

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

Trade Mark No. T0705265E
24 March 2015

IN THE MATTER OF A TRADE MARK APPLICATION BY

SOUTHERN RUBBER WORKS SDN BHD

AND

OPPOSITION THERETO BY

CONVERSE INC

Hearing Officer: Lee Li Choon (Ms)
 IP Adjudicator

Mr G Radakrishnan and Ms Gillian Tan (Infinitus Law Corporation, as instructed by
Virtus Law LLP); Mr Arthur Loke (Virtus Law LLP) for the Applicants
Ms Ngoi Soon Hui (Drew & Napier LLC) for the Opponents

Cur Adv Vult

GROUND OF DECISION

1 On 10 March 2007, Southern Rubber Works Sdn Bhd (“the Applicants”)



applied to register the trade mark, _____, via Trade Mark Application No.
T0705265E (“the Application Mark”) in Class 25 for the following goods:

Footwear, sportswear, headwear and articles of clothing, beach clothes, coats, cyclist's clothing, field coats, jackets, parkas, rainwear, shorts, singlets, sport shorts, sports jerseys, sports shirts, swimming trunks, swimsuits, tennis skirts, track suits, T-shirts, vests, windbreaker, badminton shoes, beach shoes, boots, football boots, football shoes, golf shoes, gymnastic shoes, jogging shoes, mountain slippers, rain shoes, sandals, slippers, sports sandals, sports shoes, tennis shoes, belts [clothing], caps, clogs, hats, headbands, inner soles, sash, skull caps, socks, sports headgear, underwear, visors, wristbands [clothing].

The goods can be generically described as footwear, articles of clothing and headwear.

2 The Application Mark was accepted and published on 20 April 2007 for opposition purposes. Converse Inc ("the Opponents") filed their Notice of Opposition on 20 August 2007 to oppose the registration of the Application Mark. The Applicants filed their Counter-Statement on 21 September 2007.

3 The Opponents filed evidence in the form of a Statutory Declaration of Laura W. Kelly, the Assistant General Counsel, Nike Inc, Affiliates, who was also the Vice President, Legal, with Converse Inc from 2000 to 2008, dated 24 February 2009 ("Opponents' 1st SD"). In response, the Applicants filed a Statutory Declaration of Loke Yeow Fui alias Loke Yew Fai, the Executive Director of Southern Rubber Works Sdn Bhd dated 30 July 2010 ("Applicants' 1st SD"). The Opponents then filed a Statutory Declaration of Stephanie Vardavas, the Assistant General Counsel of Nike, Inc (Converse Inc is a wholly owned subsidiary of Nike, Inc) dated 1 March 2011 in reply ("Opponents' 2nd SD"). The Applicants then filed a further Statutory Declaration of the same Loke Yew Fai dated 28 October 2014 ("Applicants' 2nd SD").

4 On 3 March 2015, the parties exchanged their written submissions. The opposition was heard by me on 24 March 2015.

Grounds of Opposition

5 The Opponents rely on sections 8(2)(b), 8(7)(a) and 7(6) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (the "Act") in support of their opposition.

Applicable Law and Burden of Proof

6 The applicable law is the Act and the burden of proof falls on the Opponents.

Background

The Applicants

7 The Applicants, a company incorporated in Penang, is in the business of making and selling footwear. The Applicants have been manufacturing casual shoes and sports shoes in Malaysia since 1971. They first marketed their shoes under the brand name "Pallas" and later under "Jazz" and their brands have been used in various forms, sometimes in combination with the word, "Star", and sometimes with a star device as well. The Applicants' shoes have been traded and sold in other countries

besides Malaysia, and these include Singapore, Indonesia and Brunei (see paragraph 5 of Applicants' 1st SD). In Singapore, the Applicants have not opened outlets or appointed distributors for their shoes. However, according to the Applicants' 1st SD (see paragraph 5), merchants from Singapore have traded in the Applicants' shoes over the years.

8 The Application Mark first originates from the trademark "JAZZ" in Malaysia in 1986. Subsequently the word "STAR" was added to the word "JAZZ" together with a yin-yang black and white version of a star with a half-moon in black in 2002. The inclusion of the word "CLASSIC" together with the words "JAZZ STAR" and star device within a circle as it appears in the Application Mark is presently used as a trademark only on high-cut basketball shoes (see paragraph 6 of the Applicants' SD). This is the mark that is the subject of the present dispute.

9 The Applicants have registrations of their "JAZZ" and "JAZZ STAR" marks in various countries including Cambodia, Hong Kong, Indonesia, Malaysia, Myanmar,



Pakistan and Singapore. Other than Singapore, the Application Mark has been applied for in various countries, including China, Indonesia, Malaysia, Myanmar, Thailand and Vietnam. Except for Myanmar in which the Application Mark has been registered since 2007, the Application Mark is still pending registration in all the other countries mentioned (see paragraph 7 of Applicants' 1st SD).

The Opponents

10 The Opponents, Converse Inc., are a Delaware corporation in the USA and a wholly-owned subsidiary of Nike, Inc., a corporation organized under the laws of the State of Oregon, U.S.A. The prior registered marks that the Opponents are relying on in these opposition proceedings now belong to All Star C.V which is another wholly-owned subsidiary of Nike, Inc. The Opponents claimed that they have locus standi in these opposition proceedings by virtue of the decision in *J.E Borie SA v MHCS* [2013] SGIPOS 4 ("*Borie*"), wherein it was held that a party may rely on third party marks in opposition proceedings under Section 8(2) of the Trade Marks Act.

11 The Opponents claim to be an iconic American athletic shoe brand with nearly a century of authentic sports history and footwear innovation, and say their company, Converse, is "*America's Original Sports Company*", and an industry standard for generations. The Opponents say their rich heritage includes the shoe that allegedly revolutionised the game of basketball and which later became a favourite worldwide, and an American icon: the Chuck Taylor ® All Star ®. Today, the Converse collection of products includes sports performance, sports classics and sports lifestyle athletic footwear for men, women and children, as well as athletic-inspired apparel. The Opponents say that their reputation for their products goes beyond the United States. Most importantly, the Opponents maintain that they are known for the star



device, or the idea of the star, as represented in their mark and they use this as the main feature prominently on all of their products.

12 For the ground of opposition under section 8(2)(b), the Opponents are relying on the following earlier Trade Marks:

Registered TM	TM No. (Registration Date)	Class	Goods
	T9710480C (26 August 1997)	25	Headwear; all included in Class 25.
	T8705620B (18 November 1987)	25	Footwear
ONE ★ STAR	T9710720I (1 September 1997)	25	Footwear, sports clothing, headgear; all included in Class 25.
	T7980991D (29 June 1979)	25	Footwear, socks and articles of sports clothing
	T7980990F (29 June 1979)	25	Sports clothing for men, women and children including socks and footwear being articles of clothing
ALL STAR	T8402531D (14 May 1984)	25	Shirts, socks and footwear, all being articles of clothing
ALL STAR	T9711601A (22 September 1997)	25	Headgear for wear; all included in Class 25.
ALL STAR	T8402532B (14 May 1984)	18	Bags
	T8003160C (17 July 1980)	18	Bags included in Class 18

13 The above registrations were formerly owned by the Opponents prior to their assignment to All Star C.V. All Star C.V. and Converse Inc. are affiliated companies

and All Star C.V. now owns the Converse trademark property rights outside the U.S., with the exception of Japan.

PRELIMINARY DECISION

Whether the Opponents Have Locus Standi to Oppose

14 The Applicants raised a preliminary objection on the basis that the Opponents no longer have the locus standi to proceed with the opposition proceedings. According to the Applicants, the Opponents were the proprietor of the earlier trade marks in the table at paragraph 12 above at the time of filing the Notice of Opposition. However, as the earlier trade marks have been assigned to All Star CV in 2013, the Opponents, who are no longer the owners of the earlier trade marks since 2013, have lost their right to proceed in these opposition proceedings.

15 In response, the Opponents relied on the *Borie* case in which the Assistant Registrar Mark Lim Fung Chian of the Intellectual Property Office of Singapore (IPOS) held that a party may rely on third party marks in opposition proceedings under section 8(2) of the Act.

16 The Applicants then contended that the *Borie* case only dealt with an opposition under section 8(2) of the Act. Thus, whilst the Opponents may rely on the *Borie* case in support of their standing to oppose under section 8(2), they cannot rely on the *Borie* case in relation to the other 2 grounds of opposition, namely, under section 8(7)(a) and 7(6) of the Act.

17 A closer examination of the *Borie* case shows that the case stands for the broader proposition that under section 13(2) of the Act, “any person” may give notice of an opposition. On the issue of the requisite standing of a person to bring various types of proceedings under the Trade Marks Act, the Assistant Registrar Mark Lim pointed to the differences in wording in the various parts of the legislation. For instance, the reference is to “any person” in section 13(2) of the Act (pertaining to who may file a notice of opposition under section 13); “person having a sufficient interest” in section 67 (which deals with rectification or correction of the register); and “the proprietor of that earlier trade mark” in section 9 of the Act (which deals with honest concurrent use and provides that where the Registrar is satisfied that honest concurrent use is established, he shall not refuse the application by reason of the earlier trade mark unless objection on that ground is raised in opposition proceedings “by the proprietor of that earlier trade mark”).

18 In this case, the standing to bring opposition proceedings is based on that found in section 13, in particular, paragraph 2 of section 13 of the Act, i.e., “any person”. I agree with the interpretation by the Assistant Registrar Mark Lim in *Borie*. “Any person” may bring opposition proceedings. There is no requirement that the Opponents must be the proprietor of the earlier marks they are relying on for these opposition proceedings nor is there a requirement that they must be persons having any sufficient interest (which even so, arguably they have as they were the proprietors of the earlier trade marks). The *Borie* case has settled the issue as to who may file for opposition proceedings.

19 Although the *Borie* case concerns an opposition under section 8(2), the interpretation rendered is not confined to an opposition under section 8(2) only. It does not matter whether the opposition filed under section 13 is relying on a ground of opposition under section 8(2) or any other ground of opposition, including the grounds of opposition under section 8(7)(a) and section 7(6) (save for an opposition against an applicant who has established honest concurrent use of the applicant's later mark because under section 9, an opposition against such honest concurrent use may only be brought by the proprietor of the earlier trade mark). It is to be noted that section 7 merely provides for the absolute grounds for the refusal of registration and section 8 merely provides for the relative grounds for the refusal of registration. Sections 7 and 8 themselves are silent on the requirement of the standing to bring proceedings under these said provisions. The standing to bring proceedings are found in the relevant provisions dealing with the respective proceedings, that is, section 13 that deals with opposition proceedings, section 22 that deals with revocation proceedings and section 23 that deals with invalidation proceedings. For opposition proceedings under section 13, as stated above, "any person" may bring such proceedings.

20 Accordingly, the Opponents have the locus standi in these opposition proceedings to oppose the registration of the Application Mark by the Applicants under section 8(2)(b), section 8(7)(a) and section 7(6) of the Act.

MAIN DECISION

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

21 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.

22 For this ground of opposition, the Opponents are relying on their earlier marks listed in paragraph 12 above. As all of these marks were registered prior to the relevant date of 10 March 2007, they therefore constitute earlier marks as defined under Section 2(1) of the Act.

Test under Section 8(2)(b) of the Act

23 The approach to be adopted in an opposition under section 8(2)(b) of the Act is the step-by-step approach most recently endorsed by the Court of Appeal in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 ("*Staywell*") which is described in [15] as such: "*Under the step-by-step approach, the three requirements of similarity of marks, similarity of goods or services, and likelihood of confusion arising from the two similarities, are assessed*

systematically. The first two elements are assessed individually before the final element which is assessed in the round.”

24 As for the applicable test for determining whether a mark is likely to cause confusion with an earlier mark in this step-by-step approach, it is as enunciated by the Court of Appeal in the same case, *Staywell* at [55] as follows:

55 Under our law, the two threshold requirements for successfully opposing a proposed registration, or establishing liability for infringement, are similarity or identity of the marks and similarity and identity of the services. Once these threshold criteria have been met, the issue of the likelihood of confusion arises and this in our view directs the court to look at (a) *how* similar the marks are; (b) *how* similar the *goods* are; and (c) given this, how likely the relevant segment of the public will be confused. In *Hai Tong* we said ([18] *supra* at [85(c)]): Having regard to the express terms of s 27(2), there are three specific elements that plainly must be considered. These are: (i) the similarity between the registered mark and the allegedly infringing mark; (ii) the similarity or identity between the goods or services in relation to which the marks are used; and (iii) the relevant segment of the public in relation to whom the court must consider the likelihood of confusion. Each of these elements can vary. The marks may be identical or similar, and if the latter, they can vary in their degree of similarity. In the same way, the goods or services in relation to which the marks are used may be identical or similar, and again, if the latter, they may vary in the degree or extent to which they are similar. ... And as to the relevant segment of the public, there may be characteristics that are particular to the group in question. Each of these factors will have a bearing on the likelihood of confusion. As an illustrative proposition, the likelihood of confusion must be greater where, say, the contesting marks are similar to a high degree, the goods are identical in nature and the segment of the public in question is undistinguished in its attention than would be the case if the marks and the goods are somewhat similar but not exceedingly so, and the relevant segment of the public happens to be highly knowledgeable and very fastidious. ...

Marks Similarity

25 In assessing how similar the marks are, the decided cases have established that there are three aspects of similarity to consider, *viz*, visual, aural and conceptual similarity. Under our law, it is well-established that there is no need for all three aspects of similarity to be made out before the marks can be found to be similar (*Staywell* at [18]; *MediaCorp News Pte Ltd v Astro All Asia Networks plc* [2004] 4 SLR(R) 496 at [32]; *Sarika Connoisseur Café Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 (“*Sarika*”) at [16]). Indeed, “the criteria of visual, aural and conceptual similarities do not invite a formulaic consideration”; rather, they “*are signposts towards answering the question of whether the marks are similar...[and][t]rade-offs can occur between the three aspects of similarity in the marks similarity inquiry*”(*Staywell* at [18]) (emphasis mine).

26 It is also clear that the assessment of marks similarity is mark-for-mark without consideration of any external matter (*Staywell* at [20]). At the marks

similarity stage, I also do not have to consider the relative weight and importance of each aspect of similarity having regard to the goods (also *Staywell* at [20]).

27 In comparing the marks as a whole, the Court of Appeal in *Staywell* has also said at [26], “When speaking of the assessment of a mark as a whole, it may be noted that the cases have consistently stated that the “visual, aural and 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” (emphasis mine)”. In this regard, the finding may be that a component of a mark is inherently technically distinctive and in that event, “this can have a bearing on whether as a result of this, that component or element is found to be the dominant and distinctive element of the mark in the non-technical sense” (see *Staywell* at [28]). By “technical distinctiveness”, the Court of Appeal was referring to elements that stand in contradistinction to descriptiveness; elements that make the mark a badge of origin. And “distinctiveness in the ordinary and non-technical sense simply refers to what is outstanding and memorable about the mark. Such components tend to draw the consumer’s attention, bearing in mind the imperfect recollection of the average consumer.” (see *Staywell* at [23]).

28 That said, “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.” (see *Staywell* at [29]). The Court of Appeal reiterated at [30] that, “distinctiveness (in both its technical and non-technical sense) is a factor *integrated into* the visual, aural and conceptual analysis as to whether the competing marks are similar. It is not a separate step within the marks-similarity inquiry.”

29 I will address the question of the similarity of the marks by considering their visual similarities, aural similarities and conceptual similarities, each in turn.

Visual Similarities

30 Of the prior registrations belonging to the Opponents, the only registered mark



that stands to be considered is this mark which has been registered for headwear (T9710480C registered on 26 August 1997) and for footwear (T8705620B registered on 18 November 1987). By the Opponents’ own assessment, this is also the mark that is closest to the Application Mark (see paragraph 10 of the Opponents’ written submissions). As the other prior marks relied on by the Opponents bear little resemblance to the Application Mark and as the Opponents themselves did not make reference to any of the other marks other than these 2 in their own submissions for their opposition under section 8(2)(b), I find that there is no case for opposition based on the other marks.

31 Thus, for the purpose of my analysis for the ground of opposition under



section 8(2)(b) of the Act, I will focus on this particular mark which has

been registered for headwear and footwear (“the Opponents’ mark”). The Opponents contended that the commonality in the layout of the 2 competing marks makes the Application Mark and the Opponents’ mark similar.

32 Visually, both marks contain an outline that consists of two concentric circles placed very close together, less than one millimetre apart; a star device in the centre of the two concentric circles; and some words. The concentric circles in the Application Mark are outlined in a solid line whereas the concentric circles in the Opponents’ mark are outlined in dotted-lines. The word in the top arc of the Opponents’ mark is their brand name, “CONVERSE”. The word in the top arc of the Application Mark is “CLASSIC”. The words at the bottom arc of the Opponents’ mark are “ALL STAR” and the words at the bottom arc of the Application Mark are “JAZZ STAR”. The Opponents’ mark also contains the name of a famous US basketball player, “Chuck Taylor” in signature form in the middle across the star device, with “Chuck” on the left side of the star and “Taylor” on the other side.

33 The words in the marks are different. However, there is some similarity in the placement of the words in the Application Mark and that in the Opponents’ mark, with a difference in that there is the name “Chuck Taylor” across the star in the Opponents’ mark.

34 The star device which is in the centre of both competing marks is a lot more prominent than the words. Visually, the star is the prominent feature in both competing marks due to the relative size of the star device vis-à-vis the words and the size of the star in relation to the whole mark. Thus, I find the star device to be a distinctive component (distinctive in the non-technical sense) in that it is an outstanding and memorable feature in both marks.

35 There are some differences between the two stars: the star in the Opponent’s mark is in solid colour and the star in the Application Mark is coloured on one half and white on the other.

36 Broadly speaking, visually, both marks contain a star which is a distinctive component within a concentric circular outline and some words. The placement of the star in the middle of the circular device is the same in both marks. The sizes of the stars and their placement relative to the other elements such as the words and relative to the circular outline in both marks are the same. The placement of the words and the star device within the concentric circular outline is the same except that the Opponents’ mark contains the additional words, “Chuck Taylor” across the star device in the Opponents’ mark.

37 In my view, visually, both marks bear some similarity in that both competing marks consist of a prominent star device in the centre within a concentric circular outline; and that both competing marks contain words that are placed in the same places within the concentric circular outline and relative to the prominent star device. On the prominent feature, the star device itself, there is also similarity in the two competing marks notwithstanding slight differences in the star device in that the Application Mark contains a two-tone star.

38 On the whole, given that the star device is distinctive (distinctive in the non-technical sense) in both marks and given that there is similarity between the star devices within similar circular outlines, and the words in both marks are placed in the same locations in the two marks, I conclude that the two marks are visually similar.

Aural Similarities

39 On the issue of aural similarity, the question that arises is how the marks in the present case should be compared from the perspective of aural similarity. Should the marks be regarded by the words in the marks or should the comparison be based on the star device?

40 On this question, the Court of Appeal in Staywell at [31] to [32] provided the following guidance:

31 At [21], [24] and [27] of the GD, the judge considered the word “Regis” to be the dominant and distinctive component of both marks when each is read out. In our view, she was perfectly entitled to come to this view. Staywell’s argument that the judge erred in considering the dominance of “Regis” because the Opponents had never used or registered the component “Regis” alone was misconceived simply because, as we have pointed above, a component can clearly be dominant even if it is part of the mark as a whole and is not and has never been used on its own. In fairness to the judge, it should be noted that she specifically considered that the “St.” and “Park” portions of the competing marks, though not as dominant as the “Regis” portion, were not to be ignored... In relation to both the competing marks “Regis” is the element that is distinctive in the non-technical sense because it is what will stand out in the imperfect recollection of the consumer. The judge was therefore entitled to find this the common dominant element of both marks in assessing the question of whether the competing marks as a whole were similar.

32 An alternative approach which does not involve considering the dominant components of the marks would have been simply to undertake a quantitative assessment as to whether the competing marks have more syllables in common than not. This was the approach taken in *Ozone Community* at [55]...

41 In this case, even if I were to adopt the first approach, it may be argued that there are various dominant components in the two marks. One dominant component is the textual component, i.e., the words in the two marks. The other important dominant component is the star device.

42 In comparing the aural similarities of the two marks, I agree with the contention by counsel for the Applicants that the comparison should be based on the dominant textual components. On this, I am guided by the principles laid down by the Court of Appeal in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another* [2013] SGCA 26 (“*Hai Tong*”) in relation to the question of when a particular element of a composite mark could be regarded as its "dominant component":

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]).
- (ii) The textual component is large, and is in a prominent location in relation to the other components or stands out from the background of the mark or sign (see the decision of the CFI in *Shaker di L Laudato & C Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (Case T-7/04) [2009] ETMR 16 (“Shaker (CFI)”) at [41]–[43]).
- (iii) ***The textual component is in itself already widely known*** (see *Festina* at [33], *Medion* at [34] and *Crazy Ron’s* at [99]).
- (iv)

(emphasis mine)

43 The textual components in the Application Mark are “CLASSIC” and “JAZZ STAR”. “JAZZ STAR” being non-descriptive and the brand name of the Applicants, is a distinctive component of the Application Mark. The Applicants say that their mark is more likely to be known and identified as the CLASSIC JAZZ STAR mark because of the way it is arranged whereas the Opponents’ mark is likely to be referred to as the CONVERSE ALL STAR mark.

44 On the other hand, the textual elements in the Opponents’ mark are “CONVERSE”, “Chuck Taylor” in stylised form, and ALL STAR. The textual elements “CONVERSE” and “Chuck Taylor” are distinctive components (distinctive in the technical sense) in the Opponents’ mark.

45 As opposed to the star device, the respective words “JAZZ STAR” and “CONVERSE” and “Chuck Taylor” in the two competing marks, which are also the distinctive components (distinctive in the technical sense), are very different.

46 Thus, aurally, as the two marks contain the brand names of the parties, the marks will be referred to in accordance with their brand names. The Application Mark is the “Classic Jazz Star” mark and the Opponents’ mark is the “Converse All Star” mark or the “Chuck Taylor” mark. Will the two marks be referred to as the “star” mark and therefore be aurally similar? I think not. The two marks will be referred to and remembered by their textual components which contain their respective brand names.

47 In conclusion, based on their textual components, aurally, as the words are different, the two marks are different.

Conceptual Similarities

48 Conceptually, the two marks contain their brand names with a star device prominently featured within a concentric circular outline. As the two brand names are

different, conceptually, other than the similarity in that both marks contain a prominent star device, there is little conceptual similarity.

Conclusion on Similarity of Marks

49 On the whole, the marks are visually similar but aurally and conceptually different.

Goods Similarity

50 The Applicants concede that the goods such as footwear and headwear for which the Applicants seek registration are similar to the goods for which the Opponents' mark is registered. Indeed, the goods are not just similar, they are identical. However, the Applicants say that their application includes articles of clothing such as beach clothes, coats, cyclists clothing, field coats, jackets, pajamas, parkas, rainwear, shorts, singlets, sport shorts, sports jerseys, sports shirts, swimming trunks, swimsuits, tennis skirts, track suits, T-shirts, vests and windbreaker. The Applicants say that these aforesaid goods are not similar.

51 In *Staywell*, although there was no appeal in respect of the High Court's finding that the services were similar, the Court of Appeal took the opportunity to clarify certain aspects of the judge's reasoning, and held at [40] and [41] as follows:

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

[41] Hotel services are hotel services, whether these concern a luxury hotel or a more modest one. We adopt the view that while "trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise ... [w]here words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question" (*per* Floyd J in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) ("*YouView*") at [12]; see also *Omega Engineering Inc v Omega SA* [2013] FSR 25 at [33]). **Where a good or service in relation to which registration is sought falls within the ambit of the specification in which the incumbent mark is registered, the competing goods or services would be regarded as identical** (see *Gerard Meric v OHIM* (Case T-133/05) at [29])."

(emphasis mine)

52 On this issue, I agree with the Opponents' submission that where the goods are not identical, the correct approach is to ask whether the goods under the later mark are similar to the goods under the earlier mark, "*having regard to all relevant factors relating to the goods themselves*". The ultimate question "*is how the goods are regarded, as a practical matter, for the purposes of trade*". In this regard, the factors outlined in *British Sugar v James Robertson & Sons Ltd* [1996] RPC 281 would be relevant, "*in particular the consideration of the uses and the end-users of the goods*" (see *Staywell* at [43]) and they are as follows:

- (a) the respective uses of the respective goods;
- (b) the respective users of the respective goods;
- (c) the physical nature of the goods;
- (d) the respective trade channels through which the goods reach the market;
- (e) in the case of self-serve consumer items, whether in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) the extent to which the respective goods are competitive. This inquiry may take into account how those in the trade classify goods, for instance whether market research companies, who of course act for the industry, put the goods in the same or different sectors.

53 On the issue of whether articles of clothing are similar to footwear and headwear, the Opponents cited the case of *O'Neil Inc's Application* [2004] E.T.M.R 50 OHIM in which it was held that footwear is similar to clothing, since both are worn, having the function of covering and protecting and are often sold in the same outlets. The Opponents said it is very common for manufacturers in the fashion industry to retail apparel, headgear and footwear all under one roof and under one badge of origin. They cited a few examples such as FOX, Mango, Zara, Nike, Adidas and Topshop.

54 On this issue, I conclude that articles of clothing are similar to footwear and headgear as they are usually sold through the same trade channels and consumers consider it to be usual for such goods to be sold under the same trade mark and under one roof.

Likelihood of Confusion

55 As I have found the marks to be visually similar and the goods to be identical for footwear and headgear and similar for articles of clothing, the next issue I have to consider is whether a likelihood of confusion arises and in this enquiry, I have to look at (a) how similar the marks are; (b) how similar the goods are; and (c) given this, how likely it may be that the relevant segment of the public will be confused (see *Staywell* at [55]).

56 The Court of Appeal at [55] stated:

In **Hai Tong** we said (at [85(c)]):

Having regard to the express terms of s 27(2), there are three specific elements that plainly must be considered. These are: (i) the similarity

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

57 The above analysis which was in the context of infringement is also applicable to oppositions. The Court of Appeal in *Staywell* at [60] made it clear the question of likelihood of confusion has to be answered taking into account the actual and notional fair uses to which the Opponents might fairly put his registered trade mark and compare this against the full range of such rights sought by the applicant by reference to any actual use by the applicant (assuming there has been prior use) as well as notional fair uses to which the applicant may put his mark should registration be granted.

58 On the effect of the similarity of marks and the similarity of goods on the relevant segment of the public, the Court of Appeal said at [83] that extraneous factors may be considered to the extent that they inform us as to how the similarity of marks and goods would likely affect the consumer's perception as to the source of the goods subject to a few qualifications.

59 First, in opposition proceedings, it will generally not be relevant to consider extraneous facts that relate to the actual and particular circumstances and ways in which the mark was used on the goods in question. Thus, it will not be relevant to have regard to the particular way in which the goods have been affixed with the mark and are then being marketed. In light of this qualification, the Applicants' claims (at paragraphs 15, 18-20 of the Applicants' 1st SD) that the Opponents' shoes retail for a much higher price and that the Opponents utilize good quality packaging materials for their shoes – all these are irrelevant in considering the issue of likelihood of confusion by virtue of the similarity of the marks and goods.

60 Second, extraneous factors should not be advanced to negate a finding of likely confusion on the grounds that the marks are being deployed in such a way as to target different types of consumers or to notionally differentiate the goods in question.

61 The extraneous factors that are relevant for consideration would be those that show that even if on a mark-for-mark comparison the marks are similar, then having regard to extraneous material they are not confusingly so (see *Staywell* at [87]). The rationale for these qualifications has been succinctly explained at [89] – that allowing extraneous factors unqualified will enable a subsequent trader to obtain trade mark rights and enter the market with a similar mark and then avoid liability by say, an express disclaimer or by using cheaper materials or selling the goods at a much cheaper price.

62 The Court of Appeal concluded that there exists a limit to the range of external factors that may be taken into account to determine whether a sufficient likelihood of such confusion exists. The permissible factors are those which (a) are intrinsic to the very nature of the goods and/or (b) affect the impact that the similarity of marks and goods has on the consumers. In this regard, the Court of Appeal provided guidance on the types of extraneous factors which may be considered at [96]:

... the following represents a non-exhaustive list of factors which we regard as admissible in the confusion inquiry:

- (a) Factors relating to the impact of marks-similarity on consumer perception: the degree of similarity of the marks themselves (see *Hai Tong* ([18] supra) at [85(c)(iii)]), the reputation of the marks (see *Polo (CA)* ([8] supra) at [34]), the impression given by the marks (see *Polo (CA)* at [28]), and the possibility of imperfect recollection of the marks would all be relevant. Clearly, the greater the similarity between the marks, the greater the likelihood of confusion. As to the reputation of the mark, *Mobil Petroleum Co, Inc v Hyundai Mobis* [2010] 1 SLR 512 ("*Mobil*") at [74] makes it clear that *a strong reputation does not necessarily equate to a higher likelihood of confusion, and could in fact have the contrary effect* as in *McDonald's Corp v Future Enterprises Pte Ltd* [2005] 1 SLR(R) 177 (see at [64]).
- (b) Factors relating to the impact of goods-similarity on consumer perception: it would be legitimate to take into account factors concerning the very nature of the goods without implicating any steps that are taken by the trader to differentiate the goods. *This includes the normal way in or the circumstances under which consumers would purchase goods of that type* (see [20] above, *Mystery Drinks* at [48], *Lloyd* ([23] supra) at 1352; and *Phillips-Van Heusen Corp v OHIM* ([20] supra) at [55]). This factor is not directly dependent on the marketing choices that the trader makes. As alluded to at [94] above, *it would also be relevant to have regard to whether the products are expensive or inexpensive items, the nature of the goods and whether they would tend to command a greater or lesser degree of fastidiousness and attention on the part of prospective purchasers* (see generally *Hai Tong* at [85(c)(i)]), *and the likely characteristics of the relevant consumers and whether they would or would not tend to apply care or have specialist knowledge in making the purchase*.

(Emphasis mine)

Application to the Facts

63 In this case, the relevant consumers would be members of the public in general as these are goods that are purchased by ordinary retail customers. I have found that there is some visual similarity between the two star devices in the respective marks. However, the 2 competing marks are aurally and conceptually different. Thus, the similarities in the 2 competing marks are not to a high degree.

64 The Opponents assert that due to the extensive use and promotion by the Opponents, consumers have come to associate marks with a star in a circle with words inside the circle element with goods associated with Converse (see paragraph 5 of Opponents' 2nd SD). The Applicants used this same argument to say that the fact that the Opponents' mark is a well-known mark in fact works against the likelihood of confusion, citing *McDonald's Corp v Future Enterprises Pte Ltd* [2004] SGCA 50 in which the Court of Appeal said, "With widespread education and a public that is constantly exposed to the world, either through travel or the media, one should be slow to think that the average individual is easily deceived or hoodwinked. In fact, the very success of the appellant, which is inseparable from its logo, is also the very reason why confusion is unlikely."

65 In my analysis, while I accept that there is some visual similarity between the two competing marks, there is little similarity in the words in the 2 competing marks. In my view, the dissimilarity in the words in the 2 competing marks outweighs the visual similarity in the layout. Undoubtedly, the Opponents' reputation centres around their brand name, "Converse". A perusal of the Opponents' evidence through the Opponents' 1st and 2nd SDs shows that the Opponents' use of their marks is never with the star device on its own. Thus, the Opponents are associated with their brand name, "Converse". By virtue of that, given that the Opponents' earlier registrations are for a composite mark with the word "Converse" featured in the mark, it is clear that the focus would be on the words in the mark and not on the star device. The Opponents' mark will be remembered as the Converse mark and not as the star device in circle mark.

66 The words appearing in the two competing marks are different. When consumers see the Application Mark, due to imperfect recollection, they will not be confused with the Opponents' mark which they would remember as the "Converse" mark. Even if they remember that the Opponents also used a similar star device and a similar layout for the words, it is not likely that consumers would be confused as they would associate the marks by the words in the marks and the Opponents' mark would be associated with their brand name, "Converse" or "Chuck Taylor".

67 The next relevant extraneous factor for consideration in this case is the fact that there are other "star" marks on the register. The following valid marks which contain a prominent star device that are registered in Class 25 are found on the trade marks register:

Mark	Trade Mark Number	Owner	Registration or Application Date
	T9710720I	All Star C.V. (the present owner of the Converse marks)	01/09/1997

	T9209573C	Polykwan Trading Company	11/12/1992
	T8907290D	Double Star Garments and Department Store	03/11/1989
	T7667066D	Bata Brands S.A.R.L, Luxembourg	27/2/1976
	T1414432B	Mofra Shoes S.R.L	28/4/2014
	T1311897B	All Star C.V.	25/7/2013
	T1219689I	Yazid Bin Abdul Aziz	20/12/2012
	T1115328B	Khor Chong Heng	2/11/2011

	T0806505Z	Trend Star Pte Ltd	16/5/2008
	T1003298H	Xiamen Chaolong Import and Export Co. Ltd	2/2/2010
	T0806502E	Japro Impex Pte Ltd	16/5/2008

68 In addition, the Opponents also own various marks that incorporate the star device or the word, “star”. In the table above, other than the “One Star with star device” mark which is owned by All Star CV, the present holder of the trade mark rights in the Opponents’ mark, there are 2 other marks which carry the star device : T9209573C which also contains the words, “Blue Star” and will be referred to as the “Blue Star” mark and T8907290D which has no other feature in the mark other than the device of the star. The above list also shows quite a few other marks that contain the star device. In the context of this opposition, the established fact is that there are other marks containing a star device for which registration has been obtained by other proprietors.

69 Given that the star device is commonly used either as a composite component of marks or on its own, in this setting, consumers are used to seeing different forms of the star device in marks. Thus, when they see another mark with a star device, their focus will not be on the star device. The Application Mark will be seen by consumers as the “Jazz Star” or “Classic Jazz Star” mark. The Opponents’ mark will be seen by consumers as the “Converse” or “All Star” or “Converse All Star” or “Chuck Taylor” mark. Under the circumstances, given that these elements are very different, it is unlikely that consumers will be confused into thinking that the Application Mark comes from the Opponents.

70 More importantly, in relation to footwear, it is to be said that they are not normally purchased on a whim or in a hurry. Shoes are something that the general consumers would pick up to try for the fit before buying. The moment the consumer picks up a pair of shoes bearing the Application Mark, it would immediately become apparent to him or her that the shoes are manufactured by the Jazz Star owner and not by the owners of Converse even if they were to associate the star device with the Opponents as the Applicants’ goods contain the distinctive elements of the words, “Jazz Star” which are very different from the Opponents’ “Converse” brand.

71 In conclusion, I find that in spite of some visual similarity between the Opponents’ mark and the Application Mark, there is no likelihood of confusion taking into account the following:

- (a) That the visual similarity between the two marks relates only to the star device and there are other very different distinctive components in the two competing marks, namely the words, “Jazz Star” in the Application Mark and the words, “Converse”, “All Star” and “Chuck Taylor” in the Opponents’ mark.
- (b) That the two competing marks are aurally and conceptually different.
- (c) That the fact is that the star device is a common device and thus, though the star device is prominent in both marks, consumers’ focus will be on the other distinctive elements and these elements are very different.
- (d) That the fact is that in relation to footwear which is of greatest interest to both parties, the goods are something that the relevant consumer will take some care to purchase and thus, any likelihood of confusion is minimized.

Decision on Section 8(2)(b)

72 In the circumstances, the ground of opposition under section 8(2)(b) of the Act fails.

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

73 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.

74 It is well accepted law that to succeed in an action for passing off, a claimant (in this case, the Opponents) must establish the three elements of goodwill, misrepresentation and damage.

75 I will examine each of these elements in turn.

Goodwill

76 The oft-cited description of goodwill in *The Commissioners of Inland Revenue v Muller & Co's Margarine, Limited* [1901] AC 217 (at 223-224) was regarded by our Court of Appeal in *Novelty Pte Ltd v Amanresorts Ltd and Another* [2009] 3 SLR(R) 216 (“*Amanresorts*”) (at [39]) as “*the clearest exposition of what goodwill is*”: “What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation, and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has a power of attraction sufficient to bring customers home to the source from which it emanates.”

77 The relevant date at which goodwill is to be assessed is the application date of the Application Mark (i.e. 10 March 2007).

78 The Applicants argued that the first point the Opponents need to establish is that they have goodwill in their business involving the relevant mark. The Applicants' contention is that it is not good enough for the Opponents to say that they have goodwill in relation to all their marks. The Applicants' case is that in relation to the ground under section 8(7)(a), the Opponents need to show goodwill in relation to the mark that comes under contention. The Applicants' submission is that whilst the Opponents have provided sales figures and supporting documents, they did not clearly establish that there existed goodwill in Singapore before March 2007 in the business for headwear and footwear bearing the mark in contention. The Applicants contended that the Opponents have merely grouped all the sales figures as for "Converse products" and that these do not show goodwill in Singapore in relation to the business in which the Opponents' mark is used.

79 In the Opponents' 1st SD at exhibit LWK-5, the Opponents have lodged invoices showing evidence of use of their mark in contention – the mark with the star device and the words, "Converse" and "All Star". Use can be inferred by the fact that the invoices show as an imprint at the centre a logo with a star device within a circular device with the word "Converse" on top and the words, "All Star" at the bottom. And the invoices show sales of goods to retail outlets such as the ones in Peninsula Plaza and the invoices are dated as early as 1998.

80 I am therefore satisfied that there is goodwill in the Opponents' mark in Singapore prior to March 2007. The goodwill belonged to the predecessor and as the relevant marks have been assigned to the Opponents, presumably together with goodwill of the business, the Opponents have established this requirement for their ground of opposition under passing off.

Misrepresentation

81 On the test for the element of misrepresentation in passing off, the Court of Appeal in *Hai Tong* (at [109]-[110]) has clarified the differences between the likelihood of confusion to satisfy the element of misrepresentation in the tort of passing off and the likelihood of confusion for a claim for trade mark infringement. The Court of Appeal stated at [110]:

Moreover, even *in relation to the element of misrepresentation*, it has been observed in *Kellogg Co v Pacific Food Products Sdn Bhd* [1998] 3 SLR(R) 904 ("*Kellogg*") that at least in relation to the corresponding provision of the 1992 TMA, *the test in the tort of passing off is probably a more demanding one than the corresponding inquiry in a trade mark infringement action* (see *Kellogg* at [32]).

In the former, it is necessary to show that the defendant's actions amount to a misrepresentation that is likely to deceive the relevant segment of the public, whereas in a trade mark infringement action, the question is whether, because of the similarities between the registered mark and the allegedly infringing mark and between the goods or services on which these marks are applied, there is likely to be confusion. Moreover, as observed in *Polo (HC)* ([79] *supra*) at [23] and endorsed by this court in *Polo (CA)* ([16] *supra*) at [33], *in an action in passing off, the likelihood of deception is to be assessed*

having regard to all the circumstances, whereas in a trade mark infringement action under s 27(2)(b) of the Act, the likelihood of confusion must stem from the similarity between the contesting marks and the similarity between the goods or services to which they are applied. Lastly, whereas passing off is concerned with protecting the plaintiff's goodwill in his business, the action for infringement is geared towards protecting the trade mark owner's proprietary rights in respect of his trade mark...

82 As I have earlier found that there is no likelihood of confusion between the Application Mark and the Opponents' mark under section 8(2)(b) of the Act, the necessary conclusion is therefore that there is no misrepresentation in this case since a higher threshold for the likelihood of confusion is required for misrepresentation in a claim for passing off.

83 In any event, there is no misrepresentation based on the following additional circumstances which may be taken into consideration in determining if there is confusing misrepresentation on the part of the Applicants:

- (a) The Applicants do not have any retail outlet in Singapore and do not sell their shoes through authorized distributors. The Opponents on the other hand, sell their goods through their authorised retail outlets or through their own sections within a departmental store. Thus, the Opponents' goods are likely to be found in sections carrying their brand name, "Converse" whereas the Applicants' goods are likely to be found in the generic section together with other goods.
- (b) As alleged by the Applicants, the Applicants' goods cost a lot less than the Opponents' goods. The relevant consumers would take notice of this price difference.
- (c) The Applicants have also employed very different packaging from the Opponents (see paragraph 18 to 20 of Applicants' 1st SD). The Applicants' packaging comprised a brown box with the word, "Jazz" very prominently displayed on the box whereas the Opponents' packaging comprised a black box with the Opponents' mark on the top left hand corner of the packaging.

84 Based on all of the above, there is no confusing misrepresentation to the Opponents' potential customers.

Damage

85 Damage to goodwill is an essential part of the tort of passing off. As stated by the Court of Appeal in *Amanresorts* at [105], "***there must be 'a real tangible risk of substantial damage'***". Thus, the Opponents must prove a real tangible risk of substantial damage. A mere assertion of damage to its goodwill will not suffice.

86 The Opponents submitted that even in the absence of any proof of actual damage, damage can be presumed by virtue of the close similarities between the competing marks and the goods traded by both the Applicants and the Opponents. I disagree that damage can be presumed by virtue of the similarities between the competing marks and the goods traded by both parties. The threshold is higher and the Opponents bear the burden of proof. In any event, as I have found that there is no

likelihood of confusion between the Application Mark and the Opponents' mark, even if this is correct, there is no presumption of damage to be made in this case.

87 Thus, the ground of opposition under section 8(7)(a) also fails.

Ground of Bad Faith under Section 7(6)

88 Section 7(6) provides that:

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

89 In *Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd and Another and Another Appeal* [2009] 2 SLR(R) 814, the Court of Appeal endorsed the “combined” test which contains both a subjective element (*viz.*, what the particular applicant knows) and an objective element (*viz.*, what ordinary persons adopting proper standards would think). This combined test was explained (at [41]) as follows:

The subjective element of the test means that the tribunal must ascertain what the defendant knew about the transaction or other matters in question. It must then be decided whether in the light of that knowledge; the defendant's conduct is dishonest judged by ordinary standards of honest people, the defendant's own standards of honesty being irrelevant to the objective element

...

90 In *Valentino Globe BV v Pacific Rim Industries Inc* [2010] SGCA 14, the Court of Appeal held at [30] that an allegation of bad faith is a serious claim to make and it must be sufficiently supported by the evidence. The Court of Appeal further said that a plea of bad faith should not be lightly made and if made should be distinctly alleged and distinctly proved. It is not permissible to leave bad faith to be inferred from the facts.

91 The legal burden of proof lies with the Opponents. The Opponents have not presented any evidence relating to the conduct of the Applicants in applying for the registration of the Application Mark that goes to show bad faith on the part of the Applicants. The Opponents have not presented any evidence to show that the Applicants knew of facts which, to the ordinary person, would have made the Applicants' conduct in applying for registration of the Application Mark fall short of the normally accepted standards of commercial behaviour. The Opponents have merely averred that their star logo has achieved fame around the world due to their extensive use and promotion, in particular on high cut basketball shoes, and that by virtue of the Applicants operating in the same industry, the Applicants cannot have been unaware of their marks, especially the star logo. The Opponents argued that because of this background, the Applicants are clearly seeking to ride on the coat-tails of the Opponents. Other than a mere assertion of their fame *vis-à-vis* the star logo, the Opponents have not surfaced any concrete evidence to show that the Applicants have acted in bad faith in applying for registration of the Application Mark.

92 As stated above, this clearly falls short of the test of bad faith. Bad faith cannot be inferred from circumstances or facts. As such, the Opponents have failed to prove that there was bad faith on the part of the Applicants in applying for registration of the Application Mark.

93 Accordingly, the ground of opposition under section 7(6) fails.

Conclusion

94 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 24th day of June 2015

Lee Li Choon (Ms)

IP Adjudicator

Intellectual Property Office of Singapore