

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

Trade Mark No T1100417A (IR No. 1061750)  
Hearing Date: 20 February 2014

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

**LACOSTE**

**AND**

**OPPOSITION THERETO BY**

**CAROLINA HERRERA, LTD**

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

Ms Sue-Ann Li (Ravindran Associates) for the Applicants  
Ms Angeline Raj (Ella Cheong LLC) for the Opponents

*Cur Adv Vult*

**GROUNDSC OF DECISION**

1 Lacoste (the "Applicants") applied to protect "L.12.12" (the "Application Mark") on 2 Dec 2010 under International Registration No. 1061750 (Singapore Trade Mark No. T1100417A) in Classes 03, 18 and 25 in respect of the following:

- (i) Class 03: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soap; perfumes;

- essential oils, cosmetics, hair lotions; dentifrices; depilatory preparations; make-up removing preparations; lipsticks; beauty masks; shaving preparations; preservatives for leather (polishes); creams for leather.
- (ii) Class 18: Leather and imitations of leather; goods of leather and imitation leather, namely luggage (excluding bags for packaging of textile materials and bags for transporting and storing loose items); traveling bags, sports bags (excluding bags exclusively adapted for sports goods that they are designed to contain), leatherware, vanity cases (not fitted), toiletry bags (empty), handbags, beach bags, rucksacks, briefcases, school bags, pocket wallets, card cases, purses, purses (not of precious metal), pouches designed to be worn round the waist, pouches; skins; trunks and traveling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.
- (iii) Class 25: Clothing, footwear, headgear.

2 The application was accepted and published on 11 February 2011 for opposition purposes. Carolina Herrera, Ltd (the "**Opponents**"), filed their Notice of Opposition to oppose the registration of the Application Mark on 10 June 2011. The Applicants filed their Counter-Statement on 2 November 2011.

3 The Opponents filed evidence in support of the opposition on 10 December 2012. The Applicants filed evidence in support of the application on 16 May 2013. The Opponents filed a second set of evidence on 30 September 2013. A Pre-Hearing Review was conducted in writing on 5 November 2013, after which the opposition was heard on 20 February 2014.

### **Grounds of Opposition**

4 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.

### **Opponents' Evidence**

5 The Opponents' evidence comprises of two statutory declarations, both declared by Ms Ana Pallarés, Legal IP Director of the Opponents in Barcelona, Spain. The first statutory declaration is dated 10 December 2012 ("**Opponents' 1<sup>st</sup> SD**") whilst the second is dated 30 September 2013 ("**Opponents' 2<sup>nd</sup> SD**").

### **Applicants' Evidence**

6 The Applicants' evidence comprises of one statutory declaration of Mr Frederic Blanc, the Intellectual Property Manager of the Applicants on 14 June 2013 in Paris, France ("**Applicants' SD**").

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

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

## **Background**

8 The Opponents are a fashion and lifestyle company founded in 1980 and headquartered in New York, New York, United States of America ("USA"). They have six flagship boutiques, five of which are in the USA and one which is in Caracas, Venezuela. Further key stores are found in several locations in the USA. The Opponents submitted numerous pages of their pending and registered marks around the world such as Brazil, Canada, Switzerland and China, which includes various marks containing the numerals "212" in them.

9 The Opponents are also the registered proprietors of the following trade marks in Singapore:

<b>TM Numbers</b>	<b>Trade Mark</b>	<b>Class</b>	<b>Specification of Goods</b>
T0201161F	<b>212 ON ICE</b>	3	Perfumery products, essential oils, cosmetics, body milk, face and body creams, soaps, bath and shower gel, talcum powder, hair and body lotions, deodorant for personal use.
T0906637H	<b>212 VIP</b>	3	Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.
T0524829C	<b>212 SEXY</b>	3	Perfumery and cosmetic products; essential oils, toilet soaps, talcum powder, shampoo and other hair lotions; bath gels and salts; personal deodorants and dentifrices.
T9705073H	<b>212 by Carolina Herrera</b>	3	Eau de cologne, toilet soap, perfumed bath gel, body cream lotion, perfumed talcum powder, body deodorants; all included in Class 3.

(collectively, the "**212 Marks**")

10 The Opponents claim to have used the 212 Marks in connection with a wide range of goods in many countries throughout the world (Opponents' 1<sup>st</sup> SD, [7]), although its evidence is focused on the 212 Marks as used in relation to various types of perfume.

11 The Applicants are a French apparel company founded by Rene Lacoste in 1933. The Applicants have a worldwide presence in 115 countries with more than 1208 Lacoste boutiques and more than 2000 points of sale in department stores. In Singapore, the Applicants have at least 11 retail outlets and various distributors of their clothing, footwear, leather goods, eyewear, home textiles, watches and belts.

12 The Application Mark, **L.12.12**, is an industrial code name given by the Applicants' founder, Rene Lacoste, for a type of polo shirt that he designed for tennis players (see Applicants' Press Kit in the Applicants' SD, p 37). The letter "L" refers to Lacoste and the second "12" refers to the number of prototypes of the polo shirt presented to Rene Lacoste. Additionally, "1" refers to the unique fabric used in the polo shirt and "2" refers to the short-sleeved model of the polo shirt (whilst "L.13.12" refers to the long-sleeved model of the polo shirt) (see Applicants' SD at p 25 and 37). The Applicants adduced evidence showing that **L.12.12** has been used by third party websites to indicate the Applicants' polo shirts (Applicants' SD, p 67-70). The Applicants have been selling **L.12.12** polo shirts in Singapore since 1984, through their distributor, RSH Holdings Pte Ltd.

13 Inspired by the **L.12.12** polo shirts, the Applicants launched a perfume by the same name, known as the "Eau De Lacoste", worldwide, in January 2010. The product is described in the Applicants' publicity material as follows (Applicants' SD, p 100):

"EAU DE LACOSTE L.12.12 captures not just the spirit of the brand but transforms fragrance notes into abstract moods and emotions to evoke the very spirit of the iconic shirt – unforgettably cool, crisp, elegant and audaciously stylish. In essence the confidence a man feels when he puts on a classic LACOSTE L.12.12 polo shirt."

#### *Preliminary issue*

14 The Opponents had originally pleaded Section 8(2)(a) of the Act as one of the grounds on which they were pursuing the present opposition (see Notice of Opposition dated 10 June 2011 at [11]) and confirmed this position in their response to the Registrar for the Pre-Hearing Review on 4 December 2013. However, at the hearing, the Opponents confirmed that they would not rely on Section 8(2)(a) of the Act as a ground of opposition.

## **MAIN DECISION**

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

15 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.

16 In their written submissions, the Opponents argue that the Application Mark is similar to the 212 Marks because "212" is the common and dominant element in these marks, and that the general impression that would be left on the consumer is the idea/concept evoked by the numerals "212" contained in both marks (see Opponents' written submissions, [14]-[19]). However, the Opponents do not hold a registration solely for "212", although "212" is the common element in the 212 Marks.

17 The Registrar thus wrote to the parties on 27 January 2014 and directed them to submit on the issue of whether the Opponents should be granted a monopoly over "212" for the relevant classes of goods given that "212" is the common element in their "family" or "series" of marks. Both parties tendered further written submissions and bundles of authorities in relation to this issue on the day of the hearing.

***Whether the Opponents should be granted a monopoly over "212" for the relevant classes of goods***

*Opponents' Submissions*

18 At the hearing, the Opponents submitted that "212" is a unique choice of mark for perfumes because products in this category are usually referred to by name, and a combination of numbers is not common for perfumes. The word portion of the 212 Marks are not as dominant as the numerals. In their further written submissions at the hearing, the Opponents submitted that they chose the numbers "212" for its 212 marks because it was a prestigious area code in Manhattan, New York City, in the 1980s, where the Opponents had its headquarters.

19 In the present case, the Opponents pointed out that they are the only proprietors of the 212 Marks in Classes 3, 18 and 25 in Singapore, and this confirms that the use of "212" is exclusive to them in relation to the goods in these classes. To support this argument the Opponents cited ***McDonalds Corp v Future Enterprises Pte Ltd [2003] SGIPOS 3 ("McDonalds IPOS")***, where the Registrar cited the case of ***Beck, Koller (1947) 64 RPC 76*** and held that

where there are a series of marks having a common feature or a common syllable for goods dealt with in a particular trade...this is generally a circumstance adverse to an applicant for a mark containing the common

feature, since the public might think that such a mark indicated goods coming from the same source as the goods covered by the other marks, but if the marks in the series are owned by different persons, this tends to negative any proprietorial signification (sic) of the common feature, and so may assist the Applicant.

20 In addition, the Court of Appeal decision for the same case, *McDonalds Corp v Future Enterprises* [2005] 1 SLR(R) 177 ("*McDonalds CA*"), cited Kerly's Law of Trade Marks and Trade Names, 12<sup>th</sup> ed, 1986, and held that

Where there are a series of marks, *registered or unregistered, but in use*, having a common feature or a common syllable and where all the marks in such a series belong to an opponent, *these are generally circumstances adverse to an applicant* for a mark containing the common feature, since the public might think that such a mark indicated goods coming from the same source; the strength of this "series" objection depending on how distinctive the common feature is (Emphasis by Opponents)

21 The Opponents also cited two decisions which considered the law in relation to a "family" or "series" of marks under the old 1938 UK Trade Marks Act: *UNIMAX Trade Mark* [1979] RPC 469 ("*UNIMAX*") and *SEMIGRES Trade Mark* [1979] RPC 330 ("*SEMIGRES*").

22 The Opponents further submit that the 212 Marks enjoy reputation from the extensive promotion and advertisements, per the following evidence in the Opponents' 1<sup>st</sup> SD:

- (i) Their website, [www.carolinaherrera.com/212/en/areyouonthelist](http://www.carolinaherrera.com/212/en/areyouonthelist), as well as other related links on this website;
- (ii) Third party websites/online stores selling their products, such as the TANGS eStore, Sephora, Duty Free Singapore, [www.fashiontraveler.com](http://www.fashiontraveler.com) (featuring stores like Neiman Marcus and Club 21), Gumtree (a Singapore-based website), <http://www.fragranatica.com/designers/Carolina-Herrera.html>, Asia Tatler.com, <http://sg.bestbuy-world.com>, <http://list.qoo10.sg>;
- (iii) Their local distributor, Luxasia Pte Ltd, who distributes the Opponents' goods bearing the 212 Marks to various department stores in Singapore;
- (iv) Six pages of magazine articles (from November – December 2010) showing the Opponents' goods bearing the 212 Marks;
- (v) Sales figures for 2008 to 2010 in Singapore in relation to goods bearing the 212 Marks, of more than S\$1 million each year;
- (vi) Samples of supporting receipts from the Opponents' distributor, Luxasia Pte Ltd in relation to (v) above;
- (vii) Undated store outpost promotions along Orchard Road near Tangs/Heeren (sic) showing two tents with stands bearing the mark "212 VIP", promotional sales staff wearing t-shirts bearing "212 VIP";
- (viii) Undated backwall promotion at ION Sephora with bearing "212 VIP";

- (ix) Undated pictures of sales counters at Tangs store, Metro Paragon store and Takashimaya; and
- (x) Social media posts from Facebook, showing that "Carolina Herrera" received 521,633 "likes" between Aug 16, 2013 and September 14, 2013, and other promotional pictures pertaining to "212 for Women" (released 1996) and "212 MEN NYC" (released 1999).

#### *Applicants' Submissions*

23 The Applicants submit that since the Opponents did not register "212" *simpliciter*, they should not be granted a monopoly over this mark. The added elements (such as "SEXY" and "Carolina Herrera") in the Opponents' 212 Marks made it easier to register these marks and would mean that the rights obtained by the Opponents should be narrower and limited to the marks as filed. The Applicants submitted that in contrast, the Opponents have registered "212" *simpliciter* in other markets such as the UK and the US, demonstrating that they have rights to "212" in these jurisdictions, but not in Singapore.

24 The Applicants also submit that the Opponents' 212 Marks are never referred to as "212", even by the Opponents themselves. The Opponents have submitted a whole slew of "212" marks in their Notice of Opposition, but there is little evidence of use of these marks in Singapore. The evidence is only in relation to some of the marks, namely, "212 VIP", "212 MEN" and "212 SEXY". Further, there is no evidence that the public refers to these marks as "212":

- (i) one of the third party websites (at paragraph 22(ii) above) uses the "212" marks in conjunction with other words, such as "Carolina Herrera 212 GLAM", "Carolina Herrera 212 GLAM Men", "Carolina Herrera 212" and "Carolina Herrera 212 Sexy Men"; and
- (ii) even the Opponents' own invoices (at paragraph 22(vi) above) refer to the Opponents' fragrances as "212 VIP" and "212 SEXY".

#### ***Decision on whether the Opponents should be granted a monopoly over "212" for the relevant classes of goods***

##### *The law*

25 The Opponents' submissions were based on relatively old cases of ***Beck, Koller*** (decided in 1946), ***UNIMAX*** and ***SEMIGRES*** (both decided in 1979) and an outdated version of Kerly's *Law of Trade Marks*, dated 1986 (see paragraph 20 above), which were cited by the appellants in the ***McDonalds CA*** case, and not the court. The cases cited by the Opponents were decided in light of the old UK Trade Marks Act in 1938 ("UKTMA 1938"), which has since been repealed. Given that there are more recent authorities in this area of law, I would prefer to refer to these authorities, which will be discussed below. However, for completeness, I will discuss ***UNIMAX*** and ***SEMIGRES*** as the facts in these cases bear some similarity to those of the present case, although they can ultimately be distinguished.

26 In *UNIMAX*, the applicants sought to register "UNIMAX" in respect of electrical apparatus in Class 9. The opponents had registered a series of marks with the prefix "UNI", including "UNIVAC", "UNISCOPE", "UNISERVO" and "UNISET". In this case, the opponents had evidence from nine independent witnesses, all of whom had heard of these "UNI"-prefixed marks and would associate them with the opponents in relation to computer products (at 475-477 of the judgment). The opponents ultimately succeeded in their opposition under Section 11 and 12(1) of the UKTMA 1938 in respect of the mark "UNIVAC". The hearing officer was of the view that "UNIMAX" and "UNIVAC" were "too close visually and phonetically to be used on identical goods by different proprietors without a tangible risk of confusion or deception arising on the part of others", and that this risk of confusion was "enhanced" by the fact that "UNISCOPE" and "UNISERVO" were also recognized as the opponents' marks for products in the computer field (see 478 of judgment).

27 Unlike the opponents in *UNIMAX*, the present Opponents do not have any independent witness evidence (or any evidence) to show that consumers recognize the term "212" in relation to goods (in particular perfumes) in Class 3. This is discussed in detail below at paragraphs 40 to 46.

28 In *SEMIGRES*, the applicants sought to register "SEMIGRES" where the middle letter "i" was fanciful in that it was considerably darker and rectangular in form having a border with rounded corners with a white gladiola (a type of flower) in the middle, for "Tiles included in Class 19". The opponents filed evidence listing at least 18 "SEM"-prefixed trade marks filed predominantly in Classes 19 and 27. The opponents' evidence comprised of:

- (i) a statement that "[m]ost of these marks are still in use by the Company at the present time, and those that are not in use have been used and/or are intended to be used in the future";
- (ii) trade declarations by two architects who claimed to expect any flooring products prefixed by "SEM" to be manufactured and marketed by the opponents;
- (iii) trade declarations by eight other persons, all of whom answered that they knew of a family of trade marks having the prefix "SEM" in relation to flooring tiles, but only two of them saying specifically which of these "SEM"-prefixed marks they were referring to.

29 The hearing officer held that this evidence was "not as comprehensive as it might have been", given his view that the evidence should have included which of the "SEM"-prefixed trade marks the witnesses had before them when they completed the trade declarations, save for two of them (at 338 of judgment). In addition, the hearing officer considered that there could be two views as to whether the sign "SEMIGRES" could be read as a "sem-" mark or a "semi-" mark, given the presence of the fancy "i" in the sign. However, the applicants did not file any evidence to show what members of the flooring or building trades might think when presented with tiles under this sign. The hearing officer considered the evidence and held that he did not consider "that the applicants have

discharged the onus which is on them" and found in favour of the opponents in this case under Section 11 of the UKTMA 1938.

30 The hearing officer dealt briefly with Section 12 of the UKTMA 1938, given the conclusion as to Section 11 above. The evidence in this regard was considered to be "meagre" as it did not show the effect of comparison between the specific marks in question (see 339 of judgment). In addition, the hearing officer was of the view that the letter "i" caused the prefix to be read as "semi" and not "sem", the former conveying an entirely different idea from the latter, which was an apparently meaningless prefix. The objection under Section 12(1) of the UKTMA 1938 therefore failed.

31 **SEMIGRES** is not immediately applicable to the present case because it was decided on the basis of the repealed UKTMA 1938, which may have been based upon different considerations. I note that in the analysis under Section 11 of the UKTMA 1938, the hearing officer held that the applicants had the onus to show evidence of how members of the trade would perceive the sign, but this was not the case for Section 12, where the hearing officer himself undertook that exercise. With regard to consumer perception, whilst the evidence was sufficient to show deception under Section 11 of the UKTMA 1938, it was not sufficient to show "oral or visual confusion" under Section 12 of the UKTMA 1938. In comparison, there is no such distinction in the application of evidence for the objection under the present day Section 8(2)(b) of the Act, which is based on Section 5 of the UK Trade Marks Act 1994 ("**UKTMA 1994**").

32 In view of the above, I prefer the position set out in recent cases in the UK and Europe, as summarized in **Kerly's Law of Trade Marks and Trade Names (15<sup>th</sup> edition, 2011)**:

Use of a family of marks may support the contention that a mark or particular element of a mark is distinctive. **But evidence of entries in the register of trade marks will not be of assistance. Such entries do not necessarily reflect the position in the marketplace or affect the way in which marks are perceived and remembered.** (Emphasis added)

33 The view in Kerly's was derived from the case of ***Il Ponte Finanziaria SpA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) [2008] E.T.M.R. 13 ("Il Ponte")***, an opposition under Article 8(1)(b) of Regulation 40/94, which provides that a trade mark is not to be registered "if because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected". In **Il Ponte**, the applicant sought to register the mark "BAINBRIDGE" with a device of a roll of cloth unfurling to take the form of a sail of a sailing boat in Classes 18 (leather and imitations of leather) and 25 (clothing, footwear and headgear). The opponents objected on the basis that they had 11 earlier marks, all including the word "BRIDGE" in common.

34 In analysing whether the appellants' earlier marks could be considered to be a family or series of marks, the Court of Justice of the European Communities ("CJEC") held at [61] to [64] that

- 61 First of all, it should be noted that, under Arts 4 to 6 of Regulation 40/94, **a trade mark may be registered only individually** and the minimum five-year protection afforded by such registration is conferred on it only as an individual trade mark, **even where several trade marks having one or more common and distinctive elements are registered at the same time.**
- 62 While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a "family" or "series" of marks.
- 63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Art.8(1)(b) of Regulation 40/94 (see Alcon v OHIM at [55], and, to that effect, Canon at [29]). **Where there is a "family" or "series" of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.**
- 64 **As the Advocate General stated [in]... her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element.** Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a "family" or "series", **the earlier trade marks which are part of that "family" or "series" must be present on the market.**
- 65 Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks **but only of use of a sufficient number of them as to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.** (Emphasis added)

35 The CJEC did not discuss the appellants' evidence in relation to the submission on the "family" or "series" of trade marks in detail, but found that there was insufficient proof that a sufficient number of these earlier marks had been used.

36 I turn to examine *The Infamous Nut Co Ltd's Trade Marks* [2003] RPC 7 ("Infamous Nut"), decided under Section 5(2)(b) of the UK Trade Marks Act 1994, which is *in pari materia* with our Section 8(2)(b) save for the additional words " which includes the likelihood of association with the earlier trade mark" at the end of the provision, which are not at issue in the present case. In *Infamous Nut*, the applicant sought to register a series of four figurative marks each comprising of a monkey eating a nut in respect of "nuts; tree nuts, ground nuts and peanuts; all being shelled and/or roasted and/or otherwise processed" in Class 29 and in respect of "nuts; tree nuts, ground nuts and peanuts; all being fresh and/or unprocessed" in Class 31. The opponents argued that their registered trade marks constituted a "series" or "family" of "monkey holding a nut" marks. They had eight registered trade marks, as follows:

Trade Mark	Number	Date	Goods
MONKIES & DEVICE	966175	10.10.70	Roasted peanuts (unshelled) in Class 29
Percy Dalton's Monkies FRESH ROASTED PEANUTS IN SHELL & DEVICE	1174259	30.4.82	Peanuts included in Class 29
Percy Dalton's Monkies RAW PEANUTS IN SHELL & DEVICE	1174260	30.4.82	Fresh peanuts in Class 31
MONKIES	1372081	30.1.89	Roasted peanuts included in Class 29
MONKIES	1372082	30.1.89	Fresh peanuts included in Class 31
ORIGINAL Monkies NATURAL FOOD & DEVICE	1488170	17.1.92	Roast peanuts; all included in Class 29
ORIGINAL Monkies NATURAL FOOD & DEVICE	1488171	17.1.92	Fresh peanuts; all included in Class 31
Percy Dalton's Monkies ROASTED PEANUTS IN SHELL & DEVICE	2033421	13.9.95	Roasted peanuts in Class 29

37 The evidence showed that the opponents' products "[had] a turnover [of] around £500,000 per annum, which [had] remained substantially constant over the last six years" (at [7]), although the court noted that it was "unclear from the evidence what products make up that annual turnover and to which of the opponent's earlier trade marks such turnover can be attributed" (at [7]). The court concluded at [37] that

**In some circumstances, it may be possible for the opponent to argue that an element in the earlier trade mark has achieved enhanced distinctiveness in the eyes of the public because it is common to a “family of marks” in the proprietorship and use of the opponent...However, that has not been shown by the evidence to exist**

in the present opposition...**and cannot...be presumed from the state of the register...**  
(Emphasis added)

38 What comes across in the cases of *Il Ponte* and *Infamous Nut* is that, *prima facie*, registration of a number of marks each bearing the same element in common, does not automatically give rise to the presumption that the consumer would perceive them as being a family or series of marks, such that the registered proprietor of the marks is entitled to have protection of that common element. As stated by the CJEC in *Il Ponte*, the registered proprietor who claims additional protection of that common element will have to adduce sufficient evidence to show use of a sufficient number of these marks as to be capable of constituting a family or series of trade marks, for the purposes of the assessment of the likelihood of confusion.

39 The relevant audience to consider when deciding whether a family or series of marks is in existence in the marketplace is the consumer or the public (see *Il Ponte* (at [63] and [64], paragraph 34 above) and *Infamous Nut* (at [37], see paragraph 37 above)). This follows from the principle that at the end of the day, the query goes towards establishing whether there is a likelihood of confusion as a result of the applicant's use of a common element in the registered proprietor's trade marks. In this regard, the Singapore Court of Appeal in *McDonalds CA* affirmed at [34] that

[o]n [the issue of whether the conceptual link between the common use of "Mac" and "Mc" is indicative of a common identity], we think it ultimately boils down to determining whether the trial judge was correct when she said...that the existence of a "series" of marks and the degree of recognition evoked therefrom is "but one factor, which along with others, the court would have to take into account in the overall assessment of the likelihood of confusion or deception for the *average consumer* of the goods and services in question". In our opinion, this proposition is obviously correct in light of the approach enunciated by this court in [*Kellogg Co v Pacific Food Products Sdn Bhd* [1998] 3 SLR(R) 904]. Whether confusion could arise must be looked at against the entire factual situation. Thus, we agree with the judge that the fact that the prefix is common cannot be decisive. (Emphasis added)

### *The Present Case*

40 Essentially, the Opponents' evidence shows that whilst distributors and certain businesses and companies may be familiar with the Opponents' use of "212" in relation to goods (in particular perfumes) in Class 3, consumers in Singapore may not be. As such, the Opponents should not be granted a monopoly over "212" for the relevant goods in Class 3.

41 The Opponents' evidence is essentially limited to items (ii)-(vi) of paragraph 22. As for (i), the Opponents website contains only advertisements, without further evidence that

consumers in Singapore recognize "212" as a family or series mark. As for items (vii) to (x), these items are either undated or are beyond the application date of the Application Mark on 2 December 2010 and are therefore irrelevant to the present query.

42 Item (ii) shows that there are several "212" signs used by third party websites to describe the Opponents' products for sale. An extract from the TANGS e-store shows the Opponents' products bearing the signs "212 NYC" and "212 SEXY MEN" with payment details and instructions for sale in Singapore. Another extract from <http://sg.bestbuy-world.com> shows a series of four types of perfume with the signs "212 GLAM MEN", "212 MEN NYC", "212 VIP" and "212 VIP MEN" respectively. Another website, <http://list.qoo10.sg>, shows a series of about six types of perfume, similar to the previously mentioned types and including a few more signs such as "212 NYC", "212 MEN POP!", "Carolina Herrera 212 After Shave Splash", "Carolina Herrera 212 Sexy", "Carolina Herrera 212 VIP", "Carolina Herrera 212 Pop!". These items, at best, show that the business or company managing the website for TANGS in Singapore identifies that the Opponents have a series of perfumes that have the common element "212" in them. These websites do not automatically demonstrate that consumers in Singapore are aware of the same. As pointed out in *Novelty Pte Ltd v Amanresorts Ltd and another [2009] SGCA 13 ("Aman")* at [54], in the context of determining whether there was goodwill in the respondent's "Aman" names

...the evidence of the existence *per se* of domain names and websites featuring the name in which goodwill is said to exist will ordinarily be insufficient as proof of exposure of that name; something in addition to proof of the mere existence of such domain names and websites must be shown in order to establish that there has not been sufficient exposure of the name in question. This approach is not dissimilar to that adopted by Buxton LJ in 800-FLOWERS Trade Mark [2002] FSR 12...In the appellate court's decision in 800 FLOWERS, Buxton LJ commented, in the context of use of a trade mark, that (at [138]):

[t]he very idea of "use" within a certain area would seem to require some active step in that area on the part of the [trade mark owner] that goes beyond providing facilities that enable others to bring the mark into the area.

Such "active step[s]" (ibid), the learned judge suggested, could take the form of "direct encouragement or advertisement by the [trade mark] owner (ibid) which led consumers to the website featuring the trade mark in question..."

43 In the present situation, the Opponents have not adduced any evidence of such "active steps" taken by them to bring the 212 Marks or any other "212" signs in relation to the relevant goods in Class 3 to Singaporean consumers' attention.

44 I now turn to item (iv), which features 6 pages of magazine extracts (see the Opponents' Notice of Opposition at Annex C) showing further use of other "212" signs, such as "212 ICE", "212 ON ICE" used on the Opponents' products, being advertised in Singapore. Firstly, the extracts are found only over two months, November and December 2010. In November 2010, there are two full pages, each displaying the Opponents' product "212 VIP". In December 2010 (and it is not certain whether these

magazine extracts are before or after the application date of the Application Mark on 2 December 2010), there is one reference to "212 VIP" and another reference to "212 ICE". There is no reference to the 212 Marks or other "212" signs in these extracts.

45 The Opponents have enjoyed stable sales of their goods bearing the 212 Marks (see paragraph 22(v) above) of more than S\$1 million over the three years leading up to the date the Application Mark was registered. However, the "buyer" in all these sales receipts is Luxasia Pte Ltd, the Opponents' distributor in Singapore (see [10] of the Opponents' 1<sup>st</sup> SD). There is no further evidence that shows consumers in Singapore coming into contact with the Opponents' 212 Marks or "212" signs by virtue of the sale of the Opponents' goods. Although the Opponents have stated in the Opponents' 1<sup>st</sup> SD that goods bearing their "212 Marks are being sold in various departmental stores in Singapore, namely, C.K. Tang Limited, Isetan Scotts, Isetan Tampines Mall, Metro Paragon, Metro Sengkang, Robinsons Centrepoint, Robinsons Raffles City and Takashimaya Singapore Ltd," through their distributor, no further documentary proof has been provided in the Opponents' evidence as to this statement, save for some undated pictures of outdoor campaigns and advertisements (see items (vii) to (ix) of paragraph 22 above).

46 Based on the foregoing, I find that there is insufficient evidence to show that the consumers in Singapore identify the Opponents' 212 Marks or their "212" signs as a family or series of marks.

#### *Similarity of Marks*

47 However, even if I am wrong as to the above, I find that there is no visual, aural or conceptual similarity between "212" and L. 12.12.

48 In relation to marks similarity, the Court of Appeal in *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 ("Sarika") at [16] (affirmed by the Court of Appeal in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] SGCA 26 ("Hai Tong")) at [39] held that the decided cases have established that the court will consider three aspects of similarity, viz, visual, aural and conceptual similarity, although it is not a pre-requisite that all three aspects of similarity must be made out before there can be a finding of similarity between the sign and the mark. Recently, the Court of Appeal in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another and another appeal* [2013] SGCA 65 ("Staywell") affirmed this position at [18]. In addition to these established principles, the Court of Appeal held that the threshold for marks similarity is not a particularly or notably low one: *Staywell* at [16]. The Court of Appeal further reiterated that the assessment of marks similarity is mark-for-mark without consideration of any external matter, affirming dicta in *Sarika* at [17] and *Hai Tong* at [40(b)]: *Staywell* at [20].

49 The Opponents submitted that the sequence of the numbers 2-1-2 is similar to the Application Mark and therefore, there is obvious visual similarity between them. The

Applicants, on the other hand, submit that the Application Mark is not a simple word mark but rather, it is made up of five distinct components, i.e.

<b>L</b>	.	<b>12</b>	.	<b>12</b>
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50 The Applicants submit that the dots between the letter "L" and the numbers "12" and "12" are clearly visible and the numerals should be viewed as "12" (twelve) and not "212" (two, one and two).

51 Visually, I find that the two marks are not at all similar. Taking into account the overall structure and design of the Application Mark, I find that the position of the dots in the Application Mark have the visual effect that it is made up of the distinct components "L", "12" (twelve) and "12" (twelve). As such, visually, the Application Mark is likely to be perceived as having two units of twelve, i.e. 12-12 instead of four separate units of one and two, i.e. 1-2-1-2.

52 Where aural similarity is concerned, the court in *Ozone Community Corp v Advance Magazine Publishers Inc* [2010] 2 SLR 459 ("Ozone") at p 491-2 affirmed the statement in *Bently & Sherman* (3<sup>rd</sup> ed, 2009) that when comparing marks aurally, tribunals tend to carry out a quantitative assessment as to whether the two signs have more syllables in common than not. This was affirmed by the Court of Appeal in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] SGCA 26 ("Hai Tong") at [68].

53 In the present case, "212" is likely to be pronounced as "two-one-two" (3 syllables) compared with the Application Mark which is likely to be pronounced as "elle-twelve-twelve" (3 syllables) or "elle-dot-twelve-dot-twelve" (5 syllables), due to the placement of the dots. None of the three syllables in the earlier sign and the Application Mark are similar. As such, I find that there is no aural similarity between them.

54 As for conceptual similarity, the Applicants explained that the concept behind the Application Mark was basically a description of how the Applicants' polo t-shirt had come about (see paragraph 12 above). "212", on the other hand, was the Manhattan, New York area code where the Opponents had its headquarters (see paragraph 18 above). The Applicants submitted that these concepts are different and that the marks are therefore conceptually different. The Opponents, on the other hand, argued in oral submissions at the hearing that consumers do not look at "the back end", i.e. at how the marks are derived.

55 The Court of Appeal in *Sarika* at [34] (citations omitted) provided the following guidance on conceptual similarity, that has been reaffirmed by *Hai Tong* (at [70]) and applied in *Staywell* (at [34] –[37]):

...conceptual similarity involves the consideration of the "ideas that lie behind or inform the earlier mark"...However, we have difficulties with his [the High Court judge's] finding that there is conceptual similarity between the "Nutello" sign and the "Nutella" mark. His reliance on the authority of *Festina* to arrive at his conclusion may not be

totally appropriate. In *Festina*, the "Festina" and "J.Estina" marks comprised invented words and had a pictorial element of a crest and crown respectively. The judge found conceptual similarity between the marks because the respective crest and crown devices indicated a sense of "class" and "status"...In the present case, however, although the words "Nutello" and "Nutella" are invented and meaningless like those words in *Festina*, the "Nutello" sign and "Nutella" mark here do not each have a device element which evoke similar ideas. Instead, we think the case of *Hyundai Mobis (IPOS)*...is of greater relevance to the present. There, the marks in question were word marks and comprised invented words, similar to the situation in the present case. The words "Mobil" and "Mobis" were invented. **The PAR observed that while the applicants argued that "Mobis" was derived from the words "mobile" and "system", it was not obvious when one sees the word "Mobis" that it meant so. He therefore concluded that no finding of conceptual similarity could be made because both the "Mobil" and "Mobis" marks were meaningless.** Similarly, following this reasoning, since the words "Nutello" and "Nutella" are invented and meaningless with no particular idea underlying each of them (and nothing has been shown in that regard) it is difficult to say they are conceptually similar...**The Judge did not indicate what the concept [of Nutella and Nutello were]...They are just meaningless words and do not evoke any ideas.** With respect, on this issue, we hold that the Judge is in error.

(Emphasis added)

56 From the dicta above, it can be understood that the conceptual analysis of two competing signs is an analysis of the concepts that can be derived from the elements present in the sign at surface value. It does not matter, for example, that "Mobis" was derived from "mobile" and "system" – taken at surface value, "Mobis" is simply an invented word.

57 Similarly, the concept behind the Application Mark is not readily apparent and present within the sign itself. Neither does "212" present any readily apparent concept that can be derived from the sign itself. Both marks do not convey, in and of themselves, any particular concept as they are meaningless combinations of numbers or letters and numbers that do not evoke any particular ideas. As such, I find that there is no conceptual similarity between the Application Mark and "212".

58 I will now proceed to analyse whether each of the 212 Marks is similar to the Application Mark. In this analysis, I will consider afresh whether the Opponents' contention that the element "212" is the distinctive element in each of the 212 Marks can stand.

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

#### ***Similarity of Marks between the Opponents' 212 Marks and the Application Mark***

59 The Court of Appeal in *Staywell* made a distinction between "technical distinctiveness" and "distinctiveness in the ordinary sense". Based on the Opponents' submissions (see paragraphs 16 and 18 above), the type of distinctiveness at issue here is

"distinctiveness in the ordinary sense" which is described in *Staywell* at [22] and [29] as follows:

- 22 The distinctive (in the non-technical sense) and memorable components of the mark are those that tend to stand out in the consumer's imperfect recollection. That is why the court is entitled to have special regard to the distinctive or dominant components of a mark, even while it assesses the similarity of the two marks as competing wholes.

....

- 29 The finding of distinctiveness of the separate components of the mark must ultimately be related back to the impression given by the mark as a whole. The distinctiveness of a particular component of a mark is but one factor feeding into the ultimate question of whether the mark, in the form it is registered and/or used, has the strength as an indicator of origin to the exclusion of other trade sources. This latter question must be considered by looking at the mark as a whole, because it is the entire mark, and not only a component of it, that must function as the badge of origin.

60 The preliminary issue for the marks similarity query is therefore, whether "212" is "distinctive in the ordinary sense" in relation to each of the Opponents' 212 Marks. I will consider this separately in relation to each of the 212 Marks.

## **212 ON ICE and L. 12.12**

61 Visually, the Opponents' earlier mark and the Application Mark are not at all similar. I am unable to accept the Opponents' argument that the numerals "212" are distinctive in the ordinary sense in relation to the earlier mark. The numerals are of the same size, font and spatial position in relation to the words "ON ICE" and do not stand out in any way. In relation to the Application Mark, the analysis at paragraph 51 above is repeated.

62 In relation to aural similarity, the dicta in *Ozone* and *Hai Tong* as extracted at paragraph 52 above are repeated. Here, the marks are not aurally similar. The earlier mark is likely to be pronounced as "two-one-two-on-ice" (5 syllables) compared with the Application Mark which is likely to be pronounced as "elle-twelve-twelve" (3 syllables) or "elle-dot-twelve-dot-twelve" (5 syllables), due to the placement of the dots. Even if both signs are aurally pronounced with 5 syllables, each of these syllables is different.

63 As for conceptual similarity, paragraphs 54 to 56 above are repeated. Here, the words "ON ICE" in the Opponents' earlier mark evokes the concept of something cooling or cold in temperature, although when combined with the numerals "212", "212 ON ICE" read as a whole is an abstract combination without any particular meaning. Following the case of *Sarika* (at [34]), since both the marks are equally meaningless, there is no conceptual similarity to speak of. Even if the Opponents' earlier mark delivers the

concept of something cooling or cold in temperature, this is conceptually different from the Application Mark's abstract and meaningless combination of the letter and numbers.

## **212 VIP** and L . 12 . 12

64 With regard to visual similarity of the marks, I am unable to accept the Opponents' argument that the numerals "212" are distinctive in the ordinary sense in relation to the earlier mark. The numerals are of the same size, font and spatial position in relation to the words "VIP". I adopt the analysis at paragraph 51 above in relation to the Application Mark. As such, I find that there is no visual similarity between the Opponents' earlier mark and the Application Mark.

65 In relation to aural similarity, the earlier mark is likely to be pronounced as "two-one-two-vee-eye-peee" (6 syllables) whilst the Application Mark is likely to be pronounced as "elle-twelve-twelve" (3 syllables) or "elle-dot-twelve-dot-twelve" (5 syllables), due to the placement of the dots. I find that the marks are aurally dissimilar as they both have a different number of syllables and each of these syllables is also pronounced differently.

66 Conceptually, the earlier mark contains the words "VIP", which in common and ordinary English usage, is an acronym for "Very Important Person". This evokes the concept of exclusivity and prestige. However, the combination of "212" and "VIP" is an abstract combination without any particular meaning. Following the case of *Sarika* (at [34]), since both the marks are equally meaningless, there is no conceptual similarity to speak of. Even if the Opponents' earlier mark delivers the concept of exclusivity and prestige, this is conceptually different from the Application Mark's abstract and meaningless combination of the letter and numbers.

## **212 SEXY** and L . 12 . 12

67 With regard to visual similarity of the marks, I am unable to accept the Opponents' argument that the numerals "212" are distinctive in the ordinary sense in relation to the earlier mark. The numerals are of the same size, font and spatial position in relation to the words "SEXY". I adopt the analysis at paragraph 51 above in relation to the Application Mark. As such, I find that there is no visual similarity between the Opponents' earlier mark and the Application Mark.

68 Aurally, the two marks are not similar, as they have a different number of syllables which are all pronounced differently. The earlier mark is likely to be pronounced as "two-one-two-sexy" (4 syllables) whilst the Application Mark is likely to be pronounced as "elle-twelve-twelve" (3 syllables) or "elle-dot-twelve-dot-twelve" (5 syllables), due to the placement of the dots.

69 Conceptually, the earlier mark contains the word "SEXY", which evokes the concept of sexual allure. However, the combination of "212" and "SEXY" is an abstract

combination without any particular meaning. Following the case of *Sarika* at [34], since both the marks are equally meaningless, there is no conceptual similarity to speak of. Even if the Opponents' earlier mark delivers the concept of sexual allure, this is conceptually different from the Application Mark's abstract and meaningless combination of the letter and numbers.

### **212 by Carolina Herrera and L . 12 . 12**

70 With regard to visual similarity of the marks, I am unable to accept the Opponents' argument that the numerals "212" are distinctive in the ordinary sense in relation to the earlier mark. An ordinary Singaporean consumer viewing the earlier mark would think that "212" is something attributed to a person by the name of "Carolina Herrera", but there is no reason why "212" would be more distinctive as compared to "Carolina Herrera". I adopt the analysis at paragraph 51 above in relation to the Application Mark. As such, I find that there is no visual similarity between the Opponents' earlier mark and the Application Mark.

71 Aurally, the two marks are not similar. The earlier mark is likely to be pronounced as "two-one-two-bye-ca-ro-li-na-her-rare-ra" (11 syllables) whilst the Application Mark is likely to be pronounced as "elle-twelve-twelve" (3 syllables) or "elle-dot-twelve-dot-twelve" (5 syllables), due to the placement of the dots. The marks both have a different number of syllables and each of these syllables is also pronounced differently.

72 Conceptually, the prefix "by", followed with the name "Carolina Herrera", suggests that "212" is something that has been created by a person by the name of Carolina Herrera. However, the numerals "212" do not suggest the nature of such creation and the concept of the earlier mark remains somewhat vague, although perhaps not completely meaningless. The Application Mark, on the other hand, does not evoke any particular concept. I find that there is no conceptual similarity between the marks.

73 Based on the foregoing I find that the 212 Marks are not similar to the Application Mark. In view of this conclusion, I do not need to examine whether the Opponents' goods and/or services are similar to those of the Applicants' goods and/or services or whether there will be a likelihood of confusion between the Opponents' Earlier Marks and the Application Mark.

74 The ground of opposition under Section 8(2)(b) of the Act therefore fails.

### **Ground of Opposition under Section 8(4)(b)(ii)**

75 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.

#### **Decision on Section 8(4)(b)**

76 Under Section 8(4)(b) of the Act I have to consider whether the whole or an essential part of the Application Mark is identical with or similar to the 212 Marks or any "earlier trade mark", which is defined in Section 2 of the Act as follows

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

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

77 In relation to part (a), ie. the 212 Marks, I have already found that these are not similar to the Application Mark at paragraphs 59 to 73 above.

78 In relation to part (b) of this definition, the Opponents have not specifically addressed the issue of whether any trade marks other than the 212 Marks fall within the definition of "earlier trade marks" under Section 2 of the Act. In their Notice of Opposition, however, the Opponents rely on "the registered and common law rights and goodwill in the trade marks comprising of or incorporating the elements "212" in respect of the goods in Classes 3, 9, 14, 18 and/or 25" (see [3] of the Opponents' Notice of Opposition, hereinafter "**Opponents' Other Signs/Marks**"). The Opponents then appear to make several references to the Opponents' Other Signs/Marks in the Opponents' 1<sup>st</sup> SD and their written submissions, although it is not clear which of these marks are being referred to in these documents.

79 In any event, even if I find that the **Opponents' Other Signs/Marks** are "earlier trade marks" within the definition of Section 2 of the Act, the next issue that would follow is, whether the whole or an essential part of the Application Mark is identical with or similar to the Opponents' Other Signs/Marks. As the Opponents themselves have submitted, the common element in Opponents' Other Signs/Marks is "212". The basis of the Opponents' submission on marks similarity is that "212" is similar to the Application Mark (see the Opponents' written submissions at [14] – [19]). I find, therefore, that the "essential part" of the Opponents' Other Signs/Marks for the purposes of Section 8(4)(b), is "212".

80 In view of my conclusion at paragraph 47 above (and the ensuing analysis at paragraphs 48 to 57 above), ie. that "212", is not similar to the Application Mark, I find that it is not necessary to analyse the issue of whether the Opponents' Other Signs/Marks is an "earlier trade mark" for the purposes of Section 2 of the Act. Even if the Opponents succeed in claiming that the Opponents' Other Signs/Marks are "earlier trade marks", they would fail to establish any similarity between the Application Mark and the essential part of the Opponents' Other Signs/Marks.

81 In view of my conclusions in paragraphs 77 and 80 above there is no need for me to go through the other requirements of Section 8(4)(b) of the Act. As such, the ground of opposition under Section 8(4)(b) of the Act fails.

## **Conclusion**

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

Dated this 25th day of March 2014.

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