

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

Trade Mark No. T1202934H
3 November 2015

IN THE MATTER OF TRADE MARK APPLICATION BY

CHRITRS AUCTION PTE. LIMITED

AND

OPPOSITION THERETO BY

CHRISTIE MANSON & WOODS LIMITED

Hearing Officer: Mr Mark Lim Fung Chian
 Principal Assistant Registrar of Trade Marks

Mr Martin Schweiger and Ms Jacinthe Tay (Schweiger & Partners) for the Applicants
Mr Cheah Yew Kuin and Ms Faith Lim Yuan (Wong & Leow LLC) for the Opponents

Cur Adv Vult

GROUNDS OF DECISION

Introduction

1 On 5 March 2012, Chritrs Auction Pte. Limited (the “**Applicants**”) applied to register Trade Mark Application No. T1202934H “Chritrs” in Class 35 for the services of “auctioneering” (the “**Application Mark**”).

2 The Application Mark was accepted and published on 31 August 2012 for opposition purposes. Christie Manson & Woods Limited (the “**Opponents**”) filed their Notice of Opposition on 31 December 2012 to oppose the registration of the Application Mark. The Applicants filed their Counter-Statement on 26 April 2013.

3 The Case Management Conference (“CMC”) was held on 22 May 2013 and was attended by representatives of both parties. Subsequently, the matter progressed further towards the evidence rounds as negotiations had broken down.

4 The Opponents filed evidence in the form of a Statutory Declaration dated 30 April 2014 of Shum Wing Yum, Audrey (“**Ms Shum**”), the Head of Legal, Asia of Christie’s Hong Kong Limited, which belongs to the same group of companies as the Opponents (the “**Opponents’ SD**”). In response, the Applicants filed a Statutory Declaration of Lee Zi Hua, Brian (“**Mr Lee**”), the sole Director of the Applicants, dated 10 October 2014 (the “**Applicants’ SD**”). In reply, the Opponents then filed another Statutory Declaration of Ms Shum dated 8 April 2015 (the “**Opponents’ Reply SD**”).

5 On 26 June 2015, the Applicants commenced revocation proceedings against the Opponents in respect of four registered trade marks, T9102985J, T9600045A, T9600046Z and T0000833B (listed below at [17]). The Applicants also requested for consolidation of the revocation proceedings or in the alternative a stay of the current opposition proceedings.

6 At a Pre-Hearing Review on 30 July 2015 (the “**PHR**”), the Applicants accepted the Registrar’s indication not to grant their request and to continue the opposition proceedings on the condition that the Registrar will withhold enforcement of any decision to refuse registration of the Application Mark (the “**Opposition Decision**”), until the final determination of the revocation proceedings, if the Opposition Decision to refuse registration of the Application Mark is solely based on Section 8(2)(b) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (the “**Act**”).

7 On 5 October 2015, the parties exchanged their written submissions (the “**Applicants’ Written Submissions**” and the “**Opponents’ Written Submissions**” as the case may be). After reading the parties’ submissions, I requested that the parties address me on certain issues (as discussed below under the relevant grounds of opposition). Accordingly, at the hearing on 3 November 2015, the parties exchanged their further written submissions on these issues (the “**Applicants’ Supplementary Written Submissions**” and the “**Opponents’ Supplementary Written Submissions**” as the case may be).

8 At the hearing on 3 November 2015, the Opponents’ Ms Shum and the Applicants’ Mr Lee were both supposed to have been cross-examined on their respective statutory declarations. However, on the morning of the hearing itself, the Applicants informed me and the Opponents that Mr Lee was unable to attend the hearing. The Applicants’ agent produced a letter dated 6 October 2015 from Mr Lee and addressed to the Registrar to inform that Mr Lee had allegedly “*received the Jury duty summons from the Superior Court of California and unable to re-arrange [his] schedule.*” As such, he apologised for not being present at the hearing. Although the letter is dated 6 October 2015, the Applicants’ agent said that he only received it on 2

November 2015 (i.e. the day before the hearing). The copy of the Jury Summons attached to Mr Lee's letter is redacted but appears to indicate that Mr Lee was required to be present at the San Mateo County Superior Court on 6 October 2015. I consider this further at [170] and [180]-[182] below.

9 The Applicants confirmed that they were not seeking an adjournment of the hearing. With regard to the inability of the Opponents to cross-examine Mr Lee on his evidence, the Applicants simply submitted that the onus of proof is on the Opponents.

10 As Ms Shum had flown in from Hong Kong for the hearing and in order not to delay the hearing further, the Opponents were also prepared to proceed with the hearing.

11 In view of the parties' respective positions, I directed that the hearing would proceed. I also invited parties to make submissions on the effect (if any) of Mr Lee not being present to be cross-examined. At the end of the hearing, I additionally directed the parties to make further written submissions on (among other things) the evidence adduced by and from Ms Shum during the hearing.

12 The parties were supposed to have filed these further submissions on 3 December 2015. The Applicants indicated that they were not able to do so on 1 December 2015. On 10 December 2015, the parties exchanged their further written submissions (the "**Applicants' Final Written Submissions**" and the "**Opponents' Final Written Submissions**" as the case may be). The Grounds of Decision are therefore due on 10 March 2016.

Grounds of Opposition

13 The Opponents rely on Sections 8(2)(b), 8(4)(b)(i), 8(4)(b)(ii)(A), 8(4)(b)(ii)(B), 8(7) and 7(6) of the Act (in the sequence set out in the Notice of Opposition) in support of their opposition. I will address each of these grounds in this sequence in my Main Decision below.

Applicable Law and Burden of Proof

14 The applicable law is the Act and the Opponents do not dispute that the burden of proof lies on them.

Facts

15 The facts are relatively straightforward. I set out the general facts below, and will also separately discuss some additional facts in the context of the relevant grounds of opposition.

The Opponents

16 The Opponents are incorporated in England and are the primary UK trading entity of the Christie's International group of companies ("**Christie's**"). According to the Opponents, and not disputed by the Applicants, Christie's was founded in 1766 by Mr James Christie, and is an auction house specialising in auctions of valuable

collectibles. As at 28 April 2014 (i.e. the date of the Opponents' SD), Christie's had 53 offices in 32 countries. Christie's local office ("Christie's Singapore") was incorporated on 24 September 1992.

17 In Singapore, the Opponents are the registered proprietors of several trade marks, but only the marks with the English word "Christie's" and Chinese characters "佳士得" (pronounced as "Jia Shi De") in Classes 35, 36 and 9 as set out below are relevant:

Trade Mark No	Class	Mark	Specification	Registration Date
T9102985J	35	 CHRISTIE'S 佳 士 得	Auctioneering Services	16 March 1991
		<u>Mark Clauses:</u> 1) The transliteration of the Chinese characters appearing in the Mark is "Jia Shi De" which convey no meaning. 2) Registration of this Trade Mark shall give no right to the exclusive use of the word "Christie's". (emphasis added)		
T9600046Z	36	 CHRISTIE'S GREAT ESTATES	Real estate services; estate agency services; real estate brokerage; advice, and information services relating thereto.	18 November 1995

Trade Mark No	Class	Mark	Specification	Registration Date
		<p>2) To be associated with Trade Mark No. 45/96.</p> <p>3) Priority date claimed under Section 75 of the Trade Mark Act, Chapter 332: 18 November 1995 (United Kingdom).</p>		
T9600045A	36	<p style="text-align: center;">CHRISTIE'S</p> <p><u>Mark Clauses:</u></p> <p>1) Priority Date claimed under Section 75 of the Trade Marks Act: (Chapter 332): 18 November 1995 (United Kingdom).</p> <p>2) To be associated with No. 46/96.</p>	Real estate services; estate agency services; real estate brokerage; advice, and information services relating thereto.	18 November 1995
T0000833B	9	<p style="text-align: center;">CHRISTIE'S</p>	Computer software, computer programs; data recorded in electronic, optical or magnetic form; data carriers; audio and visual recordings; compact discs read only memories (CD-ROMs); compact disc-interactives (CDIs); compact discs (CDs); digital video discs	20 January 2000

Trade Mark No	Class	Mark	Specification	Registration Date
			(DVDs); publications in electronic form supplied online from databases or from facilities provided on the global communication network (including web sites); interactive videos, films, tapes, cassettes, compact disks.	

18 These are the same marks which are the subject of the revocation proceedings dated 26 June 2015 as mentioned above at [5]).

19 “Christie’s” is derived from the surname of the Opponents’ founder, Mr James Christie. As indicated in Mark Clause 1 to the Opponents’ registered mark in Class 35, the Chinese characters “佳士得” are pronounced as “Jia Shi De”, and convey no meaning in the Chinese language. It appears therefore that the Chinese characters are neither a translation nor a transliteration of “Christie’s”.

20 Details of Christie’s activities, revenue and sales are discussed in greater detail below when I consider the grounds of opposition under Section 8(4).

The Applicants

21 The Applicants were incorporated in Singapore on 30 November 2011. The Applicants have incorporated companies in other jurisdictions such as the United States of America (6 January 2011), the United Kingdom (11 April 2011), Australia (1 October 2012), Tokyo (13 November 2012), Korea (21 January 2011), Hong Kong (2 companies incorporated on 28 January 2009 and 28 January 2013 respectively) and Taiwan. All these companies include “Chritrs” as part of their company or business names, with the other parts of the names being of a descriptive nature.

22 In the Applicants’ SD, the Applicants have adduced evidence of their publicity materials with respect to auctions or exhibitions conducted in Hong Kong (since 28 June 2009); Taiwan (since 1 July 2011); and Canada, USA and Singapore (all since 2012). From the materials provided, it appears that the Applicants always use the “Chritrs” mark together with a Chinese name. Prior to October 2011, the Applicants’ Chinese name was “佳士德” (pronounced “Jia Shi De”). It is immediately apparent

that the first two Chinese characters are identical to the Opponents' Chinese name. While the third Chinese character is a different character from the Opponents' Chinese name, it is phonetically identical.

23 Sometime after October 2011, the Applicants changed their Chinese name to “佳德” (pronounced “Jia De”); the second character “士” (pronounced “Shi”) was dropped by the Applicants. It appears that this change of name occurred because of legal proceedings commenced by the Opponents against the Applicants' related company in Hong Kong and the Applicants' Mr Lee personally (see [32]-[33] below).

24 In Singapore, the Applicants have marketed their auctioneering services under the name “Chritrs” and the Chinese characters “佳德”.

25 In the Applicants' SD at [15], the Applicants assert that “*CHRITRS is a meaningless word that was invented by the Applicant as a means of coming up with a unique mark for his business.*” However, there is no explanation in the Applicants' SD as to how the “Chritrs” name and the Chinese names “佳士德” and “佳德”) were derived, and/or why they were chosen. As Mr Lee did not appear at the hearing, there was also no opportunity for him to give evidence on the derivation of these names.

Domain Name Dispute and Proceedings in Hong Kong and Taiwan

26 Both parties have been involved in related proceedings in Hong Kong and Taiwan, as well as a domain name dispute. As both parties seek to rely on the findings and outcomes of these proceedings, I briefly discuss these proceedings below (in chronological order).

27 At the outset, I should stress that related proceedings between the parties in other jurisdictions serve at best as guides to opposition proceedings here. The relevance of these decisions will hinge upon the similarity of the laws of the particular jurisdiction with those of Singapore and also upon the individual facts of the case: ***Festina Lotus SA v Romanson Co Ltd [2010] 4 SLR 552 (“Festina”)*** at [118]. For example, in the context of the grounds of opposition in the current case, it does not follow from the fact that a mark is well-known in Country X, that the mark is necessarily also well-known in Country Y. On the other hand, if a party makes certain factual assertions in one jurisdiction, he should not be permitted to take a completely different position in another jurisdiction. Thus, in the recent litigation involving the “Ku De Ta” trade marks, the Singapore Court of Appeal relied on certain statements made by one of the key witnesses in separate proceedings in Australia, which they were unable to reconcile with a certain transaction which the same witness claimed to have entered into in Singapore: ***Guy Neale and others v Ku De Ta SG Pte Ltd [2015] 4 SLR 283*** at [90], [115].

28 In the current case, for the reasons set out below, I find that the outcomes in these other proceedings are generally not persuasive in the context of the current opposition proceedings in Singapore. However, some specific observations are of some relevance, and I refer to these observations when discussing the relevant grounds of opposition in the current case.

Domain Name Dispute

29 The parties were involved in a dispute relating to the domain name “www.chritrs.com”, which was heard by a panellist appointed by the Asian Domain Name Dispute Resolution Centre (Hong Kong) (the “***Domain Name Decision***” dated 2 September 2009, which is attached as Exhibit “D” (pages 14-17) to the Applicants’ SD). The complaint against the domain name was dismissed as the Panellist was of the view that the domain name (CHRITRS) is not confusingly similar to the Opponents’ “CHRISTIE’S” mark.

30 However, it should be noted that the Uniform Domain Name Dispute Resolution Policy (UDRP) applicable to such disputes was conceived and operates as a quick and cost-effective method of combating abusive domain name registrations. To succeed under the UDRP, a complainant must establish that: (i) the respondent’s domain name must be identical or confusingly similar to a trade mark in which the complainant has rights; (ii) the respondent has no rights or legitimate interests in respect of the domain name; **and** (iii) the respondent’s domain name has been registered and is being used in bad faith. The considerations are therefore very different from those in trade mark opposition proceedings in Singapore.

31 Further, when examining the similarity between the domain name and the Opponents’ “CHRISTIE’S” mark, the Panellist remarked that “[p]laced in the context of auctioneering services, the Panel might recognise [CHRITRS] as a gross mutilation of CHRISTIE’S. However, that, again, is not the correct approach [in domain name disputes under the UDRP].” This approach is of course different from the approach when examining conflicting marks in the context of opposition proceedings.

Hong Kong Infringement Proceedings (Summary Judgment)

32 In Hong Kong, the Opponents obtained summary judgment for trade mark infringement and passing off against the Applicants’ related company in Hong Kong as well as Mr Lee, who directs and controls the business of this Hong Kong company. However, in the Hong Kong case, the comparison was between “Christie’s 佳士得” (pronounced “Jia Shi De”) and “Chritrs 佳士德” (also pronounced “Jia Shi De”): see the decision of the Hong Kong High Court dated 14 November 2012 in ***Christie Manson & Woods Ltd v Chritrs (Group) Ltd [2012] HKEC 1567*** (the “***Hong Kong Judgment***”, which is exhibited as “SWYA-12” to the Opponents’ SD). In the current opposition proceedings in Singapore, in the context of mark similarity, the comparison is between the Opponents’ “CHRISTIE’S” mark, and the Application Mark (“Chritrs”); the parties’ respective Chinese names are not relevant for the purposes of this comparison.

33 Nevertheless, it is of interest to note that, on 20 August 2011 (which was the day following service of the Writ on the Applicants’ related company in Hong Kong and Mr Lee), the Applicants’ related company in Hong Kong and Mr Lee had consented to stop using the Chinese name 佳士得 or 佳士德 or any sign consisting of these 2 names: at [6] of the ***Hong Kong Judgment***. This is likely to be the reason why

the Applicants and their various related companies changed their Chinese name to “佳德” (pronounced “Jia De”) sometime after October 2011 (see [23] above).

Taiwan Invalidation Proceedings

34 The Opponents also brought my attention to the invalidation proceedings brought by the Opponents against the Applicants in Taiwan. The decision of the Taiwan Intellectual Property Office (in Chinese) dated 24 March 2014 (the “*Taiwan Judgment*”) was attached as Tab 21 of the Opponents’ Bundle of Authorities dated 5 October 2015. An English translation of the decision was also furnished on 21 October 2015.

35 The Hearing Officer held that the Applicants’ registered mark in Taiwan (namely, “a diamond-shaped line device with the foreign-language text ‘CHRITRS’



”) should be cancelled on the basis, among other things, that it is highly similar to the Opponents’ mark comprising the foreign language text “CHRISTIE’S”: [II] of the translated *Taiwan Judgment*.

36 The Hearing Officer also held that the registration of the Applicants’ mark is likely to cause relevant consumers to associate the foreign text “CHRITRS” and the Chinese text “佳士德” (pronounced “Jia Shi De”) with the Opponents’ mark, and to mistakenly believe that both parties’ services share a common origin or that both parties are associated, and thereby leading to a misunderstanding: [III] of the translated *Taiwan Judgment*.

37 Again, I note that the comparison appears to be between “Christie’s 佳士得” (pronounced “Jia Shi De”) and “Chritrs 佳士德” (also pronounced “Jia Shi De”). With regard to the Hearing Officer’s finding that “CHRITRS” and “CHRISTIE’S” are similar, it must also be borne in mind that English is a foreign-language in Taiwan. Further, Taiwan is a civil law jurisdiction, and there is no evidence before me as to the similarities or otherwise between trade mark opposition proceedings in Singapore and trade mark invalidation proceedings in Taiwan.

MAIN DECISION

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

38 Section 8(2)(b) of the Act reads:

8.—(2) A trade mark shall not be registered if because —

...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public.

39 The term “earlier trade mark” is defined in Section 2(1) to mean:

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

(b) a trade mark which, at the date of the 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.

(emphasis added)

40 For this ground of opposition, the Opponents only rely on their earlier registered marks listed at [17] above, which as mentioned at [5] above are the subject of revocation proceedings brought by the Applicants. Undoubtedly, each of the Opponents’ registered marks qualifies as an “earlier trade mark” for the purposes of Section 8(2)(b).

41 The leading case on Section 8(2)(b) is the Court of Appeal’s seminal decision in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc [2014] 1 SLR 911* (“Staywell”). The court (at [15]) reaffirmed the step-by-step approach in the analysis of this provision. Under this approach, there are three elements, *viz*, (i) similarity between the marks, (ii) identity or similarity between the goods or services, and (iii) confusion brought about by these two similarities. All three elements must be satisfied. Further, each element is cumulative and the elements are assessed systematically. For example, if it is determined that the marks in question are not similar, it is not necessary to consider further whether the goods/services are identical/similar, or whether there exists a likelihood of confusion on the part of the public.

42 In addition, each of the Opponents’ marks must be compared individually against the Application Mark: see *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd [2015] SGHC 216* (“Rovio”) at [35], and generally (albeit in a different context) [23]-[72]. I will therefore consider each of the Opponents’ marks in turn.

Opponents’ Prior Mark in Class 35 / Effect of Disclaimer on Opponents’ Mark

43 For convenience, the marks to be compared are set out below:

	Application Mark	Opponents' Earlier Mark
Mark	Chritrs	<p>CHRISTIE'S</p>  <p><u>Mark Clauses:</u></p> <p>1) The transliteration of the Chinese characters appearing in the Mark is "Jia Shi De" which convey no meaning.</p> <p>2) Registration of this Trade Mark shall give no right to the exclusive use of the word "Christie's".</p> <p>(emphasis added)</p>
Services	Class 35: Auctioneering	Class 35: Auctioneering Services

44 Notably, the Opponents' mark is subject to a disclaimer of the word "Christie's". Since this is the only part of the Opponents' mark that can be said to be similar to the Application Mark, an important issue arises as to the effect of the disclaimer.

45 As a starting point, under Section 30(1)(a) of the Act, the applicant for registration of a trade mark may disclaim any right to the exclusive use of any specified element of the trade mark.

Registration subject to disclaimer or limitation

30.—(1) An applicant for registration of a trade mark, or the proprietor of a registered trade mark, may —

(a) disclaim any right to the exclusive use of any specified element of the trade mark; or

(b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation.

(2) Where the registration of a trade mark is subject to a disclaimer or limitation, the rights conferred by section 26 are restricted accordingly.

(3) The Minister may make rules as to the publication and entry in the register of a disclaimer or limitation.

[UK Trade Marks Act 1994, s. 13]

(emphasis added)

46 The Applicants submitted (see Applicants' Written Submissions at [9] and [10]) that “*even if the Registrar finds any similarity between the Applicant's trade mark 'Chritrs' and the Opponent's trade mark 'Christie's 佳士得' [in Class 35] by virtue of the name 'Christie's', the Opponent's opposition cannot be allowed as the basis of the similarity between the marks is attributable to nothing more than the element which the Opponent has disclaimed.*” The Applicants rely on the English decision in **Torremar Trade Mark** [2003] RPC 4 (“**Torremar**”; I consider this case further below at [59]).

47 The Opponents sought to draw a distinction between opposition and infringement proceedings. The Opponents stressed that Section 30(2) of the Act expressly refers only to Section 26 of the Act (“*Where the registration of a trade mark is subject to a disclaimer or limitation, the rights conferred by section 26 are restricted accordingly.*”), which relates to infringement proceedings, and not to Section 8 of the Act, which deals with opposition proceedings. Accordingly, the Opponents argue that their rights under Section 8 should not be constrained by a disclaimer. In support of their position, the Opponents rely on two decisions of the Registrar in **Hu Kim Ai v Liew Yew Thoong** [2007] SGIPOS 11 (“**Hu Kim Ai**”) and **Hiang Kie Pte Ltd assigned to Coffee Club Private Limited v PT Super World Wide Foodstuff Industries** [2003] SGIPOS 10 (“**Coffee Club**”). Relying on these cases, the Opponents assert that “*it would be in the public's interest to prevent too many confusingly similar marks co-existing on the trade mark register*”: see Opponents' Supplementary Written Submissions at [33]-[39].



48 In **Hu Kim Ai**, one of the issues was whether the mark “**COMMODORE**” was

**
BLANSACAR
五 星 上 將

similar to “**五 星 上 將**”, which was subject to a disclaimer of the device of stars. The Registrar observed (at [33]) that “[t]he purpose of imposing disclaimers on parts of marks which were either descriptive or non-distinctive was 'to protect the rights of others to use the descriptive or non-distinctive matter without fear of infringement action.' (Chapter 9 of the UK Patent Office's Trade Marks Work Manual)” However, she went on to hold (at [35]) that: “*the practicality of the matter is that confusion occurs in the market place where the goods are sold and bought by ordinary man in the street. These are consumers who will not be aware that there are disclaimers on the register or realise what the implication of a disclaimer is. The marks as affixed onto the goods will not indicate that such-and-such features are disclaimed or that the proprietor has no rights over the disclaimed portions. So whilst it is true that the Applicant has no proprietary interest in the '5 Star Device'..., for these practical reasons, in the comparison of the marks for similarity and the assessment of whether there is likelihood of confusion arising from the similarity under section 8(2)(b), I will look at the marks as they appear on the register.*”

49 The same approach was taken in *Coffee Club*, where it was held at [57] to [60] that “*the effect of a disclaimer.... is that other traders will be free to legitimately use these words.... However, the question of whether the Applicants' and the Opponents' marks are confusingly similar such that a likelihood of confusion or deception arises will have to be determined regardless of the disclaimers imposed on the Opponent's marks.*” The Registrar cited an earlier edition of *Kerly's Law of Trade Marks and Trade Names*, namely the 12th Edition, paragraph 9-04 at page 142, which states: “*The disclaimer does not appear on the mark as it is used, so that a mark which is deceptive as including matter distinctive of a competitor is not made less so by a disclaimer of that matter.*”

50 The effect of a disclaimer was also considered by the Registrar recently in *Pirelli & C. S.P.A. v Tao, Hsiu-Chih* [2014] SGIPOS 7 (“*Pirelli*”). One of the issues

in *Pirelli*, was whether the mark applied for “” was similar to a prior mark “”, which was subject to a disclaimer of the letter ‘P’”. The Registrar held at [21] that “*the ground of opposition under Section 8(2)(b) of the Act in relation to these trade marks fails at the outset, since the Opponents' contended point of similarity [ie, that the Application Mark shares the "P" or "Elongated P" element] is the very element for which protection has been disclaimed.*”

51 The Registrar (at [20]) relied on a statement in the latest edition of *Kerly's Law of Trade Marks and Trade Names* (15th Ed) (Sweet & Maxwell, 2011) (“*Kerly's*”) that: “*It follows that an objection based upon an earlier registration cannot succeed where the only resemblance between the marks in issue is an element for which protection has been disclaimed (citing the cases of *Paco Holdings v PacoRabanneParfums* [2000] RPC 451 and *Torremar Trade Mark* [2003] RPC 4).*”

52 However, neither the Applicants nor the Opponents cited *Pirelli* to me. At the same time, the Registrar in *Pirelli* did not consider either *Hu Kim Ai* or *Coffee Club*. For completeness, I should mention that these cases were each decided under different editions of the Trade Marks Act. However, the provisions relating to disclaimers appear to be very similar or identical. (*Coffee Club* was decided under the 1992 Act, in which the effect of disclaimers is set out in Section 20; *Hu Kim Ai* was decided under the 1999 Act, in which the effect of disclaimers is set out in Section 30; and *Pirelli* was decided under the current Act, in which the effect of disclaimers is set out in Section 30, which is reproduced at [45] above.) In particular, the wording of Section 30 in both the 1999 Act and the current Act are identical, save that the 1999 Act does not include a cross-reference indicating that the provision is derived from Section 13 of the UK Trade Marks Act 1994.

53 As I will be discussing the UK cases interpreting Section 13 of the UK Trade Marks Act 1994, it is useful to reproduce the relevant portions of this provision below:

13 Registration subject to disclaimer or limitation

- (1) An applicant for registration of a trade mark, or the proprietor of a registered trade mark, may —

(a) disclaim any right to the exclusive use of any specified element of the trade mark, or

(b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation;

and where the registration of a trade mark is subject to a disclaimer or limitation, the rights conferred by section 9 (rights conferred by registered trade mark) are restricted accordingly.

(2) Provision shall be made by rules as to the publication and entry in the register of a disclaimer or limitation.

54 From the above discussion, it can be seen that there are currently two separate lines of cases in Singapore which were decided by the Registrar. To the best of my knowledge, this issue has not been addressed by the Singapore High Court or the Singapore Court of Appeal.

55 As the relevant provisions in Singapore and the UK are identical in all material respects, it would be helpful to consider the UK cases which have interpreted Section 13 of the UK Act. There have been several such cases.

56 In *Paco/Paco Life in colour [2000] RPC 451* (“*Paco*”), the Hearing Officer held at [50] that “*the exclusive right disclaimed under Section 13 of the [UK Trade Marks 1994] Act extends to the use by another party as a trade mark of that which has been disclaimed. If the only point of similarity with the registered mark is the disclaimed element, use of the later mark would not infringe.*” In particular, the Hearing Officer expressly considered whether the disclaimer applies to trade mark registration/opposition proceedings and expressed the view at [51] that “*it is difficult to understand how Parliament could have intended a disclaimer to be taken into account for infringement purposes but not when it comes to an application to register that which could lawfully be used as a trade mark.*”

57 Explaining the significance of a disclaimer, the Hearing Officer held at [63], “*...the entry of the disclaimer should be regarded as an admission by the proprietor that - in any proceedings based upon the registration with the disclaimer - the disclaimed matter is not to be regarded as in itself distinctive of the trade origin of the proprietor’s goods or services. In these circumstances, use of the disclaimed matter by another party, as a trade mark, cannot, without other similarities, be sufficient to give rise to a likelihood of confusion with the registered trade mark concerned.*” Further, at [64], “[o]nce a disclaimer is entered the admission is made and the proprietor must live with the result. If the position changes over time the proprietor can file a fresh application for registration without a disclaimer.”

58 In that case, the Hearing Officer held at [65] that “*the ground of opposition... based upon earlier trade mark registration..., fails. The only point of similarity between the earlier mark and the later trade marks is the word ‘paco’, which is the subject of a disclaimer.*”

59 In *Torremar* (the case relied on by the Applicants; see [46] above), the Appointed Person, hearing an appeal from the Hearing Officer, held that:

27. When a trade mark is registered subject to a disclaimer of the right to exclusive use of a specified element of the registered mark, the rights conferred by registration and the acts amounting to infringement, if done without the consent of the proprietor, are restricted accordingly: Section 13(1).

28. Objections under Section 5(2) are conceptually indistinguishable from actions under Section 10(2) of the Act: they serve to ensure that trade marks whose use could successfully be challenged before the courts are not registered: Case C-39/97 Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc. [1998] ECR I-5507, paragraph 21.

29. It follows that an objection under Section 5(2) cannot succeed in a case where the resemblance between the marks in issue is attributable to nothing more than the presence in the earlier trade mark of an element for which protection has been disclaimed: Paco/Paco Life in Colour Trade Marks [2000] RPC 451.

60 In *Have a Break (Trade Mark: Opposition)* [2002] UK Intellectual Property Office 25402 (25 June 2002) (“*Have a Break*”), the Hearing Officer held at [25]–[27] that:

25. The earlier registration contains a disclaimer to any exclusive right to the use of the word TAKEABREAK. In *Paco*, I held that use of the disclaimed matter by another party, as a trade mark, cannot without other similarities, be sufficient to give rise to a likelihood of confusion with the earlier registered trade mark. The only similarity between HAVE A BREAK and ASDA TAKEABREAK resides in the disclaimed TAKEABREAK element of the earlier mark, and the same reasoning must therefore apply. I remain of the view that the presence of a disclaimer in the earlier trade mark is one of the relevant factors to be taken into account in the global appreciation required under section 5(2)(b): *Sabel BV v Puma AG* [1998] RPC 199, at paragraph 22. The disclaimer is a knock-out blow to the opponent’s case under section 5(2)(b).

26. In this connection, I note that the point has recently been considered on appeal by the Appointed Person in the form of Mr G Hobbs Q.C. in *Torremar*. Mr Hobbs appears to have reached a similar conclusion to myself (see paragraphs 26-29 of his decision).

27. In the light of my finding in *Paco* there is no need for me to consider the opposition under section 5(2)(b) any further. It must fail because of the disclaimer in the earlier mark...

61 Most recently in *General Cigar Co Inc v Partagas Y Cia SA* [2005] EWHC 1729 (Ch) (“*General Cigar*”), the English High Court heard arguments based on the above cases and held at [80]–[81], [86]–[87] and [89] that:

80. ...The problem arises in the present case from the fact that the only part of General Cigar's mark which overlaps with Partagas' mark is the part which has been disclaimed. The practice reflected in *PACO* and in PAC 3/00 is that if the only point of similarity with the registered mark is the disclaimed element, the disclaimed element cannot be relied upon either in opposition proceedings or in infringement actions.

81. The question is one of construction of section 13, and in particular whether it has the effect that where the only point of similarity with the mark applied for or registered is the disclaimed element, the application for registration may be resisted on that ground or registration may be declared invalid on that ground.

86. ...I accept the argument that it is difficult to imagine that Parliament could have intended a disclaimer to be taken into account for infringement purposes but not for opposition/invalidity purposes. One of the uses to which a trade mark may be put is as a bar to others registering similar marks. In effect section 5 of the 1994 Act serves to pre-empt the need for an infringement action by preventing the registration of marks the use of which would otherwise infringe.

87. ...A disclaimer only applies to part of a mark (because the whole of a valid mark could never be disclaimed, otherwise it would not be distinctive), and so a disclaimer only has any relevance when the marks under consideration are similar, rather than identical. This is because a disclaimer operates to affect the scope of protection by influencing the analysis of the likelihood of confusion. This concept is common to both section 10 (infringement) and section 5 (registrability), and should be applied equally in each scenario.

89. ...Consequently, I am satisfied that the decision of the Hearing Officer in *PACO* was correct... It seems to me to be in accordance with the structure and intent of the Trade Marks Directive and the 1994 Act as applied both to disclaimers and limitations.

62 As can be seen, each of these UK cases expressly considered (and rejected) the Opponents' argument that disclaimers should only be taken into account in infringement proceedings and not opposition proceedings. I find these cases sound in reasoning both from a construction and policy point of view. Accordingly, I am of the view that the Registrar's decision in *Pirelli* reflects the correct position, and that disclaimers apply equally to registration/opposition proceedings as it does to infringement proceedings. Since the only possible point of similarity between the

CHRISTIE'S

佳得

Application Mark and the Opponents' mark in Class 35 (" 得 ") rests solely on the word "Christie's", which has been disclaimed, the opposition under Section 8(2)(b) relating to the Opponents' mark in Class 35 must fail.

63 For completeness, I should briefly mention that the [Singapore] *Pirelli* approach to the effect of a disclaimer is at the *mark similarity stage*. In contrast, the UK approach is relevant at the *likelihood of confusion assessment*. However, this does

not arise from a different treatment of disclaimers, but to the fact that Singapore adopts a “three step approach” when considering an opposition under Section 8(2)(b) (see [41] above for details of this approach), whereas the UK applies a “global assessment approach”. Briefly, under the “global assessment approach”, the “three steps” of mark similarity, goods/services similarity and likelihood of confusion are elided and considered in the round.

Opponents’ Prior Marks in Class 36



64 The Opponents have two prior marks in Class 36, namely, “CHRISTIE’S” and “CHRISTIE’S”, registered for identical services. The word “CHRISTIE’S” is not disclaimed in either mark. It is obvious that the Opponents have a better chance of succeeding in an opposition based on the plain word mark “CHRISTIE’S” than on the composite mark comprising the words “CHRISTIE’S GREAT ESTATES” and the device of a man. I will therefore consider only the plain word mark “CHRISTIE’S” in my discussion below.

65 For convenience, the marks to be compared are set out below:

	Application Mark	Opponents’ Earlier Mark
Mark	Chritrs	CHRISTIE’S <u>Mark Clauses:</u> 1) Priority Date claimed under Section 75 of the Trade Marks Act: (Chapter 332): 18 November 1995 (United Kingdom). 2) To be associated with No. 46/96.
Services	Class 35: Auctioneering	Class 36: Real estate services; estate agency services; real estate brokerage; advice, and information services relating thereto.

66 As mentioned above at [41], the Opponents must satisfy three elements in order to succeed in the opposition on this ground, *viz*, similarity between the marks, identity or similarity between the services, and confusion brought about by these two similarities. I will consider each of these elements in turn.

Similarity of Marks

67 The applicable principles in *Staywell* which are particularly pertinent for our case are as follows:

- (a) The marks are to be compared for visual, aural and conceptual similarities. But these three aspects of similarity are only signposts towards answering the question of whether the marks are similar, and must not be applied in a formulaic manner. There is no prescribed requirement that all three aspects of similarity must be made out before the marks can be found to be similar: *Staywell* at [18].
- (b) Ultimately, the question is whether the marks when observed in their totality are similar rather than dissimilar. Answering this question is inevitably a matter of impression: *Staywell* at [17].
- (c) Although the marks are to be compared in their totality, the tribunal is entitled to have special regard to the dominant components in a mark. This is because in reality the average consumer rarely has the chance to compare the two marks side by side; instead, he is making the comparison based on an imperfect recollection of the two marks in his mind. In this comparison, it would be the dominant component – what is outstanding and memorable about the mark – that tends to stand out and draw his attention: *Staywell* at [23].

Visual similarity

68 The Opponents submitted that there is visual similarity between the Application Mark and “CHRISTIE’S” because: the Application Mark comprises 2 syllables, as does the CHRISTIE'S Mark; the first four letters of the marks in question are the same, and six out of seven letters of the Application Mark are identical to the CHRISTIE'S Mark; the Application Mark is in the same order of **CHRI-T-R-S** as compared to **CHRI-S-T-IE-S**, which constitute the opening and ending elements in both marks; and the Application Mark is a plain word mark with no additional differentiating matter: see Opponents' Written Submissions at [12].

69 The Opponents rely on the following cases where it was held that there was visual similarity between the relevant marks: *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 (“Sarika”) (“NUTELLA” vs “NUTELLO”); *Red Bull GmbH v. Sun Mark Limited* [2012] EWHC 1929 (Ch) (“BULLIT” vs “BULLET”); *BAKO (Trade Mark Opposition)* [2010] UK Intellectual Property Office-255-10 (“BAKO” vs “BUKO”); and *Sports Connection Pte Ltd v PT Eigerindo Multi Produk Industri* [2015] SGIPOS 5 (“Bodypack” vs “Bodypac”).

70 The Applicants submitted that visually, the Application Mark consists of 7 alphabets “Chritrs”, whereas the Opponents’ mark consists of an apostrophized 9 alphabets forming a common English name “Christie’s”: see Applicants’ Written Submissions at [6].

71 I am of the view that the cases relied upon by the Opponents can be distinguished as the relevant marks in those cases all differ by only 1 letter. Nevertheless, I find that there is a low to medium degree of visual similarity between the Application Mark and the Opponents' "CHRISTIE'S" mark.

Aural similarity

72 The Opponents were not able to decide how the Application Mark ("Chritrs") should be pronounced. In the Notice of Opposition (at [14]), the Opponents asserted that "*[t]he only way to pronounce the Application Mark is 'KRIT-RIS'.*" In the Opponents' Written Submissions (at [16]), they claimed that the Application Mark would be pronounced as "KRI-TERS". During her testimony, the Opponents' Ms Shum pronounced the Application Mark as "KRI-TREES".

73 Nonetheless, the Opponents submitted (at [16] of the Opponents' Written Submissions) that the Application Mark shares an inherent aural similarity with the "Christie's" mark, because: both marks have 2 syllables each; the starting syllable of the marks in question are highly similar, and according to established principles, the beginning of marks have more emphasis when pronounced (*Valentino Globe BV v. Pacific Rim Industries Inc. [2009] 4 SLR(R) 577* at [34]). Here, according to the Opponents, the first syllable of the Application Mark, i.e. "Kri", is very similar to the first syllable of the "CHRISTIE's" Mark, and the second syllable of both marks ends with a "S" accentuation; and allowance must be made for imperfect recollection as well as for careless pronunciation and speech (*Sarika* at [31]).

74 The Applicants submitted that aurally, the Application Mark "Chritrs" is not easy to pronounce, and for the majority of the consumers it is even unpronounceable. Given that the Application Mark is unpronounceable, it cannot be said to be aurally similar to the Opponents' "CHRISTIE'S" mark. Even if the average consumer attempts to pronounce the mark by piecing together the pronunciation of the individual consonants, they are likely to pronounce it as "Kri-trs" with one single vocal and not "Kris-tee-s" with two vocals: see Applicants' Written Submissions at [5] and [12].

75 I agree with the Applicants that the Application Mark "Chritrs" is unpronounceable. I note that this was also the finding in the *Domain Name Decision* ("The essential part of the domain name, CHRITRS, is a collision of consonants. The Panel cannot agree with the Complainant that only 'minor differences' separate CHRITRS and CHRISTIE'S. The Panel struggles to see how CHRITRS might be pronounced.") and the *Hong Kong Judgment* (the court opined at [19(v)] that CHRITRS "has no proper pronunciation."). I do not think it is permissible to take one of several hypothetically plausible pronunciations of the Application Mark, then assert that that specific pronunciation is similar to "CHRISTIE'S". I find that there is no aural similarity between the marks.

Conceptual similarity

76 I agree with the Applicants that, conceptually, the impression the Application Mark "Chritrs" leaves on the average consumer is that of an unpronounceable invented word: see Applicants' Written Submissions at [7]. In contrast, the Opponents'

Mark “CHRISTIE’S” is likely to be associated with a person, and indeed, I note that “CHRISTIE’S” is the surname of the Opponents’ founder.

77 Accordingly, I find that the marks are not conceptually similar.

Overall Finding on Mark Similarity

78 I have found that the marks are not aurally or conceptually similar, and that there is only a low to medium degree of visual similarity. Overall, I find that there is only a very low degree of similarity between the marks.

Similarity of Services

79 The general principles relating to similarity of services have been set out in *Staywell* (among other cases):

- (a) “...[R]egistration in the same specification within a class establishes a *prima facie* case for identity... This is because it is not within the scheme of the classification system to make distinctions within a specification based on whether the particular product is targeted at one or another market segment.”: *Staywell* at [40].
- (b) “...[W]hile ‘trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise ... [w]here words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question’ (per Floyd J in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) (“*YouView*”) at [12]; see also *Omega Engineering Inc v Omega SA* [2013] FSR 25 at [33]). Where a good or service in relation to which registration is sought falls within the ambit of the specification in which the incumbent mark is registered, the competing goods or services would be regarded as identical (see *Gerard Meric v OHIM (Case T-133/05)* at [29]).”: *Staywell* at [41].
- (c) “...[If] the services in question are identical, there is no further need to consider whether they are similar or the extent of their similarity... ”: *Staywell* at [42].
- (d) “On similarity of goods or services – extraneous factors may be relevant to establish the degree of similarity as between goods and services that are not identical in infringement cases and in opposition proceedings where the applicant’s and proprietor’s goods and services are registered or to be registered in different classes or specifications. Such extraneous factors are some of those identified in [*British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 (“*British Sugar*”)], in particular the uses and the users of the goods and services in question, their inherent nature and the extent to which they are competitive... ”: *Staywell* at [82].

80 The factors set out in ***British Sugar*** at pages 296-297 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.

Service of selling real estate via auction

81 After reading the parties' Written Submissions, I invited the parties to make further submissions on whether the service of selling real estate via auction falls within "auctioneering services" in Class 35, or "real estate services" in Class 36, or both. In the last scenario, there would be identity in the parties' services of interest in so far as this specific service is concerned.

82 The Opponents submitted that the service of selling real estate via auctions falls within both Class 35 and Class 36. An auction is by definition, a public sale at which things are sold to the people who offer to pay the most. When the Opponents sell real estate through such auctions, they are offering real estate services: see Opponents' Supplementary Written Submissions at [2].

83 The Opponents relied on the decision of the Registrar in ***Tai Wong Battery Industries Sdn Bhd v Kabushiki Kaisha Komatsu Seisakusho [2000] SGIPOS 1*** ("Tai Wong"), which referred at [30] to *Kerly's Law of Trade Marks And Trade Names. 12th Edition* ("Kerly's 12th Ed."), at page 154: "...The question whether goods are 'of the same description' is one of fact; it cannot be decided merely by reference to the Registrar's classification. A single class may contain more than one description of goods, whilst *goods of the same description may fall into distinct classes.*" (emphasis added)

84 The Opponents also noted that in ***E! Entertainment Television, Inc v Deutsche Telekom AG [2005] SGIPOS 5*** ("E! Entertainment"), the opponent's mark was registered for "[i]nstructional services related to telecommunications and data processing; entertainment services; organisation of sporting and cultural events, publication of printed matter", while the applicant had sought to register the application mark for "[p]roviding gossip, celebrity news, entertainment news and movie, television and music information through a global computer network". There, the Registrar held at [1] that "entertainment services" as stated in the opponent's registration could include provision of entertainment news via the internet. The

Opponents therefore argued that it is clear that a broad specification could encompass a narrower one.

85 The Applicants, on the other hand, submitted that the service of selling real estate via auctions falls within “auctioneering services” in Class 35 and not “real estate services” in Class 36. The Applicants argued that the nature of auctioneering and real estate services are very different, and for that reason, they fall into two different registration classes, namely Class 35 and Class 36. Auctioneering is a system where potential buyers place competitive bids on assets and services. The asset or service in question will be sold to the party that places the highest bid. Real estate services on the other hand encompass a broad spectrum of services in relation to real estate. These include real estate management, purchase or sale of real estate, real estate advice, real estate valuation, and real estate brokerage. The purchase or sale of real estates is usually concluded upon successful price negotiation between two interested parties: see Applicants’ Supplemental Written Submissions at [2] & [3] and Applicants’ Written Submissions at [19].

86 The Applicants point out that the “General remarks” of the International Classification of Goods and Services state that services are classified according to the branches of activities specified in the headings of the service classes and in their Explanatory Notes or, if not specified, by analogy with other comparable services in the Alphabetical List. As far as the headings of the service classes are concerned, the class heading for Class 35 is “advertising; business management; business administration; office functions”, while the class heading for Class 36 is “insurance; financial affairs; monetary affairs; real estate affairs” (see *International Classification of Goods and Services for the Purposes of the Registration of Marks (NICE Classification), 10th Edition*). Further, the *World Intellectual Property Organization’s Madrid Goods & Services Manager* database classifies “arranging and conducting of real estate auctions” in Class 35 (and not Class 36): see Applicants’ Supplemental Written Submissions at [4]-[5].

87 In my view, the service of selling real estate via auction clearly falls within “auctioneering services” in Class 35. The question is whether it also falls within “real estate services” in Class 36.

88 While I do not dispute the general principles laid down in *Tai Wong* and *E! Entertainment*, I am of the view that these cases do not aid the Opponents’ argument.

89 The Court of Appeal in *Staywell* affirmed *YouView* at [12], where Floyd J noted that in the *British Sugar* case, the court there held that jam was not encompassed within the description of "dessert sauce". The mere fact that some people did or could use jam as a dessert topping did not mean that in ordinary parlance it was a dessert sauce. It was necessary to focus on the core of what is described:

12. There are sound policy reasons for this. Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle

should not be taken too far. [British Sugar] was decided the way it was because the *ordinary and natural, or core, meaning* of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question. (emphasis added)

90 Applying **YouView**, the real issue lies in what is the ordinary and natural or core meaning of "real estate services" and "auctioneering" services. The applicable principles for the construction of specifications for the purposes of determining the similarity of goods and services were laid down by Floyd J (affirming the Hearing Officer's decision) in **YouView** at [10]:

10. The approach to the comparison of goods and services for the purpose of determining whether they are identical or similar was set out in the hearing officer's decision at [9] to [13]. I set it out here because neither side made any criticism of it:

...

12. A great deal of the submissions made at the hearing, in writing and via evidence, focussed on the meanings of terms in the specifications. The significance of classification and the relevance of class numbers were considered by ...the courts in *Altecnic Ltd's Trade Mark Application (CAREMIX)* [2002] R.P.C. 639. In *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 Jacob J held that:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

Jacob J also said, in [British Sugar]:

"When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade".

13. Specifications should not be given an unnaturally narrow meaning, as per *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, although in the context of a non-use issue, the court considered interpretation of specifications:

"In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use".

(emphasis added)

91 In determining the core meaning of real estate services, I accept the Applicants' submissions that real estate services encompass a broad spectrum of services (such as real estate management, purchase or sale of real estate, real estate advice, real estate valuation, and real estate brokerage). The purchase or sale of real estates is usually concluded upon successful price negotiation between two interested parties, and not via auction. I find that the selling of real estate through auctioning is merely incidental to real estate services.

92 I also note from the Applicants' submissions that the **World Intellectual Property Organization's Madrid Goods & Services Manager** database classifies "*arranging and conducting of real estate auctions*" in Class 35 (and not Class 36). In addition, I understand that applications in Class 35 are not cross-searched against prior marks in Class 36. In other words, if a person applies to register a mark in Class 35, similar marks in Class 36 will not be cited against the application. As explained in **British Sugar** (at page 289):

... Under the Trade Marks Act, goods and services are divided into a series of classes. The main purpose of the classes is to enable trade mark searching to be carried out.... The classification forms part of an internationally agreed system and is known as the Nice Classification, following the 1934 international conference which took place there. It is widely... used by trade mark registries throughout the world and by the so-called "international" system also known as the Madrid Agreement (in the form of the so-called Madrid Protocol)... The classification could not and does not explicitly mention all types of goods and services in detail. But there is a very large and comprehensive list of goods and services by which the Registrar goes. His judgment on where goods go is, for administrative reasons, made final. [Note: In Singapore, this is provided for in Section 6 of the Act.]....

Generally there is no difficulty in identifying which class is relevant for a particular article. But borderline cases are not infrequent. For these, the Registrar often uses the practice of describing the goods and services and adding the words *included in this Class* or *included in Class X*. He did that here. The effect of this is to confine the specification to goods which fall within the description and which also were, at the time of registration, put in

that class by the Registrar. Thus in *GE Trade Mark* Graham J. held that a registration for “Electrical machinery included in this Class” did not cover electrical switchgear: even though it was admittedly electrical machinery it was not at the time of registration put in the class concerned.

It should be noted that, in Singapore, descriptions such as *included in this Class* or *included in Class X* are not permitted on the basis that such a qualifier will not make goods/services that are not proper to that Class acceptable: see ***Intellectual Property Office of Singapore Trade Marks Work Manual*** at [5.9.1]. In other words, it is assumed that goods/services listed in a specification are proper to the relevant class. Indeed, this also follows from the fact that official fees for trade mark applications are payable on a per class basis.

93 Interestingly, I note that the Opponents themselves have registered different marks for real estate services in Class 36 and auctioneering services in Class 35, presumably to cater to the dissimilar end users of the services.

94 For the above reasons, I find that the service of selling real estate via auction does not fall within “real estate services” in Class 36. There is accordingly no identity of services in respect of any part of the services applied for in the Application Mark or the services for which the Opponents’ mark in Class 36 is registered.

95 I should also point out the potentially wide ramifications of a finding that the service of selling real estate via auction falls within both “auctioneering services” in Class 35 and “real estate services” in Class 36. This is because a strong argument can be made that the Registrar does not have the power to allow an opposition in relation to part of the specification of goods. In other words, the Registrar may not have the power to permit an application to proceed to registration with the objectionable services deleted from the specification (e.g. in this case, something along the lines of “auctioneering services (not including the auction of real estate)”). Instead, it is possible that the Registrar may need to allow the opposition in full. I examine this issue in greater detail at [102] to [114] below.

Similarity of “auctioneering services” in Class 35 and “real estate services” in Class 36

96 After reading the parties’ Written Submissions, I also invited the parties to make further submissions on how the factors relevant to an assessment of similarity of goods and services (as set out in ***British Sugar***) apply in the present case.

97 To recap, these factors 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; and

(f) the extent to which the respective goods or services are competitive.

98 The Opponents' submissions essentially are along the lines that the services are similar as real estate is often and commonly sold by way of auction services.

99 I have already found that the service of selling real estate via auction does not fall within "real estate services" in Class 36. Once we disregard the auction of real estate, applying the ***British Sugar*** factors, it is clear that "auctioneering services" in Class 35 and "real estate services" in Class 36 are not similar. There is no or minimal overlap in the uses, users, physical nature of the acts of services and trade channels; they are also not competitive.

100 Given my finding that the services of interest are not identical or similar, the Opponents fail on this ground of opposition in respect of their registrations in Class 36.

101 However, in case I am wrong, I consider below the likelihood of confusion under Section 8(2)(b) of the Act. Before doing so, I also address the important issue of whether the Registrar is empowered to allow an opposition in relation to part of the specification of goods/services.

Whether Registrar empowered to allow opposition in relation to part of specification of goods/services

102 An important issue on which I invited the parties to make further submissions was whether the Registrar is empowered to allow an opposition in relation to part of the specification of goods/services. To put the question in context, assuming that the Opponents are able to establish similarity of marks and likelihood of confusion only in respect of the service of auctioning real estate, am I obliged to allow the opposition in full, or can I permit the Application Mark to proceed to registration with the objectionable service excised from the specification (e.g. "Auctioneering services (not including the auction of real estate)").

103 The issue arises as the language of the relevant provisions in the Act relating to revocation and invalidation proceedings differs from opposition proceedings:

(a) Revocation proceedings: Section 22(6) of the Act expressly provides that "*Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.*"

(b) Invalidation proceedings: Section 23(9) of the Act clearly states that "*Where the ground of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.*"

(c) Opposition proceedings: Sections 8(1) and 8(2) of the Act do not expressly provide for a situation where a mark should be refused registration only in respect of certain goods or services for which registration is sought.

104 This issue was mentioned by the Registrar in the recent case of **Bacardi & Company Limited v G3 Enterprises, Inc** [2015] SGIPOS 17, but it was not necessary to decide on the point and the Registrar declined to do so as neither party made any submissions on the issue (see [79] of the decision).

105 The Opponents rely on the differences in the provisions relating to opposition, invalidation and revocation proceedings to argue that the Registrar is not empowered to allow an opposition in relation to part of the specification of the goods. They further argue that “*[f]rom a policy perspective... it would be undesirable to allow an opposition in relation to part of the specification of the goods as this could lead to trade mark applications being filed with overly broad specifications with the hope that at least some of the specifications may be sufficiently different from an existing prior similar mark to survive an opposition proceedings.*” The Opponents also “*highlight that all evidence and submissions to date would have been adduced and submitted based on the entirety of the specifications of goods / services which the Application Mark is sought to be registered for. It would thus not be equitable for the Registrar to unilaterally allow an opposition only in relation to part of the specifications of goods / services, without the Opponent having the opportunity to provide submission, or adduce evidence to show why such an opposition in part should also not be permitted.*”: see the Opponents’ Final Written Submissions at [38]-[41] and Supplemental Written Submissions at [11]-[12].

106 The Applicants simply assert, without citing any authority, that the Registrar is empowered to allow an opposition in relation to part of the specification of the goods. According to the Applicants: “*Unlike other forms of intellectual property law, the incentive or utilitarian theory in support of granting exclusive rights (consequently creating monopolies) does not apply to trade marks. Trade marks are essentially borne out of commercial exigencies and traders in general have a vested interest in protecting their trade marks. The trade mark regime therefore needs to strike a balance to ensure that it is not exploited to unduly stifle competition. Consequently, if the Registrar decides that ‘real estate services’ and ‘auctioneering services’ are similar because real estates may sometimes be sold via an auction, the Registrar can allow registration of the Applicant’s trade mark in relation to ‘auctioneering, except auctioneering of real estates’ in Class 35.*”: see the Applicants’ Final Written Submissions at [21]-[23].

107 I agree that the language of the relevant provisions in the Act suggests that the Registrar does not have the power to allow partial oppositions. There are, however, some considerations which militate against this conclusion.

108 Firstly, the Opponents have laudably brought to my attention a UK decision which is adverse to their position. In the case of **CityBond Trade Mark** [2007] RPC 13 (“**CityBond**”), the Appointed Person expressly considered this issue and allowed for the striking out of certain services from the specification of services in the context of an opposition proceeding.

109 The Opponents (at [42]-[48] of the Opponents' Final Written Submissions) sought to distinguish this case on the basis that the power to allow such partial oppositions is derived from Article 13 of Council [of the European Communities] Directive 89/104 which expressly provides for the partial refusal of registration of goods and services and is set out as follows:

Grounds for refusal or revocation or invalidity relating to only some of the goods or services *Where grounds for refusal of registration* or for revocation or invalidity *of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied for* or registered, *refusal of registration* or revocation or invalidity *shall cover those goods or services only.* (emphasis added)

The Appointed Person was of the view that Article 13 of Council Directive 89/10419 was binding on the Registrar and that the “*operative obligation*” on the registrar was “*to interpret and apply [the provisions of the UK Trade Marks Act of 1994 and the UK Trade Marks Rules 2000] so far as possible in conformity with the requirements of Art. 13*” (see [14]). The Opponents therefore argued that since this Directive is not applicable in Singapore, we are not similarly bound to take this position.

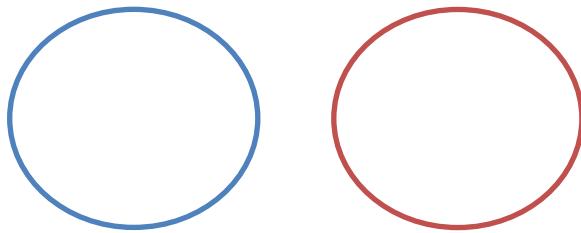
110 However, I note that it is trite, at least under Singapore law, that international treaty obligations must be translated into domestic law before they will have effect. I further note that the Appointed Person in *Citybond* (at [17]) conceded that there is no single provision of the UK Trade Marks Act corresponding to Article 13 of the Directive. Notwithstanding, he again emphasised that “*I do not doubt that [the UK Registrar's] powers can and should be exercised in conformity with the requirements of Art 13, once they have been duly and effectively invoked.*” It is therefore unclear which provision in the UK legislation their Registrar draws this power from, and it is possible that a corresponding provision exists under the Singapore Act. For example, could it be argued that Section 8(2) of the Act would not apply if the objectionable goods/services are deleted from the specification of goods/services in the mark applied for (though this still leaves open the question of whether the deletion must be done by the applicant or if it can be imposed by the Registrar)?

111 Secondly, the Registrar has in fact previously permitted a partial opposition, though this issue does not appear to have been argued in that case: see *Nike International Ltd v Camponar SL* [2001] SGIPOS 4.

112 Thirdly, there does not appear to be any strong policy reason for not permitting partial oppositions. In this regard, I am unable to agree with the Opponents (see [105] above) that “*this could lead to trade mark applications being filed with overly broad specifications with the hope that at least some of the specifications may be sufficiently different from an existing prior similar mark to survive an opposition proceedings.*” There are other provisions in the Act that discourage such conduct.

113 Although I am unable to follow the Applicants' policy arguments based on the purported theory for the existence of trade marks (see [106] above), I do note that it could be unfair not to permit partial oppositions. For example, in the present case, I have found that the service of selling real estate via auctions only falls within the Applicants' services of interest in Class 35 and not the services covered by the

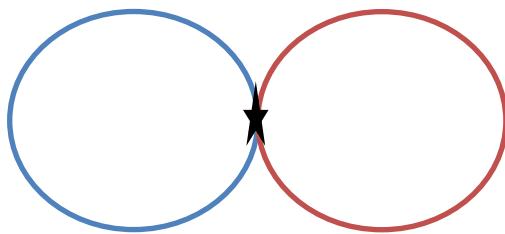
Opponents' registration in Class 36, which includes real estate services. This can be illustrated in the following Venn diagram:



Red: Opponents' registration covering real estate services in Class 36

Blue: Applicants' services of interest (i.e. auctioneering services) in Class 35

For the sake of argument, I assume that I had, instead, found that the service of selling real estate via auctions falls within both the Applicants' services of interest in Class 35 as well as the services covered by the Opponents' registration in Class 36 as illustrated in the following Venn diagram:



Red: Opponents' registration covering real estate services in Class 36

Blue: Applicants' services of interest (i.e. auctioneering services) in Class 35

**: service of selling real estate via auctions*

If I further assume that the Opponents are able to establish similarity of marks and a likelihood of confusion, this would result in the Application Mark being refused in its entirety, despite there being only a single point of overlap/similarity between the parties' respective services of interest. Arguably, such an outcome would not be fair to the Applicants.

114 However, without a clearly-reasoned basis as to how the relevant provisions in the Act can be interpreted to permit partial oppositions, the above concerns standing on their own may not withstand rigorous legal scrutiny. Given my finding that the parties' services of interest are not similar, and my further finding discussed below that there would in any event not be any likelihood of confusion, it is unnecessary for me to reach a final decision on whether the Registrar has the power to allow a partial opposition. In view of the importance of this issue, I prefer to leave the matter open for consideration in a subsequent case, hopefully with the benefit of full submissions by the relevant parties.

Likelihood of Confusion

115 In case I am wrong that the parties' services of interest are not similar, I now proceed to consider whether there is a likelihood of confusion under Section 8(2)(b) of the Act.

116 The following is a summary of the legal principles to determine likelihood of confusion under Section 8(2)(b) by the Court of Appeal in *Staywell*, which are particularly pertinent to this case:

(a) The confusion inquiry in Section 8(2)(b) must take into account the actual and notional fair uses to which the registered proprietor of the earlier trade mark has or might fairly put his registered trade mark and compare this against any actual and notional fair use to which the trade mark applicant may put his mark should registration be granted: *Staywell* at [60].

(b) The only relevant type of confusion, for the purposes of Section 8(2)(b), is that which is brought about by the similarity between the competing marks and the similarity between the goods and services in relation to which the marks are used: *Staywell* at [15].

(c) Factors relating to the impact of marks-similarity on consumer perception include the following:

(i) The degree of similarity between the marks. The greater the similarity between the marks, the greater the likelihood of confusion, and vice versa: *Staywell* at [96(a)].

(ii) Further, it is possible to give more weight to the degree of similarity in a particular aspect (*viz*, visual, aural or conceptual) of the mark. For example, if the goods are normally sold based on the consumer's direct perception, the visual aspect of the mark would be more important than the aural or conceptual aspects of the mark: *Staywell* at [20].

(iii) The reputation of the marks. A strong reputation can but does not necessarily equate to a higher likelihood of confusion: *Staywell* at [96(a)].

(d) Factors relating to the impact of goods-similarity on consumer perception include the following:

(i) The normal price of goods. Where the goods are expensive items, the average consumer is likely to pay greater attention and care when buying such goods and this affects his ability to detect subtle differences: *Staywell* at [96(b)]. (To this I would also add the learned IP Adjudicator Professor Ng-Loy Wee Loon's observations in *The Polo/Lauren Company, L.P. v United States Polo Association [2015] SGIPOS 10* at [109] that "it is [not] necessary in every case to focus on the price of the type of goods concerned. Ultimately, the aim of the

exercise is to determine the degree of care that the average consumer is likely to pay when purchasing that type of goods. In this exercise, there may be factors other than price which are more useful.”)

(ii) The nature of the goods. For example, where the nature of the goods is such that specialist knowledge is required in making the purchase, the average consumer is also likely to pay greater attention and care when buying such goods: *Staywell* at [96(b)].

(iii) The frequency and typical mode of purchase of the goods. For example, the consumer is likely to pay greater attention when the purchase transaction is infrequent (compared with routine purchases): *Staywell* at [94].

(e) It is not permissible to consider factors which are external to the marks and to the goods in question, and which are susceptible to changes that can be made by a trader from time to time, such as price differentials between the parties’ goods: *Staywell* at [95].

(f) In determining likelihood of confusion for the purpose of Section 8(2)(b), there are at least two specific aspects to the element of confusion. The first is the consumer mistaking one mark for another. The second is where consumers may perceive that both marks are different, but may yet remain confused as to the origin which each mark signifies and may perceive that goods of both marks emanate from the same source that has chosen to diversify its range of marks for any of a multitude of marketing or promotional reasons or that the two sets of goods emanate from sources that are economically linked or associated: *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941 at [74]; *Staywell* at [99].

117 I have found that there is only a very low degree of similarity between the marks overall. I have also found that there is no similarity in the parties’ services of interest. However, if I am wrong, and in particular, if the service of selling real estate via auctions falls within both the Applicants’ services of interest in Class 35 as well as the services covered by the Opponents’ registration in Class 36, there would be identity between the parties’ services of interest in respect of this specific service.

118 How would this affect the inquiry as to likelihood of confusion? In auctions, the reliability of the service provider is of critical importance. The end user has to rely on the service provider to ensure that the product he bids for is the same as the product he will receive in the event he is successful in the bid (or indeed that he will receive any product at all). In my view, it is likely that consumers are likely to be attentive to the identity of the service provider. Given the very low degree of similarity between the parties’ marks, I find that there is no likelihood of confusion.

119 Accordingly, the opposition under Section 8(2)(b) relating to the Opponents’ marks in Class 36 fails.

Opponents' Prior Mark in Class 9

120 For convenience, the marks to be compared are set out below:

	Application Mark	Opponents' Earlier Mark
Mark	Chritrs	CHRISTIE'S
Services	Class 35: Auctioneering	Class 9: Computer software, computer programs; data recorded in electronic, optical or magnetic form; data carriers; audio and visual recordings; compact discs read only memories (CD-ROMs); compact disc-interactives (CDIs); compact discs (CDs); digital video discs (DVDs); publications in electronic form supplied on-line from databases or from facilities provided on the global communication network (including web sites); interactive videos, films, tapes, cassettes, compact disks.

121 The Opponents must satisfy three elements in order to succeed in the opposition on this ground, *viz*, similarity between the marks, identity or similarity between the goods or services, and confusion brought about by these two similarities.

122 For the reasons set out at [67]-[78] above in connection with the Opponents' marks in Class 36, I find that there is only a very low degree of mark similarity.

123 Applying the ***British Sugar*** factors (see [97] above), I also find that the Applicants' services of interest are not similar to the goods for which the Opponents' mark in Class 9 have been registered. In today's modern society, computer software is used at some point in the course of providing practically any conceivable service. It cannot be the case that such a broad interpretation of computer software is to be taken in a comparison of the similarity of goods/services. With that in mind, I am of the view that the uses, users, physical nature of the goods or acts of services and trade channels are all different, and they are also not competitive. Indeed, I note that there is no allegation in the Notice of Opposition that the Opponents' goods in Class 9 are similar to the Applicants' services of interest in Class 35.

124 In the circumstances, the opposition under Section 8(2)(b) relating to the Opponents' mark in Class 9 fails as well.

Grounds of Opposition under Section 8(4)

125 Section 8(4) of the Act reads:

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

- (a) the *earlier trade mark is well known in Singapore; and*
- (b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —
 - (i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark; **or**
 - (ii) *if the earlier trade mark is well known to the public at large in Singapore —*
 - (A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or
 - (B) would take unfair advantage of the distinctive character of the earlier trade mark.

126 There are two situations to be considered under Section 8(4). First, where the earlier mark is “**well known in Singapore**”. Second, where the earlier mark is “**well known to the public at large in Singapore**” (and not merely “well known in Singapore”).

127 Section 2(1) of the Act defines an "earlier trade mark" to mean:

- (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.

(emphasis added)

128 The earlier mark relied upon by the Opponents in the present case is the “CHRISTIE’S” mark (without any Chinese characters or design elements). As is

readily apparent, there is some circularity in the relevant considerations where a mark is alleged to be an “earlier mark” on the basis that it is a “well known trade mark”. However, this is not relevant in view of the ground of opposition relied upon in the present case. As discussed at [132]-[141] below, I accept the Opponents’ submissions that “CHRISTIE’S” is a well known trade mark.

Section 8(4)(a) read with Section 8(4)(b)(i): “well known in Singapore”

129 To succeed under this ground, the Opponents have to show that: (i) the whole or an essential part of the Application Mark is identical with or similar to the “CHRISTIE’S” mark; (ii) the “CHRISTIE’S” mark is well known in Singapore; (iii) the use of the Application Mark would indicate a connection between the Applicants’ goods/services and the Opponents; and (iv) the connection is likely to damage the interests of the Opponents. These elements have been discussed in great detail by the Court of Appeal in *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 (“Amanresorts”), *Mobil Petroleum Co, Inc v Hyundai Mobis* [2010] 1 SLR 512 (“Mobil”) and *Staywell*, and the High Court in *Rovio*. In the present case, it is sufficient for me to briefly examine each of these elements in turn.

(i) Similarity of Marks

130 As observed recently in *Rovio* (at [146]), little turns on the reference to “essential part” in Section 8(4); the similarity of marks comparison is the same as under Section 8(2)(b).

131 In this regard, I have found above at [67]-[78] that there is only a very low degree of similarity between the Application Mark (“Chritrs”) and the Opponents’ “CHRISTIE’S” mark.

(ii) Well Known in Singapore

132 I set out the relevant provisions relating to what is a well known trade mark in Singapore.

133 Section 2(1) of the Act defines a "well known trade mark" to mean:

- (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.

134 Section 2(7) of the Act provides that:

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.

135 Section 2(8) of the Act states that “*[w]here 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.*”

136 Section 2(9) defines “*relevant sector of the public in Singapore*” in subsections (7) and (8) to 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.

137 The relevant date to determine whether the “CHRISTIE’S” mark is “well known in Singapore” is the date of application of the Application Mark (i.e. 5 March 2012).

138 The Opponents rely on the following in support of their position that the “CHRISTIE’S” mark is “well known in Singapore” (see generally the Opponents’ SD, which is dated 28 April 2014):

- (a) The Opponents were founded in 1766 in London, and has conducted the greatest auctions of the 18th, 19th and 20th centuries.
- (b) As at the date of the Statutory Declaration, the Opponents had 53 offices in 32 countries and 12 salerooms around the world.
- (c) The “CHRISTIE’S” mark was first used in Singapore in 1991 and the local office in Singapore was incorporated on 24 September 1992. The South East Asia department has been based in Singapore since 1990. As at the date of the Statutory Declaration, 42 auction pre-view exhibitions have been conducted in Singapore since 1993; these exhibitions are previews for auctions to be conducted in Hong Kong.
- (d) The Opponents’ worldwide revenue ranged from £8.28-£15.30 million per year between 2007-2011. The Opponents did not provide a breakdown of the revenue figures for Singapore. Instead, they asserted that, *“between 2007-2013, 179 Singaporean clients participated in online auctions conducted through Christie’s Live and online-only sales, with a total hammer value of £9,899,493.”*
- (e) The Opponents’ worldwide advertising expenditure ranged from £4.02-£9.64 million per year between 2007-2011. In Singapore, the Opponents provided a breakdown of their “marketing costs booked in Singapore”, “travel, motor, entertainment costs booked in Singapore” and “Singapore preview costs booked in Hong Kong” over the same period. The figures varied significantly from year to year, and appeared to be the highest in 2007 (SGD 139,598 + HKD 1,796,011).
- (f) There has been extensive exposure of the “CHRISTIE’S” mark in the worldwide media. In Singapore, numerous articles on the Opponents (referred to as “CHRISTIE’S”) have appeared in *The Straits Times*, *The Business Times*, *The Edge Singapore*, *Prestige* and *Affluent*.
- (g) The Opponents have registered their trade marks in various classes in many countries worldwide. The Opponents provided a list of their registrations in Asia, together with copies of the relevant registration certificates.

139 The Applicants criticized the evidence put forward by the Opponents. Among other things, the Applicants pointed out that *“art pieces fetch extremely high prices and a high revenue is not reflective of a high volume of customers”*, and asserted that *“Christie’s Singapore office’s main purpose has been to support Christie’s business in Hong Kong. The evidence adduced shows that only 151 customers utilised Christie’s online auction platform, Christie’s Live, from year 2007-2013. This figure averages to about 2 customers a month.”* (see Applicants’ SD at [8] and [12]).

140 The leading case discussing whether a mark is well known in Singapore (and also whether it is additionally well known to the public at large in Singapore) is the Court of Appeal's decision in *Amanresorts*. The Court of Appeal held at [137] that the factors laid out in Sections 2(7)(a)-2(7)(e) of the Act are not an exhaustive list in that the court is obliged to take into account "any matter from which it may be inferred that the trade mark is well known" (*per* Section 2(7) of the Act). As such, the court is ordinarily free to disregard any or all of the factors listed in Section 2(7) as the case requires and to take additional factors into consideration. However, Section 2(7)(a) (which looks at "the degree to which the trade mark is *known to or recognised by any relevant sector of the public in Singapore*") cannot be disregarded since Section 2(8) deems a trade mark to be "well known in Singapore" once this factor is established. It is therefore not too difficult for a trade mark to be regarded as "well known in Singapore" – essentially, the Court of Appeal at [145]-[146] accepted that the trade mark in question need only be recognised or known by "*any relevant sector of the public in Singapore*" which means that any trade mark which is known to even the smallest and most exclusive of niche markets can become well known in Singapore.

141 I do not think it is necessary to examine in detail the evidence put forward by the Opponents, and the Applicants' criticism of this evidence. On the whole of the evidence, I find that the Opponents meet the relatively low threshold to establish that the "CHRISTIE'S" mark is well known at least in the auctioneering service, and hence deemed to be well known in Singapore.

**(iii) Connection between the Applicants' Services and the Opponents; and
(iv) Connection Likely to Damage the Opponents' Interests**

142 I will examine these elements together. The Court of Appeal held in *Amanresorts* (at [218] and [226]) that likelihood of confusion is needed to establish these two elements. This explains why the Court of Appeal was of the view that it is not too difficult for a trade mark to be regarded as "well known in Singapore". In contrast, non-confusing types of damage by blurring and tarnishment apply only to marks which are well known to the public at large in Singapore (which is distinct from a well known mark *per se*).

143 As discussed above at [115]-[118], I am of the view that there is no likelihood of confusion in this case given the very low level of similarity between the Application Mark ("Chritrs") and the Opponents' "CHRISTIE'S" mark, and as a consumer is likely to be attentive as to the identity of a provider of auction services who has to be a trusted intermediary between the sellers and buyers.

Conclusion

144 To conclude, even though I accept that the Opponents' "CHRISTIE'S" mark is well known in Singapore, there is only a very low degree of similarity between the Application Mark ("Chritrs") and the Opponents' "CHRISTIE'S" mark. Further, the Opponents have not shown that there is likelihood of confusion and there is likelihood of damage to the Opponents' interests from the use of the Application Mark. As such, the Opponents do not satisfy the ground of opposition under Section 8(4)(a) read with 8(4)(b)(i) of the Act.

Ground of Opposition under Section 8(4)(b)(ii): “well known to the public at large in Singapore”

145 Section 8(4)(b)(ii) 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 —

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

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

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

(emphasis added)

146 To succeed under this ground, the Opponents have to show that: (i) the whole or an essential part of the Application Mark is identical with or similar to the Opponents’ “CHRISTIE’S” mark; (ii) the Opponents’ “CHRISTIE’S” mark is well known to the public at large in Singapore; and (iii) the use of the Application Mark in relation to auctioneering services would cause dilution in an unfair manner or take unfair advantage of the distinctive character of the Opponents’ “CHRISTIE’S” mark.

147 I have earlier found (at [67]-[78]) that there is only a very low level of similarity between the Application Mark (“Chitrts”) and the Opponents’ “CHRISTIE’S” mark.

148 The Act does not define what is “well known to the public in Singapore”. Nonetheless, the Court of Appeal observed that relative to trade marks which are “well known in Singapore” a “*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.”: *Amanresorts* at [233].

149 The principles governing what is “well known to the public at large in Singapore” have been discussed by the Court of Appeal in *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 (“*City Chain*”) and even though the

case dealt with Sections 55(3)(b)(i) and 55(4)(b)(i) of the Act, the following principles are applicable in determining the same phrase under Section 8(4)(b)(ii) of the Act:

(a) In determining whether a trade mark is “well known to the public at large in Singapore” *“one must certainly have regard to Section 2(7) of the Act”* and *“as the factors in Section 2(7) of the Act are not exhaustive, [i]t appears that the court is ordinarily free to disregard any or all of the factors listed in Section 2(7) as the case requires... and to take additional factors into consideration.”*: **City Chain** at [92]–[93]; **Amanresorts** at [137].

(b) *“The expression ‘well known to the public at large’ should be given a sensible meaning, bearing in mind that by virtue of Section 2(8) of the Act, where 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. Thus the test ‘well known to the public at large in Singapore’ must mean more than just ‘well known in Singapore’. To come within the former test, the mark must necessarily enjoy a much higher degree of recognition. It must be recognised by most sectors of the public though we would not go so far as to say all sectors of the public.”*: **City Chain** at [94].

(c) In determining the test for what is “well known to the public at large in Singapore”, the Court of Appeal in **City Chain** at [87] approved the US approach under Section 43(c)(2)(A) of the Lanham Act (15 USC (US) § 1127) (as amended by Section 2 of the Dilution Revision Act 2006 which was made specifically to eliminate the concept of “niche fame”), that a “famous” trade mark is one which is: *“widely recognized by the general consuming public... as a designation of source of the goods or services of the mark’s owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following:*

(i) *The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.*

(ii) *The amount, volume, and geographic extent of sales of goods or services offered under the mark.*

(iii) *The extent of actual recognition of the mark.”*

150 Although it should be self-evident, it bears repeating that much would have to depend on how a mark is actually used or promoted, and there must be evidence of such activities: **City Chain** at [96]. To put this in another way, the outcome of this enquiry cannot depend on whether the Hearing Officer has heard of the mark in question; otherwise, to borrow a well-known aphorism, the result would vary with the length of the Hearing Officer’s foot.

151 The Registrar in **Taylor, Fladgate & Yeatman Limited v Taylors Wines Pty Ltd [2014] SGIPOS 11** has helpfully summarised the evidence furnished in previous local cases where the relevant mark was found to have crossed the high threshold of what is “well known to the public at large in Singapore”:

132 In this regard, I note that only a few trade marks have reached the status of being "well known to the public at large in Singapore", e.g. "CLINIQUE" – in ***Clinique Laboratories, LLC v Clinique Suisse Pte Ltd and another [2010] 4 SLR 510*** ("Clinique"), "NUTELLA" in ***Sarika (HC)*** and more recently, "SEIKO" in ***Choice Fortune Holdings Limited v Seiko Holdings Kabushiki Kaisha (trading as Seiko Holdings Corporation) [2014] SGIPOS 8*** ("Seiko"). In these cases, 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)].

152 In the current case, I also note that "CHRISTIE" is a surname, though there is no evidence as to how common this surname is in Singapore. In ***Han's (F & B) Pte Ltd v Gusttimo World Pte Ltd [2015] 2 SLR 825***, the High Court considered the impact of a mark being a relatively common surname on its inherent capacity to distinguish and/or to acquire distinctiveness through use under Section 7 of the Act. I am not aware of any case in Singapore where the effect of a mark being a surname has been considered in the context of a party seeking to establish that the mark is "well known to the public at large in Singapore", in which event it would be entitled to protection from use of a competitor's trade mark on dissimilar goods or services even in the absence of a likelihood of confusion. It is not, however, necessary for me to address this issue in the present case.

153 The evidence relied upon by the Opponents has been set out at [138] above, along with the Applicants' criticism of this evidence (at [139] above). In my view, the evidence of the Opponents' revenue and advertising expenditure in Singapore fall far short of establishing that the Opponents' "CHRISTIE'S" mark is well known to the public at large in Singapore.

154 I should mention that the Opponents in their Final Written Submissions at [9]-[17] (and also briefly in the course of the hearing of the matter) rely heavily on the publicity which the Opponents receive "*organically in the form of articles written by third parties, and published in popular newspapers/ websites/ magazines.*" In particular, the Opponents highlight "*that over the short period of just half a year, there were 145 mentions of the Opponent's CHRISTIE'S Mark in various kinds of articles which were not necessarily focused on auctioneering services, and published in widely-circulated media.*" The Opponents argue that "*[t]he fact that the Opponent need not pay third parties any advertisement fees to publish such articles is strongly indicative of the Opponent's CHRISTIE'S Mark's well-known status to the public at large in Singapore as it is clear that there is enough public recognition and interest in the Opponent and in the services offered under the Opponent's CHRISTIE'S Mark for*

these articles to draw readership and attention." Specifically, the Opponents make reference to certain articles where "*the writer of the article simply mentioned the Opponent as 'Christie's'... without providing any background information whatsoever. In other words, the writer had presumed that the readers were already familiar with the Opponent.*"

155 While I tend to agree that such media coverage would be a relevant factor to consider (though not conclusive) in assessing whether a mark is well known to the public at large, the problem in this case is that the Opponents clearly did not seek to rely on the media articles for this purpose. For example, the Opponents in the Notice of Opposition only sought to rely on their own promotion and use of the "CHRISTIE'S" mark to support their assertion that the mark is well known to the public at large. It also appears clear from Exhibit "SWYA-2" to the Opponents' SD that the purpose of including the media articles is to impute a value in terms of advertising and public relations, which is then used to support the Opponents' figures for advertising expenditure. Further, I note that most of the articles in *The Straits Times* and *The Business Times* are counted twice as they appear in both the print and online versions of these publications. I also note that some of the publicity appears to be negative (e.g. item 10 is an article in *The Straits Times* entitled "*Christie's Told to Return \$3m*" – *the first sentence of this article reads: "Auctioneer Christie's should return the sum of £1.5 million (\$S3 million) paid by a wealthy Russian art collector for a painting that was probably fake, a High Court judge [in London] ruled last Friday.*"

156 Of course, it may not follow that negative publicity cannot be used to establish that a mark is well known to the public at large. The only point that I am making is that it would not be fair to the Applicants to permit the Opponents to rely on the media articles in this manner at this late stage in the proceedings. The Applicants did not have the opportunity to address such arguments in their Counter-Statement or SD, and only had a very limited opportunity to do so in their submissions.

157 Having found (on the evidence adduced by the Opponents) that the Opponents' "CHRISTIE'S" mark is not well known to the public at large, I need not consider whether the use of the Application Mark in relation to the goods applied for would cause dilution in an unfair manner or take unfair advantage of the distinctive character of the Opponents' "CHRISTIE'S" mark. The opposition on this ground fails.

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

158 Section 8(7)(a) of the Act provides that a trade mark shall not be registered if "*its use in Singapore is liable to be prevented 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.*"

159 As noted in *Kerly's* at [9-147], "*[t]he particular formulation of the provision suggests that the correct approach is to consider a normal and fair use of the mark the subject of the application in respect of the goods or services the subject of the application and whether or not this would result in passing off. In this sense the test is different from that involved in a claim in passing off which would normally require a consideration of all of the circumstances of the defendant's trade.*" Thus, the relevant

comparison is between the Application Mark (“Chritrs”) (i.e. the “*mark the subject of the application*”) and the Opponents’ “CHRISTIE’S” mark sans any Chinese characters or devices (as this would be the strongest “*unregistered trade mark or other sign used in the course of trade*” which the Opponents can rely on in the present case). The comparison is not between “Chritrs 佳士德 (pronounced ‘Jia Shi De’)” [or “Chritrs 佳德 (pronounced ‘Jia De’)”] and “Christie’s 佳士得 (pronounced as ‘Jia Shi De’)”.

160 The applicable principles pertaining to this ground of opposition were helpfully summarised in the High Court’s recent decision in **Rovio**:

- (a) “[T]here are three clear, identifiable core concepts fundamental to a passing off action. These are goodwill, misrepresentation and damage.” (at [158])
- (b) “[I]n the context of trade mark opposition proceedings, a court is generally hampered in evaluating the potential success of any passing off action. For one, the mark may not even have been used by the trader yet. The decision is based on a notional action for passing off. Second, the court may have relatively few facts and evidence before it on which it has to make a decision as to whether the notional passing off action will succeed..... s 8(7)(a) effectively requires the court to consider the position of the opponent in a notional passing off action.” (at [159]-[160])
- (c) “[T]he opponent... bears the burden of making out the grounds of opposition he relies on..... [T]he opponent must... persuade the court that on the materials before it, there is at least a *prima facie* case that a passing off claim would be successful if, at the time of the application, the applicant mark were to be used in a normal and fair manner in respect of the goods or services for which the mark is sought to be registered. Indeed, it may be preferable to just use the words of the statutory provision: has the Opponent established that the use is “*liable to be prevented*” by passing off? In other words that the Opponent had proved a case of passing off in the notional passing off action.” (at [161] and [164])
- (d) “To this end, it is incumbent on an opponent to adduce evidence on, inter alia, (a) the nature and extent of the goodwill and reputation relied on, (b) the closeness or otherwise of the respective fields of activity, (c) the similarity of the marks, (d) the manner in which the applicant has used the mark (if any), (e) the manner in which the particular trade is carried out, (f) the class of persons that is likely to be deceived by the applicant mark, and (g) the likely damage the opponent would suffer.” (at [165])

161 As observed in **Rovio** (at [180]), the existence of goodwill is normally established through figures of sales in Singapore and evidence of marketing and advertising efforts in Singapore. Based on the evidence set out in [138] above, I am satisfied that the Opponents have established goodwill in the “CHRISTIE’S” mark.

162 With regard to the element of “misrepresentation”, the High Court in **Rovio** observed that the Court of Appeal in **Amanresorts** stated at [234]:

... [T]he tests to be adopted for the purposes of the “connection” requirement and the ‘likely to damage the [plaintiff’s] interests requirement’ in s 55(3)(a) of the current TMA would yield the same results as those obtained from applying the corresponding tests *vis-à-vis* the Respondent’s claim for passing off ...

The High Court in **Rovio** further held (at [192] and [193]) that while **Amanresorts** was concerned with Section 55(3)(a) of the Act, the language used in that provision is substantially similar to that in Section 8(4)(b)(i) of the Act, and therefore applies equally in the context of Section 8(4)(b)(i).

163 I have already found at [142]-[143] above that the Opponents have not established the “connection” requirements in Section 8(4)(b)(i) of the Act. It follows that the Opponents are unable to establish “misrepresentation” in a notional passing off action.

164 Consequently, the opposition on this ground fails.

Ground of Opposition under Section 7(6)

165 Section 7(6) of the Act provides that a trade mark shall not be registered if or to the extent that the application is made in bad faith.

Bad Faith: General Principles

166 The leading case in this area is the Court of Appeal’s decision in **Valentino Globe BV v Pacific Rim Industries Inc [2010] 2 SLR 1203** (“**Valentino**”). It is helpful to summarise the applicable principles which are particularly pertinent in the present case:

(a) “Bad faith” embraces not only actual dishonesty but also dealings which would be considered as commercially unacceptable by reasonable and experienced persons in a particular trade, even though such dealings may otherwise involve ‘*no breach of any duty, obligation, prohibition or requirement that is legally binding*’ upon the registrant of the trade mark’: **Valentino** at [28].

(b) The test for determining bad faith is the combined test of bad faith which contains both a subjective element (*viz*, what the particular applicant knows) and an objective element (*viz*, what ordinary persons adopting proper standards would think). Thus, “bad faith” as a concept is context-dependent. In the final analysis, whether bad faith exists or not hinges on the specific factual matrix of each case: **Valentino** at [29].

(c) Once a *prima facie* case of bad faith is made out by the Opponents, the burden of disproving any element of bad faith on the part of the Applicants would arise: **Valentino** at [36].

(d) An allegation of bad faith is a serious claim to make and it must be sufficiently supported by the evidence, which will rarely be possible by a

process of inference: *Valentino* at [30]. (As observed by Professor Ng-Loy Wee Loon in *Law of Intellectual Property of Singapore* (Sweet & Maxwell, 2nd Edition, 2014) (“Ng-Loy Wee Loon”) at [21.4.1], footnote 109, this is not an absolute prohibition against drawing inferences. In support of this observation, Professor Ng-Loy cited the decision in *Festina* at [115], where the High Court pointed out that a finding of bad faith was largely, if not invariably, based on circumstantial evidence.)

(e) Once bad faith is established, the application for registration of a mark must be refused even though the mark would not cause any confusion: *Valentino* at [20].

Parties’ Submissions

167 When addressing me on this issue, I requested the parties to submit specifically on the following issues:

- (a) To what extent (if at all) is it permissible to take into account the fact (if established) that the mark is used together with the Chinese characters “佳士德” (pronounced “Jia Shi De”) (as mentioned at [23] above, the Applicants and their various related companies changed their Chinese name to “佳德” (pronounced “Jia De”) sometime after October 2011); and
- (b) The effect (if any) of the Applicants’ witness (Mr Lee) being absent at the hearing on 3 November 2015, and the consequent inability of the Opponents to cross-examine him on his evidence.

168 The Opponents’ case on bad faith rests on three main contentions: first, the Applicants’ knowledge of the Opponents’ rights in the “CHRISTIE’S” mark when the Application Mark was applied for (i.e. 5 March 2012) in light of the proceedings in Hong Kong; second, “*the uncanny visual similarity*” of the marks in question (see [71] of the Opponents’ Written Submissions); and third, the Applicants’ lack of explanation for its choice of the allegedly meaningless and unpronounceable Application Mark, which in totality constituted strong evidence of the Applicants’ bad faith in seeking to register the Application Mark in Singapore.

169 The Opponents argued that the Registrar must take into account the fact that the Application Mark is used together with Chinese characters that (at least initially) are aurally identical to the Opponents’ Chinese name. This follows from the inquiry for bad faith being context-dependent and fact-centric; it is therefore necessary to consider the totality of the Applicants’ conduct in relation to the registration of the Application Mark: see *Valentino* at [29] and *Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd and another and another appeal* [2009] 2 SLR(R) 814 (“*Wing Joo Loong*”) at [104].

170 With regard to the absence of Mr Lee at the hearing, the Opponents challenged the authenticity of the Jury Summons provided by Mr Lee (which the Opponents were unable to verify). They pointed out that Mr Lee would in any event have known about the purported summons well in advance of the hearing. There was no reason to inform the Opponents and the Registrar of his inability to attend the hearing only on the

morning of the hearing itself, and this was clearly done to avoid having to testify. Consequently, there is no explanation as to why the Applicants created and chose an allegedly unpronounceable Application Mark and/or a Chinese name that (at least initially) was aurally identical to the Opponents' Chinese name. An adverse inference should accordingly be drawn against the Applicants.

171 The Applicants' argument is as follows: firstly, the Application Mark ("Chritrs") is not similar to the Opponents' trade mark "Christie's": see *McDonald's Corp v Future Enterprises Pte Ltd [2005] 1 SLR(R) 177* ("McDonald's"). Secondly, there is no likelihood of confusion on the part of the public. Thirdly, it does not mean that there is definitely bad faith whenever the trade mark sought to be registered was the subject of disputes outside of Singapore: see *Wing Joo Loong*. Essentially, the Applicants argue that the fact that there is no similarity of marks and no likelihood of confusion is in itself a strong indication that bad faith cannot be inferred.

172 With regard to the specific issues which I asked the parties to address me on, the Applicants submitted, without citing any authority, that it is not permissible to take into account how a mark is used in order to ascertain whether or not the application was made in bad faith. Accordingly, the fact that the Application Mark is used together with Chinese characters should not be taken into account. The Applicants also submit that a negative inference should not be drawn against the Applicants for Mr Lee's failure to attend the hearing "*due to circumstances beyond his control.*"

My Findings

173 The Applicants' key contention is that bad faith cannot be inferred as there is no similarity of marks and no likelihood of confusion in the current case. In *McDonald's*, which the Applicants rely on, the Court of Appeal was considering Section 12(1) under the previous Trade Marks Act (Cap 332, 1992 Rev Ed) to determine whether the respondent's claim to proprietorship of the marks "MacTea", "MacChocolate" and "MacNoodles" (all applied for together with the device of an eagle) was not made in good faith as the respondent had allegedly copied the common prefix of McDonald's family of marks, "Mc". In this context, the Court of Appeal observed at [73]:

73 ...[The appellant] averred that even if the application marks and the appellant's marks were not substantially similar, the appellant was entitled to succeed so long as it was shown that there was bad faith or copying. It seems to us that this proposition is perhaps too wide. Otherwise, it would mean that even if it is just a small portion of an existing mark which an applicant has adopted and no confusion could arise, that would suffice to hold that there is copying and misappropriation by the applicant. We do not think so. As a rule, there must be substantial identity before bad faith or misappropriation could be inferred. Indeed s 23 of the [the previous] Act provides that "no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a trade mark belonging to a different proprietor and already on the register". This section embodies the concept of substantial identity. **What would constitute "substantial" is not a matter that can be defined objectively. Adopting a legal cliché, it will have to**

depend on the circumstances of each case. But it would be stretching reason to the extreme to assert that there is misappropriation even if what is copied is not substantial and where comparing the two marks, it is clear that no confusion is likely to arise. (emphasis added)

174 The Opponents relied on the High Court's decision in *Festina*. In that case, the court considered that the respondent's brand story for the name "J.ESTINA" appeared to be extremely contrived and noted that the alleged use of Princess Jovanna's name did not explain how and why the meaningless word "ESTINA" came into being. The respondent's failure to furnish a credible explanation in respect of the derivation of "ESTINA" was especially pertinent since six out of seven letters were identical in sequence between the two competing marks, which led to the irresistible conclusion that "ESTINA" was blatantly copied from "FESTINA". The High Court held, at [122] and [123], that "*[s]uch outright copying of the Appellant's mark [was] an act that falls short of the acceptable commercial behaviour observed by reasonable and experienced men in the relevant trade.*" The court observed at [115] and [116]:

115 The categorisation by *Bently & Sherman* ([38] *supra*) as seen above hints that despite the broad nature of the notion of bad faith, one must show *some sort of nexus* between the parties in dispute. Otherwise, the notion of bad faith would have to be decided in vacuum. A clear-cut example of such a nexus would be an outright copying of the proprietor's mark such that the two competing marks are practically identical. However, the nexus may be in the guise of something more subtle. In finding a nexus between the parties, a parallel may be drawn between ss 8(2)(b) and 7(6) [of the Act]. For example, there may be cases where although there is *some* similarity of marks or of the goods or services, it falls short of confusing similarity (*ie*, no likelihood of confusion) within the meaning of s 8(2)(b) [of the Act]. Nevertheless, the evidence of this similarity may be taken into account and considered against the background facts from which bad faith may be inferred. In other words, while the finding of bad faith is largely, if not invariably, based on circumstantial evidence, the party alleging bad faith needs to show some link between the parties, perhaps by way of a pre-existing relationship or some acts of association with the proprietor or some nexus between the two competing marks.

116 There may be a fine line between being inspired by another's trade mark as opposed to blatant copying or copying with some modifications made to the mark. The former would not attract punitive measures whereas the latter would lead to the mark being rejected. Where the dividing line between "inspiration" and "infringement" should be drawn is a matter best left to the facts peculiar to any case. (emphasis added)

175 As far as local cases are concerned, the cases of *McDonald's* and *Festina* probably sit at different ends of the spectrum. However, what remains the case is that, ultimately, "*each case would have to be decided in accordance with its own facts, and in particular, the evidence tendered*": see also *Valentino* at [34].

176 As whether bad faith exists or not hinges on the specific factual matrix of each case, I agree with the Opponents that it must necessarily follow that the Applicants'

use of a Chinese name together with “CHRITRS” is a factor that must be taken into account.

177 Applying the above considerations, and the principles set out in *Valentino* (see [166] above), on the facts of the present case, I am satisfied that the Opponents have met the high threshold to establish that the application was made in bad faith.

178 It is difficult to believe that “*CHRITRS is a meaningless word that was invented by the Applicant as a means of coming up with a unique mark for his business*” as asserted in the Applicants’ SD at [15]:

- (a) It does not make sense for the Applicants to come up with an unpronounceable name for its business;
- (b) Six (6) of the letters in the Application Mark “CHRITRS” are the same as the Opponents’ “CHRISTIE’S” mark, and the first four (4) letters are identical;
- (c) The Applicants’ initial Chinese name “佳士德” (pronounced “Jia Shi De”) is phonetically identical to the Opponents’ Chinese name “佳士得” (also pronounced “Jia Shi De”); indeed, the first two (2) Chinese characters are identical;
- (d) The Opponents’ Chinese name is neither a translation or transliteration of CHRISTIE’S, which makes the Applicants’ choice of a Chinese name which is practically identical all the more unbelievable; and
- (e) The Applicants always use the Application Mark together with their Chinese name. (This may in fact explain why the Applicants selected an unpronounceable English name; consumers would then be more likely to refer to the Applicants by their Chinese name, which as noted in practically identical to the Opponents’ Chinese name.)

179 I agree with the observation in the *Hong Kong Judgment* (at [46]) that “[t]here is also some absence of evidence that is worth mentioning. There is a deafening silence as to how the defendants’ signs came to be adopted in the first place, in a business identical to the plaintiffs’. There was no explanation as to why the unpronounceable name ‘Chritrs’ was adopted and bore such visual similarity to the plaintiffs’ English mark. Chritrs was not even a transliteration of [the Applicants’] Chinese sign.”

180 In these circumstances, I agree with the Opponents that if the Applicants had nothing to conceal, Mr Lee would have made full use of the opportunity to submit to cross-examination and vindicate the Applicants’ creation and choice of the Application Mark, as well as their reasons for applying to register the same.

181 Like the Opponents, I find that Mr Lee’s reason for his absence at the hearing leaves much to be desired. I do not think it is necessary to make any finding on the authenticity of the Jury duty summons (see [8] above for the facts in this regard). It is eminently clear that even if Mr Lee was truly unable to attend the hearing in

Singapore, there can be no justification for why the Registrar and the Opponents were only notified of his non-attendance on the day of the hearing itself (literally just minutes before the hearing was scheduled to commence).

182 By analogy, in *Cheong Ghim Fah and another v Murugian s/o Rangasamy* [2004] 1 SLR(R) 628 at [44], the Court considered that “*By all accounts, the defendant has consciously decided not to participate in these proceedings. The defendant’s counsel contended that he was out of the jurisdiction and had a ‘legitimate’ basis not to come to Singapore, as he faced police enquiries...This is decidedly not a legitimate or acceptable reason for the defendant’s absence... Furthermore, a common sense approach should prevail. A person who has nothing to conceal would usually want to cooperate in such enquiries and vindicate himself. The defendant was not just a material witness; he was the sole witness to what transpired.*” In the said case, as a result of the defendant’s absence and the plaintiff’s claims that the defendant had not kept a proper look-out and was speeding while driving, the court drew an adverse inference and held that the defendant had driven negligently. This was since the defendant was the sole witness to what transpired when he knocked down the deceased and the court held that he had no legitimate reason for being absent to give testimony.

183 I agree with the Opponents that an adverse inference should be drawn against the Applicants. On the facts of the present case, I also agree that the Application Mark was applied for in bad faith.

184 The Opponents succeed on this ground of opposition.

Conclusion

185 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition succeeds under Section 7(6) but fails on all the other grounds relied on by the Opponents. Accordingly, the Application Mark shall be refused registration.

Costs

186 Under the Act, the Registrar has the discretion on the costs to be awarded. The basis under which this discretion will be exercised was considered in some detail in the Registrar’s recent decision in *Ferrero S.P.A. v Dochirnie Pidpryiemstvo “Kondyterska Korporatsilia “Roshen”* [2015] SGIPOS 14 at [96]-[103].

187 In the present case, I note that the Opponents have succeeded on only one of the five grounds of opposition which they have relied upon. At the same time, I take into account the Applicants’ conduct in these proceedings (see the Opponents’ Final Written Submissions at [49]-[52], in particular the inexcusably late notice of Mr Lee’s non-attendance at the hearing on 3 November 2015 (see [8] and [181] above)).

188 All things considered, the Opponents are entitled to 75% of their costs to be taxed, if not agreed.

Dated this 9th day of March 2016

Mark Lim Fung Chian
Principal Assistant Registrar of Trade Marks
Hearings and Mediation Group
Intellectual Property Office of Singapore