

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

Trade Mark No T1114593Z and T1114594H
Hearing Date: 29 April 2015
(Further Written Submissions: 26 May 2015)

IN THE MATTER OF A TRADE MARK APPLICATION BY

DOCHIRNIE PIDPRYIEMSTVO "KONDYTERSKA KORPORATSIIA "ROSHEN"

AND

OPPOSITION THERETO BY

FERRERO S.P.A.

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

China Intellectual Property Agency for the Applicants (unrepresented at hearing)
Mr Sukumar Karuppiah (Ravindran Associates) for the Opponents

Cur Adv Vult

GROUND OF DECISION

1 Dochirnie pidpryiemstvo "Kondyterska korporatsiia "Roshen" (the "**Applicants**")
applied to protect the following signs:

Trade Mark Application No.	Representation	Class	Specification
T1114593Z (referred to as the "Applicants' ROSHEN Mark ")		29	Meat; Fish, not live; Poultry, not live; Game, not live; Meat extracts; Preserved, frozen, dried and cooked fruits and vegetables; Eggs; Milk and milk products; Edible oils and fats; Fruit jellies; Jams; Compotes.
		30	Confectionery; Sugar confectionery; Sweetmeats [candy]; Candy for food; Fondants [confectionery]; Fruit jellies [confectionery]; Fruit Jellies [confectionery]; Peanut confectionery; Peppermint sweets; Chocolate; Coffee; Cookies; Pastry; bread; tea; cocoa; Coffee-based beverages; Coffee beverages with milk; Honey.
T1114594H (referred to as the "Applicants' ROSHEN CLASSIC Mark ")		29	Meat; Fish, not live; Poultry, not live; Game, not live; Meat extracts; Preserved, frozen, dried and cooked fruits and vegetables; Eggs; Milk and milk products; Edible oils and fats; Fruit jellies; Jams; Compotes.
		30	Confectionery; Sugar confectionery; Sweetmeats [candy]; Candy for food; Fondants [confectionery]; Fruit jellies [confectionery]; Fruit Jellies [confectionery]; Peanut confectionery; Peppermint sweets; Chocolate; Coffee; Cookies; Pastry; bread; tea; cocoa; Coffee-based beverages; Coffee beverages with milk; Honey.

(collectively, the “**Applicants’ Marks**”)

2 Both applications were accepted and published on 18 October 2011 for opposition purposes (the “**Relevant Date**”). Ferrero S.p.A. (the “**Opponents**”) filed their Notices of Opposition to oppose the registration of the Application Mark on 20 April 2012. The Applicants filed their Counter-Statements on 10 August 2012. The first Case Management Conference (“**CMC**”) for both matters was held on 26 September 2012 and was attended by representatives from both sides.

3 The Opponents filed evidence in support of both oppositions on 30 October 2012. A second CMC was held on 21 November 2012. The second CMC was attended by

representatives from both sides. At this CMC, timelines were given for the filing of the Applicants' evidence and the Opponents' evidence in reply. At this CMC, the two opposition matters in respect of T1114593Z and T1114594H were consolidated, as agreed by the parties. As the matter progressed further towards the evidence rounds, several issues arose in the course of the proceedings, as recounted in the following paragraphs.

Procedural History

Confusion between copies of SDs filed by the Applicants

4 After some delay due to possible settlement negotiations, the Applicants were given up till 21 March 2013 to file their evidence. On 17 March 2013 the Applicants wrote to the Registrar and to the Opponents to request for a further one month extension of time (ie. up till 21 April 2013). However, in a separate letter dated 19 March 2013, the Applicants filed a set of documents described as "the Applicant's original duly executed Statutory Declaration" with the Registrar (the "**March SD**"). On 19 March 2013, the Registrar also issued a letter allowing the one month extension of time requested for (the letters crossed). The Opponents confirmed receipt of the Applicants' evidence on 20 March 2013.

5 However, on 17 April 2013, the Applicants filed a *second* set of documents also described as "the Applicant's original duly executed Statutory Declaration" with the Registrar (the "**April SD**"). The Opponents expressed puzzlement at the two sets of evidence, setting out the differences in format between the two copies. The Applicants explained that they had filed the first set of documents because they wanted to show that they had "finished the content of [their evidence] and its exhibits" but needed more time to "conform to formalities of requirements under Trade Mark Act (sic)". They explained that the first set was the same as the second set "except for formalities of requirements". The Registrar informed parties that the April SD would be treated as filed within the new deadline on 21 April 2013 and that the March SD would be disregarded. The Opponents were thus given an extended deadline up till 28 June 2013 to file their evidence in reply. The Opponents duly filed evidence in reply on 20 June 2013.

6 However, it was later discovered that there were material differences between the copies of the March SD and April SD that were served on the Opponents and the Registrar. The March SD served on the Opponents had a Chinese translation of a brochure (the "**Brochure**") in one of the exhibits, whilst the copy filed with the Registrar was an English copy. The April SD served on the Opponents had the English copy whilst the copy filed with the Registrar had the Chinese copy. The confusion led to the fixing of a further PHR on 30 September 2013 to resolve the issue. At this PHR, the Applicants finally clarified that there was a mix-up because the SDs were prepared in a rush. They then asked to inspect *their own SDs* as they did not have copies of what had been filed with the Registrar. However, despite being allowed to inspect the SDs, the Applicants did not follow up to make any arrangements to make copies of the SDs.

Applicants' failure to abide by Registrar's directions and Trade Marks Rules as to further evidence

7 After evidence had closed, the Registrar called parties for a PHR to sort out any outstanding issues prior to a full hearing. The Registrar gave directions for the Applicants to file their application for further evidence formally by 29 August 2013, as it was thought that they might need to file translated copies of the Brochure. However, instead of filing this application, the Applicants wrote a letter "confirm[ing] their intention" to file further evidence as to "a vital development pertaining to the Applicant's TM application of the subject mark in the UK which had not been submitted previously". This information was new and was not discussed at the PHR. Not surprisingly, the Opponents objected to the filing of this new evidence. As a result of this late information, the Registrar gave directions for written submissions to be filed on the issue of this further evidence. Eventually, submissions were filed by both parties and the Registrar issued a decision in writing on 5 November 2013, granting leave for further evidence to be filed, but limited to (a) translations of the foreign language documents as set out in Exhibits C and E of the Applicants' April SD and (b) the English/Ukrainian version of the Brochure in the April SD. However, leave was refused in respect of item (c), which was evidence pertaining to related opposition proceedings in the United Kingdom, including a Preliminary Indication of the UK Intellectual Property Office, dated 21 December 2007, and the Opponents' withdrawal of their trade mark application on 11 February 2008, as the Applicants had not explained why this evidence was not filed earlier in the course of proceedings when it was already available. A deadline for filing of the further evidence (on 26 November 2013) was given, as well as a costs order for the application.

8 Despite leave being granted to the Applicants in part, the Applicants expressed their unhappiness in a strongly worded letter to the Registrar on 25 November 2013, a day before the further evidence was due. In this letter, the Applicants alleged that the failure to allow item (c) (see [7] above) was a "violation and non-performance" of the Registrar's "duty as a civil servant to check such information in the first place and to consider the full facts of the case" and "a violation of the Applicant's right to be heard." The letter continued to ask the Registrar to reconsider the decision as to the further evidence. The Opponents responded to this letter, stating, *inter alia*, that they took "serious objection to the language used", that it is "totally unfounded, baseless and unwarranted". The Applicants did not respond to this letter but instead, filed and served their "Supplementary Statutory Declaration" on 13 February 2014 ("**Supplementary SD**"), about 2 ½ months after the Registrar's original deadline. Cumulatively, the issues related to this further evidence alone had the effect of delaying the proceedings by some 5 ½ months (August 2013 – mid-February 2014).

Negotiations between the parties

9 Between March 2014 and October 2014, the parties informed the Registrar that they were exploring the possibility of negotiating a global settlement. In view of this development, the matter was adjourned to give the parties time to try and resolve things

amicably. However, by 20 October 2014, the Opponents wrote to the Registrar informing that the parties were still unable to reach any settlement.

10 Further to this information, a PHR was fixed on 18 November 2014 to move the matter towards a hearing. Only the Opponents' counsel was present at the PHR. *After* the PHR, the Registrar's attention was drawn to a letter dated 15 November 2014 from the Applicants, requesting for a deferment of the PHR "by at least one month or preferably by six months". The Applicants claimed that their counsel would be on a business trip and that they had communicated with the Opponents and wished to negotiate and reach settlement within six months. However, no mention of any such negotiation was made at the PHR.

Applicants' failure to observe Trade Marks Rules in relation to Supplementary SD

11 Despite the Supplementary SD being filed late, the Applicants did not fulfil the requirements of the Rule 70 of the Trade Marks Rules (Rev. Ed. 2008) in the Supplementary SD, thus rendering the document inadmissible. The issue was highlighted by the Registrar to the Applicants in writing. The Registrar gave a window of three weeks for the Applicants to respond to the same. However, the Applicants failed to respond, and the matter was thus fixed for a hearing.

12 Rule 70 of the Trade Marks Rules (Rev. Ed. 2008) (which was in force at the time the Supplementary SD was filed) provides that:

Statutory declarations

70. Any statutory declaration filed under the Act or these Rules, or used in any proceedings under the Act or these Rules, shall be made and subscribed as follows:

(a) in Singapore, before any justice of the peace, or any commissioner for oaths or other officer authorised by law to administer an oath for the purpose of any legal proceedings;

(b) in any other part of the Commonwealth, before any court, judge, justice of the peace, notary public or any officer authorised by law to administer an oath there for the purpose of any legal proceedings; and

(c) elsewhere, before a Consul, Vice-Consul, or other person exercising the functions of a Singapore Consul, or before a notary public, judge or magistrate.

13 However, the Supplementary SD did not specify which country it was declared in and only bore the signature of the deponent, but not any notary public (if in a non-Commonwealth country), commissioner of oaths (if in Singapore) or any other relevant authority. The only other signatures found on the Supplementary SD were that of a translator from one "Alliance Profi Translation Agency" and one "Justin Tan Wei Loong,

Advocate & Solicitor, Singapore". As such, the Supplementary SD was treated as inadmissible for failure to comply with Rule 70 of the Trade Marks Rules.

Service of documents by Registrar in IPOS proceedings

14 Throughout the proceedings, various communication difficulties arose between the Applicants, the Opponents and the Registrar. In particular, the Applicants' agents wrote to the Registrar requesting that the Registrar send them letters *via* fax. However, as seen from the rules below, there is no obligation on the Registrar to comply with such request.

15 Rule 7(3) of the Trade Marks Rules (Rev. Ed. 2014) (which came into force on 13 November 2014) ("**TMR 2014**") provides that:

Service of documents

7. —(3) Where the Act or these Rules authorise or require any notice or other document to be given or sent to or served on any party by the Registrar or Registry, the Registrar or Registry may effect the giving, sending or service on the party —

- (a) by sending the notice or other document by post;
- (b) by sending the notice or other document by facsimile transmission; or
- (c) by electronic communication, by sending an electronic communication of the notice or other document using the electronic online system.

16 Rule 9(8) of TMR 2014 also provides that:

Address for service

9.—

(8) Anything sent to or served on a person at his address for service shall be taken to have been duly sent to or served on the person.

17 The "electronic online system" in Rule 7(3)(c) refers to IPOS' new electronic service system known as "**IP2SG**" (<https://www.ip2.sg>), which came into operation on or around 13 November 2014. In order to send and receive documents to and from this system, a user must register for a new account (which requires a SingPass). The Opponents are registered on this system, and therefore, correspondence with the Opponents can be sent and received through the system. However, the Applicants did not register for an account in the system. Sending by post is the default mode within the "IP2SG" system when a party does not have a registered account, and the system automatically prints a copy of the letter for post if this is the case. Rule 9(8) read with Rule 7(3) provides that anything sent by the Registrar by post to a party's address for service shall be taken to have been duly sent or served on the person. Essentially, the onus is on the party to keep his address for service updated for the purpose of the opposition proceedings.

18 Given the foregoing, all letters sent to the Applicants were sent by the Registrar to their address for service, which was stated in the "IP2SG" system at all relevant times to

be: "14 Robinson Road, #13-00, Far East Finance Building, Singapore 048545". However, the Applicants did not appear to respond to any letters towards the tail end of the proceedings. On 5 January 2015, IPOS received a return receipt from Singapore Post stating that the IPOS letter of 18 December 2014 was not delivered, with a check mark on the box "Moved". When the Registrar later communicated the Notice of Full Hearing dated 26 February 2015, Singapore Post sent another return receipt, received by IPOS on 16 March 2015, with a check mark against the box "No such name/company". Curiously, however, the Applicants had not recorded a change of address since 23 November 2012, according to IPOS records. Not surprisingly, the Applicants did not file nor serve any written submissions and/or bundle of authorities; neither did they appear at the hearing on 29 April 2015.

The hearing before IPOS on 29 April 2015

19 The matter was heard at IPOS on 29 April 2015. After hearing the Opponents' submissions, the Registrar directed that further submissions be filed in relation to two points: (1) whether a trade mark can have more than one dominant component and (2) whether an opponent is allowed to rely on evidence beyond the application date. These further submissions were due on 13 May 2015. Further to a subsequent request made by the Opponents in writing, the Registrar granted an extension of time for these submissions up till 27 May 2015. The written submissions were received by the Registry on 26 May 2015.

Grounds of Opposition

20 The Opponents rely on Sections 8(2)(b), 8(4)(b)(i) and 8(4)(b)(ii), and Section 8(7)(a) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (the "**Act**") in this opposition. The Opponents confirmed that they would not be relying on Section 7(1)(a) this ground in their letter of 14 August 2013.

Opponents' Evidence

21 The Opponents' evidence comprises of three statutory declarations by Daniele Lingua and Massimo Gaidano, proxy holders of the Opponents, all declared in Alba, Italy. The first two statutory declarations are both dated 17 October 2012 ("**Opponents' SD**") whilst the third is dated 11 June 2013 ("**Opponents' Reply SD**").

Applicants' Evidence

22 The Applicants' evidence comprises of one statutory declaration of Gennady Osiyanenko, the Director of the Applicants, declared on 22 March 2013 in Kyiv, Ukraine ("**Applicants' SD**"). The Applicants' Supplementary SD was disregarded for failure to comply with the Trade Marks Rules (see [11]-[13] above).

Applicable Law and Burden of Proof

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

Factual Background

24 The Opponents own several confectionery brands such as "Ferrero Rocher", "Nutella", "Tic Tac", "Kinder", "Kinder Bueno" and "Kinder Surprise". According to their evidence, the Opponents are ranked number four amongst the biggest chocolate and confectionery producers worldwide after Swiss Nestle and US-based Kraft and Mars. They have a global presence spanning throughout Europe, North America, South America, Africa, Asia and Oceania.

25 In Singapore, the Opponents have marketed and sold their products since about the financial year 1977-78. On 16 October 2006, Ferrero Asia Limited (Singapore Branch) was registered for the purpose of distribution of the Opponents' confectionery products. Prior to this, the distribution was carried out through other agents in particular IDS Marketing (Singapore) Pte Ltd ("**IDS Marketing**"). Sales of the Opponents' goods are carried out through a network of retailers including hyper markets, departmental stores, supermarkets, convenience stores, medical drug stores and petrol kiosks which are well spread around Singapore. The Opponents exhibited a table showing the annual sales turnover of goods from 1982 to 2011 and another table describing the advertisement and promotion of the Opponents' goods from 1999 to 2011. Several independent articles in print media in Singapore as well as a couple of surveys done in Singapore in late 2007 were tendered in support of the Opponents' goodwill and fame in the Singapore market. This evidence will be discussed in greater detail in relation to whether the Opponents enjoy goodwill and whether they are "well known" as defined in the Act.

26 The Applicants on the other hand founded their business in Kyiv, Ukraine, in 1996. The Applicants are one of the largest European manufacturers of confectionery products and sell their products in a number of Eastern European and Central Asian countries as well as Western markets such as the United States of America and Canada, as well as Israel. They have six confectionery factories located in Ukraine, Russia and Lithuania. According to their evidence, the Applicants produce confectionery products such as chocolate and jelly sweets, caramel, chocolate, biscuits, wafers, sponge cakes, swiss rolls and cakes, amounting to a production of 410,000 tons per year. The Applicants ended the 2008 financial year with a consolidated turnover of not less than US\$1,069 million. They also make reference to the annual sales of their confectionery products in Ukraine, stating that the approximate total value of such products sold has been almost US\$2,341 million. Their evidence shows them as being ranked No. 16 on the "Candy Industry's Global Top 100" chart dated January 2011. (The Applicants are ranked No. 3 on the same chart.)

27 The Applicants also enclose several documents which they submit as proof of the fact that they have "began to sell the products bearing the ROSHEN trade-marks in Singapore". These comprise of a letter from IE Singapore dated 19 September 2012 allowing the application for the Applicants to set up a Representative Office in Singapore

for one year, up till 18 September 2013. Another document is an Authorization Letter dated 22 October 2012 stating that the Applicants authorize one Brilliant Marketing Pte Ltd ("**Brilliant**") to import and retail ROSHEN confectionery products in Singapore with immediate effect. An invoice with details of Brilliant's purchase of the Applicants' goods was also enclosed. These facts are however beyond the Relevant Date and will not be considered.

Earlier Trade Marks

28 The Opponents cited the earlier Singapore registered trade marks "**NUTELLA**" (T7048827I), "**KINDER**" (T7462645E), "**TIC TAC**" (T7357891J) and "**MON CHERI**" (T7462647A) (although the last trade mark was not cited in the Opponents' Written Submissions) in support of the present opposition.

29 The Opponents also relied on the following trade marks, all registered in Class 30 in Singapore, in support of the present opposition (pp 4-5, Opponents' written submissions):

S/N	Trade Mark	Registration No.	Date
1	FERRERO ROCHER	T9006398B	15 Sep 1990
	Goods: Non-medicated chocolate confectionery.		
2		T0305569B	28 Jan 2003
	Goods: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flours and milled cereal products (except for fodder); bread, biscuits, cakes, pastry and confectionery, edible ice; honey, treacle; yeast, baking powder; cooking salt, mustard; pepper, vinegar, sauces; spices; ice for refreshment, cocoa, cocoa products, namely paste for cocoa beverages, chocolate paste, toppings and, including, chocolate toppings, chocolate, pralines, chocolate articles for Christmas-tree decorations, food products consisting of an edible chocolate casing filled with an alcoholic liquid, sweet products, pastries, including fine pastry and longlife pastry; chewing-gum, sugarless chewing gum, sugarless candies.		
3		T9302352C	1 April 1993
	Goods: Pastry, confectionery, chocolate, chocolate-based confectionery, chocolates, pralines, candies for food and cakes.		

4		T9302351E	1 April 1993
Goods: Pastry, confectionery, chocolate, chocolate-based confectionery, chocolates, pralines, candies for food and cakes.			
5	 (Words in mark, "FERRERO ROCHER")	T0508919E	30 May 2005
Goods: Biscuits, cakes, pastry and pastry products, chocolate and chocolate products, snacks, confectionery, ice-cream			

(the "Opponents' Marks")

30 The Applicants on the other had submit that they had registered several earlier marks in Class 29 and 30 for the word "ROSHEN", with the World Intellectual Property Organization designating various jurisdictions such as Armenia, Hungary, Poland, Russia, China, USA, Croatia, Albania, Austria, Bulgaria, Benelux, Belarus, United Kingdom, Italy, Ireland, Japan, France, Finland, Spain, Greece, Turkey, Egypt, Mongolia, Norway, Latvia, Australia, Kyrgyzstan, Turkmenistan, amongst others. The Applicants also state that the equivalent of the present Application Marks have been registered in the national trade mark offices of Azerbajdjan, Kazakhstan, Moldova, Taiwan, China, the USA and the Russian Federation.

MAIN DECISION

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

31 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.

32 At the hearing, the Registrar asked if the Opponents were relying on *all* the Opponents' Marks, given that their written submissions focused only on the use of "Ferrero" and "Rocher" and not the other device elements in the other Opponents' Marks. Counsel for the Opponents clarified that they would be relying *mainly* on the " **FERRERO ROCHER** " mark (T9006398B). They submitted that the dominant feature in the other marks were the words "Ferrero" and "Rocher".

33 Given the above, I first consider whether the " **FERRERO ROCHER** " mark (T9006398B) (the "**Opponents' Word Mark**") is similar to the Application Mark.

Whether a mark can have more than one dominant feature such that comparison may be made on the basis of either of these dominant features

34 In their further written submissions, the Opponents submitted that both "FERRERO" and "ROCHER" cannot be said to be more dominant than the other. However, they also submit that "ROCHER" is "distinctive enough to be registered on its own", having been registered in other jurisdictions such as the United Kingdom. In Singapore, no registration for "ROCHER" on its own has been brought to my attention. In some parts of their earlier written submissions, the Opponents suggest that the comparison should be made between the "ROCHER" element in the Opponents' Word Mark, and the Applicants' ROSHEN Mark (see paragraphs 76, 89, of the Opponents' written submissions).

35 The case law in Singapore does not support the conclusion that where a mark has more than one dominant feature, comparison may be made on the basis of *either of* these dominant features. Whilst it is possible for there to be more than one dominant feature (depending on the facts), if these features are to be given special regard, the court must necessarily find that the other features in the competing marks to be *less* dominant or even *relatively insignificant*.

36 In *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another and another appeal* [2013] SGCA 65 ("*Staywell*") at [23], the court has stated that:

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

37 In *Staywell*, "REGIS" was considered to be the dominant and distinctive component of both marks "ST. REGIS" and "PARK REGIS" by the trial judge – and the Court of Appeal held that she was perfectly entitled to come to that view (*Staywell* at [31]). The Court of Appeal observed in the same paragraph that the trial judge had

considered the "ST." and "PARK" portions of the competing marks "not as dominant as the "REGIS" portion" although they "were not to be ignored".

38 In *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] SGCA 26 ("*Hai Tong*") the Court of Appeal stated that to qualify for this "special regard", the distinctive or dominant components of the mark must be shown to be "dominant", or, alternatively, the other components of the mark must be "of negligible significance" (*Hai Tong* at [62](b)). There, the Court of Appeal agreed with the High Court judge that the textual component of the composite mark "LADY ROSE" was the dominant component, and considered the device component (a single simple stylised rose) to be "relatively insignificant" (*Hai Tong* at [65]).

39 In *Super Coffeemix Manufacturing Ltd v Unico Trading Pte Ltd and another and another appeal* [2000] SGCA 29 ("*Super Coffeemix*"), the Court of Appeal considered whether the defendants' "INDOCAFE Coffeemix" mark had infringed the plaintiffs' "SUPER & DEVICE COFFEEMIX" mark. It was held that the word "COFFEEMIX" was an essential feature of the registered mark (ie. the plaintiffs' mark). In deciding whether there was infringement, the court held at [35] that

The fact that the defendants have inserted their own name to the word mark of the plaintiffs' does not necessarily mean that the defendants have not infringed the mark of the plaintiffs. *The ultimate question is how significant that insertion is to the whole mark and whether it has sufficiently distinguished the defendants' mark from that of the plaintiffs...*

(Emphasis added)

40 In the present case, the Opponents do not assert that the word "FERRERO" is less dominant or relatively insignificant in comparison to "ROCHER". Their further written submissions at paragraph 2-3 state their position as follows:

2 ...Considering both "FERRERO" and "ROCHER" enjoys distinctiveness in the ordinary and non-technical sense, the Opponent agrees with the Registrar that **one cannot be said to be more dominant than the other.**

3 However, the Opponent submits that even then, this is not to say that individual components cannot have its own distinctiveness. Just as "FERRERO" is a distinctive component of the mark, "ROCHER" is **equally distinctive** of its own right...

(Emphasis added)

41 Where both elements are equally dominant or significant in relation to each other, it will not be possible to compare just one of these elements (ie. "ROCHER") against the Applicants' ROSHEN Mark. In order for me to do so, the element "ROCHER" must be

considered to be dominant *relative to* the other elements in the mark as a whole. Only then can "special regard" be paid to it in determining similarity. In the present case, the Opponents themselves do not draw this distinction between "ROCHER" and the other elements within the Opponents' Word Mark, or any of the other Opponents' Marks for that matter. In view of the foregoing, I find that there is *no dominant component* in the Opponents' Word Mark. I also note a recent decision by IPOS (which was handed down only after this case was heard) in *The Polo/Lauren Company, L.P. v United States Polo Association* [2015] SGIPOS 10 at [79]-[80], where it was similarly decided that there was no dominant component in the application mark, because as a whole *neither* the device *nor* the text in the application mark was more outstanding or memorable than the other. (For completeness, I should add that this decision is presently on appeal.)

Decision on Section 8(2)(b)

Similarity of Marks – T1114593Z

42 I now turn to examine the visual, aural and conceptual similarity between the competing marks, which are set out below for convenience only. The Opponents' submissions focused on the Opponents' Word Mark, even though they asserted continued reliance on all of the Opponents' Marks. Since the Opponents' line of argument relies on the similarity of the word elements in each of the Opponents' Marks, if the argument on similarity fails in respect of the Opponents' Word Mark, the other claims of similarity are also likely to fail.

Opponents' Word Mark	Applicants' ROSHEN Mark
FERRERO ROCHER	

43 The assessment of marks similarity is mark-for-mark without consideration of any external matter. This means that at the marks similarity stage, this even extends to not considering the relative weight and importance of each aspect of similarity having regard to the goods. The considerations of the importance of each aspect of similarity, depending on the circumstances of the case, are deferred to the confusion stage of the inquiry, where the court assesses the effect of objective similarity between the marks, on the perception of the consumers. (See, generally, *Staywell* at [20]).

Distinctiveness of the Opponents' Word Mark

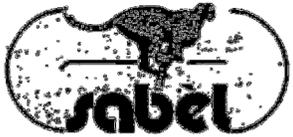
44 The Opponents submit that because the Opponents' Word Mark is "highly distinctive", "a substantially modified sign would still possibly be regarded as similar to it", and that the later mark needs to meet a high threshold to show that it is sufficiently dissimilar, citing the case of *Sarika Connoisseur Café Pte Ltd v Ferrero SpA ("Ferrero CA")* at [36] (See Opponents' earlier written submissions at [83]). The Opponents also drew my attention to the fact that they had registered the word mark "ROCHER" in the United Kingdom. Details of these registrations are found in the Opponents' SD, at [29]. I find that I am unable to consider these registrations for the purpose of assessing

distinctiveness because each mark should be assessed on its own and not by reference to other marks. Furthermore, these marks are not registered in the Singapore Trade Marks Registry.

45 The Court of Appeal in *Ferrero CA* at [36] held:

In *Bently & Sherman* at pp 866-867, the learned authors state that the question of whether marks are similar will oftentimes depend on the inherent or acquired distinctiveness of the mark for the goods for which it has been registered. Therefore, if the trade mark is highly distinctive, it follows that a sign which has been substantially modified may possibly still be regarded as similar. For such trade marks, then, there is a high threshold to be met in creating a sign or a mark sufficiently dissimilar to it. Inherently distinctive marks include those which comprise inventive words without any notional or allusive quality, an example being the word “Volvo”: *Polo (CA)* ([14] *supra*) at [23]. The distinctive quality is a factor to be considered in determining similarity between the mark and the “Nutello” sign. As such, we agree with the Judge that merely changing the last letter of the “Nutella” word mark from “a” to “o” to form the “Nutello” sign would not suffice to meet this high threshold to render the “Nutello” sign dissimilar from the “Nutella” word mark.

46 In *Bently & Sherman* (4th Edition, 2014) at p 984, this principle cited above has not changed. The learned authors refer to the following cases where it was found that the competing marks were similar despite “substantial modification” by the later mark:

Case name	Citation	Earlier Mark	Later Mark / Sign
<i>Sabel v Puma</i> ("Sabel")	Case C-251/95 [1997] ECR I-6191		
<i>Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV</i> ("Lloyd Schuhfabrik")	Case C-342/97 [1999] ECR I-3819	Lloyd	Loint's
<i>Canon Kabushiki Kaisha v MGM</i> ("Canon")	Case C-39/97 [1998] ECR I-5507	Canon	Cannon

47 In *Ferrero CA*, the following competing marks were found to be similar because the later sign fell short of the high threshold to render it dissimilar to the earlier mark (see also [45] above):

Case name	Citation	Earlier Mark	Later Sign
<i>Ferrero CA</i>	[2013] 1 SLR 531	NUTELLA	

48 In the present case, I find that "FERRERO ROCHER" is not a common English word (unlike "polo") or phrase, and enjoys a high level of distinctiveness, similar to that of "Nutella". It would follow, then, that the Applicants' ROSHEN Mark needs to cross a high threshold before it can be considered dissimilar to the Opponents' Word Mark. In some of the cases cited above, the similarity of the competing marks is of a much greater degree (as with "Canon"/"Cannon" and "Nutello"/"Nutella"), whilst in other cases, the similarity is of a lesser degree (as with "Loint's"/"Lloyd"). I also bear in mind that in the European context, the courts take a "global assessment" approach to marks similarity which considers how the mark is used in context, whilst in the Singaporean context, this would be considered an "extraneous factor" which, depending on the factor in question, may be considered at the confusion stage of the inquiry.

Visual Similarity

49 I find that the Applicants' ROSHEN Mark meets this high threshold in order to be considered dissimilar to the Opponents' Word Mark. Firstly, the Opponents' Word Mark is comprised of two words, both of which are of equal size and of the same font, whilst the Applicants' ROSHEN Mark comprises just one word. The viewer's eye would perceive both words in the mark at the same time, not giving particular importance to one word over the other. In the cases of *Sabel*, *Canon* and *Ferrero CA*, the later mark/sign was much more similar to the earlier distinctive mark. For example, in *Sabel*, the later mark/sign had a similar cat motif in common. In *Canon* and *Ferrero CA*, there was only one letter of difference between the competing marks. In *Lloyd Schuhfabrik*, whilst the words were different, both marks/signs consisted of just one word. Emphasis was also placed on the aural similarity between these two marks, which for the present case is considered below. However, in the present case, the competing marks have a different number of words and the only point of similarity is that one of the words in the Opponents' Word Mark, "ROCHER", has a few letters which are similar to the Applicants' ROSHEN Mark, ie. "R", "O", "H" and "E". However, the presence of the word "FERRERO" in the Opponent's Word Mark simply cannot be ignored. When viewed in totality, I am unable to find visual similarity between the competing marks in this case. In my view, the Applicants' ROSHEN Mark has crossed the high threshold to be considered dissimilar to the Opponents' Word Mark.

Aural Similarity

50 I find that the Opponents' Word Mark and the Applicants' ROSHEN Mark have a low degree of aural similarity, unlike the competing marks in *Lloyd Schuhfabrik*. The Opponents' Word Mark has 5 syllables, "FER-REH-ROW-ROW-SHER". The Applicants' ROSHEN Mark has 2 syllables, "ROW-SHEN". The similarity comes in the form of the 2 similar-sounding syllables in the competing marks, "ROW" and

"SHER"/"SHEN". However, overall, the additional syllables in "FER-REH-ROW" serve to differentiate the Opponents' Word Mark from the Applicants' ROSHEN Mark.

Conceptual Similarity

51 I find that the competing marks are not conceptually similar. No submissions were made as to the actual of meaning of the plain word "FERRERO ROCHER". From the perspective of the average Singaporean consumer, the words "FERRERO ROCHER" and "ROSHEN" are meaningless words that do not convey any particular idea or concept. It should be remembered that the conceptual comparison is taken only at face value and one does not consider the mark as it is placed on the goods at this stage of the inquiry. Where both marks would appear meaningless, no conceptual similarity can be found: see *Ferrero CA* at [34], citing *Hyundai Mobis v Mobil Petroleum Company, Inc* [2007] SGIPOS 12.

52 As a whole, I find that there is no similarity between the Opponents' Word Mark and the Applicants' ROSHEN Mark (ie. T1114593Z).

Overall Similarity

53 The Court of Appeal in *Staywell* at [17] held that

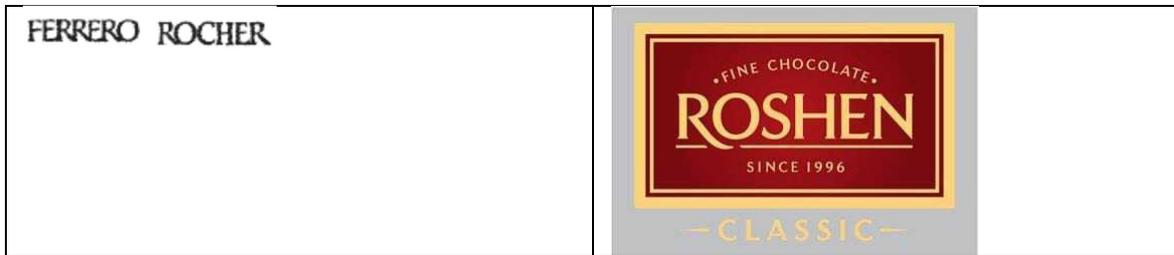
The court must ultimately conclude whether the marks, when observed in their totality, are similar rather than dissimilar. The three aspects of similarity are meant to guide the court's inquiry but it is not helpful to convert this into a checkbox exercise in which a tick, however faint it might be, in any one box must compel the court to find that the marks are similar when a sensible appraisal of the marks as a whole would show otherwise.

In the present case, I have found that there is a low degree of aural similarity, but no visual or conceptual similarity. On the whole, aural similarity between the marks may be easily displaced by the additional syllables present in the Opponents' Word Mark and the visual and conceptual differences between the competing marks. Therefore, on the whole, I find that they are dissimilar.

Similarity of Marks – T1114594H

54 I now turn to address the issue of similarity between the Opponents' Word Mark and the Applicants' Mark, T1114594H. The marks are reproduced below for convenience:

Opponents' Word Mark	Applicants' ROSHEN CLASSIC Mark
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Visual Similarity

55 I find that the competing marks are not visually similar, given that the Opponents' Word Mark comprises of two words, whilst the Applicants' ROSHEN CLASSIC Mark comprises many words, the largest of which is the word "ROSHEN". Even if the average consumer only recalls the word "ROSHEN" in the Applicants' mark due to his imperfect recollection, the presence of the word "FERRERO" in the Opponents' Word Mark has equal prominence compared to "ROCHER", and cannot be ignored. Despite the distinctiveness of the Opponents' Word Mark, the Applicants' ROSHEN CLASSIC Mark meets the high threshold to be considered dissimilar to the Opponents' Word Mark. In addition, there are too many other elements within the Applicants' ROSHEN CLASSIC Mark such as "Fine Chocolate", "Since 1996", "Classic", and embellishments to the border and the background of the mark that render it visually different from the Opponents' Word Mark, which has none of these elements in common.

Aural Similarity

56 The Applicants' Mark contains the words "FINE CHOCOLATE" (4 syllables), "SINCE 1996" (6 syllables) and "CLASSIC" (2 syllables) in addition to the larger word "ROSHEN" (2 syllables). The presence of these words give the Applicants' ROSHEN CLASSIC Mark a total of 14 syllables, as compared to the Opponents' Word Mark's 5 syllables. If the Applicants' mark is viewed as "ROSHEN", then my analysis at [50] above applies here too. At best, the competing marks here enjoy a low degree of aural similarity.

Conceptual Similarity

57 I find that the competing marks are not conceptually similar. It bears repeating that the notion of conceptual similarity is one that examines the mark at face value, without considering its accompanying goods and services (see [51] above). As also mentioned at [51] above, no submissions were made as to the actual meaning of the plain word "FERRERO ROCHER". From the perspective of the average Singaporean consumer, the plain word "FERRERO ROCHER" is a meaningless word that does not convey any particular idea or concept. On the other hand, the Applicants' ROSHEN CLASSIC Mark, on the other hand, conveys that "ROSHEN" is a type of "fine chocolate" that has been around "since 1996", given the presence of these words in the mark itself. Conceptually, therefore, the Applicants' ROSHEN CLASSIC Mark conveys the concept of an established chocolate brand that has been present since 1996.

Overall Similarity

58 In view of the dicta in *Staywell* at [17] (reproduced at [53] above), I consider the overall similarity of the competing marks. In totality, the low aural similarity between the competing marks can easily be displaced by the additional syllables present in the Opponents' Word Mark and the visual and conceptual differences between the competing marks. Therefore, on the whole, I find that they are dissimilar.

The Opponents' Marks – T0305569B, T9302352C, T9302351E and T0508919E

59 The Opponents did not make submissions on these marks individually, but asserted continued reliance on them for the purpose of the present proceedings. The Opponents' written submissions simply refer to all the marks collectively as "the Opponent's ROCHER Marks." The distinctiveness of all these marks hinges upon the distinctiveness of the words "FERRERO" and "ROCHER" only, and there is no discussion on the significance of the different word/device elements in each of the Opponents' Marks (see [71]-[85] of the Opponents' written submissions).

60 In addition, the Opponents do not make any submissions on similarity between these marks and each of the Applicants' Marks, in the sense of addressing each of these marks individually, with regard to the different word/device elements in each of the Opponents' Marks. As explained above at [42], given that there is no similarity between the Opponents' Word Mark and the Applicants' Marks, the claims of similarity as to the other Opponents' Marks are also likely to fail.

Conclusion on Section 8(2)(b)

61 Based on the foregoing, I find that the Opponents' Word Mark (i.e. T9006398B) is not similar to either of the Applicants' ROSHEN Mark or Applicants' ROSHEN CLASSIC Mark (i.e. T1114593Z and T1114594H). In view of this conclusion, I do not need to examine whether the Opponents' goods and/or services are similar to those of the Applicants' goods and/or services or whether there will be a likelihood of confusion between them.

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

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

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

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.

64 The Court of Appeal in *The Singapore Professional Golfers' Association v Chen Eng Waye* [2013] SGCA 18 ("*Professional Golfers*") at [20] affirmed the three basic elements for passing off in *Reckitt & Colman Products Ltd v Borden Inc and Others* [1990] WLR 491: that the claimant must prove (1) he has goodwill attached to his product or service (2) a misrepresentation by the defendant that his goods are the claimant's goods or emanate from a source that is economically linked to the claimant and (3) damage to his goodwill as a result of this misrepresentation.

65 The relevant date to consider is the date on which the Applicants' conduct complained of started: *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 2 SLR 550 ("*CDL*") at [34]; *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2009] SGCA 53 ("*City Chain*") at [63]. In the context of opposition proceedings, the relevant date on which to determine goodwill is the date of the application for registration of the junior mark: *Staywell* at [130] (see also IPOS decision in *Starwood Hotels & Resorts Worldwide, Inc and Another v Staywell Hospitality Group Pty Ltd* [2011] SGIPOS 7 at [33]). In the present opposition, the relevant date to assess goodwill would be the date on which the Registered Mark was applied for, i.e. 18 October 2011.

66 Following the considerations set out by the Court of Appeal in *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR 216 ("*Amanresorts*") at [42]-[66], I consider (1) the relevant sector of the public in Singapore and (2) whether the Opponents' Marks have an attractive force for custom amongst the relevant sector of the public. As for the third consideration, ie. the type of business in which such goodwill exists, this is not relevant for the present case given the Opponents' submission as to the relevant sector of the public (see [67] below).

The relevant sector of the public in Singapore

67 The Opponents submitted that the relevant sector of the public in Singapore is the general public at large. The evidence in the present case supports the Opponents' submission and my analysis will therefore proceed on this basis.

Whether the Opponents' Marks have an attractive force for custom amongst the relevant sector of the public

68 The Opponents have tendered substantial evidence, including survey evidence, to demonstrate that the marks are an attractive force for custom amongst the general public at large. Whilst the survey evidence is of limited use, the other evidence shows that the Opponents do enjoy goodwill in relation to its marks in Singapore amongst the general public at large. The evidence shows a clear chain of distribution from the Opponents' subsidiary to various mass market grocery stores in Singapore. The Opponents' sales figures are suitably impressive, ranging in the millions of dollars, consecutively, for the past 23 years. The figures for advertisement and promotion are also in the hundreds of thousands, up till 2 million, for the past 11 years. These numbers are also supported by samples of invoices and print media advertisements. In addition, the Opponents' Word Mark has received very generous and varied mentions in the local press for some 18

years, ranging from business news to crime news to eulogies to banal expressions and analogies.

69 The details of such evidence are contained in the Opponents' SD and the Opponents' Reply SD, as follows:

- (i) The Opponent's goods have been marketed and sold in Singapore since about the financial year 1977-78 *via* one IDS Marketing (Singapore) Pte Ltd ("**IDS**");
- (ii) The Opponents' established a local presence on or about 16 October 2008 *via* Ferrero Asia Limited (Singapore Branch), a foreign company registered in Singapore ("**Ferrero Singapore**");
- (iii) Sales of the Opponents' goods carried out through a network of retailers which includes hyper markets, departmental stores, supermarkets, convenience stores, medical drug stores and petrol kiosks which are well spread around Singapore, with supporting documents:
 - a) In this regard, I find that the Opponents have tendered evidence showing that from 1990-1995, there is at least one invoice per year showing that the Opponents' distributor in Hong Kong (prior to Ferrero Singapore) have sold goods to C.C.A. Snack Foods (Asia) Pte Ltd and Harpers Trading (S) Pte Ltd ("**Harpers**"), both of which having Singapore addresses and described as the Opponents' distributors;
 - b) From 1999 to 2005, there is at least one invoice per year (sometimes two) showing that Ferrero Singapore has sold goods to Harpers, Diethelm Singapore Pte Ltd and IDS (Consumer Division);
 - c) Receipts showing a continuous chain of sales from Ferrero Singapore to IDS to local grocery outlets such as NTUC Fairprice Co-Operative Ltd ("**NTUC**"), Cold Storage Singapore (1983) Pte Ltd, Watson's Personal Care Stores Pte Ltd, Giant Hypermarket (Head Office) ("**Giant**") c/o Cold Storage Singapore; 7 Eleven HQ, Hock Seng Food Pte Ltd, Guardian Health & Beauty c/o Cold Storage Singapore (1983) Pte Ltd, Isetan (Singapore) Ltd.
- (iv) The annual sales of goods bearing the Opponents' Marks:

Fiscal Year [from 1 September to 31 August]	Amount (Not less than SGD\$)
1982/83	1,000
1983/84	200
1984/85	30,000
1985/86	250,000
1986/87	350,000
1987/88	1 million

1988/89	3 million
1989/90	3.2 million
1990/91	3 million
1991/92	3.2 million
1992/93	3.5 million
1993/94	4.5 million
1994/95	4 million
1995/96	6 million
1996/97	8.5 million
1997/98	4.5 million
1998/99	3.5 million
1999/00	4.5 million
2000/01	4.7 million
2001/02	4 million
2002/03	4.6 million
2003/04	4.4 million
2004/05	6.5 million
2005/06	8 million
2006/07	13 million
2007/08	15 million
2008/09	18 million
2009/10	18 million
2010/11	19 million

- (v) The amounts spent on advertising and promotion of goods bearing the Opponents' Marks, with supporting documents:

Fiscal Year [from 1 September to 31 August]	Amount (Not less than SGD\$)
1999/00	800,000
2000/01	480,000
2001/02	520,000
2002/03	530,000
2003/04	520,000
2004/05	650,000
2005/06	600,000
2006/07	1 million
2007/08	1.1 million
2008/09	1.3 million
2009/10	1.8 million
2010/11	2.0 million

- a) Samples of receipts showing payment from the Opponents to various marketing agencies such as Diethelm Singapore Pte Ltd, Maxxus Communications Singapore ("*Maxxus*"), Mindshare Singapore;
 - b) Samples of receipts showing payment by Maxxus to MediaCorp TV for various slots in a variety of television shows ranging from drama, news, variety, etc;
 - c) Copies of photographs showing point-of-sales marketing material from 2006 to 2009; and
 - d) Copies of photographs showing advertisements carried out by Ferrero Singapore and third party trade customers such as NTUC and Giant in the local print media from 2008 to 2012.
- (vi) Copies of local newspaper reports discussing news related to the Opponents:
- a) 11 Feb 1990 – The Straits Times ("**ST**") article describing the Opponents' goods as a popular chocolate gift;
 - b) 27 January 1991 – ST article on how "cheaper chocolates in the shape of eggs or gold coins are being gradually replaced by the more expensive Ferrero Rocher, Almond Roca and Swiss chocolates in middle-income homes" during the Chinese New Year season;
 - c) 28 October 1997 – ST article about two thieves who stole Ferrero Rocher chocolates from a warehouse in Pasir Panjang belonging to Harpers Trading;
 - d) 1 August 2002 – ST article where a writer says in jest, "I will hear you and I will rip you to shreds with my bare hands the same way I tear open a Ferrero Rocher";
 - e) 17 December 2001 – ST article on MTV VJ Utt's career, and that amongst other things he is "the new Ferrero Rocher man", taking over from Talentime host Allan Wu;
 - f) 8 September 2003 – ST article on Ferrero Rocher-distributor Diethelm's plans to expand in Singapore;
 - g) 14 December 2003 – ST article on the challenges faced by service staff in various stores before the Christmas period, including a Cold Storage service manager, who talks about his experience having to spend Christmas the previous year at Cold Storage amidst "mountains of Ferrero Rocher" [chocolates], cookies and cakes;
 - h) 14 September 2004 – Business Times article about Hosen, a Singapore company that has 3 business divisions which include distributing for brands such as Pringles, Ferrero Rocher, and Nescafe;
 - i) 15 October 2005 – ST article about the death of a young corporal. The article mentions Ferrero Rocher chocolates as one of his favourites;

- j) 10 February 2006 – ST article referring to a Ferrero Rocher commercial where a mountain of Ferrero Rocher is used in a wedding setup instead of a traditional champagne fountain;
- k) 5 April 2006 – ST article (Mind Your Body section) which interviews his helper (Ms Tandoc) describing how the former deputy prime minister, S Rajaratnam, liked to frequent Cold Storage and buy Ferrero Rocher chocolates;
- l) 30 August 2006 – ST article on Malaysian pop star Siti Nurhaliza's wedding, where the goody bag for guests contained flower-shaped sugar cookies, two Ferrero Rocher chocolates in a round box, topped off with an acrylic strawberry;
- m) 5 October 2006 – ST article describing chocolate biscuit Hanuta as being "mass-market European snacks by Ferrero, the same Italian confectioner that gave the world the ubiquitous Ferrero Rocher chocolates";
- n) 16 December 2007 – ST article on the various Christmas log cakes available for sale, with one recommendation said to taste like "one of the popular chocolate treat of Ferrero Rocher";
- o) 9 April 2008 – ST article which is an interview with one Hansen Bay, the founder of Rope Sports Singapore, where he describes his "indulgences" as "Durians and Ferrero Rocher chocolates"; and
- p) 5 October 2008 – ST article describing how sweets and chocolates are repackaged so that they look presentable as gifts, and one interviewee describing that he had "resorted to giving friends and family boxed chocolates such as Ferrero Rocher" as he could not bear to present sweets packaged in plain boxes.

Whether a survey conducted after the application date is relevant to the present case

70 The Opponents also tendered two sets of survey evidence: (a) a Milward Brown survey conducted between 25 July 2007 to 28 September 2007 (the "**Milward Survey**") and (b) a Nielsen Company survey conducted in 2012 (the "**Nielsen Survey**"). The Opponents submitted that the Nielsen Survey, despite being dated *after* the application date, should be taken into consideration for the present proceedings. In their further written submissions, the Opponents submitted that this is in line with the Court of Appeal decision in *Tiffany & Co v Fabriques de Tabac Reunies SA* [1999] 2 SLR(R) 541 ("**Tiffany**").

71 In *Tiffany*, the Court of Appeal was asked to reconsider the High Court's decision in respect of Section 12(1) and Section 15 of the old Singapore Trade Marks Act 1999 ("**TMA 1999**"). Section 12 of the TMA 1999 read as follows:

Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it shall apply in writing to the Registrar in the prescribed manner for registration in Part A or B of the

register.

72 Section 15 of the TMA 1999 read as follows:

It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice or would be contrary to law or morality, or any scandalous design.

73 The Court of Appeal held that the relevant date for considering the issues between the parties should not be strictly set as the date of Fabriques' application for the trade mark registration, which was in November 1989. The facts of the case were that the trade mark was actually registered in November 1997, 8 years after it was applied for. The Court of Appeal held that whether the court should take into account facts occurring after the date of application to register the mark had to depend on each unique set of facts that arose and the court had to be aware of the realities of the situation at the date after the mark was actually registered.

74 I find it difficult to apply this decision to the present case for a few reasons. Firstly, the present case concerns *relative* rights, in particular, Section 8(7)(a) of the Act for passing off, whilst the Court of Appeal in *Tiffany* was considering whether the applicants' trade mark should not be registered in view of certain *absolute* grounds of refusal. Section 15 of the old Singapore Trade Marks Act 1999 – which was taken from Section 11 of the UK Trade Marks Act 1938 – was reformulated as Section 3(3)(b) of the UK Trade Marks Act 1994, which was in turn incorporated into Singapore law by way of Section 7(4)(b) of the current Trade Marks Act. When the court considers relative rights, the issue is whether the later mark conflicts with an earlier trade mark or an earlier right belonging to another party in the sense that its use is likely to cause confusion. When the court considers absolute rights, the issue is whether the mark that is sought to be registered is *per se* deceptive (see Ng-Loy Wee Loon, *Law of Intellectual Property of Singapore* (2nd Edition, 2014, at [21.5.1]-[21.5.2])). In the latter situation, the focus is on the application mark alone and whether it should be on the Trade Marks Register in the first place. In the former, the goodwill of the opponent must have accrued before the date of the application of the junior mark to justify the junior mark's refusal from the Trade Marks Register. To allow the opponent to prove that it had goodwill after the application date but not the applicants to do the same would seem unfair to the applicants, since the focus of Section 8 is which mark has better rights relative to each other.

75 Secondly, there is more recent authority based on Section 8(7)(a) of the current Trade Marks Act that confirms that the relevant date to take into account is the date on which the mark is applied for: see *Staywell*, referred to at [65] above.

76 Thirdly, it should be noted that *Tiffany* involved special facts, in that there was a long time lapse between the application by the respondents and the date when the appellants' opposition was rejected by the Assistant Registrar, for about 8 years (1989 – 1997). In this time, the appellants had commenced business in Singapore in two

locations, and had been operating its stores here for 6 years. It was in light of these facts that the court held that the more realistic approach is to take into account the situation as in 1997 rather than the situation in 1989 (see *Tiffany* at [56]-[57]).

77 Finally, it should be noted that the court held for the appellants on the basis that there was confusion or deception in 1989, not 1997, and that nothing turned on the choice between both dates: *Tiffany* at [56]. The court's decision in this regard is therefore *obiter dicta*.

78 In view of the above, I will consider only the survey that pre-dates the application date of 18 October 2011. In Singapore, survey evidence remains relevant in proving that a mark is well known: see, *Ferrero SpA v Sarika Connoisseur Cafe Pte Ltd [2011] SGHC 176* ("*Ferrero HC*") at [155]. *Ferrero HC* was not overturned on this point on appeal (see *Ferrero CA* at [12]).

79 The Milward Survey was done between 25 July to 28 September 2007, some 4 years before the relevant date of 18 October 2011. It surveyed a sample size of 1,000 people, both male and female, aged 11 to 44 in Singapore in a door-to-door (ie. face-to-face) survey. The survey had several primary objectives, amongst which was "to estimate the penetration of different kinds of chocolates including pralines, bite size, bar and block chocolates in Singapore" and to "gauge the standing of Ferrero Rocher as well as Kinder in this segment (the "countline segment)". The Opponents highlighted only the portion in relation to "Brand Awareness" (on page 63 of the document) to me at the hearing.

80 In relation to the "Brand Awareness" segment of the survey, the participants were asked two questions:

- (i) "Please think about chocolates. What brands of chocolates have you seen or heard of? Please mention all those that come to mind."
- (ii) "Now I'd like you to look at these brands of chocolates. Which of these brands of chocolates have you ever seen or heard of, including brands that you just told me? Which others?"

81 From these questions, the survey results (as explained by the Opponents at the hearing) showed that 52 respondents were able to state "Ferrero Rocher" in response to question (i) whilst 97 respondents were able to state "Ferrero Rocher" in response to question (ii). Respondents who personally bought or consumed chocolates in the past 6 months formed the base of this survey. In another illustration to the responses to question (i), the survey shows that 17% of respondents were able to name "Ferrero Rocher" "at first mention" whilst 52% were able to name "Ferrero Rocher" on "total mention", which I understand to include responses to question (ii) (ie. respondents were "aided" in their answers by question (ii)).

Conclusion on survey evidence tendered in this case

82 Bearing in mind that the relevant sector of the public in the present case is the

general public at large, I am unable to see how the Milward Survey is useful because it seems to focus on chocolate consumers who personally bought or consumed chocolates in the past 6 months. I am mindful of the High Court's caution in accepting the plaintiff's survey evidence to show that the "general public" recognized the shape of chocolate wafers, when the survey appeared targeted at respondents who consumed chocolate on a weekly basis (see *Societe Des Produits Nestlé SA and another v Petra Foods Ltd and another* [2014] SGHC 252 at [198] (although this decision is currently pending appeal)).

83 As for the Nielsen Survey, the Opponents explained that they were relying on two graphs that showed the Opponents have (i) a market share of 29.7% in 2010 and 28.5% in 2011 and (ii) a volume and value share of 15.9% in 2010 and 16.6% in 2011. The graphs show that the Opponents have a much larger percentage share of the market compared to their competitors, in particular, Cadbury Dairy Milk. This survey shows the Opponents having the lion's share of the chocolate market. However, there is no information about how the percentages were obtained, or how the survey was conducted. It is therefore difficult to draw any firm conclusions from the Nielsen Survey, even if it were taken into consideration. As explained earlier at [70]-[78], this survey is excluded from consideration because it post-dates the application date.

Conclusion on goodwill

84 Despite the limited usefulness of the Opponents' surveys, I find that the Opponents' Word Mark enjoys goodwill in relation to the general public at large in Singapore, given the substantial evidence of sales records, advertisement expenditure and press coverage (see [68]-[69]). No submissions were made specifically in relation to goodwill in the other Opponents' Marks. However, I am prepared to conclude that insofar as the words "FERRERO ROCHER" appears on the Opponents' Marks, they are likely to enjoy goodwill as well, since goodwill concerns the protection of the business, rather than protection of the marks *per se*. As stated in *The Singapore Professional Golfers' Association v Chen Eng Waye* [2013] SGCA 18 at [21] (citing *CDL Hotels* at [45]):

...The action for passing off is not directly concerned with the protection of a mark, logo or get-up of a business. That is more the province of the law of trade marks. Rather, passing off is concerned with protecting the goodwill between a trader and his customers.

Misrepresentation

85 The Court of Appeal in *Amanresorts* at [69]-[93] considered the following in determining whether there was actionable misrepresentation: (1) the content of the misrepresentation (2) the target audience of the misrepresentation and (3) whether the misrepresentation caused confusion. In relation to (2), the target audience would be the general public at large in Singapore (as discussed above at [67]).

Content of the misrepresentation

86 The Opponents submitted that the content of the misrepresentation was the Applicants' choice of marks in respect of the goods.

Whether the misrepresentation caused confusion

87 Confusion is an *essential element* of the tort of passing off, although it is open for the court to infer a likelihood of confusion: see *Amanresorts* at [77]. In the present case, I have found at [42]-[61] above that the Opponents' Word Mark is not similar to the Applicants' Marks, and therefore, the question of whether there is a likelihood of confusion does not arise. Even if the goods are similar, the differences between the competing marks in this case would be sufficient for consumers to distinguish the Opponents' goods from the Applicants' goods. As such, I find that the element of likelihood of confusion is not satisfied and therefore there can be no actionable misrepresentation in the present case.

Conclusion on Section 8(7)(a)

88 Given the foregoing, I do not need to further consider whether any damage is likely to be caused by the registration of the Applicants' Marks.

89 The ground of opposition under Section 8(7)(a) of the Act therefore fails.

Ground of Opposition under Section 8(4)(b)(i) and (ii)

90 Section 8(4) of the Act reads:

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

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

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

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

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

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

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

(Emphasis added)

Decision on Section 8(4)(b)(i) and (ii)

91 In order to succeed on either Section 8(4)(b)(i) or (ii) grounds, the Opponents must first show that *the whole or an essential part of the Applicants' Marks are identical with or similar to the Opponents' Marks*. In *Ferrero CA* at [70]-[71], the Court of Appeal held in relation to Section 27(2) and Section 55(2) of the Act that the additional words "essential part" in Section 55(2) did not mean that a different analysis (i.e. different from the analysis in Section 27(2)) must be undertaken for similarity in respect of this section. The words in Section 27(2) and Section 55(2) of the Act mirror the provisions in Section 8(2) and 8(4) of the Act respectively. Therefore, the analysis in Section 8(2) on similarity would apply equally here for Section 8(4)(b).

92 I have found earlier (see [42]-[61] above) that there is no similarity between the Opponents' Marks and the Applicants' Marks, therefore, the first limb of Section 8(4)(b)(i) and (ii) has not been satisfied. There is no need to further consider whether the Opponents' interest would be damaged if the Applicants' Marks are registered, or whether the Opponents' Marks are "well-known".

93 The ground of opposition under Section 8(4)(b)(i) and (ii) of the Act therefore fails.

Observations

94 The Opponents have two registrations for the word "ROCHER" in the UK: the first has been registered since 18 August 1989 in Class 30 for "Non-medicated chocolate confectionery included in Class 30; but not including cake" and the second has been registered since 1 March 1996 in Class 30 for "Confectionery" (see Opponents' SD at [29] and Exhibit M). The Applicants also own a UK trade mark registration for "ROSHEN & Design" in Class 30 for "confectionery, pastry, cookies, biscuits, crackers, candies, chocolate, honey, sugar, bread, ice cream, spicery", registered on the basis of use, since 20 June 2006 (Applicants' April SD, at [10]). I note that (1) the Applicants' UK mark was registered despite the existence of the Opponents' registration for the lone word mark "ROCHER" in the UK and that (2) since then, no further proceedings in the UK between the Opponents and the Applicants have been brought to my attention. This suggests that the Opponents and the Applicants have been in co-existence in the UK at least since 20 June 2006 (the date of the Applicants' UK registration), i.e. for more than *five* years prior to the present applications for the Applicants' Marks in Singapore.

Conclusion

95 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 Applicants' Marks shall proceed to registration.

Costs

96 In the ordinary course of proceedings at IPOS, costs typically follow the event. However, under the Trade Marks Act, the Registrar has the discretion on the costs to be

awarded. If costs are awarded, they must be awarded within the Fourth Schedule of the Trade Marks Rules.

97 Section 69(1) of the Act provides

(1) The Registrar may award costs in respect of the matters, and in the amounts provided for in rules made under this Act, against any party to proceedings brought before him.

98 Section 69 of the Act gives the Registrar discretion as to the award of costs, as long as it is within the Fourth Schedule of the Trade Marks Rules. For example, the Registrar may exercise discretion to award only part of the costs to a successful party if he has succeeded only on certain grounds of opposition/application (as the case may be). In *Barcardi & Company Limited v G3 Enterprises, Inc* [2014] SGIPOS 6, the successful applicants were awarded 70% of their costs as they had failed in their application under Section 22(1)(c) and only partially succeeded under Section 23 read with 7(1)(d) of the Act. In *Fox Street Wear Pte Ltd v Fox Racing, Inc.* [2014] SGIPOS 13 the opponents were awarded 50% of their costs, having succeeded under Section 8(2)(b) of the Act but failing on the other five grounds relied upon. In *Intelsteer Pte Ltd v Intel Corporation* [2015] SGIPOS 2 (“*Intelsteer*”), the successful applicants were allowed 30% of their costs, the applicants having succeeded on one of the four grounds advanced.

99 The Registrar has also made cost awards against a losing party which does not appear at the proceedings. In *Intelsteer*, the unsuccessful registered proprietors initially participated in the proceedings for about three years. Subsequently, however, correspondence sent to the registered proprietors at their address for service was returned undelivered, indicating that they had moved out. Subsequent checks thereafter revealed that they were officially struck off the Register of Companies. As indicated above at [98], costs were awarded against them in the proceedings. In *Andrew Knight v Beyond Properties Pty Ltd* [2009] SGIPOS 17, the opponent, Andrew Knight, had changed representation several times. Prior to the application for security for costs by the applicants, the opponent did not have representation, neither did he tender any written submissions nor attend the hearing. The application for security for costs was allowed and a cost order was also made against him.

100 The Registrar has also ordered that each party bears its own costs, despite there being a successful party. In *RC Hotels (Pte) Ltd v Kopitiam Investment Pte Ltd* [2008] SGIPOS 8, the opponents were successful under Section 7(1)(a) of the Act, but failed under Section 8(2)(b) of the Act. No finding was made in respect of other grounds relied upon in Sections 7(4) and 8(4)(a) [now 8(7)(a)] of the Act. The Registrar ordered each party to bear its own costs of the proceedings. In *KPR Singapore Pte Ltd v PSE Asia-Pacific Pte Ltd* [2010] SGIPOS 13, the parties were made to bear their own costs despite the opponents’ success in defending the applicants’ application for an extension of time to file their Counter-Statement.

101 I now turn briefly to the Australian position. Section 69 of our Act was taken from Section 221 of the Australian Trade Marks Act, which is *in pari materia* with Section 69(1) of our Act. In Australia, the Australian Trade Marks Office Manual of Practice & Procedure (at Part 55, paragraph 2.3) explains that there are some exceptions to the general rule that costs are awarded against an unsuccessful party to the proceedings. Paragraph 2.3 provides:

In exercising discretion as to costs, a court may have regard to the conduct of any party that is calculated to contribute unnecessarily to the cost of the proceedings. Such conduct need not be misconduct. As early as in 1838, in *Millington v Fox* 1B IPR 321, Cottenham LC denied costs to the successful plaintiff, who had been awarded an injunction against use of its trade marks, because he considered that the plaintiff had engaged in "an unnecessary degree of litigation" to obtain its result. The Registrar is entitled to exercise similar discretion in the interests of natural justice.

Therefore, where the successful party's actions have caused some unnecessary complication, such as an adjournment, that party may have to pay the costs arising from that part of the proceedings – see the comments of the Deputy Registrar in *Sherry Shippers Association v G.Gramp & Sons Ltd* (1953) 23 AOJP 2295. This contrasts with the situation in *R&C Products Pty Ltd v Bathox Bathsalts Pty Ltd* (1992) 24 IPR 278 where the successful opponent was awarded its costs, including the costs associated with two adjournments of the hearing because those adjournments were caused by the applicant's mishandling of the case. See also *Schutz-Werke GMBH & Co Kg v Forecase & Trading Pty Ltd*, (1998) 44 IPR 209, where costs were not awarded against the unsuccessful applicant for removal because the opponent to removal had failed to comply with reg. 21.18 (which requires evidence to be filed in English) thereby causing expense and inconvenience to the removal applicant.

In awarding costs, the Registrar or a delegate may decide that certain costs should not be covered by the award. This would always be based on the facts and history of the proceedings.

102 In the present case, I find that the Applicants' actions have caused unnecessary complications in the present proceedings, by filing inconsistent copies of their evidence, failing to comply with the Registrar's directions and with the Trade Marks Rules as regards their Supplementary SD. Their behaviour in levelling accusations at the Registrar in writing and insistence on the mode of communications with the Registrar leaves much to be desired. (See further at [4]-[18] above.) Finally, the Applicants failed to defend these opposition proceedings, neither filing any submissions nor appearing at the hearing of this matter.

103 Having considered the cases above, the Applicants' behaviour in the present proceedings, and the substantive outcome of the case, I make no order as to costs in the present proceedings.

Dated this 22nd day of July 2015.

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