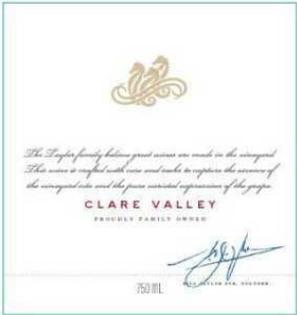


**Intellectual Property Office of Singapore Case Summary:
Taylors Wines Pty Ltd v Taylor, Fladgate & Yeatman Limited [2014] SGIPOS 11**

Source: <http://www.ipos.gov.sg/Services/HearingsandMediation/LegalDecisions/2014.aspx>

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The competing marks in the present case are as follows:

Opponents' Mark	Class / Specification	Application Marks	Class / Specification
	Class 33 / Wines	 	Class 33 / Wines, excluding fortified wines.

The Opponents failed on both grounds of opposition in Section 8(2)(b) and Section 8(4)(b)(i) and (ii) of the Trade Marks Act.

As regards visual similarity of the competing marks, the Opponents emphasized the common denominator between the competing marks, "Taylors", submitting that the apostrophe does not make a discernible difference to the average consumer, who would overlook the apostrophe, use the word interchangeably or misspell it. The Opponents also submitted that the common denominator was distinctive and dominant. The Applicants contended that there were significant differences between the competing marks. The Applicants also submitted that "Taylor" was a common family name and that there is common usage of such name in Singapore. The Opponents submitted that the Opponents' Mark had technical distinctiveness because it was not common for a family name to be used in relation to wines. Further, the Opponents submitted that the Opponents' Mark had acquired distinctiveness through centuries of use.

In light of these arguments, the Assistant Registrar ("AR") considered the European perspective on registered trade marks which were wholly (or nearly wholly) contained within a composite application mark, in *Medion AG v Thomson multimedia Sales Germany & Australia GmbH (Case C-120/04) ("Thomson")*, *Bimbo SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (Panrico SA, intervener) (Case C-591/12 P) ("Bimbo")* and *Barbara Becker v Harman International Industries Inc (and OHIM) in Case C-51/09 P*. The AR also considered the Singaporean perspective in *Ozone Community Corp v Advance Magazine Publishers Inc [2010] 1 SLR 382* and *Doctor's Associates Inc v Lim Eng Wah (trading as SUBWAY NICHE) [2012] 3 SLR 193*, in light of *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal [2013] 2 SLR 941 ("Hai Tong")* and *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another and another appeal [2014] 1 SLR 911 ("Staywell")*.

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

In Singapore, an interesting aspect of this discussion is whether there are different levels of distinctiveness for trade marks in Singapore which give rise to different consequences. When a sign is accepted for registration here, it has to be "inherently distinctive" so as not to run afoul of Section 7(1)(b)-(d) of the Act. Another way for a sign which is not "inherently distinctive" to gain registration is to satisfy the Trade Marks Registry that it is a sign which enjoys "de facto distinctiveness", that is provided for under Section 7(2) of the Act. It seems, however, that to enjoy the additional protection (described in *Hai Tong*) the proprietor must satisfy the court as to the other types of distinctiveness as described in *Staywell*). The question is whether these types of distinctiveness are the same as those required under

Section 7 of the Act, or if they are at a higher level – such that the registered proprietor must prove the same in order to enjoy a greater level of protection in court. At this stage, however, the AR noted that it was neither necessary nor appropriate to attempt to set out the general approach to be taken in various situations which may arise in the future. The analysis on marks similarity proceeded on the basis of whether the marks were distinctive and whether they were visually, aurally or conceptually similar.

In considering the "distinctiveness" of the Opponents' Mark, the AR considered if "Taylor" was a common name in Singapore, accepting that the Applicants' evidence of ACRA records of live businesses that contained the word "Taylor" suggested that it was not an uncommon name. Upon assessment of both marks as a whole, the Opponents' Mark and the Application Marks were considered not to be similar.

The goods in this case were considered to be identical goods. The goods in the Applicants' specification were considered to be a subset of the goods in the Opponents' specification. Given that the goods were considered to be identical, no extraneous factors (such as the nature of Singaporean wine consumers) applied at this stage of the inquiry.

In any event, even if the marks were similar (which they were not), there would be no likelihood of confusion.

The Opponents' submission that the Opponents' Mark was well known to the "public at large" under Section 8(4)(b)(i) and (ii) failed due to the lack of sufficient evidence.

The Application Marks could therefore proceed to registration.

Disclaimer: The above is provided to assist in the understanding of the Registrar's grounds of decision. It is not intended to be a substitute for the reasons of the Registrar. The full grounds of decision can be found at <http://www.ipos.gov.sg/Services/HearingsandMediation/LegalDecisions/2014.aspx>.