

Intellectual Property Office of Singapore Case Summary: Ceramiche Caesar S.p.A. v Caesarstone Sdot Yam Ltd [2015] SGIPOS 9

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The Opponents, Ceramiche Caesar S.p.A, sought to oppose the registration of the following mark:

Application Mark	Goods
	<i>Non-metallic tiles, panels for floors, floor coverings, wall cladding, flooring, and ceilings; non-metallic covers for use with floors and parts thereof; non-metallic profiles and floor skirting boards; slabs and tiles formed of composite stone for building panels, counter tops, vanity tops, floors, stairs, and walls.</i>
T0722229A-02	

on the basis of their earlier mark as follows:

Opponents' Earlier Mark	Goods
	<i>Non-metallic building materials, especially tiles for covering, floor coverings, tiles for gutters, cove moldings, corner beads not of metal, protruding wedges, stilted modular floors, special parts for finishing, stair treads.</i>
T0609976C	

While the Opponents raised several grounds of objections, the main ground of objection upon which the Opponents succeeded in this case was Section 8(2)(b) of the Trade Marks Act (Cap 332, 2005 Rev Ed) ("the Act").

In relation to this ground, the Registrar was of the view that the marks are somewhat similar visually and aurally but only conceptually similar to a low extent, and that the marks are more similar than dissimilar in totality.

In coming to this conclusion, the Registrar was of the view that the word "Caesar" can be considered to be of "medium" level of *inherent* distinctiveness.

In terms of visual similarity, the device, while being rather fancy, only constitutes a small part of the Application Mark, when the Application Mark is viewed as a whole. The word "Stone" would appear to be descriptive of the type of goods concerned and thus cannot be considered to be the distinctive component of the Application Mark. Thus, the word "stone" and the "device", taken together, would not be sufficient to render the marks dissimilar. There is some aural similarity between the marks. The Opponents' Earlier Mark consists of two syllables ie "Cae-sar" while the Application Mark consists of three syllables ie "Cae-sar-stone". The attention of the consumers will be directed at the first two syllables of the marks ie "Cae-sar" since this is also the dominant component of the marks. Conceptually, the Opponents' Earlier Mark comprising of the sole word "Caesar" being commonly understood to refer to the Roman General, "Gaius Julius Caesar", may convey the idea of supremacy, power and authority. On the other hand, the Application Mark consists of the device, the word "Caesar" as well as the word "Stone". The device does not convey any particular idea. As discussed above, the word "Caesar" being commonly understood to refer to the Roman General, "Gaius Julius Caesar" may convey the idea of supremacy, power and authority. However, the addition of the word "stone" would colour the Application Mark to the effect of referring to the style of masonry during the reign of Gaius Julius Caesar.

In relation to similarity of goods, the Applicants conceded that there is similarity between the goods, at least in relation to tiles.

In relation to the factors relating to the impact of marks-similarity on consumer perception, as concluded above, the marks are visually and aurally similar but only conceptually similar to a low extent. In relation to the reputation of the marks, both marks do not have much reputation to speak of, having regard to the evidence tendered. In relation to the impression of the marks and the possibility of imperfect recollection, there was evidence that the word "Caesar" is only

used by the Opponents and the Applicants while “stone” is commonly used for goods in Class 19. Thus, the would-be consumer would focus on the “Caesar” component of the Application Mark such that their impression of the marks is that they are both “Caesar” marks. This is all the more so taking into account their imperfect recollection.

In relation to the factors relating to the impact of goods-similarity on consumer perception, having regard to the usual mode of sale, where sellers of tiles will carry multiple brands and will display the tiles together either on their website or at their shop fronts, it is the visual aspect of the marks that is the most important. When a consumer views both marks together, having regard to the above in relation to mark similarity, they are likely to believe that the marks either come from the same source or are economically linked (since their impression of the marks would be that they are both “Caesar” marks). In cases where a home-owner consults a designer at the point of purchase, the consumer may not be aware that the two marks emanate from two very distinct entities. The consumer might, after consultation with the designer, decide to purchase the Applicants' products having regard to the specific qualities of, for example, quartz surfaces, but thinking that the Applicants' products are merely an extension of the Opponents' business.

Disclaimer: The above is provided to assist in the understanding of the Registrar's grounds of decision. It is not intended to be a substitute for the reasons of the Registrar. The full grounds of decision can be found at <https://www.ipos.gov.sg/resources/hearing-mediation>.