

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

Trade Mark Application No. T1002552C
15 July 2015

IN THE MATTER OF A TRADE MARK APPLICATION BY

G3 ENTERPRISES, INC

AND

OPPOSITION THERETO BY

BACARDI & COMPANY LIMITED

Hearing Officer: Ms Sandy Widjaja
Principal Assistant Registrar of Trade Marks

Mr Melvin Pang (Amica Law LLC) for the Applicants

Mr Dedar Singh Gill and Mr Gabriel Ong (Drew & Napier LLC) for the Opponents

Cur Adv Vult

GROUND OF DECISION

1 This is an opposition to the registration of the following trade mark T1002552C ("*Application Mark*"):

LOUIS.M.MARTINI

in relation to the following goods in Class 33:

Alcoholic beverages (except beers).

2 G3 Enterprises, Inc (“the Applicants”) applied to protect the **Application Mark** in Singapore on 3 March 2010. The application was accepted and published on 1 July 2011 for opposition purposes.

3 On 31 August 2011, Bacardi & Company Limited (“the Opponents”) filed their Notice of Opposition to oppose the registration of the **Application Mark**. The Applicants filed their Counter-Statement on 24 October 2011. The Opponents filed evidence in support of the opposition on 22 February 2012. The Applicants filed evidence in support of the application on 5 July 2012. On 6 July 2012, the Opponents wrote to the Registrar requesting for a stay of the proceedings pending a decision on the Invalidation / Revocation action in relation to T0508163A as the two causes of action arise out of the same circumstances. On 16 July 2012, the Registrar directed that the Opposition be stayed pending the Invalidation / Revocation action as the Registrar was of the view that the Invalidation / Revocation action would have a material bearing on the outcome of the Opposition. The Registrar then directed that as the Opposition proceedings have reached an advanced stage, the proceedings were to continue until after the time for the filing of evidence in reply has lapsed (the Opponents were due to file their evidence in reply on 5 September 2012), that is, up till the close of evidence. The Pre-Hearing Review (“PHR”) for the Opposition was to be conducted after the conclusion of the Invalidation / Revocation action. The Opponents may then file, in effect, any evidence in reply for the Opposition, as further evidence at the PHR stage.

4 The Invalidation / Revocation action was heard on 13 February 2014. The Grounds of Decision was issued on 12 May 2014 as **G3 Enterprises, Inc v Bacardi & Company Limited** [2014] SGIPOS 7 (“the **Post Registration Decision**”).

5 Following the issuance of the **Post Registration Decision**, the Opponents requested for a resumption of the Opposition proceedings on 14 November 2014. The Applicants, via their letter of 22 December 2014, also requested that all evidence, submissions and rulings filed / made for the **Post Registration Decision** be put in evidence since the **Post Registration Decision** has a direct bearing on the current Opposition proceedings. At the PHR on 22 January 2015, the Registrar gave deadlines for the filing of the Opponents’ evidence in reply, as well as supplementary evidence to be filed by both parties to refer to the evidence and written submissions filed in the **Post Registration Decision** to render the same documents applicable for the current Opposition proceedings as well. The Applicants filed their supplementary evidence on 18 March 2015 and the Opponents filed both their evidence in reply and supplementary evidence on 19 March 2015. A hearing date was then set for 15 July 2015.

Grounds of Opposition

6 The Opponents relied on Sections 8(2)(b), 8(4) and 8(7)(a) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”).

Opponents’ Evidence

7 The Opponents’ evidence filed for this Opposition Proceeding *per se* comprises of the following statutory declarations:

- (i) Statutory Declaration by Beatrice Helene Sfondylia, Senior IP Legal Counsel of the Opponents, dated 5 February 2012 (“the ***Opponents’ 1st Evidence***”);
- (ii) Statutory Declaration in Reply by Beatrice Helene Sfondylia dated 29 September 2014 (“the ***Opponents’ 2nd Evidence***”);
- (iii) Statutory Declaration in Reply by Lim Alison Ann Peck Poh, Director of Bacardi-Martini Singapore Pte Ltd (“***BMSPL***”), dated 15 October 2014 (“the ***Opponents’ 3rd Evidence***”);
- (iv) Supplementary Statutory Declaration by Lim Alison Ann Peck Poh dated 9 March 2015 (“the ***Opponents’ 4th Evidence***”);

Applicants’ Evidence

8 The Applicants’ evidence filed for this Opposition Proceeding *per se* comprises of the following statutory declarations:

- (i) Statutory Declaration by Michael J. Ellis, Vice President and Chief Financial Officer of the Applicants, dated 20 June 2012 (“the ***Applicants’ 1st Evidence***”); and
- (ii) Supplementary Statutory Declaration by Pang Sze Ray, Melvin, a solicitor with Amica Law LLC, and agent / solicitor for the Applicants dated 17 March 2015 (“the ***Applicants’ 2nd Evidence***”).

Evidence from the *Post Registration Decision*

9 Further, the following is the evidence from the ***Post Registration Decision*** which each party is relying on:

- (i) Evidence filed by Applicants (Applicants for Invalidation / Revocation)¹:
 - a) Statutory Declaration by Michael J. Ellis dated 22 January 2013 (“the *Applicants’ 1st Post Registration Evidence*”);
 - b) Statutory Declaration in Reply by Michael J. Ellis dated 19 September 2013 (“the *Applicants’ 2nd Post Registration Evidence*”);
- (ii) Evidence filed by Opponents (Registered Proprietors in Invalidation / Revocation)²:
 - (a) Statutory Declaration by Beatrice Helene Sfondylia dated 15 May 2013 (“the *Opponents’ 1st Post Registration Evidence*”);
 - (b) Statutory Declaration by Lim Alison Ann Peck Poh dated 15 May 2013 (“the *Opponents’ 2nd Post Registration Evidence*”);
 - (c) Statutory Declaration by Tay Hui Khim, Director of Red Koi Pte Ltd, dated 22 May 2013 (“the *Opponents’ 3rd Post Registration Evidence*”);
 - (d) Statutory Declaration by Tay Liang Teck Jake, Director of Laurels Food Suppliers (Pte) Limited, dated 15 May 2013 (“the *Opponents’ 4th Post Registration Evidence*”);
 - (e) Statutory Declaration by Mui Kim Meng (a.k.a. Gavin Mui), Director of Magnum Spirits & Wine Pte Ltd, dated 15 May 2013 (“the *Opponents’ 5th Post Registration Evidence*”).

Applicable Law and Burden of Proof

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

Background

11 The Opponents submitted (at paragraph 14 of their written submissions) that they are a company incorporated in Liechtenstein. The Opponents submitted that their

¹ These are taken into consideration in the current case via the *Applicants’ 2nd Evidence*.

² These are taken into account in the current case via *Opponents’ 4th Evidence*.

marks (see [12] below) were first used as part of the branding for vermouth wine as early as 1863 by the original proprietors, Martini, Sola & Company in the Piedmont region of Italy. In 1879, Martini, Sola & Company was renamed as Martini & Rossi. Over the 20th century, the Martini & Rossi group grew and in the early 1990s, the Martini & Rossi group comprised about 150 companies worldwide. Martini & Rossi was taken over by the Bacardi Group in 1992-1993. **BMSPL** was incorporated in Singapore in 1988. It is in the business of marketing and distributing the Opponents' product in Singapore.

12 The Opponents relied on the following earlier marks ("**Opponents' Earlier Marks**"):

S/N	<i>Opponents' Earlier Marks</i>	Class 33
1		Vermouth
	T3903108D	
2		Vermouth wine.
	T6026847J	
3		Vermouth and sparkling wine.
	<i>Opponents' Earlier Mark</i> T0508163A	
4	MARTINI ROYALE	Alcoholic beverages (except beers).
	T1016313F	

13 On the other hand, the Applicants deposed (at paragraphs 6 to 10 of the **Applicants' 1st Evidence**) that they are the owner of a winery known as the Louis M. Martini winery, whose headquarters are located at California. The winery was founded in 1933 by one Louis M. Martini, a wine maker originally from Genoa, Italy. Located in the heart of Napa Valley, the winery is dedicated to producing premium Cabernet Sauvignon. After 75 years in business, the winery has grown to be regarded as one of the finest winemaking establishments in California today. At all times, the winery has been owned

and operated by the Martini family. Since it was founded in 1933, the winery has been using the LOUIS M. MARTINI name and the Application Mark to represent the personal name of the founder.

14 The parties were also involved in parallel proceedings in Mexico and the People's Republic of China (in the People's Republic of China, it was in relation to the Applicants' Chinese version of their mark) where the marks were found to be confusingly similar (paragraphs 80-82 of the Opponents' written submissions).

MAIN DECISION

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

15 The relevant provisions of the Act are Sections 2 and 8(2)(b), which provide as follows:

2. —(1) *In this Act, unless the context otherwise requires —*

“earlier trade mark” means —

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

(b) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was a well known trade mark,

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

“well known trade mark” means —

(a) any registered trade mark that is well known in Singapore; or

(b) any unregistered trade mark that is well known in Singapore and that belongs to a person who —

(i) is a national of a Convention country; or

(ii) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in Singapore;

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.

Decision on Section 8(2)(b)

Step-by-step approach

16 The leading authority in relation to this section is the Court of Appeal's recent decision in *Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide* [2014] 1 SLR 911 (“*Staywell*”). In *Staywell*, the Court upheld the 3-step test approach in relation to an objection under section 8(2)(b) and rejected the proposal that the threshold of marks similarity is a low one. The Court of Appeal stated at [15] to [20]:

[15]...Since this court’s decision in *Polo (CA)*, our courts have given effect to this statutory wording by applying what is now known as the “step-by-step” approach, as opposed to the competing “global appreciation approach” applied in Europe after *Sabel BV v Puma AG, Rudolf Dassler Sport* [1998] RPC 199 (“*Sabel v Puma*”). 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...

[16] However we do not agree with the Opponents’ approach to the extent that it suggests that any particularly or notably low threshold of marks-similarity applies...

[17] More fundamentally, the minimal threshold approach is inconsistent with the reality that the similarity of marks is ultimately and inevitably a matter of impression rather than one that can be resolved as a quantitative or mechanistic exercise (see *Polo (CA)* at [35] and *Wagamama Ltd v City Centre Restaurants Plc* [1995] FSR 713 at 732)...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.

[18] We observed this in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] SGCA 26 (“*Hai Tong*”) at [40(a)]. Congruously, there is no prescribed requirement that all three aspects of similarity must be made out before the marks can be found to be similar: *MediaCorp News Pte Ltd v Astro All Asia Networks*

plc [2009] 4 SLR(R) 496 (“MediaCorp”) at [32] and Sarika Connoisseur Café Pte Ltd v Ferrero SpA [2013] 1 SLR 531 (“Sarika”) at [16]. In short, 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. Trade-offs can occur between the three aspects of similarity in the marks-similarity inquiry: Ozone Community Corp v Advance Magazine Publishers Inc [2010] 2 SLR 459 (“Ozone”), see also Bently and Sherman, Intellectual Property Law (Oxford University Press, 3rd Ed, 2009) (“Bently & Sherman”) at p 864.

[19]...A productive and appropriate application of the step-by-step approach necessitates that the court reach a meaningful conclusion at each stage of the inquiry...

[20] Finally, on this issue, we reiterate that the assessment of marks similarity is mark-for-mark without consideration of any external matter: see Mediacorp at [33], Sarika at [17] and Hai Tong at [40(b)]. 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. This does not mean that the court ignores the reality that the relative importance of each aspect of similarity might vary from case to case and will in fact depend on all the circumstances including the nature of the goods and the types of marks, as we observed at [40(b)] of Hai Tong. Rather, such considerations are properly reserved for the confusion stage of the inquiry, because that is when the court is called upon to assess the effect of objective similarity between the marks, on the perception of consumers. We recognise that this reflects a slight departure from the approach taken by the High Court in Festina Lotus SA v Romanson Co Ltd [2010] 4 SLR 552 at [55]–[56], and by this court in Sarika at [38]. We think that this is conceptually clearer because it recognises that the issue of resemblance between the competing marks is distinct from the question of the effect of such resemblance...

[Emphasis as underlined mine.]

Similarity of Marks

17 In relation to similarity of marks, the Court has this to say at [25], [26] and [30]:

[25] Technical distinctiveness is an integral factor in the marks-similarity inquiry (see Sarika at [20], Ozone Community at [47] and Polo (CA) at [36]); a mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it (Sarika at [36]). While the components of a mark may be inherently technically distinctive, ultimately the ability of the mark to function as a strong badge of origin must be assessed by looking at the mark as a whole. Conversely, the components of a mark may not be

inherently distinctive, but the sum of its parts may have sufficient technical distinctiveness...

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

...

[30] We reiterate, as was held in Sarika (at [20]) and in Hai Tong (at [26]), that distinctiveness (in both its technical and non-technical senses) 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.

[Emphasis as underlined mine.]

18 Further, the Court provided the following principles in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941 at [40] (“*Hai Tong*”):

[40] (c) Although the focus of this part of the inquiry is on the marks in question, it is necessary to set out the viewpoint the court should assume. This viewpoint is that of the average consumer who would exercise some care and a measure of good sense in making his or her purchases, not that of an unthinking person in a hurry (see *Polo* (CA) ([16] *supra*) at [34]).

(d) Furthermore, it is assumed that the average consumer has “imperfect recollection” (see *MediaCorp* at [33], citing *Nautical Concept Pte Ltd v Jeffery Mark Richard* [2007] 1 SLR(R) 1071 (“*Nautical Concept*”) at [30]). As such, the two contesting marks are not to be compared or assessed side by side and examined in detail for the sake of isolating particular points of difference. Instead, the court will consider the general impression that will likely be left by the essential or dominant features of the marks on the average consumer (see *Saville Perfumery Ld v June Perfect Ld and FWWoolworth & Co Ld* (1941) 58 RPC 147 (“*June Perfect*”) at 161–162).

[Emphasis as underlined mine].

19 For ease of reference, the marks are as follows:

<i>Application Mark</i>	<i>S/ N</i>	<i>Opponents' Earlier Marks</i>
LOUIS.M.MARTINI T1002552C	1	MARTINI T3903108D
		 T6026847J
	3	 <i>Opponents' Earlier Mark</i> T0508163A
		MARTINI ROYALE T1016313F
	4	

20 Although the Opponents sought to rely on all four marks, in the instant case *Opponents' Earlier Mark T0508163A* is of particular interest as one of the holdings of the *Post Registration Decision* which the Opponents is seeking to rely on extensively is that the *Opponents' Earlier Mark T0508163A* has acquired distinctiveness in relation to vermouth and sparkling wine. The issue of whether the Opponents can rely on all four marks will be dealt with further below.

21 As a starting point for the similarity analysis, it is clear that all the marks, that is, the *Application Mark* and the *Opponents' Earlier Marks* share the common element "MARTINI". However, just because there is a shared element between the marks, it does not necessarily mean that the marks are similar.

22 In this regard, I agree with the Applicants (at paragraph 13 of their written submissions) that in cases where there is a common denominator, it is important to look at the differences between the mark and the sign in order to decide whether the challenged sign has been able to distinguish itself sufficiently.

23 I am mindful of the Court's guidance in *Staywell* and *Hai Tong* (discussed above) that distinctiveness is a factor integrated into the visual, aural and conceptual analysis as to whether the competing marks are similar and it is not a separate step within the marks-similarity inquiry. However, due to the extensive submissions / evidence made in relation to this issue, for ease of analysis, I will summarise my findings first, before applying them within the context of the mark-similarity analysis. In this regard, I note that the learned Assistant Registrar in *Taylor's Wines Pty Ltd v Taylor, Fladgate & Yeatman Limited* [2014] SGIPOS 11 ("*Taylor's*") at [47] has taken the same approach:

[47] The distinctiveness of a trade mark is a factor integrated into the visual, aural and conceptual analysis as to whether the competing marks are similar, and not a separate step within the marks-similarity inquiry: *Staywell* at [30], affirming *Sarika (CA)* at [20]. However, in *Hai Tong* at [26] the court added that "for the purpose of elucidating the analytical process, we have highlighted it [the distinctiveness inquiry] here as a separate step".

Distinctiveness

24 It is necessary at this stage to have regard to the *Post Registration Decision* for it is clear that the Opponents are relying extensively on the Registrar's finding in that decision that the *Opponents' Earlier Mark T0508163A* has acquired distinctiveness in relation to vermouth and sparkling wine.

25 Three issues arise out of this finding. Firstly, what is the extent of the (acquired) distinctiveness of the *Opponents' Earlier Mark T0508163A*. Secondly, what, if any, is the main distinctive component of the *Opponents' Earlier Mark T0508163A*? Thirdly, in light of the second issue, which of the Opponents' Earlier Marks (above) can be taken into consideration for the purposes of an objection under Section 8?

26 In this regard, the Opponents argued that it is the word "MARTINI" which is the main distinctive component of the *Opponents' Earlier Mark T0508163A* such that all four earlier marks, which incorporate the alleged main distinctive component "MARTINI" can be taken into consideration. On the other hand, the Applicants argued that it is the *Opponents' Earlier Mark T0508163A* as registered which has been found to have acquired distinctiveness such that the other marks have to be examined separately.

27 In order to resolve the issues above, it is necessary to re-visit the basis on which the Registrar found that the *Opponents' Earlier Mark T0508163A* has acquired distinctiveness in the *Post Registration Decision*. The relevant paragraphs of the *Post Registration Decision* are as follows at [206] – [225]:

[206] Further, I refer to the SD of AL at paragraph 3. *BMSPL* was incorporated in Singapore on 27 April 1988. As per paragraph 4 of the SD of AL, *BMSPL* is part of the Registered Proprietors' group of companies and is in the business of marketing and distributing the Registered Proprietors' products in Singapore. *BMSPL* imports Martini products, which consists of essentially vermouth products and sparkling wine products (Martini Products), from Tradall. As mentioned above, Tradall is part of the Registered Proprietors' group of companies as well.

[207] As per the Registered Proprietors' submissions above, *BMSPL* distributes Martini Products in Singapore in two main ways. Firstly, *BMSPL* supplies Martini Products directly to the following supermarket chains in Singapore (i) NTUC Fairprice; (ii) the Dairy Farm Group (ie Cold Storage and Giant); (iii)

Carrefour Singapore; and (iv) Isetan. Secondly, **BMSPL** supplies Martini Products to the following network of distributors in Singapore (i) Magnum Spirits & Wines Pte Ltd (Magnum); (ii) Laurels Food Suppliers Pte Ltd (Laurels); (iii) Hai Choo Wines & Spirits; (iv) Red Koi Pte Ltd (Red Koi); (v) Hock Tong Huat Pte Ltd.

[208] The above is corroborated by the evidence of the different distributors.

[212] I refer to the SD of AL at paragraph 10. The recent turnover in Singapore for the Martini Products in SGD as seen above is reproduced below:

Sum of NSV	Brand		
Period	Martini Vermouth	Martini Sparkling	Grand Total
FY2007	152,810	107,920	260,730
FY2008	166,000	126,730	292,730
FY2009	170,870	130,100	300,970
FY2010	170,771	148,364	319,135
FY2011	173,413	268,757	442,170
Grand Total	833,864	781,871	1,615,735

In particular, I note that the sales turnover is only in relation to two kinds of products, vermouth and sparkling wine.

[213] I also refer to the SD of BHS at Exhibit 9 at page 369 where it shows a chart by IWSR showing volume figures for sales of Martini Vermouth in Singapore for the period 2005 to 2010:

Year	2005	2006	2007	2008	2009
Volume (in terms of 9 litre cases)	3,150	2,900	2,900	2,850	2,700

I refer to Exhibit 10 of the same evidence at pages 374 to 377, where there is another chart by IWSR, showing the value figure for sales in USD of Martini Trade Mark in Singapore for the period 2005 to 2009. The chart in Exhibit 10 is partially reproduced as follows:

Total Martini Trade mark	Value in USD 000s				
	2005	2006	2007	2008	2009
Singapore	280,000	275,000	291,000	327,000	362,000

[214] The Registered Proprietors explained that the discrepancy in the figures is due to the fact that the IWSR figures were derived from retail sales while the turnover figures from **BMSPL** were derived from their sales to their wholesale network.

[215] I refer further to the SD of AL at paragraphs 17 to 23. In particular, paragraph 22 includes a table which shows the different establishments which serve Martini Products. There are a total of 29 establishments, which includes hotel bars, restaurants and other bars and pubs. It is also noted that some of these establishments have more than one outlet and these outlets serve Martini Products. One example is Boulevard Restobar and Boulevard Bayfront. The relevant pages of the menus of both outlets serving Martini Products are pages 357 and 364 respectively of Exhibit 6 of the SD of AL. Another example is the Indochine Group. At this point, I think it should be apparent that it is not necessary for all bars, pubs, restaurants and food and beverage establishments to sell Martini Products.

[216] As per paragraph 20 of the SD of AL, from the evidence it would appear that Martini Products are served alongside "martini" cocktails in many food and beverages establishments. The Martini Products, in particular Martini Bianco, Martini Rosso and Martini Extra Dry, are usually listed under the Aperitif section.

[217] There are two points which I would like to make from the above evidence. Firstly, unlike the *Love Case*, where there was no separate sales volume for the simple LOVE mark, in this case, it is clear that there have been sales of products bearing the Registered Mark. Secondly, I agree with the Registered Proprietors that it is a significant point that the menus of the food and beverage establishments feature both the Martini Products and "martini" cocktails in that it suggests that the relevant consumer of alcoholic beverages (via the trade), is educated of the distinction between "martini" cocktails in general and Martini Products.

[218] I also agree with the Registered Proprietors as per their reply submissions that it is also noteworthy that in the Apertitifs section, the Martini Products are featured amidst other trade marks such as Campari, Pernod and Noilly Prat. This strongly suggests to the reader of the menu, that Martini Bianco, for example is a trade mark.

[219] In this regard, I also agree with the Registered Proprietors that a consumer of alcoholic beverages who is reasonably well informed and reasonably observant and circumspect, would be able to understand that "bianco" and "rosso" simply denote product lines. I am of the view that the average discerning consumer of alcoholic beverages, who is reasonably well informed and reasonably observant and circumspect would be aware that the main types of vermouth includes dry and sweet vermouths and that sweet vermouths can be red ("rosso" meaning red in Italian) or white ("bianco" meaning white in Italian). I am of the view that alcoholic beverages are products which, aside from the fact that they are to be imbibed, are products which are very much a question of preference such that the average consumer of the relevant class would be particularly discerning and knowledgeable as to the various types of alcoholic beverages which he or she would prefer and thus choose to consume.

[210] In relation to retail sales via, for example, supermarkets, there is of course no issue about the Registered Mark being understood to be a brand for the Martini Products, since the Registered Mark is applied to the relevant Martini Products. At this point, I note that while the Registered Proprietors' sparkling wine products are not as commonly found in the menus (those submitted via the Registered Proprietors' evidence), there is no question of such products being sold via the retail channel. See for example, page 114 of Exhibit 4 of the SD of AL – where it is an invoice from **BMSPL** to NTUC Fairprice dated 1st December 2006).

[221] In light of all of the above, I am of the view that the defence under Section 23(2) has been made out such that the Registered Mark has acquired a distinctive character, but only in relation to vermouth and sparkling wine.

[222] I will now address the Registered Proprietors' evidence from abroad, in particular, evidence of the different ways in which the Registered Proprietors have promoted their marks including the Registered Mark and Prior Martini Marks (collectively Martini Marks) abroad. This includes, amongst others, the Martini Terazza Bars as well as direct advertising and promotion.

[223] I agree with the Registered Proprietors as per their reply submissions that the evidence should not be regarded as irrelevant just because it is from abroad. The principle that trade mark law is territorial in nature does not mean that the law should turn a blind eye to matters which are extra-territorial in nature. In a world that has become inextricably linked by the internet and mass media and where consumers are well travelled, it is artificial to ignore such information.

[224] However, that said, in a case where the burden of proof is on the Registered Proprietors to prove acquired distinctiveness, it is insufficient to simply assert that (i) the world is linked by the internet and mass media; and (ii) that the relevant consumers are well travelled. More is required. So for example, one way is to show web traffic for the purposes of any promotion on You-tube, for example, the George Clooney Martini Commercial 2007 on You-tube as per the SD of BHS at Exhibit 19 at page 570. As this point, I acknowledge that it may be difficult to prove, for instance, that the relevant consumer in Singapore is well travelled. However, in a situation like this where one seeks to rely on this fact to discharge his/her burden of proof, more is required than a mere statement. As such, while I do not discount the Registered Proprietors' evidence from abroad in its entirety, I can only accord some weight to it even though, as it is apparent, the Registered Proprietors has invested much on their promotional activities overseas and have tendered much evidence in relation to the same.

[225] One last word and that is in relation to the Power 100 survey, which is an independent annual research study assessing the power of the world's leading spirits and wine brands, in particular, the survey reports for 2009 and 2010 (paragraphs 51 to 53 of the SD of BHS and Exhibits 30 and 31 of the same

evidence). In this regard, I agree with the Applicants that upon reading the survey reports, it is unclear if the markets surveyed includes, Asia and in particular, Singapore, which render them unhelpful in the quest by the Registered Proprietors to show acquired distinctiveness in the local context.

[Emphasis as underlined mine]

28 In light of the above, it is clear that from the above that while the *Opponents' Earlier Mark T0508163A* has acquired distinctiveness in the *Post Registration Decision*, it is the word "MARTINI" which is the dominant element of the *Opponents' Earlier Mark T0508163A*. The reason is that the evidence tendered showed that the Opponents' products reach the ultimate consumer in 2 main ways (i) via supermarkets (the distributors are only the agents); and (ii) via food and beverage establishments. There is no dispute that when the products bearing the *Opponents' Earlier Mark T0508163A* are sold via the supermarkets, the consumer will come face to face with the *Opponents' Earlier Mark T0508163A* itself as registered (ie, with the word "MARTINI" and the device) since the *Opponents' Earlier Mark T0508163A* is applied onto the Opponents' products. However, when the Opponents' products are sold via food and beverage establishments, the menus of such establishments only reflect the word "MARTINI". As provided above, the fact that the Opponents' products are featured amidst other trademarks such as Campari etc strongly suggests to the reader of the menu, that Martini Bianco, for example is a trade mark. In relation to "bianco" it was held that a consumer of alcoholic beverages who is reasonably well informed and reasonably observant and circumspect, would be able to understand that "bianco" and "rosso" simply denote product lines. This is because alcoholic beverages are products which, aside from the fact that they are to be imbibed, are very much a question of preference such that the average consumer of the relevant class would be particularly discerning and knowledgeable as to the various types of alcoholic beverages which he or she would prefer and thus choose to consume (see above [219] of the *Post Registration Decision*).

29 It is appropriate at this juncture to refer to *Staywell* at [23] – [24]:

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

[24] Distinctiveness in the technical sense on the other hand, usually stands in contradistinction to descriptiveness. Where the latter connotes words that describe the goods or services in question, or of some quality or aspect thereof, the former refers to the capacity of a mark to function as a badge of origin. Distinctiveness can be inherent, usually where the words comprising the mark are meaningless

and can say nothing about the goods or services; or acquired, where words that do have a meaning and might well say something about the good or services, yet come to acquire the capacity to act as a badge of origin through long-standing or widespread use...

[Emphasis as underlined mine]

30 However, it will be clear that marks that are technically distinctive nonetheless sit on a spectrum. This is clear from the Courts' guidance in *Staywell* above at [25]: "a mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it". The use of a relative term, "greater", clearly suggests that marks will possess varying degrees of distinctiveness, inherent or otherwise. As to the types of technically distinctive marks which sit on such a spectrum I refer to the recent High Court decision of *Han's (F & B) Pte Ltd v Gusttimo World Pte Ltd* [2015] 2 SLR 825 ("*Hans*").

31 In *Hans*, Judicial Commissioner Wei (as he then was) made the following useful comments in relation to the issue of distinctiveness. Although the comments were made in the context of a declaration of invalidity (Section 23 read with Section 7(1)(b)), they are pertinent nonetheless. The comments are as follows at [61] and [63]:

[61] Returning to the meaning of distinctiveness, the trade mark must necessarily, either inherently or as a result of use, perform the most basic function of distinguishing the goods of the trader from those of his competitors in the marketplace. Some trademarks carry a high level of "inherent distinctiveness" in the sense that these marks will be understood by the public as bearing a trade mark meaning, even if they have not yet been used or promoted to the public. Invented words are classic examples of such trade marks. Take, for example, a manufacturer of sailing boats who decides to market the boats under a new trade mark which he has invented. The mark is "ADOGSTY". It has no meaning at all. Such an invented word mark has a high level of inherent distinctiveness and ability to serve as a trade mark. After all, what else could the word "ADOGSTY" mean when used in relation to the sailing boats?

...

[63] Other marks, on the other hand, while possessing the capability to distinguish goods or services in the course of trade, may have low levels of inherent distinctiveness. Often this will be because the mark includes a word or symbol or device that is at least partially descriptive of the goods or service. Alternatively, it may be that the word chosen has a laudatory meaning or some meaning that captures a mood or image of some relevance to the product or

service in question. The phrase **"Twinkling Star"**, for example, when used as a trade mark for diamond wedding rings, arguably possesses a low level of inherent distinctiveness, since it captures the idea of the sparkle of the

gemstone...

[Emphasis as underlined mine]

32 At this juncture, it is appropriate to recall the factors which are to be taken into consideration in deciding the issue of acquired distinctiveness as set out in *Hai Tong* at [32] – [33]:

[32] Even a mark that is not inherently or obviously distinctive may become so by use...

[33] In this regard, it may be helpful to have regard to the following factors that were considered by the High Court in *Doctor's Associates Inc v Lim Eng Wah* (trading as SUBWAY NICHE) [2012] 3 SLR 193 ("Subway Niche") in determining whether a mark had acquired distinctiveness through use (see *Subway Niche* at [21]):

- (a) the market share held by the registered mark;
- (b) the nature of its use (whether or not it was intensive, widespread and long-standing);
- (c) the amount invested in promoting the mark;
- (d) the proportion of the relevant class of individuals who identified goods sold under the mark as emanating from a particular source; and
- (e) any statements from trade associations and chambers."

33 Having regard to the above factors, it is clear that even if a mark has been found to have acquired distinctiveness in relation to certain goods or services, this does not necessarily mean that the said mark has acquired a high level of acquired distinctiveness. Whether or not the said mark enjoys a high level of acquired distinctiveness beyond the level which is required for it to be considered to have acquired distinctiveness surely must depend very much of the extent of use of the said mark.

34 Therefore, to assess if the *Opponents' Earlier Mark T0508163A* has acquired a high level of distinctiveness as argued by the Opponents, we need to further consider the evidence tendered by the Opponents in the *Post Registration Decision* which has been summarised above.

35 With reference to the paragraphs replicated above, I note in particular, the following.

36 For the turnover in Singapore, the figures are as such:

- (i) On the basis of the figures provided by *BMSPL*, the average annual sales amount is SGD 323,147; or

- (ii) On the basis of the figures provided by the International Wine and Spirits Record (“*IWSR*”), the average annual sales amount is USD 285, 000.

The Opponents explained in the *Post Registration Decision* that the discrepancy in the figures is due to the fact that the *IWSR* figures were derived from retail sales while the turnover figures from *BMSPL* were derived from their sales to their wholesale network. Thus only one set of figures can be taken into account as there is a likelihood of overlap if both sets of figures are taken into account.

37 However, the above has to be seen together with the fact that there are 29 establishments which serve the Opponents’ products as it is clear that in such establishments, the Opponents’ products, unlike those sold via the retail channel, are not sold via bottles, but by glasses. This means that the sale of one bottle from the distributor to a food and beverage establishment can be translated into several glasses of the Opponents’ products which in turn means that the Opponents’ products will enjoy more exposure than what the sales figures reflect (which are presumably sales in bottles or cartons but in any event not in glasses). However, the significance of the evidence ends here. I am of the view that to show that the *Opponents’ Earlier Mark T0508163A* has acquired a high level of technical distinctiveness, more is required. In light of the above, I am unable to agree with the Opponents’ argument at paragraph 42 of their written submissions that the [*Opponents’ Earlier Mark T0508163A*] enjoys a high degree of technical distinctiveness such that a higher threshold must be met before a competing sign would be considered dissimilar to it.

38 It has been alluded to above that it is the word “MARTINI” which is the dominant element of the *Opponents’ Earlier Mark T0508163A*. However, even if the main distinctive component is the word “MARTINI”, this does not mean that the device can be ignored since an assessment of a mark entails an analysis of the mark as a whole, bearing in mind, in particular, its distinctive and dominant components.

39 Following the above, I am of the view that only the Opponents’ Earlier Mark 2 (T6026847J) (“”) and 3 ie the *Opponents’ Earlier Mark T0508163A* (“”) can be taken into consideration for the purposes of this Opposition action. This is because these two earlier marks are nearly identical. On the other hand, the Opponents’ Earlier Mark 1 (T3903108D) is purely a word mark while the Opponents’ Earlier Mark 4 (T1016313F) includes the additional word “Royale”. However, I note that the Opponents’ Earlier Mark 2 (T6026847J) is only registered for “vermouth wine” while the *Opponents’ Earlier Mark T0508163A* is registered for “vermouth and sparkling wine”. Since the specification for the *Opponents’ Earlier Mark T0508163A* is wider, for the purposes of analysis in relation to Section 8 grounds moving forward, I will only refer to the *Opponents’ Earlier Mark T0508163A*.

Visual Similarity

40 For ease of reference only, the marks in question are replicated again below:

<i>Application Mark</i>	<i>S/N</i>	<i>Opponents' Earlier Marks³</i>
LOUIS.M.MARTINI	3	
T1002552C		
		T0508163A (" <i>Opponents' Earlier Mark T0508163A</i> ")

41 In considering visual similarity of composite marks, as submitted by the Opponents at paragraph 37 of their written submissions, it is apposite to have regard to the Court's guidance in *Hai Tong* at [62] ([62(a)] essentially reflects [40(c)] and [40(d)] which has been reproduced above):

[62] ...We consider that the following non exhaustive list of principles may be called in aid when assessing the visual similarity of composite marks:

...

(b) The visual similarity of two contesting marks or signs must normally be assessed by reference to the overall impressions created by the marks or signs, bearing in mind their distinctive and dominant components. When the other components of a complex mark or sign are of negligible significance, it is permissible to make the comparison solely on the basis of any dominant element(s).

(c) The overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components (see *Specsavers* ([54] *supra*) at [52(e)]).

(d) 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

³ As alluded above, only the *Opponents' Earlier Mark T0508163A* will be referred to moving forward.

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* ([52] *supra*) at [33], *Medion* at [34] and *Crazy Ron’s* at [99]).

(iv) The composite mark or sign is applied to goods or services marketed or sold primarily through *online* trade channels (see *Festina* at [55] and *Intuition Publishing* ([30] *supra*) at [64]–[65]).

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

(i) the device is significant and large (see, *eg*, the decision of the European General Court in *New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (*OHIM*) (Case T-415/09) (29 September 2011));

(ii) the accompanying word(s) are devoid of any distinctive character, or are purely descriptive of the device component (see *Quelle AG* ([58] *supra*) at [60]; see also *Sime Darby* ([37] *supra*) at [18] and [20]–[21]) or of similar goods of a superior quality (see the decision of the CFI in *Saiwa SpA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (*OHIM*) (Case T-344/03) [2006] ECR II-1097 at [41] and [45]); or

(iii) the device component is of a complicated nature (see, *eg*, *Waseem Ghias t/as Griller v Mohammed Ikram t/as The Griller Original, Esmail Adia t/as Griller King, Shahzad Ahmad t/as Griller Hut, Griller Original Limited, Griller Hut Limited* [2012] EWPC 3).

But usually not where:

(iv) the device is simple and will not evoke any particular concept for the average consumer (see, *eg*, the decision of the European General Court in *Kavaklidere-Europe v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (*OHIM*) and *Yakult Honsha Kabushiki Kaisha* (Case T-276/09) [2012] ETMR 45);

(v) the device component does not attract the attention of the average consumer of the goods in question because such a consumer is regularly confronted with similar images in relation to those goods (see *Shaker (CFI)* at [42]); or

(vi) the device component is more likely to be perceived as a decorative element rather than as an element indicating commercial origin (see *Trubion* ([56] *supra*) at [45] and *Oberhauser* ([56] *supra*) at [47]; see also *Wassen* ([56] *supra*)).

[Emphasis as underlined mine]

42 As already alluded to above, I am of the view that it is the word “MARTINI” which is the main distinctive component of the *Opponents’ Earlier Mark T0508163A*. However, I have also alluded to above that having regard to the evidence tendered, both in the *Post Registration Decision* as well as the instant case, I am of the view that while the *Opponents’ Earlier Mark T0508163A* can be said to have acquired a distinctive character for vermouth and sparkling wine, the evidence tendered is not sufficient to show that the *Opponents’ Earlier Mark T0508163A* has acquired a highly distinctive character for the said products.

43 Importantly, even if it can be said that the word “MARTINI” is the main distinctive component of the *Opponents’ Earlier Mark T0508163A*, it is to be recalled that in analysing a mark, it is to be assessed as a whole, having regard to the distinctive and dominant components.

44 Applying the principles laid down in *Hai Tong* above in relation to the visual assessment of composite marks, I am of the view that while the word “MARTINI” is the main distinctive component of the *Opponents’ Earlier Mark T0508163A* since the word is large and is in a prominent location, I am also of the view that the device is also large. I am further of the view that while the device may not necessarily be regarded as significant, or at least not as significant as the word “MARTINI”, it is clearly *not* negligible such that the assessment of the *Opponents’ Earlier Mark T0508163A* can be based solely on the word “MARTINI” alone.

45 In relation to the *Application Mark*, while I am of the view that the word “MARTINI” is also the more distinctive element of the *Application Mark*, it is also quite clear that the other words “LOUIS.M” cannot be ignored, having regard to the respective size and positioning of the words relative to the word “MARTINI”.

46 I also note that the font of the word “MARTINI” in the *Opponents’ Earlier Mark T0508163A* is of a bold and strong font, while the words “LOUIS.M.MARTINI” is of a softer, less intense font. In relation to the issue of the font of the words, the Opponents also sought to argue, at paragraph 39 of their written submissions, quoting [34] of *Doctor’s Associates Inc v Lim Eng Wah (trading as Subway Niche)* [2012] 3 SLR 193 (“*Subway*”) that “trade mark protection may not be circumscribed simply by tweaking the font or style of the lettering of the word mark, particularly where one had deliberately registered the word mark in block letters to represent that the distinctiveness of the mark lies in the word itself”. This proposed application of the said principle for the current case is clearly misguided. This principle is not applicable in relation to the *Opponents’ Earlier Mark T0508163A* in this instance as the said mark is not a word mark *simpliciter*

but a composite mark. The principle that registration in bold font includes registration in all fonts is only applicable for registration of a mark which only includes words *per se*. In this regard, I note that in *Subway*, the marks which were alleged to have been infringed are all word marks registered in block letters (see [4] of *Subway* which listed (i) T8903282C; (ii) T0511829B; and (iii) T0511831D).

47 Having regard to all of the above considerations, I am of the view that the marks are only visually similar to a low extent.

Aural Similarity

48 With regard to aural similarity, I note the Court in *Staywell* stated at [31] and [32] that there are two approaches. One approach is to consider the dominant component of the mark and the other is to undertake a quantitative assessment as to whether the competing marks have more syllables in common than not. The High Court in *Hans* has provided further clarification with regard to the application of the above principle in relation to composite marks:

[137] In my view, there is phonetic similarity between the HAN sign and the Han’s trade marks. The main phonetic component of the HAN sign is “HAN”. “Cuisine of Naniwa” is subsidiary. It is doubtful that the average consumer would make constant reference to the seven-syllable “HAN Cuisine of Naniwa” phrase every time he refers to it. “HAN” and “Han’s” are both single-syllable words which share similar pronunciations. Adequate allowance must be made for imperfect recollection and careless pronunciation and speech: *Future Enterprises Pte Ltd v McDonald’s Corp* [2006] 4 SLR(R) 629 at [12]. The slightest mispronunciation would result in complete identity. There is, therefore, phonetic similarity between the HAN sign and the Han’s trade marks.

[Emphasis as underlined mine]

49 For ease of reference, the marks in the *Hans* case are reproduced below:

The Han’s trade marks	
The HAN sign	

50 Having regard to the *Hans* case, for the *Application Mark*, while the dominant component is the word “MARTINI”, it is clear that the other words “LOUIS.M” cannot be ignored as their roles are only slightly less significant than that of the word “MARTINI”. This is apparent from the size of the font and positioning of the words “LOUIS.M” relative to the word “MARTINI”.

51 It is clear from the *Hans* case that words which are in much smaller fonts and in relatively less prominent positions are not taken into account in construing aural similarity. The current case is clearly different. In fact, the word “LOUIS” is similar to the word “MARTINI” in terms of size and font, while the letter “M” is only of a slightly smaller size and font. Thus they cannot be disregarded in assessing aural similarity and due regard has to be given to these words.

52 In light of the above, I am of the view that there is aural similarity but only to a low extent.

Conceptual Similarity

53 The Court in *Staywell* expounded at [35] as follows:

...Unlike the aural analysis, which involves the utterance of the syllables without exploring the composite meaning embodied by the words, the conceptual analysis seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole (Bently & Sherman at p 866). Greater care is therefore needed in considering what the conceptually dominant component of a composite mark is, because the idea connoted by each component might be very different from the sum of its parts...

[Emphasis as underlined mine]

54 It is clear that the *Application Mark*, comprising of the words “LOUIS.M.MARTINI” conveys the idea of a ‘complete’ personal name (ie comprising both a first name and surname). On the other hand, although the *Opponents’ Earlier Mark T0508163A* also conveys the idea of a personal name, it is a ‘partial’ personal name (ie the word “MARTINI” would be construed as either a first name or a surname).

55 I do not agree with the Applicants’ submissions at paragraph 33 of their written submissions where they argued that the [*Opponents’ Earlier Mark T0508163A*] is likely to be seen as a descriptive reference to a type of alcoholic cocktail. I am mindful of the Courts’ guidance in *Staywell* above that at the mark similarity analysis stage the marks are compared mark-to-mark without any reference to any extraneous matter, including that of the goods and services for which the marks are registered / sought to be registered. However, distinctiveness of a mark cannot be construed in a vacuum without reference to the goods / services for which the mark is registered / sought to be registered. One example is the word APPLE. While this word can be regarded as distinctive in relation

to, for example, computers, clearly the same word would not be regarded as distinctive in relation to apples.

56 In the current case, it is clear that the Opponents are relying on the fact that the *Opponents' Earlier Mark T0508163A* has been found to have acquired distinctiveness in relation to vermouth and sparkling wine. Therefore, it would not be appropriate to have regard to any other goods.

57 Finally, in relation to the device in the *Opponents' Earlier Mark T0508163A*, I am of the view that the strong lines and shapes together with the strong and bold font of the word "MARTINI" cause the *Opponents' Earlier Mark T0508163A* to exude a bold and strong connotation. On the other hand, the font of the words "LOUIS.M.MARTINI" in the *Application Mark* is much softer and less intense, and thus consequently imbuing the *Application Mark* with a much softer feel.

58 Taking all of the above into consideration, I am of the view that the marks are conceptually similar to a low extent.

Conclusion on the similarity of marks

59 It is to be recalled following *Staywell* above that:

[17] ... The court must ultimately conclude whether the marks, when observed in their totality, are similar rather than dissimilar...

60 In light of the analysis above, I am of the view that the marks are similar visually, aurally and conceptually to a low extent. Therefore, on the whole, I am of the view that the marks are similar in totality, albeit only to a low extent.

61 Before I leave this ground, the Opponents have tendered various cases, including several from other jurisdictions, to support their case under this limb. My comments are as follows.

62 The first case is the local case of *Subway*. The Opponents referred to the same at paragraphs 38 and 39 of their written submissions. The relevant paragraph in *Subway* is as follows:

[32] ...In contrast, the distinctiveness of the SUBWAY mark complicates matters in the instant case. As the SUBWAY mark bears no inherent or intrinsic distinctiveness (as it is not an inventive word), its distinctiveness, (if any) must be acquired through use. I consider the SUBWAY mark is fairly distinctive as the use of the mark is very widespread (with 92 SUBWAY outlets in Singapore) and long standing (since in 1996 in Singapore) and the plaintiff has without a doubt invested significant sums annually in promoting the mark leading to a large proportion of the Singapore public being capable of identifying SUBWAY sandwiches as part of or emanating from the SUBWAY brand.

[Emphasis as underlined mine]

63 The evidence which formed the basis of a finding that the *Opponents' Earlier Mark T0508163A* has acquired distinctiveness has been discussed above. I note the following:

- (i) *BMSPL* supplies the Opponents' products directly to the following supermarket chains in Singapore (i) NTUC Fairprice; (ii) the Dairy Farm Group (ie Cold Storage and Giant); (iii) Carrefour Singapore (now defunct); and (iv) Isetan. There was no evidence tendered as to the total number of outlets which sell the Opponents' products although I note that the *Opponents' 3rd Evidence* at paragraph 6 and page 3 listed a total of 14 supermarkets which sell the Opponents' products.
- (ii) There are also a total of 29 establishments, which include hotel bars, restaurants and other bars and pubs which serve the Opponents' products. It is also noted that the *Opponents' 3rd Evidence* at paragraph 7 listed 7 food and beverage establishments which serve the Opponents' products.
- (iii) While the evidence tendered (the *Opponents' 2nd Post Registration Evidence* at paragraph 3) indicated that *BMSPL* was incorporated in Singapore on 27 April 1988, the evidence tendered by *BMSPL* in relation to sales figures commenced in 2007 (sales figures were provided for a period of 5 years until 2011). Alternatively, for the sales figures provided by *IWSR*, the figures commenced in 2005 (sales figures were provided for 5 years until 2009). As mentioned above, only one set of evidence can be taken into account to avoid any overlap.
- (iv) Finally, there is no evidence tendered in relation to any promotional figures in Singapore at all.

64 Having regard to the above, while it is understandable why the Court in *Subway* held the way it did in relation to visual similarity (as referred to by the Opponents at paragraph 39 of their written submissions):

The SUBWAY mark and the SUBWAY NICHE sign were visually similar. Significantly, the marks shared a common denominator in the form of the word "Subway". The addition of "niche" to the SUBWAY NICHE sign did not offset this similarity because of the distinctiveness of the SUBWAY mark.

I am of the view that the current case cannot be treated in a similar fashion.

65 In relation to Case T-185/03 *Vincenzo Fusco v OHIM*, the Opponents submitted at paragraph 13 of their supplementary written submissions, that Court of First Instance ("*CFI*") considered that the Italian consumers would generally attribute greater

distinctiveness to a surname rather than a forename and thus would keep in mind the name “Fusco” rather than the forenames “Antonio” or “Enzo”.

66 However it is noted that one of the considerations of the *CFI* is as follows:

[53] In the present case, account should be taken of the perception that the relevant Italian public has of the signs in question. The Court notes in that respect that, as the intervener pointed out, Italian case-law generally considers that the surname constitutes the heart of a sign made up of a forename and a surname. Moreover, it is common ground between the parties that 'Fusco' is not one of the most common surnames in Italy.

[Emphasis as underlined mine]

67 Similarly, the same comment applies to Case T-40/03 *Julián Murúa Entrena v OHIM (“Murúa”)*. As submitted by the Opponents at paragraph 14 of their supplementary written submissions, the court in that case held that the dominant element of the verbal sign of the composite trade mark applied for and the only element of the earlier trade mark were identical (ie *Murúa* in both cases). Consequently, the average Spanish consumer when confronted with a product bearing the trade mark applied for (a composite mark bearing the words *Julián Murúa Entrena* which is perceived as combination of a first name and surname) is liable to regard that product as having the same commercial origin as a product bearing the earlier trade mark (*Murúa* which is perceived as a surname).

68 However, there are several factors which the *CFI* in *Murúa* took into account in relation to the issue of similarity of signs. One of these factors is the judgment No 559/1994 of the Tribunal Supremo of 20 June 1994, delivered in a dispute between the parties in that case, which was produced in the course of the administrative procedure before the Office of Harmonisation of the Internal Market (“*OHIM*”). The *CFI* commented at [71]:

In that case, in a dispute between the applicant and the intervener, the Tribunal Supremo ruled that the word mark Julián Murúa Entrena, registered in Spain, which covered the same goods as those designated by the trade mark applied for, should be annulled because of the likelihood of confusion, on the part of the Spanish public, with the earlier word mark MURÚA, of which the intervener is the proprietor and on which the opposition before OHIM was also based. More specifically, the Tribunal Supremo held that it was clear from the later registration of the trade marks Viñas Murúa and Murúa that the surname 'Murúa' was the dominant element of that trade mark. The likelihood of confusion was demonstrated by the fact that, when they classified Rioja wines, persons unrelated to the defendant (the applicant in the present case), without its intervention, were confused between the trade marks Murúa and Bodegas Murúa, SA, on the one hand, and Bodegas Murúa Entrena, SA, on the other, and perceived the wine designated by the trade mark Murúa as coming from both undertakings, as the

defendant had acknowledged, while imputing the mistake to third parties. Against this background, the Tribunal Supremo ruled that 'since the word "Murúa" [was] the means of identifying the wines and it [was] this word that [had] led, upon the defendant's application, to the refusal to register the trade marks "Murúa Gangutia" and "Heredad Murúa Gangutia", it [was] clear that registration should also [have been] refused, at the administrative stage, in respect of the trade mark "Julián Murúa Entrena" and that it should now, at the judicial stage, be annulled'.

[Emphasis as underlined mine]

69 The Opponents further argued, at paragraph 15 of their supplementary written submissions, that *Murúa* is cited in the OHIM Guidelines for Examination on Community Trade Marks (Part C, Opposition, Section 2, Chapter 8, page 21) as follows:

Surname against first name plus identical surname

When two signs contain the same surname but only one of them also contains a given first name, the rule of thumb is that normally there will be a likelihood of confusion. Consumers might be misled and attribute a common origin to the goods/services concerned. The presence of a first name in one of the conflicting signs will not suffice to safely distinguish the signs in the minds of consumers. The surname alone will be perceived as the short version of the full name, thus identifying the same origin.

[Emphasis as underlined mine]

70 The above is a general principle to guide examiners when they are seeking to examine marks. However, surely there is a need to assess the facts of each case to see if the general principle is applicable before coming to a final conclusion.

71 In relation to *In re Thomas Barton (Serial No. 85826787)*, it is indicated as a heading to the decision that the opinion is not a precedent of the Trade Mark Trial and Appeal Board ("*TTAB*"). It is noted that *TTAB* designates all final decisions as either precedential or not precedential, and only precedential decisions are binding on the *TTAB*.

72 Lastly, in relation to *R. Thorne & Sons Ltd v Pimm's Ltd. (1907)* 26 RPC 221, it is clear that the plaintiff in that case had been using their mark "Thorne Whisky" for many years such that it had acquired, both in the trade and among the public, a reputation under that name (see [47] – [53]). This is clearly not so in the current case. As I have alluded to above, while it is the case that the *Opponents' Earlier Mark* has been found to have acquired distinctiveness, this does not automatically mean that the said mark has a high level of the same.

Similarity of Goods

73 In relation to this limb, the Court in *Staywell* provided the following principles at [43]:

[43]...the real question is whether Staywell’s services that were sought to be registered under Class 35 are similar to the Opponents’ services under Class 43, having regard to all relevant factors relating to the services themselves. Some of the factors set out in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 (“British Sugar”) at 296 would be relevant at the goods-similarity stage of the inquiry, in particular the consideration of the uses and the end-users of the services. The question is how the services are regarded, as a practical matter, for the purposes of trade...

[Emphasis as underlined mine]

74 The factors set out in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 (“*British Sugar*”) are as follows:

- (a) the respective uses of the respective goods or services;
- (b) the respective users of the respective goods or services;
- (c) the physical nature of the goods or acts of service;
- (d) the respective trade channels through which the goods or services 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 or services are competitive.

75 For ease of reference, the goods for the marks are as follows:

<i>S/N</i>	<i>Opponents’ Earlier Mark T0508163A</i>	<i>Application Mark</i>
3	Class 33	Class 33
	Vermouth and sparkling wine.	Alcoholic beverages (except beers).

76 It is quite clear from the above that there is an overlap between the goods of the respective marks as it would be obvious that vermouth being a type of fortified wine and sparkling wine can be considered as different types of wines. In turn, wines are clearly a type of alcoholic beverage. Thus, the term “alcoholic beverages (except beers)” is broad enough to cover both vermouth and sparkling wine. Vermouth and sparkling wine being a subset of the term “alcoholic beverages (except beers)”, there is identity with respect to the goods (see the Opponents’ supplementary written submissions at paragraph 28).

77 The Applicants’ submitted at paragraphs 41 to 43 of their written submissions that as there is only a small overlap in the goods claimed by the *Application Mark* and the *Opponents’ Earlier Mark T0508163A*, even if the Registrar takes the view that the

Opponents' Earlier Mark T0508163A is similar to the *Application Mark*, the Opponents can only object to the *Application Mark* being protected for vermouth and sparkling wine such that the Opponents cannot object to the *Application Mark* being protected for alcoholic beverages that are not vermouth or sparkling wine.

78 It is to be recalled that the second limb of the ground of objection under Section 8(2)(b) caters to both identity as well as similarity of goods, reproduced below for ease of reference:

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.

[Emphasis as underlined mine]

Thus the analysis does not have to stop at the point of the conclusion reached above, that there is identity with respect to the goods since vermouth and sparkling wine are subsets of the term “alcoholic beverages (except beers)”. On the basis that vermouth and sparkling wine are excluded from the specification of goods in the *Application Mark*, it is permissible to proceed to determine whether there is similarity in relation to the goods (Opponents’ supplementary written submissions at paragraphs 29 and 30).

79 At this juncture, an issue arises as to whether the Registrar is empowered to allow an opposition in relation to part of the specification of the goods. However in light of my conclusion with regard to similarity of the goods below, it is not necessary for me to decide on this point in the current case. Further, it is also not appropriate for me to do so since neither party has made any submissions in relation to the same.

80 I note that the term “alcoholic beverages (except beer)”, being very broad, covers not only vermouth and sparkling wine but also, for example, still wines such as red and white wines. The question then is whether vermouth and sparkling wine can be regarded to be similar to, for example, still wines?

81 In this regard, I agree with the Opponents’ submissions (paragraph 29 of the Opponents’ supplementary written submissions) that in order to answer the question, there is a need to apply the factors as elucidated in in *British Sugar*. In the current case, the uses, users, as well as the physical nature and trade channels of the goods are similar. When the goods are sold via the retail channel, while they may not be on the same shelves, they would be shelved in close proximity. The goods can also be said to be indirect substitutes. One example would be sparkling wine versus still wine.

82 In light of the above, I am unable to agree with the Applicants’ submissions at paragraph 43 of their written submissions that there is only a small overlap in the goods such that the Opponents cannot object to the *Application Mark* being protected for

alcoholic beverages that are not “vermouth”, or “sparkling wine”. As alluded to above, “vermouth” and “sparkling wine” can be considered to be similar to other items under the broad term “alcoholic beverages (except beers)”. In this regard, I agree with the Opponents at paragraphs 29 and 30 of their supplementary written submissions that to the extent that the goods do not overlap, they are similar.

83 Thus I am of the view that this element has been satisfied.

Likelihood of confusion

84 At [55] of its decision in *Staywell*, the Court of Appeal restated as follows:

[55]... 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 services are and (c) given this, how likely the relevant segment of the public will be confused. 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. 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. ...

[Emphasis as underlined mine]

Notional Fair Use

85 Further, the Court of Appeal in *Staywell* clarified the approach to determining likelihood of confusion at [60]:

[60] Accordingly in opposition proceedings the inquiry must take into account the full range of the competing monopoly rights that are already enjoyed on the one hand, namely the actual and notional fair uses to which the incumbent proprietor has or 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...

[Emphasis as underlined mine]

Extraneous Factors

86 In *Staywell*, the Court of Appeal also affirmed the relevance (or otherwise) of extraneous factors as follows at [83], [84] and [96]:

[83] On the effect of the foregoing on the relevant segment of the public – extraneous factors may be considered to the extent that they inform the court as to how the similarity of marks and goods will likely affect the consumer’s perception as to the source of the goods. This however, is subject to some important qualifications which we will now elaborate upon.

[84] ...in opposition proceedings, it will generally not be relevant to consider extraneous factors that relate to the actual and particular circumstances and ways in which the mark was used on the goods in question. While it will be necessary to consider the notional or fair uses to which each of the marks could be put, for instance in terms of what types of goods or services are within the contemplated uses for which the mark has been registered, it will not be relevant to have regard to the particular way in which the goods or services have been affixed with the mark and are then being marketed.

...

[96] Based on these considerations, 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* at [85(c)(iii)]), the reputation of the marks (see *Polo (CA)* 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 Schuhfabric Meyer v Klijsen Handel BV*, Case C-342/97 [1999] 2 CMLR 1343 at 1352; and *Philips-Van Heusen Corp v OHIM* [2004] ETMR 60 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. We refer here to *In the matter of an Application by the Pianotist Company for the Registration of a Trade Mark* (1906) 23 RPC 774 (“*Pianotist*”) where it was observed that, having regard to the nature of the article in question (musical instruments), the (high) price at which it was likely to be sold, and the nature of the consumers who are likely to purchase such products (“generally persons of some education”), a man of ordinary intelligence was unlikely to be confused (at 778). The price of the type of product being sold is distinct from the issue of price disparity between the parties’ products. The former consideration directly impinges on the degree of care the consumer is likely to pay to his purchase and therefore his ability to detect subtle differences. As observed in *Reed Executive Plc v Reed Business Information Ltd* [2003] RPC 12 at [103], “a 50 pence purchase in the station kiosk will involve different considerations from a once-in-a-lifetime expenditure of 50,000 pounds”. On the other hand, superficial price disparity between the competing goods, which speak more about the trader’s marketing choices rather than differences in the nature of the goods themselves, is not a factor we find relevant to the inquiry.

[Emphasis as underlined mine].

87 Last but not least, the likelihood of confusion required is that to be expected amongst “a substantial portion of the relevant segment of the public” (*Hai Tong* at [78(e)]).

88 In terms of the factors relating to the impact of marks-similarity on consumer perception, I have already concluded above that the marks are visually, aurally and

conceptually similar to a low extent. In relation to this, as will come to light later, I am of the view that it is the visual and the aural aspects of the mark, in that order, that are more important.

89 In relation to the reputation of the marks, having regard to the evidence tendered to support the finding that the *Opponents' Earlier Mark T0508163A* has acquired distinctiveness, I am of the view that the reputation of the *Opponents' Earlier Mark T0508163A* in Singapore is not high. I stress that I make this finding only in relation to the local context. As alluded to in the *Post Registration Decision* at [222] to [225] (reproduced above), while it would appear that the Opponents have invested substantially in promoting their products overseas, it has not been shown if such promotional activities reached the local audience.

90 On the Applicants' side, they have also sought to tender evidence as to the sales and promotion of the *Application Mark*. In terms of sales, the Applicants sought to tender sample invoices showing shipment and sales of products under the *Application Mark* to Singapore (see Exhibit C of the *Applicants' 1st Evidence* at pages 62 – 68). However, I agree with the Opponents' submissions at paragraph 34 of their written submissions that this evidence is fraught with difficulties. Firstly, there are only a total of 7 pages of invoices (pages 62 – 68 of the *Applicants' 1st Evidence*). Secondly, all the invoices are dated after the relevant date of 3 March 2010, which is the date of application of the *Application Mark*. Thirdly, the invoices do not show use of the *Application Mark* but rather the term LMM is used. Finally, it is unclear if the goods mentioned in these invoices actually reached consumers in Singapore. For example, at page 64 of the same evidence, the billing entity and address is an Indonesian company and address while the entity for shipment is also an Indonesian company although the address is a Singapore address.

91 The Applicants sought to tender evidence of sales (in addition to that above) and promotion in relation to products bearing the *Application Mark* in general at paragraphs 11 – 16 of the *Applicants' 1st Evidence*. However, the main issue is that it is unclear if these materials ever reached the local audience. In light of the above, I am of the view that it has not been shown that the *Application Mark* has any reputation in the local context. Under the legislation, as at the point of application for the registration of a trade mark, it is acceptable to have an intention to use the mark. It is not a pre-requisite for an applicant to be already using the trade mark before embarking on the registration process. However, the point is that if the mark is used only after the date of application of the trade mark in the local context, then there is no reputation in this regard when considering the likelihood of confusion since the relevant date for the purposes of analysis is the date of application of the trade mark.

92 In relation to the impression of the marks and the possibility of imperfect recollection, while there is no evidence tendered by either party as the state of the market, the Opponents argued at the oral hearing as well as at paragraphs 4(e), 5(g), 20, 22 and 24(a) of their supplementary written submissions that apart from the Opponents, there is no other trader in the market place for Class 33 goods using “MARTINI” as a trade mark.

However, the Opponents did not tender any evidence in this regard to support this argument. While the Opponents made this argument in the context of the analysis of similarity of marks, I am of the view that it is more appropriate to discuss this issue at this juncture since the Court in *Staywell* has stated that the analysis of marks at the mark similarity stage is mark-for-mark without any reference to any extraneous matter.

93 I have sought to do a quick search using the keyword “MARTINI” for Class 33 and the search results (SQTMSM2015100200110S) is attached to this decision. Such public searches can be done by any party over the IPOS website. In summary, the search results shows that while there is no other use of “MARTINI” *per se* in Class 33, there are, however, several variants of “MART-” marks in Class 33, whether it be MARTIN (see T0409801H - item 8 of the search results) or MARTINA (T0721995I – item 13 of the search results) or MARTINO (see T0906680G – item 15 of the search results).

94 The significance of the above information is this. As a result of the common use of variants of “MART-” marks, it would not be unreasonable to project that consumers, being accustomed to seeing variants of “MART-” for marks on Class 33 goods, would naturally turn to other elements of the marks. In the current case, it is the words “LOUIS.M.” in the *Application Mark*. In light of the above, the effect of the similarity on the would-be consumer would be that they would focus on the words “LOUIS.M.” in the *Application Mark* in light of the existence of many variants of “MART-” marks in Class 33.

95 At this juncture, it is appropriate to note that while it may be true as a general principle that the public would normally ascribe greater attention to a surname rather than a forename, this surely must be seen in the context of the actual facts of a particular case. For example, where the surname in question is common, it would only be natural for one to look out for the first name instead (or as well). I am also mindful that the search results in the instant case show that there are many variants of “MART-” marks rather than the fact that there is more than one entity using “MARTINI” *per se* in Class 33. However, I am of the view that the existence of such variants is sufficient to cause a consumer to be more mindful of the other less common portions of the mark.

96 It is to be recalled that, following *Staywell*, the greater the similarity between the marks, the greater the likelihood of confusion.

97 For the factors relating to the impact of goods-similarity on consumer perception, in particular, in relation to the very nature of alcoholic goods, it was held in the *Post Registration Decision* at [219] that:

[219] In this regard, I also agree with the Registered Proprietors that a consumer of alcoholic beverages who is reasonably well informed and reasonably observant and circumspect, would be able to understand that "bianco" and "rosso" simply denote product lines. I am of the view that the average discerning consumer of alcoholic beverages, who is reasonably well informed and reasonably observant and circumspect would be aware that the main types of vermouth includes dry and

sweet vermouths and that sweet vermouths can be red (“rosso” meaning red in Italian) or white (“bianco” meaning white in Italian). I am of the view that alcoholic beverages are products which, aside from the fact that they are to be imbibed, are products which are very much a question of preference such that the average consumer of the relevant class would be particularly discerning and knowledgeable as to the various types of alcoholic beverages which he or she would prefer and thus choose to consume.

[Emphasis as underlined mine]

I see no reason to depart from the above view in this instance.

98 Further, in this regard, I agree with the Applicants at paragraph 64 of their written submissions that:

[64]...It is not uncommon for such consumers to pay great attention to the trade source, age and country of origin as such factors are determinative of the quality of the goods in question...the quality of alcoholic beverages (except beers) can vary greatly depending on its source of origin...

[Emphasis as underlined mine]

99 In terms of the price of the goods, in Singapore at least, alcoholic products are not inexpensive as a result of the tax imposed on them (paragraph 64 of the Applicants’ written submissions).

100 Thus, the very nature of “alcoholic beverages (except beers)” (i.e. the goods for which the ***Application Mark*** is applied for in this case) is such that they would tend to command a greater degree of fastidiousness and attention on the part of prospective purchasers for the following reasons:

- (i) They are to be ingested;
- (ii) They are “lifestyle” goods such that the brands which purchasers ultimately purchase are very much a matter of preference;
- (iii) There are many variant factors which determine the quality of the products; and
- (iv) They are rather expensive.

101 In light of the above, I disagree with the Opponents’ submissions at paragraph 34 of their supplementary written submissions, that “alcoholic beverages (except beers)” are not specialised products such that consumers will be discerning and fastidious in their purchase. Further, I also disagree with the Opponents’ submissions in the same paragraph that the Applicants are exaggerating the price effect in relation to the attention that consumers will pay to their purchases since “consumers can choose to purchase a glass of wine or a single serving of vermouth. One does not have to buy the whole bottle”. For purposes of parity, one should compare the price of a glass of alcoholic

beverage to that of a glass of non- alcoholic beverage in the food and beverage establishment. In this regard, I refer to the *Opponents' 3rd Evidence* at Exhibit 9. This exhibit contains samples of menus of various food and beverage establishments across Singapore. Pages 117 – 132 show the menu of “Verve Pizza Bar”. Page 121 shows that a serving of Coke costs SGD 5. Page 128 shows a glass of “Martini Bianco” costs SGD 14.

102 On the other side of the coin, with regard to 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, consumers of “alcoholic beverages (except beer)” are generally well-informed and knowledgeable about their prices, quality and value. The consumers in general tend to be more discerning.

103 The Opponents argued at paragraphs 33 – 34 of their supplementary written submissions, that the Applicants have not tendered any evidence to support their assertion that consumers of alcoholic beverages would exercise higher attention to the trade source of such products and take greater care in their purchase. However, I note two points. Firstly, as the Applicants have argued at the oral hearing, this argument, that, a consumer of alcoholic beverages is reasonably well informed and reasonably observant and circumspect, was raised by the Opponents (as Registered Proprietors) in the *Post Registration Decision* (at [219]; replicated above). It would appear that the Opponents are now taking an opposite stance. Secondly, even if the Opponents wish to take such an opposite stance in relation to this issue for this current Opposition, they have not tendered any evidence in support of this assertion. It is to be recalled that the burden of proof for this Opposition is on the Opponents.

104 In relation to the normal way in, or the circumstances under which, consumers would purchase alcoholic products, as can be seen from the Opponents' evidence tendered in relation to acquired distinctiveness, two common routes in which these products reach the consumer are (i) via the retail channel; and (ii) via food and beverage establishments. When these products are sold via retail channels, they will be self-service items which are placed on the relevant shelves. I refer to the *Opponents' 3rd Evidence* at paragraph 6 of the same and Exhibit 8. The evidence tendered showed the Opponents' products displayed on the shelves of various supermarkets. It is also possible for wine products to be sold in wine speciality shops. Bottles of alcoholic beverages are also usually displayed on shelves at such speciality shops. It is also a common feature of such speciality shops to have attendants who are well-versed in the trade so as to be able to assist the consumer where necessary. Therefore, when alcoholic products are sold via the retail route, it is clear that it is the visual aspect of the marks that is paramount.

105 The other route through which alcoholic products reach the consumers is via food and beverage establishments. I refer to the *Opponents' 3rd Evidence* at paragraph 7 and Exhibit 9.

106 The Opponents argued at paragraph 67 of their written submissions that the unique context of how drinks are ordered and identified at food and beverage establishments is

such that the aural component of the mark is paramount since any other visual distinctive design or font incorporated within the mark of a particular product would not be reproduced on the menu. The Opponents concluded that this particular context and the use of the common and dominant denominator “MARTINI”, will lead to a finding of a likelihood of confusion.

107 In relation to this, the Court in *Staywell* at [84] (reproduced above) have indicated that “in opposition proceedings, it will generally not be relevant to consider extraneous factors that relate to the actual and particular circumstances and ways in which the mark was used on the goods in question” and that “it will not be relevant to have regard to the particular way in which the goods or services have been affixed with the mark and are then being marketed”. Thus, the said circumstance, that is, it is common to only replicate the words in the marks and not the devices in menus, cannot be taken into account.

108 When alcoholic beverages are sold via this route, consumers will look at the menu and either (i) orally order the product or (ii) point at the item to the staff such that it is the visual and the aural aspects of the marks (and in that order) which are important. Having regard to the ordering process, the nature of the good and the nature of the consumer, I am of the view that there would not be a likelihood of confusion.

109 I am mindful that the "initial interest confusion" doctrine does not apply in Singapore such that the material time at which this confusion must exist in the mind of the relevant public is at the time of purchase (see *Staywell* at [116] and *Law of Intellectual Property of Singapore (Sweet & Maxwell, 2014 Rev Ed)* by Ng-Loy Wee Loon (“*Law of Intellectual Property of Singapore*”) at [21.5.26]).

110 In this regard, I am of the view that even if a consumer is caused to wonder if the alcoholic beverages come from the same source or are economically linked, given the particular nature of the goods and the nature of the consumers, any likelihood of confusion will be displaced at the point of purchase.

Conclusion on likelihood of confusion

111 In summary, I find that there is no likelihood of confusion between the ***Application Mark*** and the ***Opponents’ Earlier Mark T0508163A***. The competing marks share, at best, a low degree of similarity. As regards the goods of interest, which have been found to be identical or similar in nature, the impact of this identity or similarity between them is reduced by the fact that the competing marks share a low degree of similarity and because the very nature of the goods is such that they would tend to command a greater degree of fastidiousness on the part of prospective purchasers while the nature of the consumer is such that he is likely to pay more attention when buying the goods in question. The average Singaporean consumer for alcoholic beverages (except beers) is reasonably knowledgeable and discerning about such alcoholic beverages and would thus make a considered decision before committing to a purchase in a supermarket or food and beverage establishment, thus greatly lessening any impact of goods similarity.

112 Thus in light of all of the above, on balance, taking into account the permissible extraneous factors, I find that there is no reasonable likelihood of confusion.

113 The ground of opposition under Section 8(2)(b) therefore fails.

114 Before I leave this ground, I note that the Opponents relied on several other cases from *OHIM*. In this regard, the relevance of these specific cases has been reviewed by the learned Assistant Registrar in *Taylor's* (see [32] – [36] of the said case).

Independent distinctive role of earlier mark within the later mark

[32] A question that arises in this case is whether it is possible for a registered trade mark that is wholly (or nearly wholly) contained within a composite application mark to have "an independent distinctive role" such that the competing marks should be found to be similar. I briefly consider the approaches of the European Union and the Singaporean courts in this regard.

[33] In the case of *Medion AG v Thomson multimedia Sales Germany & Australia GmbH (Case C-120/04) ("Thomson")* the court was faced with the earlier mark "LIFE" and the later application "THOMSON LIFE", both for "leisure electronic devices". It held that even if the earlier registered trade mark was **not** the dominant element of the later, composite mark, it would be possible for this earlier registered trade mark to have "an independent distinctive role" in the composite mark (see *Thomson* at [30]). The court held that this would apply even if the "owner of a widely known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known" (*Thomson* at [34]).

[34] In a more recent case, *Bimbo SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (Panrico SA, intervener) (Case C-591/12 P) ("Bimbo")* the court found that the principle on the "independent distinctive role" may not apply "if, together with the other component or components of the sign, that component forms a unit having a different meaning as compared with the meaning of those components taken separately" (see *Bimbo* at [25]). In this case, the court was concerned with the earlier mark "DOGHNUTS" and the later application mark "BIMBO DOUGHNUTS", both for similar goods in Class 30. The court upheld an earlier decision that "DOGHNUTS" had an independent distinctive role and concluded that there was a likelihood of confusion. This was despite the non-identical spelling of the word "DOGHNUTS" (instead of "Doughnuts") – although this point was raised by the appellant.

[35] However, in another case, *Barbara Becker v Harman International Industries Inc (and OHIM) in Case C-51/09 P ("Becker")*, the court did not apply this principle. The court considered whether the earlier mark, "BECKER", was confusingly similar to the later application mark, "BARBARA BECKER",

both for goods within Class 9. The court noted that the surname "Becker" was common, but that "a surname does not retain an independent distinctive role in every case solely because it will be perceived as a surname" (see *Becker* at [38]). The court continued, at [39], stating that to allow the earlier mark to succeed would result in acknowledging that any surname which constitutes an earlier mark could be effectively relied on to oppose registration of a mark composed of a first name and that surname, even though, for example, the surname was common or the addition of the first name would have an effect, for a conceptual point of view, on the perception by the relevant public by of the composite mark⁴.

[36] In Singapore, the concept of the "independent distinctive role" of a registered trade mark within a later application mark/sign has not specifically been discussed. However, the court tries to determine if the earlier registered trade mark is "distinctive" and whether the other elements in the later application mark/sign erode the distinctiveness of the earlier mark within it.

[Emphasis as underlined mine]

Thus, it would be more appropriate to address the issue of the distinctiveness of the earlier mark and this has been discussed above.

115 In relation to foreign decisions which relate to the Opponents' "MARTINI" and variants of "MARTINI" marks, they are not helpful for the current case. Aside from the fact that the legislation in these jurisdictions may be different from that in the local context, the factual circumstances abroad are in all likelihood very different to those in Singapore. For example, it is apparent from the evidence tendered by the Opponents in the *Post Registration Decision* that the Opponents appeared to have invested much in terms of promotion of their marks overseas.

116 The Opponents also sought to refer to several other foreign cases under this element of "likelihood of confusion". My responses in relation to them are as follows.

117 In relation to the Australian Registry Decision of *Foster's Wine Estates Ltd v Serafino Wines Pty Ltd* [2010] ATMO 81 ("*Maglieri*"), I am of the view that the case does not assist as the hearing officer found that *Maglieri* is a very uncommon surname:

[28] The O'Keefe #2 declaration and the Forman #2 declaration attest to how striking and unusual the term *Maglieri* is when used in the wine industry. The O'Keefe #2 and Forman #2 declarations state that *Maglieri* is also a very uncommon surname. Mr O'Keefe states his belief that it is more likely that consumers would assume a trade connection between wines bearing trade marks containing the uncommon surname, such as a forename/surname combination, as

⁴ The Opponents contended that while "Becker" is a common surname in Germany, "MARTINI" is not common in Singapore.

the uncommon surname will be the part of the trade mark which consumers recall. I agree with this submission.

[Emphasis as underlined mine]

118 Clearly, the above is something which the hearing officer had in mind before he made the following comments in the respective paragraphs below (as replicated by the Opponents at paragraph 75 of their written submissions):

- (i) that he “considers that the striking and memorable feature of the opposed trade mark is the word MAGLIERI” (at [30]);
- (ii) that he “note[s] the additional words to some of the opponent’s trade mark registrations but these are minor variations and it is likely that the common element, MAGLIERI, in all the trade marks will induce traders and the public into believing that goods branded with the trade marks emanate from the same trade source” (at [33]); and
- (iii) that “[w]hile the opposed trade mark contains the additional word SERAFINO”, he was “not satisfied this is enough to sufficiently differentiate the applicant’s trade mark from the opponent’s trade marks” (at [34]).

119 Clearly, this is not so in the current case. It has already been mentioned above that variants of the word “MART-” are rather common as marks for Class 33 goods.

120 In relation to the unreported case of *Gucci SpA v Cosino Ludolf Gucci & Ors [2009] HKCU 1148 (“Gucci”)*, I am of the view that the case does not assist either for the following reasons.

121 First of all, the Court adopted the European approach towards the issue of similarity of marks see [79] i.e. the global appreciation test as advocated in the case of *Sabel BV v Puma AG* [1998] RPC 199. This is different from the approach in Singapore where the Court in *Staywell* clearly stated that the approach in the local context is that of the 3-step test.

122 Second, it is clear that based on the evidence tendered before the Court, “Gucci” is a strong mark in Hong Kong, see [90]:

[90]...The Gucci brand is now almost a household name in the luxury goods market, and on the evidence before me, it is extremely well-known both internationally and in Hong Kong...

[Emphasis as underlined mine]

123 In fact, when the Court was introducing the plaintiff at [10], it stated as follows:

[10]: As far as Hong Kong is concerned, the first Gucci shop was opened in the Peninsula Hotel in 1974. Presently, there are 9 Gucci stores in Hong Kong, with its flagship store in the Landmark, Central. I have mentioned above that in 2007, worldwide revenue derived from the sale of Gucci products was in the region of HK\$60 billion. In that year, sales in Hong Kong contributed about HK\$1.7 billion. The plaintiff also spent substantially in advertising its products in Hong Kong. Advertising expenses in 2007 alone were estimated as HK\$25 million. Another HK\$12.3 million was spent in 2007 on PR expenses.

[Emphasis as underlined mine]

124 The Opponents' submissions at paragraph 76 of their written submissions where they referred to [94] to [97] of *Gucci* must be read in light of the above. In fact I refer to [94] (which was replicated by the Opponents at paragraph 76 of their written submissions):

[94] When the word 'Cosimo' is used together with 'Gucci in a word sign on goods (particularly on goods of the types which are also marketed by the plaintiff), to an average customer who sees such a word sign, the dominant element of the sign is clearly the word 'Gucci'. **In my view, it is likely that the average customer seeing such a sign would come away thinking that the goods are related to Gucci.** When 'Cosimo' is unknown and 'Gucci' is so widely known, the overall impression of the average customer is likely to be dominated by the leading element of the mark, namely, 'Gucci'. Visually, aurally and conceptually, 'Gucci' is the dominant element of the sign.

[Emphasis in bold the Opponents' and emphasis as underlined mine].

125 Similarly, I also refer to [96] of *Gucci* which was also quoted by the Opponents' in their written submissions at paragraph 76:

[95] I am fortified in my view above by the decision of the office for Harmonization in the Internal Market (Trade Marks and Designs) ("OHIM") in a contested European Community Trade Mark application relating to the mark "JENNIFER DESIGNED BY JENNIFER GUCCI" ... OHIM decided that the word "GUCCI" was the dominant element of the mark, and given the exceptional distinctiveness of the Gucci Mark, **the incorporation of the word "GUCCI" as part of the mark to be registered would lead to a likelihood of confusion.** ...

[Emphasis in bold the Opponents' and emphasis as underlined mine].

126 The issue is, is the *Opponents' Earlier Mark T0508163A* in the current case "so widely known" or does it possess such "exceptional distinctiveness"? Clearly, the answer must be found in the evidence tendered to support the finding that the *Opponents' Earlier Mark T0508163A* has acquired distinctiveness. The evidence has been discussed

above and I will not repeat them here. Suffice to say that in my view, the evidence as tendered is not sufficient to show that the *Opponents' Earlier Mark T0508163A* possess such a high level of distinctiveness.

127 In relation to *In the matter of Application No. B1545079 by Jhane Barnes (Del.) Inc to register a trade mark BARNES STORM* (O-036-01), the applicant applied for the mark “Barnes Storm” for Class 25 goods. The application contains a disclaimer of any exclusive right to the use of the word “Barnes”. The opponents are the owner of several marks “Storm” for different goods including those in Class 25. As the hearing officer noted at page 6, line 28:

The applicant’s mark is BARNES STORM but it is BARNES not STORM which is disclaimed. Thus the word STORM must be considered distinctive of non-waterproof type clothing.

In light of the above, it is not surprising that the hearing officer held at page 6, line 40 (as replicated by the Opponents at paragraph 78(a) of their written submissions) that “the degree of similarity between the trade mark BARNES STORM and the trade mark STORM is sufficient to cause deception and confusion amongst a substantial number of persons.”

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

128 Section 8(4)(b)(i) 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...

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

Similarity of marks

129 In relation to this ground, it is clear that the first element that must be satisfied is that “the whole or an essential part of the trade mark” must be identical or similar to an earlier mark.

130 In relation to this element, my view is primarily the same in relation to the similar element under Section 8(2)(b), that is, the marks are more similar than dissimilar in totality such that this element has been made out.

Well-known in Singapore

131 The critical question is whether the ***Opponents' Earlier Mark T0508163A*** is well known in Singapore as at the relevant date of 3 March 2010, which is the date of application of the ***Application Mark***.

132 The starting point for this element are the relevant definitions in Sections 2(7), (8) and (9) of the Act.

Section 2(7) of the Act states:

Subject to subsection (8), in deciding, for the purposes of this Act, whether a trade mark is well known in Singapore, it shall be relevant to take into account any matter from which it may be inferred that the trade mark is well known, including such of the following matters as may be relevant:

- (a) the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;*
- (b) the duration, extent and geographical area of –
 - (i) any use of the trade mark; or*
 - (ii) any promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied;**
- (c) any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application;*
- (d) any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory;*
- (e) any value associated with the trade mark.*

Section 2(8) of the Act reads:

Where it is determined that a trade mark is well known to any relevant sector of the public in Singapore, the trade mark shall be deemed to be well known in Singapore.

Section 2(9):

In subsections (7) and (8), “relevant sector of the public in Singapore” includes any of the following:

- (a) all actual consumers and potential consumers in Singapore of the goods or services to which the trade mark is applied;*
- (b) all persons in Singapore involved in the distribution of the goods or services to which the trade mark is applied;*
- (c) all businesses and companies in Singapore dealing in the goods or services to which the trade mark is applied.*

133 In relation to the provisions above *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 (“*Amanusa*”) has provided much guidance:

[137]...It appears that the court is ordinarily free to disregard any or all of the factors listed in s 2(7) as the case requires (subject to [Section 2(7)(a) of the Act]), and to take additional factors into consideration....

...

[139] Despite what has been said earlier, it can be persuasively said that s 2(7)(a) is arguably the most crucial factor when determining whether a trade mark is well known in Singapore. This is because, by virtue of s 2(8) of the current TMA:

Where it is determined that a trade mark is well known to any relevant sector of the public in Singapore, the trade mark shall be deemed to be well known in Singapore.

...

[229] Finally, it will be recalled that it is not too difficult for a trade mark to be regarded as “well known in Singapore” – essentially, the trade mark in question need only be recognised or known by “any relevant sector of the public in Singapore” [emphasis added] (see s 2(7)(a) of the current TMA), which sector could in certain cases be miniscule...

[Emphasis as underlined mine].

134 Finally, the Court in *Amanusa* discussed the ambit of the phrase “all actual consumers and potential consumers in Singapore of the goods to which the trade mark is applied” at [152] and concluded that “the inquiry is much more focused and manageable if one looks only at the specific goods or services to which the [Opponents’] trade mark has been applied (that is, if one considers only the [Opponents’] goods or services).”

135 In light of the above, I am prepared to hold that the *Opponents’ Earlier Mark T0508163A* is well known in Singapore in that I am of the view that the *Opponents’ Earlier Mark T0508163A* would be well known to all businesses and companies in Singapore dealing in the goods to which the said mark is applied.

Confusing connection

136 In this regard, the Court at *Staywell* provided at [120]:

...As for the third element, the detailed analysis in *Amanresorts* has put it beyond doubt that the connection requirement of s 8(4)(b)(i) and s 55(3)(a) of the Act will be satisfied where there is a likelihood of confusion (see *Amanresorts* at [226] and [233])....

137 Having taken the above into consideration, I am of the view that there is no confusing connection here for largely the same reasons that I have provided for my conclusion in relation to the likelihood of confusion under Section 8(2)(b).

Damage

138 In relation to this element, as I have found that there is no confusing connection, there is no need for me to delve into it.

Conclusion on Section 8(4)(b)(i)

139 The objection under this ground fails.

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

140 The relevant provisions of the Act read:

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—*

(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 —

(ii) if the earlier trade mark is well known to the public at large in Singapore;
(A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or

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

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

Similarity of marks

141 In relation to this ground, it is clear that the first element that must be satisfied is that “the whole or an essential part of the trade mark” must be identical or similar to an earlier mark.

142 I have already concluded that the *Application Mark* and the *Opponents’ Earlier Mark T0508163A* are similar under the ground of objection under Section 8(2)(b). I will not repeat my analysis here.

Well-known to the public at large

143 The critical question is whether the *Opponents’ Earlier Mark T0508163A* is well known to the public at large (in Singapore) as at the relevant date of 3 March 2010, which is the date of application of the *Application Mark*.

144 In relation to the element, it is clear that the relevant provisions and case law which relate to the limb “well known in Singapore” (as referred to above) applies. Further, the Court in *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 held:

In the context of s 55(3)(b)(i) of the Act, the test “well known to the public at large in Singapore” had to mean more than just “well known in Singapore”. To come within the former test, the mark had to necessarily enjoy a much higher degree of recognition. It had to be recognised by most sectors of the public though the court would not go so far as to say all sectors of the public.

[Emphasis as underlined mine]

145 In addition, the Court in *Amanusa* provided at [233]:

...A second, much more extensive level of protection is granted to trade marks which have attained the coveted status of being “well known to the public at large in Singapore”. These trade marks, which form a rare and exclusive class, are entitled to protection from use of the defendant’s trade mark on dissimilar goods or services even in the absence of a likelihood of confusion; that is, such trade marks are entitled to protection against the unfair dilution and the taking of unfair advantage of their distinctive character...

[Emphasis as underlined mine]

146 In relation to this element, the Opponents at paragraph 112 of their written submissions (read with paragraphs 95 – 105 of the same), referred, in particular, to the following:

- (i) The fact that in the *Post Registration Decision*, the Registrar found the *Opponents’ Earlier Mark T0508163A* to have acquired distinctiveness for vermouth and sparkling wine.

- (ii) The sales figures for the *Opponents' Earlier Mark T0508163A* in Singapore.
- (iii) The Opponents have used the "MARTINI" marks in relation to MARTINI TERRAZZA bars. These are exclusive bars in the major cities of the world, which played host to generations of famous personalities from show business, the arts, sportsmen, artists, politicians and royalty.
- (iv) In relation to advertising and promotion, the following activities:
 - (a) The hiring of famous and imaginative artists to create massive poster campaigns;
 - (b) The employment of famous personalities in conjunction with their advertising campaigns;
 - (c) Evidence from the video-sharing website www.youtube.com for "MARTINI" advertisements showing that there are a large number of results;
 - (d) The sponsorship of "Dictionary of Cocktails" in 1998;
 - (e) Various items of branded promotional material have been created – including ashtrays and glasses etc that have a presence throughout the world including Asia on all points of sale, both on-trade and off-trade; and
 - (f) Sponsorships under the "MARTINI" marks in motorsport / motor racing activities.
- (v) The Power 100 survey reports for the years 2009 and 2010 in the category of "The World's Most Powerful Spirits & Wine Brands".
- (vi) Evidence that the "MARTINI" marks are extensively protected around the world through numerous trade mark applications and/or registrations.
- (vii) Evidence of successful enforcement in overseas jurisdictions in relation to the "MARTINI" marks.

147 Looking at the evidence tendered in relation to local sales of the Opponents' products, I have already commented in the context of the issue of the distinctiveness of the *Opponents' Earlier Mark T0508163A* that while the evidence is sufficient to support a finding that the *Opponents' Earlier Mark T0508163A* has acquired distinctiveness, it is insufficient to show that the *Opponents' Earlier Mark T0508163A* has acquired a high level of technical distinctiveness.

148 In relation to the evidence of promotional activities overseas (there is no evidence of promotional activities in the local context), as it is evident in the *Post Registration Decision* at [206] – [225] (replicated above), the Registrar in coming to his conclusion on the issue of acquired distinctiveness of the *Opponents' Earlier Mark T0508163A* has focussed on the evidence in the local context. Paragraphs [222] – [225] have been replicated above and will not be reproduced here. In summary, the Registrar only gave some weight to the evidence of promotional activities overseas as it is unclear if such promotional activities ever reached the local audience. A similar issue plagued the evidence in relation to the Power 100 survey reports for 2009 and 2010. It is unclear if the markets surveyed includes, Asia, and in particular, Singapore.

149 Todate, there are only a handful of cases where this limb has been made out. The learned Assistant Registrar in *Taylor's* at [132] helpfully provided a summary of the type of evidence tendered for marks held to be well-known to the public at large:

... In these cases [i.e. CLINIQUE, NUTELLA and SEIKO], there was, inter alia, relevant survey evidence demonstrating more than 70% of consumer awareness of the mark (in *Sarika (HC)* at [155(b)] and *Seiko* at [104]), generous expenditure on marketing and advertising (e.g. \$3 million each year for 4 years in Clinique at [39], more than \$4 million each year for 5 years in Seiko at [96(v)]) as well as exposure of the mark to the public through physical sales outlets in Singapore (13 stores and counters in Singapore in *Clinique* at [41], 100 optical shops in Singapore in *Seiko* at [96(iii)], 94-98% of stores in Singapore that sell food items in *Sarika (HC)* at [155(a)]). There is also evidence of very large sales figures in each of these cases: about \$10 million per annum from 2004 to 2008 in Clinique at [39], \$14 million per annum from 2005 to 2010 in Seiko at [96(ii)], and 2 million units of "Nutella" bread spread sold every year in Singapore (to 1.1 million households) in Sarika (HC) at [155(a)].

[Emphasis as underlined mine]

150 In light of the above, I am unable to conclude that the *Opponents' Earlier Mark T0508163A* is well known to the public at large based on the evidence tendered as described above.

151 As this element has not been made out, there is no need for me to look at the other limbs of dilution and unfair advantage.

152 The ground of opposition under Section 8(4)(b)(ii) therefore fails.

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

153 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.

Decision on Section 8(7)(a)

154 It is trite law that there are 3 elements to be satisfied to establish passing off, namely:

- (i) goodwill;
- (ii) misrepresentation;
- (iii) damage.

155 A widely-quoted description of goodwill is as follows (see *The Commissioners of Inland Revenue v Muller & Co's Margarine, Limited* [1901] AC 217, referred to at *Law of Intellectual Property of Singapore* at [17.1.1]):

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.

[Emphasis as underlined mine].

156 It is important to focus on goodwill in Singapore as the Court in *Staywell* at [136] and [137] has clarified that the local approach, unlike other jurisdictions like Australia, is still the “hardline” approach, albeit such an approach having been softened by *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR(R) 975 to include pre-trading activity.

157 It is important to note that the Applicants must establish that they have acquired goodwill as at the relevant date and this date is the date on which the defendant's conduct complained of started: *Law of Intellectual Property of Singapore* at [17.2.5]). Applying the principle to the current case, the relevant date in this instance is the date of the application of the *Application Mark* which is 3 March 2010.

158 It is also important to note that passing off protects goodwill and not the mark used to promote it (see *Law of Intellectual Property of Singapore* at [17.1.3]). Having said the above, it is clear that under the law the “get up” can include various aspects of the business, including a mark, as per *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 WLR 491, and quoted in *Amanusa* at [36].

159 In relation to proving goodwill I refer to *Law of Intellectual Property of Singapore* at [17.2.1 and 17.2.2]:

[17.2.1] The following is the test used by the Courts to determine if the plaintiff's mark performs the function of aiding the public to locate the plaintiff's goods or services or business: as at the relevant date, has the plaintiff's mark or get up become distinctive of his goods or services in the sense the relevant public in Singapore associates or identifies the mark or get up exclusively with the plaintiff's goods or services or business?

[17.2.2] Proving the relevant public's awareness of the plaintiff's mark or get-up and association of this mark or get-up with the plaintiff's goods or services or business is a factual inquiry. The plaintiff usually tenders evidence of his use and promotion of this mark or get-up in Singapore such as sales volume, the extent and amount of advertisement and media coverage of his goods or services or business conducted under this mark or get-up or market surveys.

[Emphasis as underlined mine].

160 I refer to the sales turnover of the Opponents in Singapore above. It is clear that the Opponents have the relevant goodwill in Singapore as at the relevant date.

Misrepresentation

161 The principles in relation to the element of misrepresentation have been comprehensively laid out in *Law of Intellectual Property of Singapore* at [18.3.8] – [18.3.17]. I further note that the Court held in *Amanusa*:

(10) The tests to be adopted for the “connection” requirement and the “likely to damage the [plaintiff's] interests” requirement in s 55(3)(a) of the TMA would yield the same result as those obtained from applying the tests for the elements of “misrepresentation” and “damage to goodwill”, under the passing off claim. However, the two sets of tests were different in so far as the tests relating to passing off were concerned with the plaintiff's *goodwill*, whereas the tests under s 55(3)(a) related to the *interests* of the plaintiff. A proprietor of a well known trade mark might not have goodwill in Singapore, but his interests might nonetheless still be damaged: at [234].

[Emphasis as underlined mine].

162 I have found that there is no confusing connection under Section 8(4)(b)(i) (and also that there is no likelihood of confusion under Section 8(2)(b)). Having regard to the authorities cited in the preceding paragraph, I am of the view that, for the same reasons, the element of misrepresentation also has not been made out.

163 For completeness and the avoidance of doubt, it is noted that the Opponents' submissions (at paragraph 67 of their written submissions) as to the unique context of how drinks are identified at food and beverage establishments that is, it is common to

only replicate the words in the marks and not the devices in menus, can be taken into account under this element of misrepresentation under the ground of objection of passing off.

164 However, even if this particular circumstance is taken into consideration, I am of the view that there can be no misrepresentation, having regard to the ordering process (described above at [107]), the nature of the good and the nature of the consumer.

Damage

165 As I have found that there is no misrepresentation, there is no need for me to look into the element of damage.

Conclusion

166 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 awarded costs to be taxed, if not agreed.

Dated this 13th day of October 2015

Sandy Widjaja

Principal Assistant Registrar of Trade Marks
Hearings and Mediation Group
Intellectual Property Office of Singapore