

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

Trade Mark Application No. T1015606G
26 February 2014

IN THE MATTER OF A TRADE MARK APPLICATION BY

TAO, HSIU-CHIH

AND

OPPOSITION THERETO BY

PIRELLI & C. S.P.A.

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

Ravindran Associates for the Applicant
Donaldson & Burkinshaw for the Opponents

Cur Adv Vult

GROUND OF DECISION

1 This opposition matter was decided solely on the basis of the parties' written submissions, without an oral hearing. The matter was originally fixed for hearing on 26 February 2014. However, on 20 February 2014, counsel for the Opponents wrote to the Registry stating that their clients had instructed them not to attend the hearing but that they maintained their interest through their written submissions and were content for the hearing to proceed. On 25 February 2014, counsel for the Applicant wrote to the Registry stating that the Applicant had similarly instructed them not to attend the hearing.

In view of the situation, the Registrar gave his decision without proceeding with an oral hearing, under Rule 37(4) of the Trade Marks Rules (2008 Rev Ed).

2 The applicant, Tao Hsiu-Chih (the "**Applicant**") is a Taiwanese individual who applied, on 25 November 2010, to protect the following sign in respect of goods in Classes 20 and 24:



Class 20

Bamboo curtains; Indoor blinds of reed, rattan or bamboo (sudare); Curtain hooks; Figures made of rattan; Rattan [unworked or partly worked material]; Curtain Rails; Bead curtains for decoration; Curtain rods; Indoor window blinds (shades) [furniture]; Curtain rollers; Slatted indoor blinds.

Class 24

Woven fabrics and knitted fabrics; Non-woven textile fabrics; Curtains of textile or plastic; Shower curtains; Curtains; Net curtains; Curtain loops of textile material; Furnishing and upholstery fabrics.

(the "**Application Mark**")

3 The Application Mark was accepted and published on 29 April 2011 for opposition purposes. Pirelli & C. S.P.A. (the "**Opponents**"), filed their Notice of Opposition to oppose the registration of the Application Mark on 28 June 2011. The Applicant filed her Counter-Statement on 9 September 2011.

Grounds of Opposition

4 The Opponents rely on Sections 8(2), 8(7)(a) and 7(6) of the Trade Marks Act (Cap 332, 2005 Rev Ed) ("**the Act**") in this opposition. The Opponents had initially relied on Section 8(4)(a), 8(4)(b)(i) and 8(4)(b)(ii) of the Act but later dropped these grounds of opposition, by way of an amendment to their Notice of Opposition on 3 October 2013. The Applicant did not object to this amendment.

5 The Applicant highlighted in her written submissions dated 27 January 2014 ("**Applicant's written submissions**") that the Opponents have not specified which limb of Section 8(2) of the Act they are relying on. In their Response to the Registrar dated 28 October 2013 the Opponents maintained that they were proceeding under "all the grounds indicated in the Opponents' Notice of Opposition except "well-known" mark grounds". However, in the Opponents' written submissions dated 27 January 2014 ("**Opponents'**

written submissions") the Opponents only made submissions on Section 8(2)(b) of the Act. As such, I will only consider the Opponents' reliance on Section 8(2)(b) of the Act, as they have not made any submissions in relation to Section 8(2)(a) of the Act.

Opponents' Evidence

6 The Opponents' evidence consists of one statutory declaration by Pier Giovanni Giannesi filed on 9 July 2012 ("**Opponents' SD**").

Applicant's Evidence

7 The Applicant, in turn, filed a statutory declaration in her own name dated 25 March 2013 ("**Applicant's SD**").


Applicable Law and Burden of Proof

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

Background


9 The Applicant is the proprietor of a Taiwanese-incorporated company, CSL Sunmaster Enterprises Co., Ltd ("**Sunmaster**"), a designer and supplier of curtains, blinds, sunshades and parts thereof. An extract from Sunmaster's website in the Applicant's SD states that their main products include a "system of roller blinds, wooden venetian, pleated blinds, Roman blinds, vertical blinds, chip curtain, outdoor shading systems and special hard ware accessories system" which are available for a variety of uses: "commercial/household, indoor/outdoor, manual/electric/intelligent control" and other solutions tailored to suit a customer's needs. The Applicant claims she created the Application Mark independently, as it was derived from her English name, "**T**ao, **S**heena." The Application Mark was created without any knowledge or reference to the Opponents' Marks (found at paragraph 11 below).




10 The Applicant has obtained registration for  in Classes 20 and 24 in the European Union and Australia. The European and Australian registrations were obtained after the Applicant successfully resisted opposition from the Opponents in these jurisdictions. The same mark has been filed in the same classes ie. Class 20 and 24 in Taiwan, Japan, Korea and Israel.



11 The Opponents were founded in 1872, starting a business which was initially a factory producing rubber articles. Over the years they diversified their production into insulated wire for telegraphy, submarine telegraph cables, and eventually, the first bicycle

tyre. Today, they have 19 tyre industrial plants, in four continents, operating through a widespread sales network in over 160 countries around the world. They are the fifth largest operator in the world in the premium tyre sector, and have been exclusive supplier for Formula 1 for three years, between 2011 and 2013. The Opponents seek to rely on the following trade marks in support of the present opposition:

	Mark	Registration Number	Class No.	Specification of Goods/Services
(a)		T8003330D	07	Belts conveyors all included in Class 7.
		T9612767B	07	Driving belts, pulleys and driving motors, not for land vehicles; all included in Class 7.
		T0602485B	09	Glasses, sun-glasses, baseball batting helmets, bicycle helmets, catchers' helmets, helmets for motorcyclists, protective helmets, protective helmets for sports, safety helmets, life-saving rafts.
		T8003331B	09	Cables included in Class 9.
		T8003332J	12	Pneumatic tyres and driving belts for motor vehicles included in Class 12.
		T9612768J	12	Driving belts and driving motors, for land vehicles; all included in Class 12.
		T0602486J	12	Boats, namely inflatable boats, rubber dinghies, sail boats, motor boats; kayaks, canoes.
		T9715253J	18	Athletic bags; sport bags; bags; handbags; knapsacks, suitcases, trunks for travelling, travelling bags, purses, billfolds, attache cases, wallets, briefcases, leather shoulder belts, key-cases, passport cases; business and credit card cases; umbrellas; all included in Class 18.
		T9715255G	28	Bags adapted to carry sports implements; gymnastic and sporting articles; all included in Class 28.
		T0816901G	09	Data processing equipment; computers, computer peripherals; computer hardware; computer software; computer games; electronic games; gaming apparatus for use with television receivers and/or monitors; computer games software; computer games cartridges; interactive educational games for use with television receivers and/or monitors; electronic handheld devices for the wireless receipt, storage and/or transmission of data and messages; digital music players; MP3 players; personal digital assistants, electronic organizers, electronic notepads; telecommunications apparatus; telephones; mobile telephones; apparatus, instruments, software and

			<p>media for recording, reproducing, carrying, organising, storing, processing, editing, extracting, encoding, decoding, encrypting, playing, manipulating, downloading, uploading, streaming, transmitting, broadcasting, receiving, retrieving and reproducing music, sound, images, text, signals, software, information, data and/or code; music, sounds, ringtones, images, games, text, signals, software, information, data and code provided by telecommunications networks, by online delivery and/or by way of the Internet and the world wide Web; computer software to enable peer-to-peer networking and file sharing; database management software, character recognition software, telephony management software, electronic mail and messaging software, paging software, mobile telephone software; data synchronization programs and application development tool programs for personal and handheld computers; search engine software; computer software for conducting and coordinating real-time and asynchronous communications among computer users sharing information and audio/video data via electronic communications networks; electronic publications (downloadable); screensavers; electronic card; digital photographic images; sound and/or video recordings; downloadable digital sound and/or video recordings; computer software facilitating the licensing and/or exploitation of intellectual property; computer software for payment of licence fees; computer software to allow users to perform electronic business transactions via the Internet; computer software for supply chain management; data carriers; magnetic and/or optical data carriers, recording discs; CDs, CD-ROMs, SACDs (super audio CDs); DVDs, DVD-ROMs; DVD-audio; DVD-video; UMDs (universal media discs); memory cards, random access memory, read only memory; solid state memory apparatus; batteries; rechargeable batteries; chargers; chargers for electric batteries; headphones; stereo headphones; in-ear headphones; loudspeakers; amplifiers;</p>
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				printers; cameras; video cameras; bags and cases adapted or shaped to contain any of the aforementioned goods; parts and fittings for all the aforementioned goods.
			28	Toys, games puzzles and playthings; gymnastic and sporting articles not included in other classes; electronic games, handheld electronic games; gaming apparatus (other than adapted for use with television receivers); bags and cases adapted or shaped to contain any of the aforementioned goods; parts and fittings for all the aforementioned goods; play and modelling components (including in the form of kits, construction kits or sets containing the aforesaid components) for building models of land, water and air vehicles, space vehicles, space stations and other large industrial equipment, and figures; toy cars and toy land, water and air vehicles, toy space vehicles, toy space stations.
		T9715254I	25	Overalls, tracksuits, sweat-suits, jackets, sport jackets, wind-resistant jackets, rainproof jackets, raincoats, short overcoats, anoraks, trousers, jeans, skirts, shirts, t-shirts, polo-shirts, sweatshirts, blouses, jerseys, sweaters, blazers, cardigans, underwear, stockings, socks, bathrobes, bathing suits, sun suits, foulards, caps, hats, gloves, belts, shoes, boots, slippers; all included in class 25.
		T9209390J	27	Floor covering.
(b)	 (the "Elongated P" or "Elongated P Mark", as appropriate)	T0306027J	09	Glasses, video games, cables, electric conductors, their parts and fittings; electric joints, their parts and fittings; cables and conductors for telecommunication, their parts and fittings; optical fibres; optical fibre cables, their parts and fittings; telecommunication systems and lines, their parts and fittings; optical telecommunication systems and lines, their parts and fittings; wave length multiplexing optical telecommunication systems and lines, their parts and fittings; transmission systems and lines for video, voice and data, their parts and fittings; interactive services distribution systems and lines, their parts and fittings; optical-electronic systems, their parts and fittings;

				passive optical lines systems, their parts and fittings; optical apparatus and instruments, their parts and fittings; devices for generating, commuting, combining, amplifying, regenerating, transmitting and receiving optical signals, their parts and fittings; cable television devices, their parts and fittings; planar optical device, their parts and fittings; lasers, their parts and fittings; optical amplifiers, their parts and fittings; optical modulators, their parts and fittings.
(c)		T0602056C	09	Glasses, sun-glasses, baseball batting helmets, bicycle helmets, catchers' helmets, helmets for motorcyclists, protective helmets, protective helmets for sports, safety helmets, life saving rafts.
		T0602057A	12	Boats, namely inflatable boats, rubber dinghies, sail boats, motor boats; kayaks, canoe.
		T0301940H	14	Silverware, timepieces, jewellery.
		T0301941F	18	Luggage, leather goods.
		T0301942D	25	Clothing, footwear and headgear.
		T0803147C	33	Wines and alcoholic beverages except beer.
(d)		T0626099H	25	Clothing articles for men, women and children; namely, shirts, blouses, skirts, coats, trousers, pants, vests, jerseys, pajamas, socks and stockings, singlets, corsets, garters, underpants, petticoats, hats, headscarves, neckties, raincoats, overcoats, greatcoats, bathing suits, sports overalls, wind-resistant jackets, ski pants, belts, fur coats, scarves, gloves, dressing gowns, footwear; namely, shoes, sports shoes, slippers and boots.

(collectively, the "Opponents' Marks")

12 The Opponents' Marks are predominantly used on the Opponents' range of tyre products for use on vehicles including cars, SUVs and vans. The Opponents' net sales and marketing figures in Singapore are as follows (as summarized from the Opponents' SD):

	Net Sales in Singapore (S\$)	Marketing figures for products in Singapore (labelled in the Opponents' SD as "Net Sales in Singapore") (to nearest S\$ dollar)
2007	11,654,576	507,685
2008	10,885,123	461,445
2009	5,722,555	335,311
2010	5,165,043	487,522

2011	7,168,867	370,044
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13 Some of the Opponents' Marks feature (what Opponents refer to as) an "elongated P", which was independently conceived by the Opponents fortuitously during a sketch at a business meeting in 1908 and later developed into its present-day form (as seen at paragraph 11(b) above).

MAIN DECISION

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

14 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.

Opponents' Submissions

15 With regard to Section 8(2)(b) of the Act, the Opponents essentially submit that the Elongated P is the dominant component of the Opponents' Marks (see paragraphs 2 and 3 of the Opponents' written submissions). On this basis, the Opponents further submit that "the general impression or significant detail of both marks is the [Elongated P] which is found in the Application Mark and all of the [Opponents' Marks]" (see paragraph 7 of the Opponents' written submissions). The Opponents' written submissions do not address each of the Opponents' Marks separately, but addresses them in general (paragraphs 7 to 13 of the Opponents' written submissions).




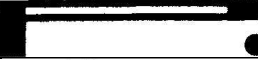

Applicant's Submissions

16 The Applicant submits that the question to ask is whether the common element of the competing marks (ie. the Elongated P) is so dominant as to render the different elements ineffective to obscure the similarity between the competing marks. The Applicant submits that this question should be answered in the negative and referred principally to two prior opposition decisions involving the same parties, in Australia and the European Union respectively. The Applicant highlighted that the hearing officer in the Australian opposition had taken the view that, *inter alia*, "the overall impression of the trade marks is one of dissimilarity rather than resemblance" and that the Elongated P was not the portion of the trade mark "which will so overwhelm a person's mind that they will not remember the word "Project" or "Pirelli" and confuse these two trade marks." The Applicant submitted that the opposition division in the European Union, the Office

for Harmonisation in the Internal Market (Trade Marks and Designs) ("OHIM") reached a similar decision, holding that the marks are visually similar to a very low degree and are not phonetically or conceptually similar.

Decision on Section 8(2)(b)

17 The main issue before the Registrar is whether the following marks are visually, aurally and conceptually similar:

Opponents' Marks	Application Mark
	
	
	
	

18 The test for marks similarity is stated by the Court of Appeal in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2013] SGCA 65 ("*Staywell*") at [26]-[27]:

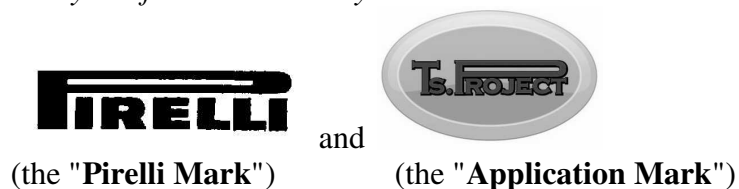
26 When speaking of the assessment of a mark as a whole, it may be noted that the cases have consistently stated that the "visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and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

27 In *Matratzen* the European Court of First Instance dismissed the contention that a consideration of the dominant and distinctive components of a mark would mean a failure to consider the mark as a whole. After stating that the similarity between two marks must be assessed globally, but in light of their distinctive and dominant components, the court said (at [34]):

It should be made clear that that approach does not amount to taking into consideration only one component of a complex trade mark and comparing it with another mark. On the contrary, such a comparison must be made by examining the marks in question, each considered as a whole. However, that does not mean that the overall impression created in the mind of the relevant public by a complex trade mark may not, in certain circumstances, be dominated by one or more of its components.

This was endorsed by the European Court of Justice ("ECJ") on appeal in *Matratzen Concord GmbH v OHIM*, (C-3/03 P) at [31] – [32]. More recently in *32Red Plc v WHG (International) Ltd* [2012] RPC 2012 the English Court of Appeal dismissed the argument that the judge below had erred in deconstructing the competing composite word marks (*viz.*, "32RED" and "32vegas" and finding "32" to be the dominant component (at [85] and [89]). Our courts have taken the same approach in cases involving competing marks with a common denominator, such as in *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2005] 4 SLR(R) 816 ("*Polo (HC)*") at [25] and *Richemont International SA v Goldlion Enterprise (Singapore) Pte Ltd* [2006] 1 SLR(R) 401 at [12] ("*Richemont*"). The question in those cases was whether the common element of the competing marks was so dominant as to render the different elements ineffective to obscure the similarity between the marks.

Analysis of marks similarity



19 I turn to address a preliminary point before I begin my analysis on marks similarity between the Piorelli Mark and the Application Mark. The Piorelli Mark registrations in Trade Mark Nos. T8003330D, T8003332J, T9612768J and T9612767B are subject to the disclaimer, "Registration of this mark shall give no right to the exclusive use of the letter 'P'." Section 30(5) of the Act provides that

(5) If the trade mark is registered subject to any disclaimer or limitation, the rights of the proprietor are restricted by the disclaimer or limitation.

20 The learned authors of *Kerly's Law of Trade Marks and Trade Names* (15th Ed) (Sweet & Maxwell, 2011) explain that: "It follows that an objection based upon an earlier registration cannot succeed where the only resemblance between the marks in issue is an element for which protection has been disclaimed (citing the cases of *Paco Holdings v PacoRabanneParfums* [2000] RPC 451 and *Torremer Trade Mark* [2003] RPC 4)".

21 The Opponents' submission as regards the Opponents' Marks (which includes the Piorelli Mark) is centred on the premise that the Application Mark shares the "P" or "Elongated P" element in common with the Opponents Marks. However, the rights in relation to Trade Mark Nos. T8003330D, T8003332J, T9612768J and T9612767B are expressly subject to the disclaimer that "Registration of this mark shall give no right to the exclusive use of the letter 'P'". As such, the ground of opposition under Section 8(2)(b) of the Act in relation to these trade marks fails at the outset, since the Opponents' contended point of similarity is the very element for which protection has been disclaimed.

22 However, there are several other Pirelli Mark registrations (see paragraph 11(a) above) that were not registered with the disclaimer. I therefore turn to examine the marks similarity between the Pirelli Mark and the Application Mark, and in any event, find that they are not similar.

Visual Similarity

23 The Court of Appeal in *Hai Tong* undertook a comprehensive examination of case law in relation to the issue of when the text or device of a composite mark could be regarded as its "dominant component": see generally, [41] – [67]. In particular, in relation to whether the device component could be a dominant component of a mark, it was held at [62(e)] that

The device component has been found to be an equally significant, if not the dominant, component of a composite mark or sign where:

- (i) the device is significant and large (see, eg, the decision of the *European General Court in New Yorker SHK Jeans GmbH & Co KG v OHIM* (Case T-415/09) (29 September 2011));
- (ii) the accompanying word(s) are devoid of any distinctive character, or are purely descriptive of the device component (see *Quelle AG* at [60]; see also *Sime Darby* at [18] and [20]-[21]) or of similar goods of a superior quality (see the decision of the CFI in *Saiwa SpA v [OHIM]* (Case T-344/03) [2006] ECR AA-1097 at [41] and [45]; or
- (iii) the device component is of a complicated nature (see, eg, *Waseem Ghias t/as Griller v Mohammed Ikram t/as The Griller Original, Esmail Adia t/as Griller King, Shahzad Ahmad t/as Griller Hut, Griller Original Limited, Griller Hut Limited* [2012] EWPC 3).

But not usually where:

- (iv) the device is simple and will not evoke any particular concept for the average consumer (see, eg, the decision of the *European General Court in Kavaklidere-Europe v [OHIM] and Yakult Honsha Kabushiki Kaisha* (Case T-276/09) [2012] ETMR 45);
- (v) the device component does not attract the attention of the average consumer of the goods in question because such a consumer is regularly confronted with similar images in relation to those goods (see *Shaker* (CFI) at [42]); or
- (vi) the device component is likely to be perceived as a decorative element rather than as an element indicating commercial origin (see *Trubion* at [45] and *Oberhauser* at [47], see also *Wassen*).

24 In the case of *Honda Motor Europe Ltd OHIM Case T-363/06* [2009] ETMR 34 ("*Honda*"), also cited by the Court of Appeal in *Hai Tong* at [57], it was noted that the

"S" device component did not appear to be very original or elaborate, being the first letter of the textual component "SEAT":



25 At [31] of *Honda*, the Court of First Instance of the European Communities (Fourth Chamber) held that

In the present case, **it should be noted that the “S” device element of the earlier trade mark is slightly stylised, but does not appear to be original or very elaborate.** It is the first letter of the verbal component “seat”, which, even placed below the “S” device element and printed in smaller characters than that device element, is nevertheless written in large capital letters, is larger than that device element, and is perfectly legible. Moreover, as OHIM rightly contends, and despite the elements referred to by the applicant—such as the reproduction of the “S” device element on the cover of Seat's annual report or on the front of the cars sold by that company—that device element **has no intrinsic semantic content of its own which would lend the earlier trade mark distinctive character, but primarily has the purpose of accentuating the first letter of the word “seat”.** (Emphasis added)

26 Similarly, the Elongated P device in the Pirelli Mark is the first letter of the textual component, "Pirelli". Furthermore, the Elongated P device is integrated into the Pirelli Mark and does not appear to be a separate element within the whole mark that is indicative of a business origin. Taking guidance from *Honda*, I find that the Elongated P does not appear very original or elaborate in that it is likely to be perceived by the average English-speaking Singaporean consumer as a letter "P" that has the primary purpose of accentuating the first letter of the word "Pirelli".

27 Instead, I find that the textual components of the competing marks are the dominant component of the Pirelli Mark and the Application Mark. In *Hai Tong*, the Court of Appeal held at [62(d)] that:

The textual component of a composite mark or sign could (but will not necessarily or always) be the dominant component of the mark or sign. Some instances where this might be the case include where:

- (i) **The two marks or signs in question each contain a similar device. The overall resemblance between them may then be diminished if they bear words which are entirely different from each other** (see *Lee Cooper* at 501). (Emphasis added)

28 The only point of visual similarity in the competing marks is the Elongated P device. However, the overall resemblance between them is diminished by the fact that both marks comprise of words that are completely different from each other. The Pirelli Mark is comprised of the word "Pirelli" whilst the Application Mark is comprised of the word(s) "Ts.Project". Whilst "Ts" does not have any meaning, the word "Project" could be synonymous with a scheme, plan, task or assignment. Based on the extract from the New Oxford Dictionary of English tendered by the Applicant (Exhibit 6), the word "project" refers to "an individual or collaborative enterprise that is carefully planned and designed to achieve a particular aim." The word "Pirelli", on the other hand, is an invented word that does not have any meaning in the English language. Given that the dominance of the textual component of the competing marks, I find that visually, the Pirelli Mark and the Application Mark are not similar.

Aural Similarity

29 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* (3rd 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* at [68]. In the present case, the Pirelli Mark is likely to be pronounced in 3 syllables, viz, "PEE-REH-LEE" whereas the Application Mark is likely to be pronounced as "TEE-ESS-PRO-JECT" (4 syllables) or "TEE-ESS-DOT-PRO-JECT" (5 syllables), due to the presence of the full stop. In any event, the number of syllables in both marks is not similar. Neither of the individual syllables sounds similar as well. I find that the Pirelli Mark and the Application Mark are aurally dissimilar.

Conceptual Similarity

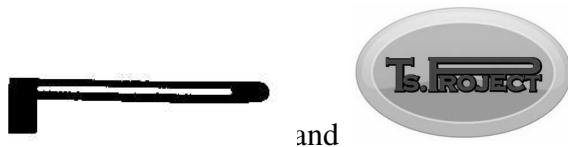
30 I now turn to analyse conceptual similarity of the competing marks. The analysis is limited to an analysis of the concepts that can be derived from the elements present in the signs at surface value: see *Lacoste v Carolina Herrera, Ltd* [2014] SGIPOS 3 at [56], citing dicta in *Sarika* at [34] (which has been reaffirmed in *Hai Tong* at [70] and *Staywell* at [34]-[37]). The word "Pirelli" in the Pirelli Mark appears to be an invented word, which does not convey any particular concept to the consumer. The word(s) "Ts.Project" in the Application Mark gives the impression that "Ts" is separate from "Project" given the full stop between the two words. "Ts Project" in and of itself is a meaningless combination of words. To the average Singaporean consumer, the term "Project" could be synonymous with a scheme, plan, task or assignment. However, the term "Ts" does not have any meaning and does not clarify the scope of the word "Project". In *Sarika*, the Court of Appeal referred to the case of *Hyundai Mobis v Mobil Petroleum Co, Inc* [2007] SGIPOS 12 ("*Mobil*") and held at [34] that

[The Principal Assistant Registrar in *Mobil*] concluded that no finding of conceptual similarity could be made because the "Mobil" and the "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 that they are conceptually similar.

31 Similarly, the words "Pirelli" and "Ts.Project" are, at surface value, meaningless with no particular idea underlying them, and it is difficult to say there is any conceptual similarity between them.

32 In the overall analysis, there is no visual, aural or conceptual similarity between the Pirelli Mark and the Application Mark.



Visual Similarity

33 Much of the Opponents' argument on marks similarity rests upon the similarity of the Elongated P with the letter "P" in the Application Mark, which is elongated such that it spans over the letters "Project" in similar style to the Elongated P. In my view, the marks are visually similar in that they have one component, the Elongated P, in common. However, this is not sufficient to make an overall finding of visual similarity as the Application Mark contains other components that are not of negligible significance.

34 The Court of Appeal in *Hai Tong* at [54] analysed the case of *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] FSR 19 ("*Specsavers*") and referred to paragraph [52] of *Specsavers*, where the English Court of Appeal held that:

- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, **but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements...** (Emphasis added)

35 The Court of Appeal stated in the same paragraph that "[t]his suggests that there is no general legal proposition that any component of a composite mark dominates." Further at [62(b)], the Court of Appeal held, in similar vein, that

When the other components of a complex mark are of negligible significance, it is permissible to make the comparison solely on the basis of any dominant element(s).

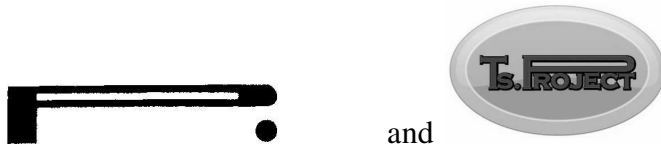
36 On the facts of the present case, there is just one component in the Opponents' Elongated P mark. Although this component is found in the Application Mark, the words "Ts" and "Project" are not of "negligible significance" and are sufficient to distinguish it from the Opponents' Elongated P mark. The Elongated P is positioned in between the words "Ts" and "Project" and comes across visually as a decorative element of the word "Project" rather than a standalone graphic device that indicates a particular business origin. It would be difficult to ignore the words "Ts" and "Project" that visually convey the impression of being two separate words, which are collectively of more significance than the Elongated P.

Aural Similarity

37 Aurally, the Elongated P mark consists of a single letter of the alphabet, pronounced as "PEE" (1 syllable), whilst the Application Mark is likely to be pronounced as "TEE-ESS-PRO-JECT" (4 syllables) or "TEE-ESS-DOT-PRO-JECT" (5 syllables), due to the presence of the full stop. In any event, the number of syllables in both marks is not similar. Neither of the individual syllables sounds similar as well. I find that the Elongated P Mark and the Application Mark are aurally dissimilar.

Conceptual Similarity

38 The Elongated P mark visually represents a letter of the English alphabet, "P" but has no particular conceptual meaning in and of itself. The observations as to the concept of the Application Mark in paragraph 30 above are repeated. The Elongated P Mark and the Application Mark are both meaningless words that do not evoke any ideas and accordingly, I find that they are not conceptually similar.



(the "Elongated P (dot) Mark")

Visual Similarity

39 The marks above were subject to prior opposition in the European Union in Opposition B 1 818 833 (Annex 4 of the Applicant's Bundle of Authorities). There, the opposition was rejected in its entirety. I note that the OHIM Opposition Division held that "visually, the marks are similar to the extent that they coincide in the prolonged letter "P". However, in every other visual aspect, the signs are dissimilar." The position of the full stop, or dot, was considered not to be a relevant similarity given its different relative positions within each mark (see page 2 of the OHIM decision).

40 I concur with the observations of the OHIM Opposition Division in this regard and find that the marks are only similar insofar as they both share the Elongated P device.

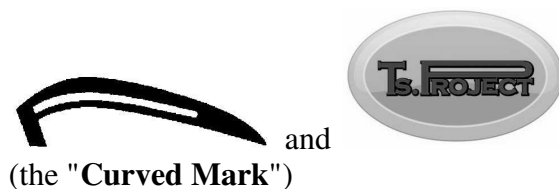
Otherwise, the marks are visually dissimilar, given that the full stop in the Opponents' Elongated P (dot) Mark is found after the "P", whilst it is part of the word "Ts.Project" in the Application Mark. Despite the fact that they share one common element in the Elongated P, the placement of the dot and the other elements in the Application Mark, such as the words "Ts.Project", are not insignificant such that comparison may be made solely between the Elongated P in each mark (see the observations at paragraphs 33-35 above). I find that the Elongated P (dot) Mark and the Application Mark are not similar.

Aural Similarity

41 Aurally, the Opponents' Elongated P (dot) Mark consists of a single letter "P" followed by a full stop, likely to be pronounced as "PEE" or "PEE-DOT" (1 or 2 syllables). The Application Mark is likely to be pronounced as "TEE-ESS-PRO-JECT" (4 syllables) or "TEE-ESS-DOT-PRO-JECT" (5 syllables), due to the presence of the full stop. In any event, the number of syllables in both marks is not similar. Neither of the individual syllables sounds similar as well. I find that the Elongated P (dot) Mark and the Application Mark are aurally dissimilar.

Conceptual Similarity

42 The Elongated P (dot) Mark visually represents a letter of the English alphabet, "P" but has no particular conceptual meaning in and of itself. The additional full stop is a trivial element that does not add any dimension to the said mark. The observations as to the concept of the Application Mark in paragraph 30 above are repeated. The Elongated P (dot) Mark and the Application Mark are both meaningless words that do not evoke any ideas and accordingly, I find that they are not conceptually similar.



Visual Similarity

43 Visually, the Curved Mark is dissimilar to the Application Mark. The Curved Mark appears to be a visual distortion of the Elongated P device. The resulting image makes it not immediately identifiable as the letter "P". It is difficult to see how the Curved Mark is similar to the Elongated P component in the Application Mark, much less the entire Application Mark itself.

Aural Similarity

44 Aurally, it is difficult to see how the Curved Mark may be pronounced, since it is more of a graphic than it is an identifiable word or letter. For the purpose of this exercise

it could be pronounced as "PEE" or "CURVED-PEE" (1 or 2 syllables). The Application Mark is likely to be pronounced as "TEE-ESS-PRO-JECT" (4 syllables) or "TEE-ESS-DOT-PRO-JECT" (5 syllables), due to the presence of the full stop. Neither the number of syllables in both marks nor the individual syllables in both marks are similar. I therefore find that the Curved Mark and the Application Mark are aurally dissimilar.

Conceptual Similarity

45 Conceptually, the curve of the letter "P" in the Curved Mark could suggest fluidity or a bending motion. The observations as to the concept of the Application Mark in paragraph 30 above are repeated. Whilst the Curved Mark suggests fluidity or bending motion, the Application Mark does not suggest any particular concept. Therefore, the Curved Mark and the Application Mark are not conceptually similar.

46 In view of the foregoing, I find that the Opponents' Marks (as stated at paragraph 11 above) 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 Applicant's goods and/or services or whether there will be a likelihood of confusion between the Opponents' Marks and the Application Mark. The ground of opposition under Section 8(2)(b) of the Act fails.

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

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

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

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

Goodwill

Opponents' Submissions

48 The Opponents submit that they have "goodwill in the Opponents' Marks" (paragraph 22 of the Opponents' written submissions) on the basis of their "huge sums of advertising expenditure, amounting to several million dollars in Singapore alone" and that their advertising strategy "is not limited to Singapore but worldwide" (paragraph 21 of the Opponents' written submissions). They further submit, in the same paragraph, that the Opponents' Marks "[have] developed to an extent that in today's world it is more akin to being a lifestyle brand which would be recognized way beyond just their initial core products of tyres."

Applicant's Submissions

49 The Applicant submits that the Opponents' evidence of goodwill in its statutory declaration is "noticeably scanty". They highlight that the Opponents' annual sales turnover figures are not supported by any documents or annual reports of the Opponents. Further, there is no indication of what products the sales relate to and what mark was used in these sales. Nothing in the Opponents' SD shows any use of the Elongated P or the Elongated P (dot) Mark per se. At best, the Opponents' goodwill is limited to the Pirelli Mark for vehicle tyres.

Decision on goodwill

50 The Court of Appeal in *Staywell* restated the classic principles of goodwill for the purposes of passing off, at [130]:

It is not disputed that to succeed in an action for passing-off, the classic trinity of goodwill, misrepresentation and damage must be proven...It is well-established that such goodwill must exist in Singapore at the date of the application for the registration of the junior mark.

51 The relevant date to consider for the purposes of this case will be the date that the Application Mark was accepted and published for the purposes of opposition, ie. 29 April 2011.

52 The evidence in the Opponents' SD relating to goodwill is as follows:

- (i) Statement by the Opponents' Authorized Representative, Pier Giovanni Giannesi ("**Mr Giannesi**") that the Opponents have "19 tyre industrial plants, in four continents, operating through a widespread sales network in over 160 countries around the world" being the "fifth largest operator in the world in the tyre sector";
- (ii) Statement by Mr Giannesi that the Opponents are the exclusive supplier for Formula 1 for a three-year term 2011-2013;
- (iii) Printouts showing the Opponents' registered trade marks in the European Union, Hong Kong, and Malaysia;
- (iv) 1-page exhibit (Exhibit C) showing a website printout of the types of car tyres sold by the Opponents;
- (v) 2-page exhibit (Exhibit D) showing a website printout of the Opponents' logo evolution and company history;
- (vi) Tables showing sales turnover and annual marketing figures for the years 2007 to 2011 for the Opponents' "products in Singapore" (see paragraph 12 above);
- (vii) 30-page exhibit (Exhibit E), described by the Opponents as "copies of random material showing a report on the extensive advertisement, promotional and publicity efforts in connection with the [Opponents' Marks]", dated 9 November 2011.

53 The statements made by Mr Giannesi in items (i) and (ii), as well as the sales turnover figures and marketing figures at (vi) are bare and unsupported by any

documents. Furthermore, the Opponents' exclusive supplier status for Formula 1, even if supported, would not be relevant after 29 April 2011. As for (iii), the printouts of the Opponents' registered trade marks are not proof that these trade marks have been used. There is no evidence of the use of these trade marks in Singapore. As for (iv), this is a website printout that only describe types of car tyres that are called "P7", "P6", "Cinturato P7", "P Zero Rosso", "P Zero System", "P Zero", "P Zero Corsa System" – none of which make any reference to the Opponents Marks. Item (v) is a snapshot of the company's history from its founding in 1872 to date, describing the evolution of its business from a factory producing rubber articles, to insulated wire for telegraphy, bicycle tyres, car tyres, eventually going into real estate and telecoms. However, the website excerpt does not make any specific mention of any business in Singapore.

54 Lastly, in item (vii), the material here appears to be a set of presentation slides on the topic "Industrial Plan: 2015 Vision and 2012 – 2014 Targets Updates" by one Andrea Imperiali, given in London, United Kingdom, on 9 November 2011. One of the slides shows the Opponents' "Brand Value in 2011: Economic Value Assessed by Interbrand" as €2.27 billion. However, it is not clear which market(s) this is for and whether the estimate was made after the relevant date. There is no other information about the Opponents' brand value in Singapore *per se*. In any event, the disclaimer on the last page of the presentation slides states that "[this] presentation contains statements that constitute forward-looking statements based on Pirelli & C SpA's current expectations and projections about future events" and that "[s]uch forward looking statements are not guarantees of future performance and involve risks and uncertainties, and actual results may differ materially from those expressed in or implied by these forward looking statements, many of which are beyond the ability of Pirelli & C SpA to control or estimate precisely. Consequently it is recommended that they be viewed as indicative only." This suggests that the figures are not even based on actual past performance in 2011.

55 Given the above, I am unable to find that the Opponents have any goodwill in Singapore, in relation to any of its goods and services, given the paucity of evidence in this regard.

Decision on Section 8(7)(a)

56 As the Opponents have not established that they had the requisite goodwill in Singapore at the relevant time, the first element of the tort of passing off has not been established. I need not go on to consider the other elements of misrepresentation and damage. The ground of opposition under Section 8(7)(a) of the Act fails. However, I will briefly comment on the element of misrepresentation in the paragraph below.

57 Even if there is goodwill in the Opponents' business, it is unlikely that the public will be confused into thinking that the Applicant's goods emanate from or are from a source related to the Opponents by reference to the Application Mark. Firstly, there is no similarity between the Opponents' Marks and the Application Mark (see paragraphs 19 – 46 above). Secondly, the Opponents and the Applicant are in very different fields of

business and have registered or purported to register their marks in different classes (and specification) of goods. The Opponents' Marks are "predominantly used on the Opponents' range of tyre products for use on vehicles including cars, SUVs, and vans," (Opponents' SD at [8]) and their trade mark registrations are for products including belt conveyors, data processing equipment, cables, pneumatic tyres, driving belts, boats, athletic bags and other related accessories thereto. The Applicant's business, on the other hand, is in the design and supply of "curtains, blinds, sunshades and the parts thereof" (see Applicant's SD at [4]) and they have sought registration in Classes 20 and 24, for bamboo and rattan related products (including window blinds, curtains and related accessories thereto), as well as woven and knitted fabrics for curtains, curtain accessories, furnishing and upholstery. There does not appear to be any relation between the Opponents' and the Applicant's scope or intended scope of business.

Ground of Opposition under Section 7(6)

58 Section 7(6) of the Act reads:

7.— (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

Opponents' Submissions

59 The Opponents submit that, on the basis of a "tripartite test" found in *Shell and Co (Aust) Ltd v Rohm and Haas* [1949] 78 CLR 601, followed by the local case of *Tiffany & Co v Fabriques de Tabac Reunies SA* [1999] 3 SLR 147, that they have ownership of the Opponents' Marks. Following this, the Opponents submit that the Applicant should have adduced evidence proving her claim to the ownership and right to register the Application Mark which features the Elongated P in Singapore. Finally, the Opponents submit that the Applicant chose to incorporate the Elongated P into her Application Mark even though she could have filed an application that did not feature the Elongated P. The Opponents cite two cases – the first, *Trade Mark Application No. 2011973 by Team Lotus Ventures (Opposition by Group Lotus Ltd (M45584))* (Decision dated 23 October 1998) ("**Team Lotus**") in the United Kingdom for the proposition that bad faith was made out if there is striking similarity between the competing marks, and the second, *Rothmans of Pall Mall Limited v Maycolson International Ltd* [2006] SGHC 51 ("**Rothmans**"), for the proposition that the court is entitled to find bad faith even if the competing marks are not so similar as to cause confusion.

Applicant's Submissions

60 The Applicant submits that an allegation in bad faith is a serious one that should not be lightly made, citing the case of *McDonald's Corp v Future Enterprises Pte Ltd* [2004] SGCA 50 (citing the case of *Royal Enfield Trade Marks* [2002] RPC 24). They submit that the Opponents have made allegations of bad faith, but have not adduced any

evidence of dishonesty by the Applicant. Neither have the Opponents adduced evidence of any trade mark registrations in Taiwan, the Applicant's home country. The Applicant submits that the Opponents are expecting an inference to be drawn that the Applicant is acting in bad faith merely because of the similarity of the Elongated P in the competing marks, which would be an incredible and unacceptable conclusion.

Decision on Section 7(6)

61 The legal burden of proving bad faith rests squarely on the Opponents, although the evidential burden of proof may shift to the Applicant. As stated by the Court of Appeal in *Valentino Globe BV v Pacific Rim Industries Inc* [2010] 2 SLR 1203 (“*Valentino*”) at [21]:

As was noted by this court in *Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd* [2009] 2 SLR(R) 814 (“*Wing Joo Loong*”) at [33]:

It is trite law that the legal burden of proof needed to substantiate an action for revocation and/or invalidation of the registration of the trade mark lies throughout on the plaintiff.

...In our view, whether a case is of opposition to registration under s 7(6) or a case of invalidation under s 23 on the ground of bad faith, it seems to us that there should not be any difference as regards the burden of proof on bad faith in both scenarios. **It is in line with common sense and logic that he who asserts must prove although, depending on the evidence tendered, the evidential burden could shift to the other side. The legal burden of proof required to substantiate a ground to oppose the registration of a trade mark remains throughout on the party making the application,** and this would be the Appellant in the present case. (Emphasis added)

62 This burden is not an easy one to discharge. As described by the Court of Appeal in *Valentino* at [30]:

Furthermore, it is pertinent to note that an allegation of bad faith is a serious claim to make and it must be sufficiently supported by the evidence (see *Nautical Concept Pte Ltd v Jeffery Mark Richard* [2007] 1 SLR(R) 1071 at [15] which we reproduce below):

An allegation that a trade mark has been applied for in bad faith is a serious one. In *Royal Enfield Trade Marks* [2002] RPC 508, it was held (at [31]) that:

A plea of fraud should not be lightly made ... and if made should be *distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the facts* (see *Davy v. Garrett* [1878] 7 Ch. D. 473 at 489. In my judgment precisely the same considerations apply to an allegation of bad faith made under section 3(6) [of the

UK Trade Marks Act 1994]. *It should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctly proved and this will rarely be a process of inference.*
(Emphasis in original)

63 In the present case, the Applicant does not take issue with the Opponents' right to register, or ownership of, the *Opponents' Marks*. What the Opponents may have meant in their written submissions is that they have *exclusive* right to register and/or ownership of the *Elongated P component* of the Opponents' Marks. However, this issue was not actually raised by the Opponents and I will therefore not deal with it here.

64 The Opponents contend that the Applicant fell short of the standard of acceptable commercial behaviour in failing to prove her "claim to the ownership and right to register the Application Mark which features the Elongated P in Singapore, or evidence of use and/or intention to use the Application Mark in Singapore" (at paragraph 36 of their written submissions). Yet, the Opponents have not provided evidence or even submissions as to *why* they believe the Applicant did not have the right to register the Application Mark in Singapore. The Opponents have failed to shift the evidential burden of proof to the Applicant in this regard.

65 Lastly, I am not certain as to how the Opponents' submissions with regard to *Team Lotus* and *Rothmans* will assist them. The Opponents have not stated whether they are claiming that the competing marks are so similar such that bad faith must be found (ie. a submission supported on the authority of *Team Lotus*) or that they are claiming that despite the competing marks being "not so similar", the court could still make a finding of bad faith (ie. a submission supported on the authority of *Rothmans*). The two cases appear to support two different positions, neither of which has been taken by the Opponents.

66 In any event, these two cases can be distinguished from the present case. In *Team Lotus*, the competing marks shared, in the hearing officer's view, "a striking degree of similarity" whilst the trade mark applicant did not submit any Counter-Statement or evidence to deny the claim of bad faith. In the present case, there is no similarity between the competing marks, especially in view of my earlier finding on marks similarity under Section 8(2)(b) of the Act. The Applicant is also fully represented and has denied the claim of bad faith in her Counter-Statement, evidence and written submissions. In *Rothmans*, the competing marks were not similar, but the parties had been embroiled in several long-standing disputes overseas. The High Court found that the trade mark application was made in bad faith because of several suspicious circumstances: the manner in which the applicants obtained their company registration, their advertising strategy that drew emphasis on the resemblance between their product and that of the opponents, and the fact that the trade mark applied for was a mere variation of another mark that the applicants were prohibited from registering under an Europe-wide injunction (see, generally, at [36] – [42] of *Rothmans*). This factual scenario is far removed from the present case, where no evidence or submissions have been put forward as to the Applicants' alleged bad faith.

67 In view of the foregoing, the Opponents have failed to meet the required standard of proof required in bad faith. The ground of opposition under Section 7(6) of the Act therefore fails.

Conclusion

68 Having considered all the pleadings and evidence filed and the submissions made in writing, I find that the opposition fails on all grounds. Accordingly, trade mark application number T1015606G shall proceed to registration. The Applicant is also entitled to costs to be taxed, if not agreed.

Dated this 12th day of May 2014.

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