of the disputed document read as follows:

- "1. It is normative in the wine industry that wine is sold in glass bottles with a label which contains several pieces of information, which include the producer (which is the brand/trade mark), the type of fruit used, the year of production, the geographical origin and/or appellate origin of the wine. Sometimes, a textual description of the wine or the producer of the wines is included as well.
2. For reference, we enclose a printout from a website which serves as a guide and describes how a wine bottle label may be understood."

17 The rest of the document describes, in similar fashion, *inter alia*, how wines are labelled, how a single winery may produce several brands of wine, and that many wineries produce both wines and fortified wines. The attached print outs include, *inter alia*, a Google search result for the search term "Taylors", a website which demonstrates how wine labels are read, and an article that appears to compare the Opponents' wine products and the Applicants' wine products.

18 In my view, this document is tendered primarily for the purpose of introducing the website printouts. These printouts are essentially "documents" or "electronic records" which, in IPOS proceedings, must be proven by way of evidence in a statutory declaration.

19 In the Evidence Act (Cap 97, Rev Ed 1997) ("**Evidence Act**"), the terms "document" and "electronic record" are defined in Section 3 of the Evidence Act as follows:

- “document” includes, in addition to a document in writing —
- (a) any map, plan, graph or drawing;
 - (b) any photograph;
 - (c) any label, marking or other writing which identifies or describes anything of which it forms a part, or to which it is attached by any means whatsoever;
 - (d) any disc, tape, sound-track or other device in which sounds or other data (not being visual images) are embodied so as to be capable (with or without the aid of some other equipment) of being reproduced therefrom;

- (e) any film (including microfilm), negative, tape, disc or other device in which one or more visual images are embodied so as to be capable (with or without the aid of some other equipment) of being reproduced therefrom; and
- (f) any paper or other material on which there are marks, impressions, figures, letters, symbols or perforations having a meaning for persons qualified to interpret them;

“electronic record” means a record generated, communicated, received or stored by electronic, magnetic, optical or other means in an information system or transmitted from one information system to another;

20 The website printouts are essentially "*documents in writing*" or "*any paper or other material on which there are marks, impressions, figures, letters, symbols*". Alternatively, as information from a web page on the Internet, they are electronic records that are "*generated, communicated, received or stored by electronic (means)...in an information system*".

21 In the Evidence Act, proof of such documents is by way of primary evidence, unless the documents fall under an exception allowing proof to be by way of secondary evidence: Sections 66 and 67 of the Evidence Act, see also Jeffrey Pinsler SC, *Evidence and the Litigation Process* (4th edition) (LexisNexis, 2013) at [11.020].

22 In IPOS proceedings, Rule 69 of the Trade Marks Rules (Rev Ed 2008) (the "**Rules**") provides that the default mode of evidence in IPOS proceedings is by way of statutory declaration:

Evidence in proceedings before the Registrar

69.—(1) In any proceedings before the Registrar under the Act or these Rules, evidence shall be given by way of a statutory declaration, unless otherwise provided by the Act or these Rules or directed by the Registrar.

23 In order to put these documents / electronic records into evidence at any time after the close of evidence in IPOS proceedings (ie. at the end of the filing of the Opponents' reply evidence), the Opponents needed to have sought leave to file further evidence, as required by Rule 35 of the Rules:

Further evidence

35. No further evidence may be filed by either party except that, in any proceedings before the Registrar, the Registrar may at any time, if he thinks fit, give leave to either party to file further evidence upon such terms as to costs or otherwise as the Registrar may think fit.

24 IPOS has also issued a circular on the filing of further evidence, in HMG (previously "HMD") Circular 1 of 2011, dated 8 April 2011 ("**Circular 1/2011**"). This circular describes the administrative details as to how leave of the Registrar should be sought for the purposes of Rule 35 of the Rules. It also describes the situations when the Registrar is more, or less, likely to be inclined to grant the application for further evidence. For example, where further evidence is

sought without consent from the other side, the Registrar will weigh certain non-exhaustive factors in coming to a decision, such as, why the evidence could not have been filed earlier and the stage of proceedings at which the further evidence is sought.

25 The Opponents have not sought leave to file this evidence as required by Rule 35 of the Rules and in accordance with Circular 1/2011. I find that the Opponents' document titled "Opponent's Additional Written Submissions", together with all its exhibits, is inadmissible for failure to comply with the Rules. I will proceed to give my decision without taking this document into account.

MAIN DECISION

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

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

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

...

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

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

Decision on Section 8(2)(b)

The step-by-step approach

27 The Singapore Court of Appeal in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another and another appeal* [2014] 1 SLR 911 ("*Staywell*") has recently affirmed the "step-by-step" approach to determining similarity between competing marks under Section 8(2)(b) of the Act, at [15]:

Since this court's decision in *Polo (CA)* [*The Polo/Lauren Co, LP v Shop-In Department Store Pte Ltd* [2006] 2 SLR(R) 690], 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...

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... Whilst there have been suggestions that the two approaches might be distinct without being different, we maintain this dichotomy and endorse the step-by-step approach as being conceptually neater and more systematic and, importantly, as being more aligned with the requirements imposed under our statute (see *Polo (CA)*) at [8].

(Emphasis added)

28 I now turn to analyse each of these requirements under the "step-by-step" approach.

Similarity of Marks: General Principles

29 In assessing whether the competing marks are similar, three aspects of the marks are taken into consideration, *viz.*, whether they are visually, aurally and conceptually similar: *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941 ("*Hai Tong*") at [39], affirming an earlier Court of Appeal decision in *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 ("*Sarika (CA)*") at [16]. The Court of Appeal in *Hai Tong* elaborated further at [40] on other general principles in this assessment:

- a) The thrust of the inquiry into similarity is directed at assessing substantive similarity. The three aspects of this evaluation, namely, visual, aural and conceptual similarities, aid the court's evaluation by signposting its inquiry. They do not serve as a mechanistic formula of any sort. It follows that the law does not require all three similarities...to be made out before the registered mark and the allegedly infringing mark may be found to be similar.
- b) In assessing the similarity between two competing marks, the court considers them "as a whole" (see *City Chain* at [47] and [50]), but does not take into account "any external added matter or circumstances" because the comparison is "mark for mark"...
- c) Although the focus of this part of the inquiry is on the marks in question, it is necessary to set out the viewpoint that 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...
- 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 and another* [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...

30 In particular, the Court of Appeal in *Staywell* at [20] affirmed *Hai Tong* at [40(b)] and held that

...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 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 type of marks, as we observed in *Hai Tong* at [40(b)]. **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].

(Emphasis added)

31 In addition, the Court of Appeal in *Staywell* at [16]-[19] rejected the notion that there is "any particularly or notably low threshold of marks-similarity", and stated that the court "must ultimately conclude whether the marks, when observed in their totality, are similar rather than dissimilar."

Independent distinctive role of earlier mark within the later mark

32 A question that arises in this case is whether it is possible for a registered trade mark that is wholly (or nearly wholly) contained within a composite application mark to have "an independent distinctive role" such that the competing marks should be found to be similar. I briefly consider the approaches of the European Union and the Singaporean courts in this regard.

33 In the case of *Medion AG v Thomson multimedia Sales Germany & Australia GmbH (Case C-120/04)* ("*Thomson*") the court was faced with the earlier mark "LIFE" and the later application "THOMSON LIFE", both for "leisure electronic devices". It held that even if the earlier registered trade mark was **not** the dominant element of the later, composite mark, it would be possible for this earlier registered trade mark to have "an independent distinctive role" in the composite mark (see *Thomson* at [30]). The court held that this would apply even if the "owner of a widely known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known" (*Thomson* at [34]).

34 In a more recent case, *Bimbo SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (Panrico SA, intervener) (Case C-591/12 P)* ("*Bimbo*") the court found that the principle on the "independent distinctive role" may not apply "if, together with the other component or components of the sign, that component forms a unit having a different meaning as compared with the meaning of those components taken separately" (see *Bimbo* at [25]). In this case, the court was concerned with the earlier mark "DOGHNUTS" and the later application mark "BIMBO DOUGHNUTS", both for similar goods in Class 30. The court upheld an earlier decision that "DOGHNUTS" had an independent distinctive role and concluded that there was a likelihood of confusion. This was despite the non-identical spelling of the word "DOGHNUTS" (instead of "Doughnuts") – although this point was raised by the appellant.

35 However, in another case, *Barbara Becker v Harman International Industries Inc (and OHIM) in Case C-51/09 P ("Becker")*, the court did not apply this principle. The court considered whether the earlier mark, "BECKER", was confusingly similar to the later application mark, "BARBARA BECKER", both for goods within Class 9. The court noted that the surname "Becker" was common, but that "a surname does not retain an independent distinctive role in every case solely because it will be perceived as a surname" (see *Becker* at [38]). The court continued, at [39], stating that to allow the earlier mark to succeed:

would result in acknowledging that any surname which constitutes an earlier mark could be effectively relied on to oppose registration of a mark composed of a first name and that surname, even though, for example, the surname was common or the addition of the first name would have an effect, for a conceptual point of view, on the perception by the relevant public by of the composite mark.

36 In Singapore, the concept of the "independent distinctive role" of a registered trade mark within a later application mark/sign has not specifically been discussed. However, the court tries to determine if the earlier registered trade mark is "distinctive" and whether the other elements in the later application mark/sign erode the distinctiveness of the earlier mark within it.

37 The marks similarity between a registered trade mark that was wholly contained within a composite application mark was considered in the High Court case of *Ozone Community Corp v Advance Magazine Publishers Inc [2010] 1 SLR 382 ("Ozone")*. In this case, the court had to consider the earlier mark "GLAMOUR" and the later application mark "HYSTERIC GLAMOUR", both in Class 16. Both marks were devoid of stylisation, embellishment or device. The court compared the visual differences between the two marks at [53] as follows:

In the present instance, although the word marks of Ozone and AMP share one common denominator, viz, the word "glamour", I agreed with the PAR's observation that there were:

... many visual differences between the marks. The HYSTERIC GLAMOUR mark has 15 letters, GLAMOUR has 7 letters; the HYSTERIC GLAMOUR mark has two words, the GLAMOUR mark has one.

Furthermore, given that the word "hysterical", which appears at the beginning of Ozone's word mark, is almost of equal length to the word "glamour", I could not see how it would be entirely overlooked or overshadowed by the word "glamour". That Ozone's word mark has two words was to my mind a visual difference. Thus, even if "glamour" is the more common word of the two (ie, "hysterical" and "glamour") and may come to mind more quickly than "hysterical", the consumer with an imperfect recollection (see [50] above) would still remember that Ozone's word mark has an additional word to "glamour". In these circumstances, I saw no reason to disturb the PAR's finding that Ozone's

HYSTERIC GLAMOUR mark was visually dissimilar to AMP's GLAMOUR mark.

38 The court in *Ozone* also considered if the "GLAMOUR" mark had achieved any acquired distinctiveness, but concluded that the evidence was not sufficient to establish this fact: see *Ozone* at [70]-[71]. This is discussed in greater detail below at paragraph [57].

39 In another High Court case, *Doctor's Associates Inc v Lim Eng Wah (trading as SUBWAY NICHE)* [2012] 3 SLR 193 ("*Subway*"), the court considered another registered trade mark that was wholly contained within a composite sign. The registered trade mark was the word mark "SUBWAY" registered in several classes including Class 30 for, *inter alia*, sandwiches, and Class 43, for, *inter alia*, sandwich shop services. The defendant used a "SUBWAY NICHE" mark (containing some embellishments) to sell sandwiches. On the issue of marks similarity, the court found that the defendant's "SUBWAY NICHE" mark was "visually similar" because of the acquired distinctiveness of the registered trade mark "SUBWAY" (discussed below in paragraphs [55]-[56]) and because the addition of the word "niche" to the "SUBWAY NICHE" mark did not "offset this similarity because of the distinctiveness of the "SUBWAY" mark" (see *Subway* at [32]-[34]).

40 From the cases above, the "distinctiveness" of the earlier registered trade mark appears to play a significant role in the court's determination of whether the competing marks are eventually found to be similar.

41 The Court of Appeal in *Hai Tong* at [30] held that

...the more fancy or arbitrary a mark, then in general, the greater the protection it will receive, in the sense that the defendant would have to demonstrate to a more compelling degree that his mark or sign is indeed dissimilar from the registered mark (see *Sarika* at [20], *Polo (CA)* at [10] and [*Ozone Community*] at [44]). On the other hand, the more descriptive a mark, the greater the latitude afforded to the defendant in using words or ideas of a generic nature, even if these have some similarity to what is found in the registered mark.

42 There are a few types of "distinctiveness" as elaborated upon by the Court of Appeal in the recent decision of *Staywell* at [23]-[24]:

- i) "*Technical distinctiveness*", which refers to "distinctiveness in the technical sense...in contradistinction to descriptiveness". Such distinctiveness can be either:
 - (a) *Inherent distinctiveness*, which is "usually where the words comprising the mark are meaningless and can say nothing about the goods or services"; or
 - (b) *Acquired distinctiveness*, "where words that do have a meaning and might well say something about the good or services, yet come to acquire the capacity to act as a badge of origin through long-standing or widespread use".

- ii) "*Distinctiveness in the ordinary and non-technical sense*", which simply refers to what is outstanding and memorable about the mark, that tends to stand out in the consumer's imperfect recollection.

43 The specific point on whether a *name*, if common, should give the applicant greater latitude in its use, was discussed in the IPOS decision in *Kenzo v Tsujimoto Kenzo* [2013] SGIPOS 2 ("*Kenzo*"), at [38]-[41]. There, the Principal Assistant Registrar ("**PAR**") highlighted an extract in Bently and Sherman, *Intellectual Property Law* (Oxford University Press, 3rd ed, 2009), that an applicant has a lower threshold to cross for common names which intrinsically have a low level of distinctiveness (see [39]). The evidence of 6 live business entities in Singapore bearing the name "Kenzo" suggested that it was not an uncommon personal name.

44 It may be observed that the European Union, in considering whether the registered trade mark has an "independent distinctive role" within the later application mark, may allow even marks which would not be considered "inherently distinctive" in the Singapore sense (e.g. "LIFE" and "DOUGHNUTS") to prevail in opposition, as long as they are registered trade marks of some repute, and as long as the later application mark does not have a different meaning when considered as a whole with the other elements present in it.

45 In Singapore, an interesting aspect of this discussion is whether there are different levels of distinctiveness for trade marks in Singapore which give rise to different consequences. When a sign is accepted for registration here, it has to be "inherently distinctive" so as not to run afoul of Section 7(1)(b)-(d) of the Act. Another way for a sign which is not "inherently distinctive" to gain registration is to satisfy the Trade Marks Registry that it is a sign which enjoys "*de facto* distinctiveness", that is provided for under Section 7(2) of the Act (for a detailed analysis on distinctiveness within Section 7 of the Act, see *Love & Co Pte Ltd v The Carat Club Pte Ltd* [2009] 1 SLR(R) 561). It seems, however, that to enjoy the additional protection (described in *Hai Tong* at [30] (cited above at [41])) the proprietor must satisfy the court as to the other types of distinctiveness described in *Staywell* at [23]-[24] (summarized/cited above at [42]). The question is whether these types of distinctiveness are the same as those required under Section 7 of the Act, or if they are at a higher level – such that the registered proprietor must prove the same in order to enjoy a greater level of protection in court. It is neither necessary nor appropriate for me to attempt to set out the general approach to be taken in the various situations which may arise in future.

46 For the purposes of the present opposition case, I will start by considering the distinctiveness of the Opponents' Mark, and then move on to consider the visual, aural and conceptual similarities between the Opponents' Mark and the Application Marks, as required under the step-by-step test.

Similarity of Marks: Distinctiveness

47 The distinctiveness of a trade mark is a factor integrated into the visual, aural and conceptual analysis as to whether the competing marks are similar, and not a separate step within the marks-similarity inquiry: *Staywell* at [30], affirming *Sarika (CA)* at [20]. However, in *Hai*

Tong at [26] the court added that "for the purpose of elucidating the analytical process, we have highlighted it [the distinctiveness inquiry] here as a separate step".

Parties' submissions on distinctiveness

48 At the hearing, both the Opponents and the Applicants spent some time discussing the issue of whether the Opponents' Mark was distinctive. The Opponents submitted that the Opponents' Mark, being a family name, was technically distinctive in relation to the class of goods it is registered for, namely, wines, as it was not common for a family name to be used in relation to wines. In their written submissions, the Opponents cited *Sarika (CA)* at [20] where the court held that the more distinctive the registered trade mark, the more alteration or differences will be required to render the challenged mark dissimilar to the registered mark. In addition, the Opponents also submitted, on the basis of the evidence in their statutory declarations, that the Opponents' Mark had acquired distinctiveness "through centuries of use" (see Opponents' written submissions at [19]).

49 The Applicants submitted that the approach to marks similarity was a "2-step approach" that considered the issues of marks similarity and distinctiveness separately, citing *Ferrero SpA v Sarika Connoisseur Cafe Pte Ltd* [2013] 1 SLR 531 [2011] SGHC 17 ("*Sarika (HC)*") and *Ozone* (see Applicants' written submissions at p 10). In their view, the Opponents' Mark comprises of "a common family name" and that the common usage of such name in Singapore can be shown by reference to the existence of 69 different Singapore corporate entities with "TAYLOR", "TAYLOR'S" or "TAYLORS" in their names (based on search records from the Accounting and Corporate Regulatory Authority ("**ACRA**")). The Applicants cited the IPOS decision in *Kenzo*, where the PAR stated that the fact that "KENZO" "can be perceived as a personal name not uncommonly used in trade in Singapore, on the basis of evidence that showed the "KENZO" name being used in relation to a number of live business entities in Singapore."

50 At the marks similarity stage of the inquiry, I am to compare the visual, aural and conceptual elements without considering the relative importance of each aspect of similarity having regard to the goods: *Staywell* at [20] (cited above). As such, I do not consider the distinctiveness of the name "Taylor" *having regard to the goods*, ie. wines.

51 However, I will consider the Applicants' evidence of the ACRA search records of the various business live business entities in Singapore that use the name "Taylor", as this relates to the question of whether the marks are similar, and does not go towards measuring the *effect* of objective similarity between the marks on the perception of consumers. The latter is concerned with the admission of evidence that would cause the consumer to pay more attention to certain types of similarity, e.g. that the visual and aural aspects of similarity are relatively more important than conceptual similarity because of evidence on the mode of purchase of products: see *Sarika (CA)* at [38].

52 The Applicants' evidence in 1st Taylor at Tab F shows a number of live business entities that use the name "Taylor" in Singapore. These are:

- i) Taylor (Stanley) Singapore Private Limited
- ii) Taylor Supply
- iii) Taylor Vinters LLP Singapore Branch

- iv) Taylor's Education Pte Ltd
- v) Taylor's International Alliance Network Pte Ltd (f.k.a. Tian Network Pte Ltd)
- vi) Taylor-So & Co Pte Ltd
- vii) Taylored Fitness
- viii) Taylors Arts Studio Pte Ltd.

53 There are 8 entities that are live business entities using the name "Taylor" in Singapore, and not 69 as the Applicants contend. Most of these businesses are either now known by a different name that does not include "Taylor", or are terminated, struck off, dissolved or ceased, as the case may be. Unlike *Kenzo*, there is no information as to the type or description of each of these businesses. I note that in *Kenzo* there were 6 such live businesses which contained the name "Kenzo".

54 Based on the evidence above, it is possible that the name "Taylor" is perceived as a personal name *not uncommonly* used in Singapore (although I would stop short of saying that it is "common"). I find that the Opponents' Mark is not particularly distinctive, since there is some evidence that it is used as the trading name of a number of live business entities in Singapore. Since it is a personal name not uncommonly used in Singapore, there is no reason that it should be granted any additional layer of protection that is usually reserved for marks which are inventive words which are technically distinctive. I would not, however, say that the Opponents' Mark is *so common* that the Applicants are entitled to cross a *lower* level of alteration to show that it is dissimilar to the Opponents' Mark.

55 I now turn to the question of whether the Opponents' Mark has achieved acquired distinctiveness. The Court of Appeal in *Hai Tong* at [33] held that it may be helpful to have regard to the following factors (which were considered by the High Court in *Doctor's Associates Inc v Lim Eng Wah (trading as SUBWAY NICHE)* [2012] 3 SLR 193 ("*Subway*") at [21]):

- (a) the market share held by the registered mark;
- (b) the nature of its use (whether or not it was intensive, widespread and long-standing);
- (c) the amount invested in promoting the mark;
- (d) the proportion of the relevant class of individuals who identified the goods sold under the mark as emanating from a particular source; and
- (e) any statements from trade associations and chambers.

56 In *Subway* at [32], the High Court considered the SUBWAY mark to be

...fairly distinctive as the use of the mark is very widespread (with 92 SUBWAY outlets in Singapore) and long-standing (since 1996 in Singapore) and the plaintiff has without a doubt invested significant sums annually in promoting the mark leading to a large proportion of the Singapore public being capable of identifying the SUBWAY sandwiches as part of or emanating from the SUBWAY brand.

57 In *Ozone*, however, the High Court declined that the mark in question had achieved acquired distinctiveness. The court considered evidence on this point in relation to the defendant's "GLAMOUR" mark at [70]-[71]:

70 Has the word mark GLAMOUR then acquired distinctiveness through use in Singapore? To my mind, based on the limited and unsatisfactory evidence tendered by AMP [the defendant] which did little to support its claim that the GLAMOUR mark was extensively used in Singapore, this question must be answered in the negative. As evidence in support of its circulation figures between 1990-2002 (see [14] of the GD), AMP tendered nine invoices from STP Distributors Pte Ltd...

71 It may readily be observed that these nine invoices related only to sales in specific months in the limited period from 2000 to 2002. They did not reflect a monthly distribution from 1984 (the year AMP claimed its use of the GLAMOUR mark in Singapore started) and neither did they correspond to the total distribution figures submitted by AMP (see [14] of the GD). For example, although the invoice dated 24 August 2001 reflected only the sale of 30 copies of the September 2001 edition of the GLAMOUR magazine to TIMES, AMP claimed a distribution figure of 823 in September 2001. The nine invoices adduced supported only a fraction of the distribution figures claimed by AMP. Furthermore, the nine invoices related only to the distribution of the GLAMOUR magazine to one branch of TIMES (viz, the Centrepoint outlet) and a single supermarket. There was nothing in evidence to support the promotion and/or subsequent sale of the GLAMOUR magazine to the Singapore public. In these circumstances, given the paucity of AMP's evidence, I was of the view that it could not be said that the GLAMOUR mark had acquired distinctiveness in Singapore.

58 In the present case, the Opponents did not point me to any specific parts of their evidence to support this point. Their written submissions only makes reference to Exhibit A of 1st Cuming, which is a print out from the Opponents' website that describes the business having been established over three centuries ago in 1692 and is based in Oporto, Portugal (see generally pp 11 – 33 of 1st Cuming). In relation to the Singapore market, the Opponents submit that the Opponents' Mark was first used in Singapore since 1979, but that their sales records before 2008 are no longer available (1st Cuming, [11]). The Opponents also tendered a number of sales receipts between the period 2008 to 2011, which show delivery of the Opponents' goods to various locations in Singapore. These receipts are as follows (my own analysis):

	Year	No. of receipts	No. of units sold	Description of goods (some examples only)	Goods delivered to
i)	2008	5	336 (264 sold to DFS)	"TP Taylors 10 yrs Tawny" and "TP Taylor Fine Tawny Port"	Grand Hyatt Singapore, Isetan (Singapore) Limited, Scotts, Laurels Food Suppliers, RC Hotels (Pte) Ltd, DFS Venture Singapore (Pte) Ltd ("DFS")

ii)	2009	5	767 (684 sold to DFS)	"Taylor's Port L.B.V. 2003 100 CL", "Taylor's 10 Yrs Tawny"	The Central Winemart Pte Ltd, RC Hotels (Pte) Ltd, Millie's Enterprise, Laurels Food Suppliers, DFS
iii)	2010	5	421 (324 sold to DFS)	"Taylor's Port L.B.V. 2005 100 CL", "Taylor's 10 yrs Tawny"	NTUC Fairprice Co-op Ltd, Suti Corporation Pte Ltd, Chuan Ho Trading Co Pte Ltd, DFS, Marina Bay Sands Pte Ltd
iv)	2011	5	1,138 (1,020 sold to DFS)	"Taylor's Fine Ruby Port 75 cl", "Taylor's Fine Tawny Port 75 cl"	Magnum Spirits & Wine Pte Ltd, Chuan Hoe Trading Co Pte Ltd, DFS, NTUC Fairprice Co-op Ltd, Singapore Airline Ltd.

59 From the evidence above, it appears that there have been some sales in Singapore of the Opponents goods. However, there are two points to be made about this evidence. First, although the description of the goods in the invoices include the word "Taylor's" or "Taylors", the statutory declaration does not state if the *Opponents' Mark* is found on these goods that have been sold. Second, the invoices show that most of the units have been sold to "DFS Venture Singapore Pte Ltd" ("**DFS**"), instead of being sold through the other sales outlets in Singapore.

60 The Opponents also tendered an "independent statement" from "a Portugese Official body, the Port and Douro Wines Institute (IVDP) confirming the volume and value of sales of TAYLOR'S port wine exported to Singapore for the 15 year period between 1998 to 2012" (1st Cuming at [12]). This document is a one-page *copy* of a document signed by an unidentified person, simply called "The IVDP's President", which affirms a small table titled "annex 1" [sic] that is labelled, "Port Wine exports with TAYLOR'S brand to Singapore". It is not clear whether "TAYLOR'S brand" refers to the Opponents' Mark. The document and annex also appears to relate only to the *export* of such goods to Singapore, but not the *sales* of such goods to the Singapore public. A declaration at the end of the document states, "TAYLOR'S is a well known brand that enjoys a good reputation and goodwill in global markets." This is far too general a statement to indicate that it has attained any sort of reputation or goodwill in Singapore *per se*. Overall, it is difficult to see how this document supports the Opponents' claim of acquired distinctiveness in Singapore.

61 The Opponents also tendered a number of pages of advertisements and other promotional material relating to the Opponents' Mark, in Exhibits F and H of 1st Cuming. However, these relate to foreign publications, and there is no information on how they are related to the Singapore market. The Opponents also made reference to an "in-flight pouring contract" between them and Singapore Airlines, apparently to serve the Opponents' port wine to passengers in First Class. However, the evidence in this regard is a one-page document with what appears to be a cut-out description of "champagnes and wines" from a personal blog. This is insufficient to prove the existence of such a contract, much less is it proof that the Opponents' Mark has acquired distinctiveness in the Singapore market.

62 The Opponents' evidence is strongest over a 4-year period (2008 – 2011), although there is a gap between the date they claim that the Opponents' Mark was first used (1979) and 2008 of about 29 years where there is no cogent evidence of any sales or use of the Opponents' Mark. In *Ozone*, the court held that evidence of sales for just 2 years out of 18 years of (alleged) sales was insufficient to show that the defendant's GLAMOUR mark had acquired distinctiveness. Similarly, I am unable to find that the Opponents' Mark has acquired distinctiveness on the basis of just 4 out of 33 years of sales. Furthermore, there is some doubt as to whether the Opponents' Mark was applied on the goods that were sold and how far these sales went in leading the *Singapore* public to recognize it as being distinctive, given that the majority of the Opponents' goods appear to have been sold to just 1 vendor, DFS. There is also no evidence on the market share of the Opponents during those 4 years and whether the quantity of goods sold represented a substantial portion of the market. Unlike *Subway*, where there was evidence of substantial investment in promotion of the SUBWAY mark, there is virtually no evidence of marketing or promotion relevant to the Singapore market in the present case.

63 As I have found that the Opponents' Mark tends towards a low level of distinctiveness and does not have any acquired distinctiveness, it does *not* enjoy any greater protection in the sense that the Applicants have to demonstrate to a more compelling degree that the Application Marks are dissimilar.

Visual Similarity

64 The Opponents emphasized the common denominator between the competing marks, which was "Taylors", submitting that the apostrophe "does not make a discernible difference to the average consumer, who would overlook the apostrophe, use the word interchangeable [sic] or misspell it." (Opponents' written submissions at [14]). The Opponents refer to the "distinctiveness and dominance of the common denominator" but no further submissions were made as to the "dominance" of the common denominator. As regards the Applicants' Device Mark, the Opponents submit that the additional elements in the device e.g. "Clare Valley" do not "offset the visual similarity of the marks".

65 The Applicants contend that there are "significant differences" between the competing marks. The Applicants submitted a number of cases that address the issue of the common denominator between two competing trade marks, namely, *McDonald's, Polo (CA), Ozone, Pret A Manger (Europe) Limited v Ezaki Glico Kabushiki Kaisha [2006] SGIPOS 13 ("Pret A Manger")*, *Hu Kim Ai trading as Geneve Timepiece v Liew Yew Thoong trading as Crystal Hour [2007] SGIPOS 1*.

66 The Applicants also highlighted the case of *Ozone*, where the High Court was comparing the competing marks "GLAMOUR" and "HYSTERIC GLAMOUR". The Applicants submit that the Applicants' Word Mark is visually different because it is composed of two words, similar to the *Ozone* case. Even if the word "Taylor's" was a dominant component, the word "Wakefield" is visually longer and attention is drawn to this word because of the hard "K" component in the middle of the word.

67 In relation to the Applicants' Device Mark, the Applicants relied on *Pret A Manger* at [27]:

I cannot ignore the star device in the Applicant's Mark, as it forms a prominent part of the mark. And this prominent feature in the Applicants' mark makes it visually different from the Opponents' mark. The marks are also dissimilar visually because the word Pret in the Applicants' mark is stylised [sic] whereas the Opponent's mark appears in normal script and the words in the marks, Pret and Pretz are also different. The overall impression of both marks is that they are visually different.

68 The Applicants' Word Mark was even more visually dissimilar to the Opponents' Mark since it comprises multiple colours of black, blue, gold and red, with centralized attention on the seahorse device. Further, the Applicants' Word Mark comprises other components such as the gold border, blue border, background statement (including the words "Clare Valley") and signature of one Bill Taylor Snr.

69 I turn to analyse each of the Application Marks vis-à-vis the Opponents' Mark below.

TAYLOR'S and **TAYLORS WAKEFIELD**

70 Visually, I find that the word "Wakefield" is a prominent component of the Applicants' Word Mark that creates a visual difference in the mind of the average consumer with imperfect recollection. It is likely that the average consumer will remember, at the very least, that the Applicants' Word Mark comprises of two separate and distinct words, whilst the Opponents' Mark comprises of just one word. The additional word "Wakefield" in the Applicants' Word Mark is not likely to be overlooked or overshadowed by the word "Taylors" and visually, stands out prominently on its own. As such, I find that the competing marks are not visually similar.



71 With regard to composite marks the words of the Court of Appeal in *Hai Tong* at [41] are instructive:

In dealing with the test for assessing the visual similarity of marks where one or more of the marks is a composite mark, there appears to have been some emphasis on the textual component of the composite mark. In so far as it has been advanced as a proposition of law that in general, words "talk" in composite marks, we do not agree...Rather, we consider that in assessing the visual similarity of two composite

marks, the correct approach is to consider the marks in totality without placing undue emphasis on any particular component of such marks unless such emphasis is warranted *on the facts* (Emphasis in original)

72 Here, we are dealing with a word mark (the Opponents' Mark) and a composite mark (the Applicants' Device Mark). The Opponents have not made any submissions as to *why* the "Taylors" component is particularly dominant on the facts of the present case, save from merely asserting that it should be so.

73 Taking the two marks and comparing them as a whole, I find that they are visually dissimilar. The text portion of the Applicants' Device Mark occupies just a quarter of the mark's entire space, with the word "Taylors" occupying just one eighth of that space. Furthermore, there are numerous other design elements and other informative elements on the mark that set it apart from the Opponents' Mark. The focus of the eye is drawn to the centralized location of the golden seahorse device. It is also difficult to ignore the presence of the text, the words "Clare Valley" and the signature elements directly beneath the golden seahorse device, which together take up almost half the space of the entire mark. The words "Taylors Wakefield" are likely to be perceived as just one of the many elements found in the space of the mark. On the facts of the present case, there does not appear to be any reason to put emphasis solely on the word "Taylors" as the dominant component of this composite mark.

Aural Similarity

74 The Opponents submit that in the field of beverages and wine, aural similarity is of particular importance in the marks similarity inquiry. The Opponents relied on the case of *Johnson & Johnson v Uni-Charm Kabushiki Kaisha (Uni-Charm Corp)* [2007] 1 SLR 1082 ("*Johnson*") which cited the case of *Mystery Drinks GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs), Karlsberg Brauerei KG Weber Intervening* [2004] ETMR 217 ("*Mystery Drinks*"). The Opponents write that "In the [Mystery Drinks] case, the figurative mark MYSTERY with stylized M and MIXERY were neither conceptually nor visually similar, but were aurally similar ... in the field of beverages this was sufficient."

75 The Applicants submit that phonetically, the Applicants' Word Mark comprises multiple components which are pronounced in a completely dissimilar way from the Opponents' Mark. The Applicants' Word Mark has 4 syllables and 2 distinct words, whilst the Opponents' Mark comprises 2 syllables and just one word, "Taylor's". The Applicants submit that the present case is similar to *Ozone*, where the court made a comparison between a single word mark, "GLAMOUR" and 2 word mark, "HYSTERIC GLAMOUR", and found that they were aurally dissimilar (*Ozone* at [56]). In relation to the Applicants' Device Mark, the Applicants submit that there is even more phonetic dissimilarity as there are many other elements in the device portion which, if pronounced, will comprise of "multiple sounds", eg. the background statement which reads, "THE TAYLOR FAMILY BELIEVES GREAT WINES ARE MADE IN THE VINEYARD. THIS WINE IS CRAFTED WITH CARE AND SEEKS TO CAPTURE THE ESSENCE OF THE VINEYARD SITE AND THE PURE VARIETAL EXPRESSION OF THE GRAPE", "CLARE VALLEY" and "PROUDLY FAMILY OWNED." In relation to both Application Marks, the Applicants submit that the element "WAKEFIELD" stands out because

of its "cacophonous K sound", and is different from the Opponents' Mark, which contains "relatively soft sounds, ending with a sibilant sound."

76 In view of the Court of Appeal's decision in *Staywell*, there should not be any emphasis on aural similarity based on the specific characteristics of the market *at this stage* of the assessment under Section 8(2)(b) of the Act. Rather, such considerations are properly reserved for the confusion stage of the analysis. I refer again to the Court of Appeal in *Staywell* at [20]:

...This means that at the marks similarity stage this even extends not to considering the relative weight and importance of each aspect of similarity having regard to the goods...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 ("*Festina*") at [55]-[56] and by this court in *Sarika (CA)* 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. A practical application of this can be found in European jurisprudence: see *Mystery Drinks* and *Phillips-Van Heusen Corp v OHIM* [2004] ETMR 60. In these cases the court considered, respectively, the particular significance of aural similarity in relation to beverages normally sold by oral order, and visual similarity in relation to clothing normally sold based on the consumer's direct perception, both for the specific purpose of determining whether consumer confusion was likely to arise.

(Emphasis added)

77 In *Festina*, the High Court also applied the *Mystery Drinks* case for the proposition that "the relative importance of each type of similarity would vary with the circumstances of each case, in particular the type of goods and the type of mark" (see *Festina* at [52]). The High Court also considered the significance of the verbalization of a trade mark to the context of purchase of a watch (the relevant goods in that case), and eventually decided that "the aural similarity between the [competing marks] would militate against the visual dissimilarity in this instance": *Festina* at [55]-[56] (as cited in *Staywell* above).

78 In *Sarika (CA)*, the Court of Appeal considered High Court's decision in *Festina* (at [32] and [53]) and held, at [38] (as cited in *Staywell* above):

For the present case, we are of the view that the visual and aural aspects of similarity are relatively more important than conceptual similarity. This is because the "Nutella" mark and "Nutello" sign are word-only and effectively can only be engaged visually or verbally. Moreover, considering the mode of purchase of products sold under the respective mark and sign, *viz*, the "Nutella" cream spread being bought from supermarkets and the "Nutello" drink being ordered in TCC cafes, visual reading and recognition of the words in the mark and sign are the only ways of selecting or ordering these products. For the "Nutello" sign in particular, the verbalisation of it is needed when one orders the "Nutello" drink in the TCC café.

79 The Court of Appeal in *Staywell* has made clear that their position "reflects a slight departure" from the cases of *Festina* and *Sarika* on this point. This means that at the marks similarity stage, there is no room for argument that a certain aspect of similarity stands out over the other aspects of similarity *having regard to the goods in question*. This argument should be reserved for the confusion stage of the inquiry, where the effect of the marks similarity is tested on the perception of consumers.

TAYLOR'S and TAYLORS WAKEFIELD

80 Given the above, I turn to examine the competing marks on the basis of the test for aural similarity, as stated by the Court of Appeal in *Hai Tong* at [68]:

We turn to the assessment of aural similarity...When comparing marks or signs aurally, a quantitative assessment is carried out to ascertain if the marks or signs in question have more syllables in common than not (see *Sarika* at [28] and *Ozone* at [55], citing with approval *L Bently & B Sherman, Intellectual Property Law...* at p 865). The syntax of the marks or signs being compared is also considered. Hence, it is relevant to consider the total number of syllables in each mark or sign concerned and ascertain whether there is a pause in reading of the mark or the sign, as when a mark or sign is made up of two discrete words (see *Ozone* at [14] and *Intuition Publishing* at [54]).

81 A quantitative assessment of the competing marks shows that they are dissimilar. The Opponents' Mark has 2 syllables, namely, "TAY-LOR'S" whilst the Applicants' Word Mark comprises of 4 syllables, namely "TAY-LORS-WAKE-FIELD". The latter is also made up of two discrete words, namely, "Taylors" and "Wakefield" whilst the former would be read as a single word, "Taylor's". I find the dicta in *Ozone* at [56] to be instructive in this regard:

...Also, Ozone's HYSTERIC GLAMOUR word mark would be read and pronounced as two separate and distinct words, in the order of "hysteric" and "glamour". AMP's GLAMOUR word mark, on the other hand, would be read as a single word. The comparison in this case was between a two-word mark and a single word mark, so that even if the actual word "hysteric" was forgotten, it would not be forgotten that there was an additional word in Ozone's word mark.

82 Similarly, I find that it would be unlikely that the presence of an additional word, "Wakefield", could be simply overlooked even if the relevant consumer has imperfect recollection of the competing marks.



83 As for the Opponents' Mark and the Applicants' Device Mark, I find that these marks are dissimilar to a greater extent given the additional syllables that are found in the paragraph of words (see paragraph [75] above) and the additional words, "CLARE VALLEY". It would be difficult for a consumer to ignore the difference between the single word, "Taylor's" and numerous other words (35 words (in the paragraph [75] above), 2 words ("CLARE VALLEY") and 3 words ("PROUDLY FAMILY OWNED")) in the Applicants' Device Mark. It follows that the number of syllables in the Opponents' Mark (2 syllables) is markedly different from the number of syllables from the many words present in the Applicants' Device Mark.

Conceptual Similarity

84 In considering whether there is conceptual similarity, the inquiry is directed at the ideas that lie behind or inform the marks or signs in question: *Hai Tong* at [70]. However, the consideration of these ideas that lie behind the mark is limited to an analysis of the concepts that can be derived from the elements present in the sign at surface value: *Lacoste v Carolina Herrera Ltd [2014] SGIPOS 3* at [56], citing *Sarika* at [34] and *Staywell* at [34]-[37].

85 The Opponents submitted that the competing marks are conceptually similar because they all contain the dominant component, "TAYLORS". In the alternative, "even if the full components of both [competing marks] are considered", the Opponents submit that both marks would be perceived by the relevant consumers as a family name and as such, there is conceptual similarity (see Opponents' written submissions at [19]).

86 The Applicants submit that conceptually, the Opponents' Mark is different from the Applicants' Word Mark because the word "WAKEFIELD" transforms the nature of the mark from a straightforward individual name to one with a locational aspect, citing the case of *Kenzo*, where the Principal Assistant Registrar found that "KENZO" and "KENZO ESTATE" were not conceptually similar, following another case *Cardinal Place Trade Mark*, BL 0/339/04 where it was held that the word "Place" in the mark "CARDINAL PLACE" operated to change the meaning of the mark from an "ecclesiastical" to a "locational" one.

TAYLOR'S and TAYLORS WAKEFIELD

87 I find that the competing marks are conceptually similar in that they both evoke the concept of a personal name to the average consumer. I am unable to agree that the word "WAKEFIELD" will evoke the concept of a place to the average consumer. Unlike the words "Place" and "Estate", the word "WAKEFIELD" is *not* a plain English dictionary word that commonly refers to a type of location. This is the extent of my analysis as I cannot consider the type of goods that the competing marks are registered / applied for at this stage of the inquiry. Thus, taking the competing marks as wholes, I find that there is conceptual similarity between them.



88 However, I find that the Opponents' Mark and the Applicants' Device Mark are conceptually dissimilar. The Applicants' Device Mark, quite unlike the Applicants' Word Mark, is comprised of several elements that make it look like a typical wine label. Most tellingly, it has a paragraph of fine print that refers to it as a type of wine (see full text at paragraph [75] above). Further, the Applicants' Device Mark bears the words "Clare Valley". Unlike the plain "Wakefield" word found in the Applicants' Word Mark, the word "Valley" is a plain English dictionary word that refers to a location. Thus, whilst the Opponents' Mark evokes the notion of a personal name, the Applicants' Device Mark describes a type of wine found in the "Clare Valley" region that goes by the name "Taylors Wakefield".

Decision on Marks Similarity

89 Based on the facts of this case, I am unable to find any reason why there should be any higher threshold of marks similarity for the Applicants to satisfy, given that the Opponents' Mark has a low level of technical distinctiveness. I note that even the European Union, which does not focus on the distinctiveness of the earlier registered mark, did not allow a registration for a common surname to prevail against a later application for a name that included the whole of this common surname within it: see *Becker*, above at paragraph [35]. I also bear in mind that the analysis of marks similarity is not a mechanistic, check-box exercise and that it is not a pre-requisite for all aspects of similarities to be made out before the marks can be found to be similar.

90 In my assessment, the Opponents' Mark is not at all similar to the Applicants' Word Mark and the Applicants' Device Mark. The conceptual similarity in the Opponents' Mark and the Applicants' Word Mark is not, on the whole, sufficient to overcome the visual and aural dissimilarities between them.

91 The first element of marks similarity under Section 8(2)(b) of the Act is not made out in respect of both the Application Marks, and the inquiry effectively ends here. However, in case I am wrong, I also consider the second element of the provision, ie. whether the goods or services are identical or similar.

Similarity of Goods

92 I will deal with the Opponents' and the Applicants' submissions before turning to my analysis on goods similarity. To recap, the Opponents' and the Applicants' goods are both registered/applied for in Class 33 and the specifications are as follows:

Opponents' goods	Applicants' goods
Wines.	Wines, excluding fortified wines.

93 The Opponents submit that if the marks fell within the same class of products, the requirement of similarity of goods would be *prima facie* established and it would be unnecessary for the court to engage in the *British Sugar* test, *Sarika (HC)* at [88]. On this basis, the Opponents submit that there is a clear overlap between the Opponents' registration for "Wines" in Class 33 and the Application Marks' application for "Wines, excluding fortified wines", also in Class 33 (see [24]-[25] of the Opponents' written submissions). At the hearing, the Opponents highlighted two cases in their written submissions in support of their point on goods similarity: *Hai Tong*, at [22] and *In the matter of application No 2008447A by ST DUPONT to register a mark in Class 25 and opposition thereto under No. 44948 by E.I. DU PONT NEMOURS AND COMPANY (Reported as Trade Mark Case Summary: 0/546/01) ("DU PONT")*, at [30].

94 The Applicants' only submission in this regard is that "whatever similarity there may be between the [Applicants'] [g]oods, is *per se* not sufficient to prevent registration of the [Application Marks] under Section 8(2)(b) of the Act. The Applicants also made reference to two cases, *E! Entertainment Television, Inc v Deutsche Telekom AG [2005] SGIPOS 5* and *Gilead Sciences Inc. v Glaxo Group Limited [2006] SGIPOS 12*. In both these cases, the parties' goods were found to be similar, although the marks were dissimilar. However, the Applicants do not admit that the goods in this case are similar. At the hearing, the Applicants added that, to a consumer of wine, port wine, which are sold by the Opponents, are very different from the wines that the Applicants sell.

Analysis on similarity of goods

95 The Court of Appeal in *Staywell* at [82] described the test for goods similarity as follows:

On similarity of goods or services – **extraneous factors may be relevant to establish the degree of similarity as between goods and services** that are not identical in infringement cases and **in opposition proceedings where the applicant's and proprietor's goods and services are registered or to be registered in different classes or specifications**. Such extraneous factors are some of those identified in *British Sugar*, in particular the uses and the users of the goods and services in question, their inherent nature and the extent to which they are competitive. **Extraneous factors are not to be considered if the goods and services are identical, because there will be no need to determine how similar they are** (see [42] above). Goods and services will be regarded as identical where they are registered or to be registered in the same class and specification in opposition proceedings, while in the infringement context it will be permissible to have regard to the classification in which the allegedly infringing item or service would have been inserted had the alleged infringer sought registration of his mark.

(Emphasis added)

96 In *Staywell*, the parties did not appeal against the High Court judge's finding that the services in relation to which the respective marks were used or for which registration was sought were similar. Nevertheless, the Court of Appeal set out its opinion comprehensively in this regard, at [40]-[43] of the decision. In particular, the Court of Appeal clarified the dictum in *Polo (HC)* at [33], where Lai J held that registration in the same category establishes a *prima facie* case for similarity. The same dictum (in *Polo (HC)* at [33]) was relied upon by Chan J in *Sarika (HC)* at [88], which was cited by the Opponents in their submissions. The Court of Appeal in *Staywell* held at [40]:

Following the dictum of [Lai J] in *Polo (HC)* at [33], the Judge stated that registration in the same category establishes a *prima facie* case for similarity. This invites some clarification. We think that what Lai J was referring to was registration in the same specification. **We would go further to say that registration in the same specification within a class establishes a *prima facie* case for identity.** This is because it is not within the scheme of the classification system to make distinctions within a specification based on whether the particular product is targeted at one or another market segment.

(Emphasis added)

97 The Court of Appeal made this statement in the context of the fact scenario in that case, where there was a *precise overlap* between the appellants' and respondents' services in Class 43, ie. "hotel, food and beverage services". In our case, there is no such "precise overlap". In the present case, the question is whether "Wines, excluding fortified wines" (Applicants) can be considered to be the *same specification* as "Wines" (Opponents), such that the parties' goods are *prima facie* identical. I therefore proceed to take a closer look at the *Staywell* decision in this regard.

98 At the end of paragraph [41] in *Staywell*, the Court of Appeal held:

Where a good or service in relation to which registration is sought **falls within the ambit of the specification** in which the incumbent mark is registered, **the competing goods or services would be regarded as identical** (see *Gerard Meric v OHIM*, Case T-133/05 ("*Gerard Meric*") at [29])

(Emphasis added)

99 In *Gerard Meric* at [29], it was held that

...goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application...**or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark** (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33)

(Emphasis added)

100 In *Gerard Meric*, The Court of First Instance ("CFI") upheld the Board of Appeal's decision that the earlier Community trade mark for "any ready-made clothing, in particular *napkin pants*, footwear", falling within Class 25 (Spanish translation of *napkin pants* in this case being: "*children's napkinpants*"), is "identical or at least very similar to" the specification of the application mark sought for "napkin-pants made out of paper or cellulose (disposable)" falling within Class 16. The CFI also considered some other factors in making its decision, such as the nature of the goods, their function or purpose, their marketing points of sale and their complementary nature: *Gerard Meric* at [37].

101 In relation to wines specifically, the UK Trade Marks Registry ("UKTMR") held in *Winez v Instituto* [2006] ETMR 19 ("*Winez*") at [24]-[26] that in respect of Class 33, the applicants' specification for "Table wines, the produce of Bulgaria" was identical to the opponents' specification "Wines included in Class 33". The UK TMR also had regard to other factors such as the nature of the goods, the end users, the method of use and whether they are in competition with each other or are complementary, following the case of *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97 [1998] ECR I-5507; [1999] ETMR 1.

Decision on similarity of goods

102 In deciding whether the specifications are identical, I bear in mind that these are opposition proceedings. The specification that a mark is registered for includes the notional or fair uses to which it could be put. As the Court of Appeal in *Staywell* highlighted at [57]-[58]:

57 In opposition proceedings, the contest is between the holder of an existing registered trade mark who opposes the proposed application, and the applicant who is seeking to register a new mark. The opponent enjoys certain monopoly rights associated with the use of its mark and it opposes the registration of the applicant's mark on the grounds that such registration would entail an unwarranted interference with those monopoly rights, *whether or not these are already being exercised*.

58 It is useful to note that under s 26 of the [Trade Marks] Act, registration confers the exclusive right on the proprietor of the mark "in relation to the goods or services for which the mark is registered"...**This means that once the applicant has registered his trade mark, he acquires the exclusive right to use the mark not only for the goods and services which he might have actually contemplated at the time registration was granted, but for the whole spectrum of goods and services within the specification for which the mark is registered...**

(Emphasis added)

103 The examples of identical goods in *Gerard Meric* and *Winez* cited above suggest that the specifications need not be identical in order for the goods or services in question to be found to

be identical. As summed up in *Staywell*, the good or service for which registration is sought need only fall *within the ambit* of the earlier registration.

104 In light of the principles elucidated in *Staywell* and in consideration of the examples in *Gerard Meric* and *Winez*, I find that, on the facts of the present case, the Opponents' and the Applicants' goods in Class 33 are **identical**. The Applicants' specification "Wines, excluding fortified wines" is essentially a subset of, and is contained within, the Opponents' earlier specification, "Wines". The latter is very general and includes all kinds of wines, including fortified wines and sparkling wines (as indicated in the World Intellectual Property Organization (WIPO)'s taxonomy of goods under the NICE classification system: http://web2.wipo.int/nicepub/edition-20140101/taxonomy/class-33/?pagination=no&lang=en&mode=full&explanatory_notes=show). The Opponents' earlier registration grants it exclusive protection over the whole spectrum of the specification "Wines", whether or not the Opponents have actually exercised these exclusive rights.

105 Since I have found the goods to be identical, there is no need to consider whether they are similar and I therefore do not consider whether any "extraneous factors" apply at this stage of the inquiry: see *Staywell* at [82], as cited above. In view of the foregoing, I find that the second limb of identity (or similarity) of goods under Section 8(2)(b) of the Act is made out.

Likelihood of Confusion

106 As I have already found that the competing marks are dissimilar, despite the goods being identical, the opposition under Section 8(2)(b) of the Act fails. However, if I am wrong as to the dissimilarity of the competing marks and as to the identity of the goods in question, I consider whether there will be a likelihood of confusion if the marks and the goods are both *similar*. If the goods are considered *similar*, some extraneous factors may be relevant to establish the degree of similarity between these goods and services, as stated in *Staywell* at [82] (cited above at paragraph [83]), namely, the uses and the users of the goods and services in question, their inherent nature and the extent to which they are competitive.

107 The Applicants submitted that there would be no likelihood of confusion primarily because of the nature of the relevant sector of the public in question. In their written submissions, they submit that the customers of the Applicants' goods are wine purchasers, who are "typically discerning consumers who are knowledgeable and exercise great caution, care and due diligence before buying such goods" and would pay particular attention to the geographical origin of the wine. In their written submissions, the Opponents appeared to agree that the relevant consumer in this case should not be the general public but rather, confined to a "more specific cross-section of the public" (see Opponents' written submissions at [27(c)], p 12). The Opponents referred to *Ozone* at [83] for the proposition that the relevant consumer could be a more specific cross-section of the public. At the hearing, the Opponents submitted that Singaporean consumers would not be as circumspect about identifying different types of wine, as compared to consumers in France, whom the Opponents said would be "more circumspect" about purchasing wine. The Opponents did not have any evidence to back up this assertion.

108 Assuming the threshold criteria of marks and goods similarity has been met, the issue of likelihood of confusion arises. The court looks at how similar the marks are and how similar the services are, and given this, how likely the relevant segment of the public will be confused: *Staywell* at [55], citing the dicta in *Hai Tong* at [85(c)]:

...Once these threshold criteria have been met, the issue of the likelihood of confusion arises and this in our view directs the court to look at (a) *how* similar the marks are (b) *how* similar the services are and (c) given this, how likely the relevant segment of the public will be confused. In *Hai Tong* we said (at [85(c)]):

Having regard to the express terms of s 27(2), there are three specific elements that plainly must be considered. These are: (i) the similarity between the registered mark and the allegedly infringing mark; (ii) the similarity or identity between the goods or services in relation to which the marks are used; and (iii) the relevant segment of the public in relation to whom the court must consider the likelihood of confusion. ...[A]s to the relevant segment of the public, there may be characteristics that are particular to the group in question...As an illustrative proposition, the likelihood of confusion must be greater where, say, the contesting marks are similar to a high degree, the goods are identical in nature and the segment of the public in question is undistinguished in its attention than would be the case if the marks and the goods are somewhat similar but not exceedingly so, and the relevant segment of the public happens to be highly knowledgeable and very fastidious...

109 On the *effects* of the similarity of marks and the similarity of goods on the relevant segment of the public, extraneous factors may be considered, although these are subject to some important qualifications (*Staywell* at [84]):

First, **in opposition proceedings, it will generally *not* be relevant to consider extraneous factors that relate to the actual and particular circumstances and ways in which the mark was used on the goods in question.** While it will be necessary to consider the notional or fair uses to which each of the marks could be put, for instance, in terms of what types of goods or services are within the contemplated uses for which the mark has been registered, it will not be relevant to have regard to the particular way in which the goods or services have been affixed with the mark and are then being marketed. This would thus exclude consideration of such factors such as differences in the intended market segments, trading strategies employed, websites used or the trader's chosen limitations as to his use of the mark...It would denude of significance the critical distinction we have drawn between infringement and opposition proceedings if the confusion inquiry were diverted into a consideration rooted in the details of the actual circumstances in which the goods or services affixed with the mark are being marketed.

(Emphasis added)

110 The Court of Appeal elaborated on the types of extraneous factors allowed at [95]-[96], as follows:

95 Although the risk of origin-based confusion is the primary interest sought to be protected by trade mark law, there must be a limit to the range of external factors that may be taken into account to determine whether a sufficient likelihood of such confusion exists. **The permissible factors are those which (a) are intrinsic to the very nature of the goods and/or (b) affect the impact that the similarity of marks and goods has on the consumer.** The impermissible factors are those differences between the competing marks and goods which are created by a trader's differentiating steps. In other words, factors which are not inherent in the goods, but are susceptible to changes that can be made by a trader from time to time, should not be permissible considerations. In particular, we are satisfied that it is unnecessary, unworkable and impermissible for the court to have regard to such issues as pricing differentials, packaging and other superficial marketing choices which could possibly be made by the trader. In contrast, **extraneous factors that relate to the *purchasing practices and degree of care paid by the consumer when acquiring goods of the sort in question, can be considered and assessed without descending into the details of particular differentiating steps which the trader might choose to take in relation to the goods and services falling within the specification.***

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* ([18] *supra*) at [85(c)(iii)]), the reputation of the marks (see *Polo (CA)* ([8] *supra*) 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* ([23] *supra*) at 1352; and *Phillips-Van Heusen Corp v OHIM* ([20] *supra*) 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.

(Emphasis added)

(i) *Factors Relating to the Impact of Marks-Similarity on Consumer Perception*

111 For reasons stated at paragraphs [27]-[91] above, I find that there is no similarity between the competing marks. I have also found that there is insufficient evidence to show that the Opponents' Mark is technically distinctive or has otherwise acquired distinctiveness. However, if I am wrong about this and accept that there is similarity between the competing marks, this similarity is of a very low level and would mean that there is a correspondingly low likelihood of confusion.

(ii) *Factors Relating to the Impact of Goods-Similarity on Consumer Perception*

112 Both the Opponents and the Applicants submitted that based on the facts in this case, the relevant segment of the public would be wine consumers. The dispute between them was the *nature* of *Singaporean* wine consumers, ie, whether they were particularly fastidious or exercised a greater degree of care when making wine purchases. Neither side made submissions on their evidence as to the nature of *Singaporean* wine consumers to support their respective positions.

113 In my analysis, the evidence shows that the Opponents' goods are sold at hotels (such as Marina Bay Sands and Grand Hyatt Singapore), duty-free shops and supermarkets (such as NTUC Fairprice) (see paragraph [58] above). From the Applicants' marketing material, it appears that their products were distributed to various restaurants around central Singapore (eg. South Bank Thai Restaurant in Boat Quay, Tree Top in Orchard Road, Angus Steak House in Takashimaya, Tasting Notes in Robertson Walk) as well as various supermarket chains (Giant, Carrefour, NTUC, Cold Storage, Isetan) (see Tab D of 1st Taylor, pp 18 – 20). Given this evidence, I find that the normal way in which consumers of the Applicants' and the Opponents' goods make their purchases is through supermarkets or restaurants in various central locations in Singapore.

114 The Applicants' evidence contains details of its marketing plans in Singapore, as prepared for them by their exclusive distributor, Auric Pacific Marketing Pte Ltd ("**APM**"). In one of APM's presentation slides titled "Market Overview", dated 15 November 2007, the following is noted:

- i) "With the myriad of wine labels available and accessible, consumers are spoilt for choices [sic].
- ii) For daily consumption, consumers are less particular on the quality and will pick up the lowest priced wines they can find or the best value for quality offered.

- iii) Discerning and quality sensitive consumers (occasionally lower end consumers) spend on mid-end wines. Price offer plays a smaller part in the purchase discussion. They are reasonable [sic] well informed on the wine labels from media exposure or personal experience. Purchase of wines tend to be those frequently advertised, widely promoted (through samplings, winemaker's dinners) and has high visibility at store level.
- iv) There is also a growing group who are serious wine drinkers/connoisseurs who are well informed and knowledge thirsty. They compare and analyze wine price according to its quality. Brand loyalty almost do not exist [sic] as they love exploring labels, usually from mid-end to high-end."

115 In another of APM's marketing plans prepared for the Applicants, dated 28 February 2011, the following was noted in the slides titled "Market Overview":

- i) "New F&B outlets continue to flourish with the completion of integrated resorts. Potential growth in on-trade premise – opportunity for Taylors to expand distribution.
- ii) Increased competition and wide choice selection for on-premise customers and they are demanding lower prices for similar quality.
- iii) Consumers recall and order brands by visual – need for Taylors to produce attractive POSM [not defined] like ice buckets, aprons, and tent card stands."

116 The evidence tendered by the Applicants suggests that there are different types of consumers within the group of wine consumers in Singapore in 2007, namely, those who buy wine "for daily consumption", those who are "discerning and quality-sensitive", those who are "serious wine drinkers/connoisseurs"), and a "growing group" of wine consumers who are well-informed and knowledgeable about wine prices and quality. By 2011, the growth of the food and beverage sector appears to have increased the selection of wines for wine consumers, causing them to be more demanding about price and quality. Based on this evidence, I find that the nature of Singaporean wine consumers is quite varied, although they would be reasonably knowledgeable about wines to be able to determine the quality / value of their purchases. Even at the lowest end, ie. those who buy "for daily consumption", these consumers appear to be cognizant of quality / value, although they are likely to compromise these aspects in favour of lower prices. Given the type of consumer involved, the impact of the similarity of goods on the consumers' perception is not likely to be very strong since the consumers are of a more discerning class, and are likely to be able to distinguish between different types of wines.

Conclusion on likelihood of confusion

117 In sum, I find that there is no likelihood of confusion between the Application Marks and the Opponents' Mark. The competing marks share, at best, a low degree of similarity. As regards the goods, which have been found to be identical or similar in nature, the impact of this identity or similarity between them is reduced by the fact that the competing marks share a low degree of similarity and because the nature of the consumer is such that he is likely to pay more attention to the competing marks when buying the goods in question. The average Singaporean wine consumer is reasonably knowledgeable about wines and would consider the label(s) on the

relevant bottle(s) before committing to a purchase in a supermarket or restaurant, thus greatly lessening any impact of goods similarity.

Decision on Section 8(2)(b)

118 In view of the foregoing, the ground of opposition under Section 8(2)(b) of the Act fails.

Ground of Opposition under Section 8(4)(b)

119 Section 8(4) of the Act reads:

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

(a) the earlier trade mark is well known in Singapore; and

(b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —

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

(ii) if the earlier trade mark is well known to the public at large in Singapore –

(A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or

(B) would take unfair advantage of the distinctive character of the earlier trade mark.

Opponents' Submissions

120 The Opponents submit that their mark is well-known because it has been in "substantial use in Singapore" since the 1970s, and that worldwide, they have been in the business for four centuries, using their mark for at least three centuries. They submit that the volume and value of sales of their products imported to Singapore for the last 15 years are "substantively in the hundreds of thousands" for most years, being consistently in the range of S\$400,000. The Opponents claim that they have adduced evidence of extensive promotion through the media, internet, magazines, journals and newspapers, events, sponsorships and other promotional activities. At the hearing, the Opponents further submitted that consumers would have easy access to the Opponents' brand through websites on the internet. Finally, they submit that they have enforced their rights successfully in the European Union against the present Applicants.

Applicants' Submissions

121 The Applicants submit that the Opponents' evidence is "paltry", in that they do not show any sales figures or documentary evidence that the Opponents' Mark has been used in Singapore since 1979 and that there are no sales records before 2008. Further, no figures for marketing and

promotion expenses are provided, and the only evidence of such marketing in the Opponents' evidence relate to magazines that are primarily circulated in the UK. No evidence has been adduced to show circulation of these publications in Singapore, neither is there any advertising actually undertaken in Singapore. There is also no evidence of marketing expenditure for the Singapore market. The only evidence the Opponents have are sales figures of their goods in Singapore, but the Applicants submit that these figures alone are insufficient to establish that the Opponents marks are well known, referring to dicta in *Grand Tec Resources Pte Ltd v The Gates Corporation* [2006] SGIPOS 7. In relation to Section 8(4)(b)(ii), the Applicants further submitted that the Opponents have not satisfied the higher burden of being "well known to the public at large in Singapore", which is the reserve of a "rare and exclusive class" of trade marks, citing *Novelty Pte Ltd v Amanresorts Ltd and Anor* [2009] 3 SLR(R) 216 ("*Amanresorts*"). The Applicants also submit that the sales figure of about \$400,000 in Singapore falls far short of the standard expected of a well-known mark. In *Clinique*, a case cited in IPOS' *Kenzo* decision, marketing expenditure was in the region of \$3 million each year, whilst sales figures were about \$10 million each year.

Decision on Section 8(4)(b)

122 Under Section 8(4)(b) of the Act I have to consider whether the whole or an essential part of the Application Marks are identical with or similar to the Opponents' Mark or any "earlier trade mark" as defined in Section 2 of the Act. The Opponents have not made any submissions as to any "earlier trade mark" and have focused only on their registered trade mark (ie. the Opponents' Mark).

123 In order to succeed under this ground of opposition, the Opponents must show, under Section 8(4)(b)(i) of the Act, that:

- i) The whole or an essential part of the Application Marks is/are identical with or similar to the Opponents' Mark;
- ii) The Opponents' Mark is well known in Singapore;
- iii) The use of the Application Marks in relation to the goods claimed would indicate a connection with the Opponents;
- iv) Use of the Application Marks is likely to damage the Opponents' interests.

124 Alternatively, the Opponents must show, under Section 8(4)(b)(ii) of the Act, that:

- i) The whole or an essential part of the Application Marks is/are identical with or similar to the Opponents' Mark;
- ii) The Opponents' Mark is well known to the public at large in Singapore;
- iii) The use of the Application Marks in relation to the goods it seeks registration for would cause dilution in an unfair manner of the distinctive character of the Opponents' Mark.

Marks Similarity

125 As to the query in paragraphs [123(i)] and [124(i)] above, I have already found that the Opponents' Mark is not similar to either of the Application Marks (see paragraphs [89] to [91] above). The enquiry under Section 8(4)(b) of the Act effectively ended there since the Opponents

have failed to discharge one of the threshold requirements for proving the ground of opposition under both Section 8(4)(b)(i) and Section 8(4)(b)(ii) of the Act.

Well known in Singapore / Well known to the public at large in Singapore

126 However, if my assessment of marks similarity is wrong, it is still difficult to find that the Opponents' Mark is well known to the relevant sector of the public in Singapore, based on the submissions and the evidence tendered by the Opponents in this case.

127 In relation to part (ii) of the query (under Section 8(4)(b)(i) of the Act) above, the "*relevant sector of the public in Singapore*" is arguably the most crucial factor in determining whether the mark is "well known in Singapore": see *Amanresorts* at [139]. The relevant sector of the public in Singapore is defined in Section 2(9) of the Act as follows:

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

128 At the hearing, however, the Opponents submitted that the "relevant sector of the public in Singapore" was "the public at large", *for the purposes of Section 8(4)(b)(i) of the Act*. The threshold to meet when claiming that a trade mark is well known to the public at large in Singapore is a relatively high one. As stated by the High Court in *Sarika (HC)* at [153]

[The Act] does not define the phrase "well known to the public at large in Singapore". However, in *City Chain*, the Court of Appeal 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]). Such an approach, as the Court of Appeal recognised, would be in line with the United States' approach in determining famous marks (*City Chain* at [94]). It flows from the logic in *City Chain* that *if* a trade mark is shown to be "well known to the public at large in Singapore", it is *necessarily* also "well known in Singapore".

129 The Opponents have tendered the following evidence to prove that their mark is well known to *the public at large* in Singapore:

- i) A sworn statement from the Opponents' director, Ian Cuming, that the Opponents' Mark was first used in Singapore in 1979;
- ii) A table showing the volume and value of sales of "Taylor's port wine" exported to Singapore for the 15 year period 1998 to 2012. The supporting document for this table an independent statement from the "Port and Duoro Wines Institute"

- declaring that this "demonstrates the volume and value of Port Wine exported to Singapore under the trademark TAYLOR'S";
- iii) Another table showing the annual sales figures in Singapore for "Taylor's wine" for the fiscal years 2009 to 2012 (beginning 1 April 2008 ending 31 March 2012), supported by copies of random invoices/receipts/delivery notes evidencing sales in Singapore;
 - iv) Various promotional literature in several industry magazines, online port wine review articles; and
 - v) An image of a Singapore Airlines First Class wine list, featuring the Opponents' port wine, taken from website <http://hackmytrip.com/2012/10/asia-trip-report-singapore-airlines-first-class-menu/>.

130 Of the evidence above, (i) and (ii) are bare statements that are not supported by any evidence of use or sales in Singapore. As for (iv), these promotional literature items appear to be either unidentified or from foreign publications. For example, there is an extract from a publication called "Vintage Port by James Suckling" but no information on the date, circulation or country of publication is furnished. Similarly, there is no information on the country of publication/circulation in one "Punch Magazine" dated 18 May 1990 by one James Ainsworth (although there is a British address at the top left hand corner of the page and quotations in British pound currency throughout the article). Another extract is from "GQ Magazine (Main)" with a caption at the top of the page stating "Country: UK" and "Circulation: ABC 120057 Monthly". Without any other evidence, I find that it is unlikely that any Singapore readers would have chanced upon these magazines. As for (v), it is a one-page document containing a cropped image that has been superimposed on the document, with the website address printed below it. There is no indication of when this website was accessed, who published the information or whether it was circulated in Singapore. Furthermore, this document was submitted as proof of "an in-flight pouring contract between 2009 and 2011" (see [17] of 1st Cuming), yet the website address appears to be dated in 2012.

131 As for (iii), the Opponents have submitted a number of random copies of invoices as proof of the annual sales figures in Singapore "of TAYLOR'S wine" for the fiscal years 2009 to 2012 (4 years). These are described in greater detail at paragraph [58] above. The question, then, is whether this is sufficient to show that the Opponents' Mark is well known to *the public at large* (as submitted by the Opponents).

132 In this regard, I note that only a few trade marks have reached the status of being "well known to the public at large in Singapore", e.g. "CLINIQUE" – in *Clinique Laboratories, LLC v Clinique Suisse Pte Ltd and another* [2010] 4 SLR 510 ("*Clinique*"), "NUTELLA" in *Sarika (HC)* and more recently, "SEIKO" in *Choice Fortune Holdings Limited v Seiko Holdings Kabushiki Kaisha (trading as Seiko Holdings Corporation)* [2014] SGIPOS 8 ("*Seiko*"). In these cases, there was, *inter alia*, relevant survey evidence demonstrating more than 70% of consumer awareness of the mark (in *Sarika (HC)* at [155(b)] and *Seiko* at [104]), generous expenditure on marketing and advertising (e.g. \$3 million each year for 4 years in *Clinique* at [39], more than \$4 million each year for 5 years in *Seiko* at [96(v)]) as well as exposure of the mark to the public through physical sales outlets in Singapore (13 stores and counters in Singapore in *Clinique* at [41], 100 optical shops in Singapore in *Seiko* at [96(iii)], 94-98% of

stores in Singapore that sell food items in *Sarika (HC)* at [155(a)]. There is also evidence of very large sales figures in each of these cases: about \$10 million per annum from 2004 to 2008 in *Clinique* at [39], \$14 million per annum from 2005 to 2010 in *Seiko* at [96(ii)], and 2 million units of "Nutella" bread spread sold every year in Singapore (to 1.1 million households) in *Sarika (HC)* at [155(a)].

133 In contrast, for the present case, there is no evidence of *any* expenditure on marketing and promotion in Singapore, neither is there *any* evidence of advertising in the Singapore market. As for the evidence in their receipts at part (iii) above, the sales figures work out to an average of about \$449,000 per fiscal year for 4 years. The unit price of the Opponents products range from about \$14/bottle to \$140/bottle, with many other price variations in between (\$30, \$35, \$56, and so forth). No submissions were made as to how many bottles on average were sold per year. In any event, these figures would fall far short of those for well known trade marks, as detailed in the paragraph above. The totality of evidence before me is insufficient to convince me that the Opponents' Mark should be granted the status of being well known to the public at large in Singapore.

134 In view of my conclusion on marks similarity (paragraphs [89]-[91]) and whether the Opponents' Mark is well known to the public at large (paragraphs [126]-[133]), there is no need for me to go through the other requirements of Section 8(4)(b) of the Act. The ground of opposition under Section 8(4)(b) of the Act fails.

Conclusion

135 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 Marks shall proceed to registration. The Applicants are also entitled to costs to be taxed, if not agreed.

Dated this 26th day of August 2014.

Diyannah Binte Baharudin
Assistant Registrar of Trade Marks
Hearings and Mediation Group
Intellectual Property Office of Singapore