

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

Trade Mark No. T1212601G  
31 August 2016

**IN THE MATTER OF A TRADE MARK APPLICATION BY**

**PT PURINUSA EKAPERSADA AND PT PABRIK KERTAS TJIWI KIMIA TBK  
LTD**

**AND**

**OPPOSITION THERETO BY**

**STORA ENSO OYJ**

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

Ms Gloria Goh and Ms Amanda Soon (Allen & Gledhill LLP) for the Opponents

Ms Yvonne Tang and Ms Lee Ziying (Drew & Napier LLC) for the Applicants

*Cur Adv Vult*

**GROUND OF DECISION**

1 This is an opposition to the registration of the following trade mark T1212601G ("Application Mark"):

**ENZA**

in relation to the following goods in Class 16:

*Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); food wrapping film; industrial packaging containers of paper; printers' type; printing blocks*

2 PT Purinusa Ekapersada and PT Pabrik Kertas Tjiwi Kimia Tbk ("the Applicants") applied to protect the *Application Mark* in Singapore on 28 August 2012. The application was accepted and published on 1 November 2013 for opposition purposes. Stora Enso Oyj ("the Opponents"), filed their Notice of Opposition to oppose the registration of the *Application Mark* on 3 March 2014. The Applicants filed their Counter-Statement on 3 July 2014. The Opponents filed evidence in support of the opposition on 30 April 2015. The Applicants filed evidence in support of the application on 11 December 2015. The Opponents did not file any evidence in reply. The Pre-Hearing Review ("PHR") was held on 10 May 2016. Following the PHR, the Applicants filed their supplementary evidence on 3 June 2016. The hearing was set for 31 August 2016.

### **Grounds of Opposition**

3 The Opponents rely on Sections 7(6), 8(2)(b), 8(4) and 8(7)(a) of the Trade Marks Act (Cap 332, 2005 Rev Ed) ("the Act") in this opposition.

### **Opponents' Evidence**

4 The Opponents' evidence comprises the following:

- (i) Statutory Declaration by Ms Katarina Nilsson, Manager of Group Intellectual Property of the Opponents, dated 16 April 2015 ("the Opponents' Evidence");

### **Applicants' Evidence**

5 The Applicants' evidence comprises the following:

- (i) Statutory Declaration made by Mr Arthur Tahya, Mr Kurniawan Yuwono, Mr Suhendra Wiriadinata, Mr Arman Sutedja, Directors of the Applicants, dated 4 December 2015 (“the Applicants’ 1<sup>st</sup> Evidence”); and
- (ii) Supplementary Statutory Declaration made by Mr Arthur Tahya, Mr Kurniawan Yuwono, Mr Suhendra Wiriadinata, Mr Arman Sutedja, dated 24 May 2016 (“the Applicants’ 2<sup>nd</sup> Evidence”).


### Applicable Law and Burden of Proof



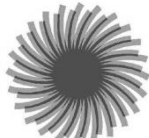
6 As the applicable law is the Act, there is no overall onus on the Applicants either before the Registrar or in opposition proceedings. The undisputed burden of proof in the present case falls on the Opponents.


### Background

7 The Opponents deposed (paragraph 4 of the Opponents’ Evidence) that the Opponents are a global paper, biomaterials, wood products and packaging company. The Opponents have some 28,000 employees in more than 35 countries worldwide and is a publicly traded company listed in Helsinki and Stockholm. The Opponents’ clients include publishers, printing houses and paper merchants, as well as packaging, joinery and construction industries. The Opponents deposed that their annual production capacity includes, amongst others, 5.4 million tonnes of chemical pulp, 11.7 million of tonnes of paper and board and 1.3 billion square metres of corrugated packaging. The Opponents are transforming the company into a value-creating renewable materials company focussing on growth markets including those in Asia.

8 The Opponents rely on the following earlier marks (collectively, *Opponents’ Earlier Marks*):

S/N	<i>Opponents’ Earlier Marks</i>	Class
<i>Opponents’ Earlier “Curve” Mark</i>		
1	 T9905677F	<u>Class 19</u> Building materials (non-metallic); all included in Class 19.

2	 T9905676H	<p><b><u>Class 16</u></b>  Paper and board, newsprint, magazine paper, printing paper, writing paper, kraft papers, corrugated papers, laminated papers, paper for bags and sacks, wrapping paper, packaging paper, packaging board, paperboard and cardboard, liquid packaging board, paper and board boxes and bags and/or in combination with plastic or foils, coreboard and cores, fine paper including writing and drawing paper, copying paper, offset paper, continuous stationery paper, label paper, envelope paper, paper for use in the graphic arts industry, paper for use in the manufacture of wall paper.</p>
3	 T9905675Z	<p><b><u>Class 1</u></b>  Pulp, paperpulp, fluffpulps.</p>
<b><i>Opponents' Earlier "Sunburst" Marks</i></b>		
<b><i>Opponents' Earlier "Sunburst" Mark 1</i></b>		
4	 storaenso T1114805Z	<p><b><u>Class 1</u></b>  Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; chemical substances for preserving foodstuffs; pulp; paper pulp; fluff pulp made from wood.</p> <p><b><u>Class 16</u></b>  Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; paper; cardboard; paper and cardboard for multiple purposes; paper and cardboard for packaging purposes; paper and cardboard for graphic and printing purposes; corrugated paper and cardboard; tubes and cores made from paperboard, cardboard and heavyweight paper; paperboard, cardboard and heavyweight paper for making tubes and cores; book and printing paper.</p> <p><b><u>Class 19</u></b>  Building materials including sawn timber for use in joinery, furniture and construction, sawn timber for use as building materials for furniture, beams, doors, door frames, windows, window frames, interior panels, interior and exterior walls and wall elements, partition elements, flooring, roofing, ceiling, scaffoldings, garden furniture, exterior claddings, saunas, rough and semi-finished sawn wood products and components; laminated building materials; prefabricated</p>

		construction elements for external and internal walls, ceilings and roofs.
<b><i>Opponents' Earlier "Sunburst" Mark 2</i></b>		
5	 <b>STORANSEN</b> T1114806H	<p><b><u>Class 1</u></b>  Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; chemical substances for preserving foodstuffs; pulp; paper pulp; fluffpulp (raw material) made from wood.</p> <p><b><u>Class 16</u></b>  Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; paper; cardboard; paper and cardboard for multiple purposes; paper and cardboard for packaging purposes; paper and cardboard for graphic and printing purposes; corrugated paper and cardboard; tubes and cores made from paperboard, cardboard and heavyweight paper; paperboard, cardboard and heavyweight paper for making tube and cores; book and printing paper.</p> <p><b><u>Class 19</u></b>  Building materials including sawn timber for use in joinery, furniture and construction, sawn timber for use as building materials for furniture, beams, doors, door frames, windows, window frames, interior panels, interior and exterior walls and wall elements, partition elements, flooring, roofing, ceiling, scaffoldings, garden furniture, exterior claddings, saunas, rough and semi-finished sawn wood products and components; laminated building materials; prefabricated construction elements for external and internal walls, ceilings and roofs.</p>

9 The Applicants deposed (paragraph 3 of the Applicants' 1<sup>st</sup> Evidence) that PT Pabrik Kertas Tjiwi Kimia Tbk (PT Pabrik Kertas) (one of the co-applicants) operates manufacturing facilities in Sidoarjo, near Surabaya in East Java, Indonesia. The Applicants deposed that PT Pabrik Kertas' mill which first started as a caustic soda plant, now boasts many state of the art paper and converting machines, making it one of the world's largest stationery manufacturers under one roof. The mill commenced operations in 1978 with an annual paper production capacity of 12,000 metric tons. The Applicants deposed that by 2006, the annual paper and board production capacity grew to over 1,200,000 metric tons along with an additional stationery-converting capacity of approximately 320,000 metric tons per annum.

10 The other co-applicant, PT Purinusa Ekapersada is a packaging product company and is primarily in the business of producing packaging made from paper and cardboard. It is also the majority shareholder of PT Pabrik Kertas (see paragraph 6 of the Applicants' 1<sup>st</sup> Evidence).

## MAIN DECISION

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

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

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

“earlier trade mark” means —

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

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

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

“well known trade mark” means —

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

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

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

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

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

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public.

***Decision on Section 8(2)(b)***

*Step-by-step approach*

12 In the recent authoritative decision of *Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide* [2014] 1 SLR 911 (“*Staywell*”), the Court of Appeal re-affirmed the 3-step test approach in relation to an objection under section 8(2)(b), and also rejected the argument that the threshold of marks similarity is a low one (at [15] to [20]):

[15]... Since this court’s decision in *Polo (CA)*, our courts have given effect to this statutory wording by applying what is now known as the “step-by-step” approach, as opposed to the competing “global appreciation approach” applied in Europe after *Sabel BV v Puma AG, Rudolf Dassler Sport* [1998] RPC 199 (“*Sabel v Puma*”). Under the step-by-step approach, the three requirements of similarity of marks, similarity of goods or services, and likelihood of confusion arising from the two similarities, are assessed systematically. The first two elements are assessed individually before the final element which is assessed in the round...

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

[17] More fundamentally, the minimal threshold approach is inconsistent with the reality that the similarity of marks is ultimately and inevitably a matter of impression rather than one that can be resolved as a quantitative or mechanistic exercise (see *Polo (CA)* at [35] and *Wagamama Ltd v City Centre Restaurants Plc* [1995] FSR 713 at 732)... The court must ultimately conclude whether the marks, when observed in their totality, are similar rather than dissimilar. The three aspects of similarity are meant to guide the court’s inquiry but it is not helpful to convert this into a checkbox exercise in which a tick, however faint it might be, in any one box must compel the court to find that the marks are similar when a sensible appraisal of the marks as a whole would show otherwise.

[18] We observed this in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] SGCA 26 (“*Hai Tong*”) at [40(a)]. Congruously, there is no prescribed requirement that all three aspects of similarity must be made out before the marks can be found to be similar: *MediaCorp News Pte Ltd v Astro All Asia Networks plc* [2009] 4 SLR(R) 496 (“*MediaCorp*”) at [32] and *Sarika Connoisseur Café Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 (“*Sarika*”) at [16]. In short, the criteria of visual, aural and conceptual similarities do not invite a formulaic consideration; rather, they are signposts towards answering the question of whether the marks are similar. Trade-offs can occur between the three aspects of similarity in the marks-similarity inquiry: *Ozone Community Corp v Advance Magazine*

Publishers Inc [2010] 2 SLR 459 (“Ozone”), see also Bently and Sherman, Intellectual Property Law (Oxford University Press, 3rd Ed, 2009) (“Bently & Sherman”) at p 864.

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

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

[Emphasis as underlined mine.]

### *Similarity of Marks*

13 In relation to similarity of marks, the Court of Appeal in *Staywell* had this to say at [25], [26] and [30]:

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

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



...

[30] We reiterate, as was held in *Sarika* (at [20]) and in *Hai Tong* (at [26]), that distinctiveness (in both its technical and non-technical senses) is a factor integrated into the visual, aural and conceptual analysis as to whether the competing marks are similar. It is not a separate step within the marks-similarity inquiry.

[Emphasis as underlined mine.]




14 Further, the Court of Appeal set out the following principles in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] SGCA 26 at [40] ("*Hai Tong*"):

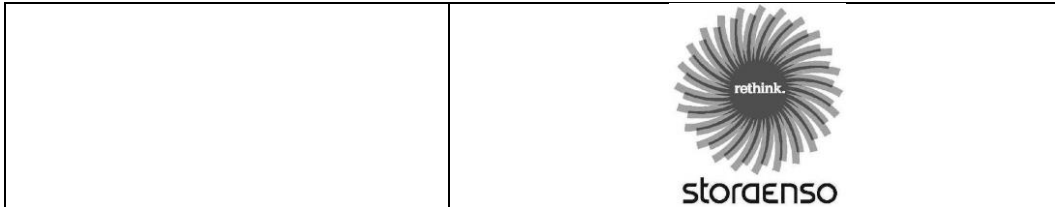
[40] (c) Although the focus of this part of the inquiry is on the marks in question, it is necessary to set out the viewpoint the court should assume. This viewpoint is that of the average consumer who would exercise some care and a measure of good sense in making his or her purchases, not that of an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

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

[Emphasis as underlined mine].

15 For ease of comparison, the marks are as follows:

<i>Application Mark</i>	<i>Opponents’ Earlier “Curve” Mark</i>
	
	<i>Opponents’ Earlier “Sunburst” Mark 1</i>
	
	<i>Opponents’ Earlier “Sunburst” Mark 2</i>



### *Distinctiveness*

16 I am mindful of the Court’s guidance in *Staywell* (discussed above) that distinctiveness is a factor integrated into the visual, aural and conceptual analysis as to whether the competing marks are similar and it is not a separate step within the marks-similarity inquiry. However, for ease of analysis, I will summarise my findings first, before applying them within the context of the mark-similarity analysis. In this regard, I note that *Hai Tong* at [26] provided as follows:

[26] Distinctiveness is considered within the assessment of similarity, as noted by this court in *Sarika*. However, for the purpose of elucidating the analytical process, we have highlighted it here as a separate step...

[Emphasis as underlined mine].

17 The Opponents argued, at paragraph 18 of their written submission, that a mark which has a greater technical distinctiveness enjoys a higher threshold before a competing sign will be considered dissimilar to it (*Staywell* at [25]). According to the Opponents, the Opponent’s “STORAENSO” name and the *Opponents’ Earlier Marks* all carry a high level of technical distinctiveness, and the *Application Mark* does not meet the necessary threshold to be considered dissimilar to the Opponents’ Earlier Marks.

18 I agree that each of the *Opponents’ Earlier Marks* is rather distinctive, but I am also of the view that the *Application Mark* is highly distinctive as well such that it meets the necessary threshold to be considered dissimilar to the *Opponents’ Earlier Marks*. More of this will be apparent in the analysis below.

### *Visual Similarity*

19 As a starting point, I note that all the marks are composite marks.

20 In considering composite marks, it would be appropriate to refer to the case of *Hai Tong* at [62]:

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

(a) As we have noted above at [40(c)] and [40(d)], when assessing two contesting marks or signs, the court does so with the “imperfect recollection” of the average consumer (see *MediaCorp* ([40] *supra*) at [33], citing *Nautical Concept* ([40] *supra*) at [30]). The two marks or signs should not be compared side by side or examined in detail because “the person who is confused often makes comparison from memory removed in time and space from the marks” (see *MediaCorp* at [33], citing *Caterpillar* ([40] *supra*) at [55]).

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

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

(d) The textual component of a composite mark or sign *could* (but will not necessarily or always) be the dominant component of the mark or sign. Some instances where this might be the case include where:

(i) The two marks or signs in question each contain a similar device. The overall resemblance between them may then be diminished if they bear words which are entirely different from each other (see *Lee Cooper* at 501).

(ii) The textual component is large, and is in a prominent location in relation to the other components or stands out from the background of the mark or sign (see the decision of the CFI in *Shaker di L Laudato & C Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (Case T-7/04) [2009] ETMR 16 (“*Shaker (CFI)*”) at [41]–[43]).

(iii) The textual component is *in itself* already widely known (see *Festina* ([52] *supra*) at [33], *Medion* at [34] and *Crazy Ron’s* at [99]).

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

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

(i) the device is significant and large (see, *eg*, the decision of the European General Court in *New Yorker SHK Jeans GmbH & Co KG v Office for*

*Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case T-415/09) (29 September 2011));

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

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

But usually not where:

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

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

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

### ***Opponents' Earlier "Curve" Mark***

21 The Opponents argued, at paragraph 12 of the Opponents' written submission, that for the *Opponents' Earlier "Curve" Mark*, the words "STORAENSO" precede a relatively small "curve" device and are thus the most eye-catching and distinctive feature of the mark. In this regard, the Opponents referred to *Hai Tong* at [62(d)(ii)], and argued that while the *Opponents' Earlier "Curve" Mark* is a composite mark, the words occupy a large part of the visual real estate as they are centralised in the visual field and it is to the words that the eye is drawn. In this regard, the Opponents argued at paragraph 13 that since the device element in the *Opponents' Earlier "Curve" Mark* is small, the words "STORAENSO" are the dominant element in the marks.

22 On the other hand, the *Application Mark* consists of the letters “Enz” and an equilateral triangle device. Alternatively the *Application Mark* can also be construed as “ENZO” or “ENZA”, the equilateral triangle device being construed as the letter “O” or “A” respectively. In this regard, the Applicants argued, at paragraph 16 of their written submission, that the *Application Mark* would be read as “Enz” and an equilateral triangle device, or alternatively as “ENZA”. It would certainly not be read as “ENZO” as “[t]here are no sharp corners in the letter “O”” while “[i]n contrast, there are 3 sharp corners in the letter “a”, which coincides with the number of sharp corners i.e. 3 in the triangle device in the *Application Mark*”. In support of their argument, the Applicants submitted that the Registry has itself described the mark as “ENZA” in the register under the heading “Mark Index-Words in Mark”.

23 The Opponents submitted, at paragraph 11 of their written submission, that it is not reasonable to assume, as the Applicants do, that the *Application Mark* would not be construed as “ENSO”, since the triangle outline could conceivably be seen to be forming the outline of a stylised letter “O”, even though it is not circular in shape. The letter “A” in upper case is typically recognised as consisting of two slanting sides which meet at the top and are joined at their mid-points by a horizontal bar. The triangle device in the *Application Mark* does not feature the horizontal bar at the mid-point of the slanting sides but rather at their base, which results in the triangle device not clearly representing the letter “A”. Thus the Opponents submitted that the *Application Mark* could be read as “ENZO” just as easily as it may be read as “ENZA”.

24 I am more inclined to accept the Applicants’ argument above that the *Application Mark* consists of the letters “Enz” and an equilateral triangle device. In this regard, I note that the equilateral triangle device does not purely consist of an equilateral triangle *per se* but contains some design in the form of “stripes”. Alternatively, should the device be read as a letter, I am also more inclined to construe it as a letter “A” rather than “O”. Nevertheless, I am prepared to accept that it is also plausible to construe it as the letter “O”.

25 Regardless of whether the *Application Mark* is read as “ENZO” or “ENZA”, the Opponents submitted at paragraph 12 of their written submission that both the words “ENZO” and “ENZA” are visually similar to the word “ENSO” in the Opponents’ Earlier Marks having regard to their argument above that the words “STORAENSO” are the dominant and distinctive feature of the Opponents’ Earlier “Curve” Mark.


26 The Applicants referred to the case of *Hai Tong and Caesarstone Sdot-Yam Ltd v Ceramiche Caesar S.p.A.* [2016] 2 SLR 1129 (“*Caesarstone*”) to support their argument that marks must be assessed as a “whole” (paragraphs 19 – 22 of the Applicants’ written submission). It is noted that *Caesarstone* is subject to appeal to the Court of Appeal. However, as at the date of this decision, the High Court decision is still applicable. Specifically, I refer to the Applicants’ submission at paragraph 21 where the Applicants referred to *Caesarstone* at [62] where Justice Wei referred to the case of *William Bailey’s Application* [1935] 52 RPC 136 at 151–152:

I do not think it is right to take part of the word and compare it with a part of the other word; one word must be considered as a whole and compared with the other word as a whole...

[Emphasis as underlined mine]

27 The Applicants argued that the letters “STORAENSO” are all of equal size and of the same font (paragraph 24 of the Applicants’ written submission), such that applying *Caesarstone*, the *Application Mark* should be examined as a single word. (For purposes of comparison, I note that the mark under consideration in *Caesarstone* is



28 In the current case, the *Opponents’ Earlier “Curve” Mark* is  and it is noted that the first letter “S” and letter “E” are of a slightly (and only ever so slightly) bigger font than the rest of the letters. However, having regard to the way that the words are portrayed, that while these letters are of a slightly bigger font than the rest of the letters, that there is *no* space between the two words, I am of the view that “STORAENSO” can still be examined as one word (albeit with its separate components namely “STORA” and “ENSO”). In this regard, as provided by *Caesarstone* at [64], “[“STORAENSO”] is noticeably longer than the [*Application Mark*]” such that “the visual impact of the added length is clear”.

29 The Applicants argued, at paragraph 25 of the Applicants’ written submission, that the curve device is a fanciful curve that is as eye-catching and distinctive as the words “STORAENSO”. It is not a small device as the Opponents claimed but is of equal and / or similar size as that of the words “STORAENSO”. I agree. I am of the view that not only is the curve device at least of equal and / or similar size to the words, it is also unique, such that it cannot be ignored.

30 Having regard to the arguments above, I am of the view that the marks are not similar for the following reasons.

31 As indicated above, I am of the view that having regard to the way that the words are portrayed, that while the letters “E” and “S” are of a slightly larger font than the rest of the letters, there is no space between the words “STORA” and “ENSO”, such that it can be construed as one word (albeit with its separate components namely “STORA” and “ENSO”). Further, the curve device is not only unique but is at least, of equal and / or similar size to the words. In light of this, I am of the view that the *entire* composite mark of the *Opponents’ Earlier “Curve” Mark* must to be perceived as a whole and importantly that there is no one component which is to be accorded more weight than the others.

32 On the other hand, with regard to the *Application Mark*, as mentioned above, I am of the view that the equilateral triangle can also be said to be an unusual device, having regard to the minor, but nonetheless obvious, stripes such that the *Application Mark* can be seen as “EnZ” with a device. Should the triangular device be understood as a letter, my

first instinct would be to read it as a letter “A” rather than an “O” having regard to the three sharp edges of the triangular device. Nonetheless, I accept the Opponents’ argument that it is possible to regard the triangular device as a letter “O” such that the *Application Mark* will be understood as “ENZO” rather than “ENZA”.

33 Even if this is so, I am of the view that the *Application Mark* can only be considered to be at most similar to the “ENSO” component of the *Opponents’ Earlier “Curve” Mark*. It is to be recalled that there is the word “STORA”, which consists of 5 letters, before the word “ENSO”. There is also the unique curve device which is at least of equal and / or similar size to the words. Since the “ENSO” component only takes up about a third of the *Opponents’ Earlier “Curve” Mark*, the marks cannot be said to be similar.

34 In this regard, I disagree with the Opponents’ argument at paragraph 14 of the Opponents’ written submission, that, applying *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2005] 4 SLR(R) 816 (“*Polo*”) at [26], “...it is important to look at the differences between the marks in order to decide whether the challenged mark is able to distinguish itself sufficiently and substantially” that the *Application Mark* does not contain any other words or graphical elements to sufficiently and substantially distinguish the *Application Mark* from the *Opponents’ Earlier “Curve” Mark*.


35 I am of the view that the essence of the *Polo* case is that where there is a common denominator, it is important to look at the differences between the marks to decide if the marks can be regarded as similar or dissimilar. In this regard, it does not matter whether the differences lie in the challenged mark or the earlier mark. What is provided in paragraph 26 of *Polo* is simply one instance where the marks can be regarded as different, that is, where the challenged mark contains additional components to enable it to distinguish itself sufficiently and substantially from the earlier mark. In this regard, it could also be the case that the earlier mark has additional components which render the marks to be dissimilar.

36 Further, the Opponents also argued at paragraph 14 of their written submission, that the fact that the average consumer has “imperfect recollection” and will not compare two marks side by side means that there is a great deal of visual similarity between the *Opponents’ Earlier “Curve” Mark* and the *Application Mark*. I am of the view that having regard to the extent of the dissimilarity of the marks, there can be no similarity even having regard to the “imperfect recollection” of the average consumer.

### ***Opponents’ Earlier “Sunburst” Marks***

37 To begin with, I note that the Opponents themselves regard the *Opponents’ Earlier “Sunburst” Marks* to be less similar to the *Application Mark* than the *Opponents’ Earlier “Curve” Mark*. In this regard, I refer to paragraph 12 of the Opponents’ written submission:

The similarity is particularly stark for the Opponent's Registrations Nos.

T9905677F, T9905676H and T9905675Z “  ” (“*Opponent's Curve Marks*”), where the words “STORAENSO” precede a relatively small curves device, and are therefore the most eye-catching and distinctive feature in the marks

[Emphasis as underlined mine]

38 Similar to my reasoning above in relation to the *Opponents' Earlier "Curve" Mark*, even if I accept the Opponents' argument that it is possible to regard the triangular device as a letter “O” such that the *Application Mark* will be understood as “ENZO” rather than “ENZA”, the *Application Mark* can only be considered to be similar to the “ENSO” component of the *Opponents' Earlier "Sunburst" Marks*. In this regard, it is noted that for the purposes of the *Opponents' Earlier "Sunburst" Marks*, in the word “STORAENSO” the letters are of equal size and prominence. As such, the similarity between the *Application Mark* and the *Opponents' Earlier "Sunburst" Marks* is less than the similarity between the *Application Mark* and *Opponents' Earlier "Curve" Mark*. Even so, it must be emphasized that the component “STORA”, which consists of 5 letters, cannot be ignored.

39 Further, it is clear that the *Opponents' Earlier "Sunburst" Marks* contain the “sunburst” device which is not only larger in size than the words “STORAENSO” but is also located in a prominent and central position right above the words “STORAENSO”. In fact, the “sunburst” device can be said to occupy about two thirds of the *Opponents' Earlier "Sunburst" Marks*. Further, I would add that for the *Opponents' Earlier "Sunburst" Mark 2*, there is also the word “rethink.” right in the middle of the “sunburst” device.

40 Having regard to the above, it is clear that the “sunburst” device cannot be ignored and serves to further differentiate the *Opponents' Earlier "Sunburst" Marks* from the *Application Mark*, in addition to the word “STORA”.

41 On the whole, I am of the view that the *Application Mark* is only similar to, at most, less than one third of the *Opponents' Earlier "Sunburst" Mark 1*. In light of this, having regard to the fact that *Opponents' Earlier "Sunburst" Mark 2* also contains the word “rethink.” right in the centre of the “sunburst” device, the similarity between the *Application Mark* and *Opponents' Earlier "Sunburst" Mark 2* is even less, and is very minimal.

42 At the oral hearing, the Opponents sought to rely on the examples raised in *Hai Tong* at [57] to buttress their arguments that the device is merely decorative. In this regard, the Opponents specifically referred to the cases of:

- (i) *Honda Motor Europe Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (Case T-363/06) [2009] ETMR 34 (“*Honda*”);



- (ii) *Claudia Oberhauser v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case T-104/01) [2002] ECR II-4359 (“*Oberhauser*”)
- (iii) *Trubion Pharmaceuticals, Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case T-412/08) [2009] ECR II-239 (“*Trubion*”).

43 However as pointed out by the Court of Appeal in *Hai Tong*, these cases must be seen in light of the *specific facts* of each case:

[57] However, an examination of these decisions will reveal that these views should be understood in the specific context of considering and assessing the marks in question... Thus:

- (a) In *Honda*, the textual component of the composite mark



was found to be the dominant component as the “S” device component “[did] not appear to be original or very elaborate” and was the first letter of the textual component “SEAT” (see *Honda* at [31]).

- (b) In *Oberhauser*, the court observed that the average consumer looking at a jeans label would take in and remember the predominant textual component of the composite mark



rather than the various figurative aspects of that mark because the latter aspects would be seen as “decorative features of a label that is commonplace for jeans in its form and components, and not as the most important element indicating the origin of the product” (see *Oberhauser* at [47]). In short, in this particular context, a complex device was seen to be decorative and not distinctive...

- (e) In *Trubion*, the court found that the device component in the composite mark



even if not negligible in terms of its size, was likely to be perceived by consumers essentially as a decorative element, and not as an element indicating the commercial origin of the goods (see *Trubion* at [45]).

[Emphasis as underlined mine]

44 I would add that in *Trubion*, the goods were health related products in Class 5 such that it would be not be surprising that the verbal components took precedence over the figurative elements (the Opponents themselves in their written submission at paragraph 38 commented that medicines are a type of good where a consumer would exercise care with regard to their purchase as they may cause undesirable consequences if carelessly consumed).

45 In conclusion, I am of the view that the *Opponents' Earlier "Curve" Mark* is visually more dissimilar than similar to the *Application Mark*, since the *Application Mark* is only similar to one third of the *Opponents' Earlier "Curve" Mark*.

46 With regard to the *Opponents' Earlier "Sunburst" Marks*, they are even more visually dissimilar than similar to the *Application Mark* (in comparison to the *Opponents' Earlier "Curve" Mark*) since the *Application Mark* is only similar to, at most, less than one third of the *Opponents' Earlier "Sunburst" Mark 1*. With regard to the *Opponents' Earlier "Sunburst" Mark 2*, the marks are only minimally similar, if at all.

#### *Aural Similarity*

47 With regard to aural similarity, the Court in *Staywell* stated at [31] and [32] that there are two approaches in this regard. One approach is to consider the dominant component of the mark ("Dominant Component Approach") and the other is to undertake a quantitative assessment ("Quantitative Assessment Approach") as to whether the competing marks have more syllables in common than not.

48 First and foremost, I note that in the *Opponents' Earlier "Sunburst" Mark 2*, there is the word "rethink." in the middle of the "sunburst" device. In this regard, I refer to the High Court in *Han's (F & B) Pte Ltd v Gusttimo World Pte Ltd* [2015] SGHC 39 where Justice Wei clarified as follows:

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

[Emphasis as underlined mine]

49 In light of the above, the word “rethink.” can be considered as subsidiary and is thus not taken into account for the purposes of the current analysis. In light of this conclusion, the main verbal element for the *Opponents’ Earlier Marks* is simply the word “STORAENSO”. As such, I will deal with the issue of aural similarity in relation to *Opponents’ Earlier Marks* as a whole.

50 I start by noting that there is a possibility of the *Application Mark* being construed as “Enz” together with an equilateral triangle device. If this is the case, it is obvious that there can be *no* aural similarity between the *Application Mark* and *Opponents’ Earlier Marks*. Thus the focus of this segment is to analyse the situation where the *Application Mark* is construed as “ENZA” or “ENZO” versus “STORAENSO” for the *Opponents’ Earlier Marks*.

51 It is to be recalled that I have concluded above that that *entire* composite mark of *Opponents’ Earlier “Curve” Mark* must be perceived as a whole and importantly that there is no one component which is to be accorded more weight than others.

52 In relation to the *Opponents’ Earlier “Curve” Mark*, the Applicants deposed at paragraph 15 of the Applicants’ 1<sup>st</sup> Evidence that “*there will be a small but significant pause between STORA and ENSO due to the way the mark has been stylised with the letter E of the word ENSO subtly larger than the letters which follow*” such that the ““*STO-RA*’ *element leaps out at the average consumer and cannot be ignored, due to its prominence as it is positioned in front and also because it is longer than the second element ENSO*”. In response, the Opponents argued at paragraph 16 of their written submission that any pause between the words “STORA” and “ENSO” will be of little importance given the aural similarity between “ENSO” and “ENZO”/“ENZA”.

53 Even if I were to accept the Opponents’ argument above and disregard the pause between the words “STORA” and “ENSO”, the fact that the word “STORA” is prominently positioned in front and is a two-syllable word (similar to ENSO) cannot be ignored and must be taken into consideration.

54 In relation to *Opponents’ Earlier “Sunburst” Marks* it has been noted above that “letters are of equal size and prominence” in the word “STORAENSO”.

55 The Opponents argued, at paragraph 15 of their written submission, that since “ENSO” is aurally similar to “ENZO” or “ENZA” and given the recognised “*tendency of persons using the English language to slur the termination of words*” (*London Lubricants* (1925) 42 RPC 264 at [279] referred to by the Singapore High Court in *Johnson & Johnson v Uni-Charm Kabushiki Kaisha (Uni-Charm Corp)* [2007] 1 SLR(R) 1082 at [11]), any aural dissimilarity between “ENSO” and “ENZO”/“ENZA” will be further minimised, since “SO”, and “ZO” or “ZA” are the last syllables of the marks.

56 To begin with, the Opponents did not seek to apply either of the approaches as propounded in *Staywell* above. Further, in seeking to apply *London Lubricants* (1925) 42 RPC 264 (“*London Lubricants*”), the Opponents have clearly ignored the word “STORA”,

which is a two-syllable word, plainly placed before the word “ENSO” in the *Opponents’ Earlier Marks*. That cannot be right.

57 As discussed above, the *Application Mark* can be construed as “ENZO” or “ENZA”, the equilateral triangle device being construed as the letter “O” or “A” respectively. Where the equilateral triangle device is construed as the letter “O” or “A” respectively (i.e. the entire word would then be “ENZA” or “ENZO” respectively), it will be pronounced as “EN-ZAH” or “EN-ZOH”.

58 In addition to the above, it would appear that the Opponents did not replicate the full context of the principle in *London Lubricants*. In this regard, the principle is as such (see the Applicants’ written submission at paragraph 37):

[279] But the tendency of persons using the English language to slur the termination of words also has the effect necessarily that the beginning of words is accentuated in comparison, and, in my judgement, the first syllable of a word is, as a rule, far the most important for the purpose of distinction.”

[Emphasis as underlined mine]

59 Applying the Dominant Component Approach, and applying the principle in *London Lubricants*, “STO-RAH-EN-SOH” is clearly different from “EN-ZAH” or “EN-ZOH” since “STO-RAH” being the beginning of the word, will be emphasized.

60 In this regard, the Applicants submitted at paragraph 40 of their written submission, applying *Ferrero S.P.A. v Dochirnie Pidpryemstvo "Kondyterska Korporatsiia "Roshen"* [2015] SGIPOS 14 at [50] (“*Roshen*”), that “*the additional syllables in “STO-RAH” ...serve to differentiate the [Opponents’ Earlier Marks] from the Application Mark*”. It is noted that in *Roshen* the Opponents’ earlier marks “Ferrero Rocher” consists of two words. In the instant case, both “STORAENSO” or “STORAENSO”, having no space between “STORA” and “ENSO”, is depicted as one word. Nonetheless I am of the view that the same principle can be applied in this case.

61 In light of the above, having regard to the fact that (i) the word “STORA” is prominently positioned in front and as such will be accentuated, and that (ii) it is a two-syllable word (similar to ENSO), it clearly cannot be ignored and must be taken into consideration so as to render “STO-RAH-EN-SOH” is aurally different from “EN-ZAH” or “EN-ZOH”. However, in the event of imperfect pronunciation, such that “ZOH” is pronounced as “SOH”, I am prepared to accept that there is some aural similarity.

62 Alternatively, applying the Quantitative Assessment Approach, out of the four syllables constituting “STO-RAH-EN-SOH”, when compared to “EN-ZAH” there is only one common syllable, which is “EN”. Thus the marks are aurally more dissimilar than similar.

63 In relation to the pronunciation “EN-ZOH”, again applying the Quantitative Assessment Approach, out of the four syllables constituting “STO-RAH-EN-SOH”, when compared to “EN-ZOH” there is only one common syllable, which is “EN” such that the marks are aurally more dissimilar than similar.

64 However, again, in the event of imperfect pronunciation such that “ZOH” is pronounced as “SOH”, I am prepared to accept that there is some aural similarity.

65 In light of the above, in the circumstance where the *Application Mark* is construed as “ENSO”, there is some aural similarity between the marks.

### *Conceptual Similarity*

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

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

[Emphasis as underlined mine]

67 The Opponents, at paragraph 17 of their written submission, relied on *Carolina Herrera, Ltd v Lacoste* [2014] SGIPOS 3 at [56]:

[56] From the dicta above, it can be understood that the conceptual analysis of two competing signs is an analysis of the concepts that can be derived from the elements present in the sign at surface value. It does not matter, for example, that "Mobis" was derived from "mobile" and "system" – taken at surface value, "Mobis" is simply an invented word.

[Emphasis as underlined mine]

68 Relying on the above, the Opponents argued at paragraph 17 of their written submission that at surface value, the *Opponents' Earlier Marks* do not have any meaning or evoke any particular concepts. The Opponents submitted that the Opponents invented the term “STORAENSO” and it has no meaning. Further, the Opponents refuted the Applicants’ contention that the *Opponents' Earlier Marks* bring to mind associations with the idea of “storage” or “store” by virtue of the word “STORA”.

69 On the other hand, the Applicants deposed, at paragraph 16 of the Applicants’ 1<sup>st</sup> Evidence that the *Application Mark* does not carry any meaning as the words “Enz” and “ENZA” do not have any meaning in the English language.

70 The above analysis overlooks the presence of devices in the marks. As the Court of Appeal has indicated in *Staywell* (above), “the idea connoted by *each component* might be very different from the *sum* of its parts”. Further, the Court of Appeal also opined as such at [36] of *Staywell*, albeit *obiter dicta*:

[36] In the present case, while the term “REGIS” might, perhaps reasonably, be said to connote royalty, in our view this connotation becomes secondary once the prefixes of “Park” and “ST.” are introduced. As the Judge noted at [26] of the GD, the composite mark connotes a geographical location, while the composite phrase “ST. REGIS” connotes a saintly character. If any connotation of royalty attaches at all, it is far more significant in the “Park Regis” mark, considering the inclusion of the fleur-de-lis device.

[Emphasis as underlined mine]

Although it is noted that in the end the Court of Appeal found conceptual similarity on a different basis (see [37] of *Staywell*) the point is that devices also have a part to play in the overall meaning and thus concept of a mark.

71 In this regard, having concluded above that the devices in the *Opponents’ Earlier Marks*, be it the “curve” device or the “sunburst” device respectively, forms an integral part of the *Opponents’ Earlier Marks* (in particular for the *Opponents’ Earlier “Sunburst” Marks*, in view of the size and positioning *per se* of the “sunburst” device) it would be inappropriate to ignore these devices.

72 On the other hand, for the *Application Mark*, there is a possibility of the *Application Mark* being construed as “Enz” and equilateral triangle device. In fact, it is noted that the equilateral triangle device has some design on it, albeit subtle.

73 In light of all of the above, I am inclined to agree with the Applicants that the *Opponents’ Earlier Marks* bring to mind associations with the idea of “storage” or “store” by virtue of the word “STORA”. In this regard, it is irrelevant that the Opponents invented the term “STORAENSO” and that the word “STORA” does not and is not intended to refer to any idea of “storage” or “store” (see paragraph 17 of the Opponents’ written submission) since it is what a consumer would perceive at surface value which is relevant, and *not* the actual intention of the Opponents. If this is so, the marks would be regarded as *conceptually dissimilar*, in contrast to the Opponents’ submissions at paragraph 17 of their written submission.

74 However, even if I am wrong about the word “STORA” bringing to mind associations with the idea of “storage” or “store”, there is, minimally, no conceptual similarity between the *Opponents’ Earlier Marks* and the *Application Mark*. For clarity, I stress at this juncture that having no conceptual similarity is *not* equivalent to being conceptually dissimilar.

75 Accordingly, in light of the above, I am of the view that there is, minimally, no conceptual similarity between the *Opponents' Earlier Marks* and the *Application Mark*.

*Conclusion on the similarity of marks*

76 It is to be recalled following *Staywell* at [17] and [18] that:

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

[18] ... Trade-offs can occur between the three aspects of similarity in the marks-similarity inquiry...

[Emphasis as underlined mine]

77 Further, the average consumer has an “imperfect recollection” and there is a need to consider the general impression that will likely be left by the essential or dominant features of the marks. However, it is also important to remember that the average consumer is one who would exercise some care and a measure of good sense in making his or her purchases, not that of an unthinking person in a hurry.

***Opponents' Earlier “Curve” Mark***

78 I am of the view that if the *Opponents' Earlier “Curve” Mark* is visually more dissimilar than similar to the *Application Mark* while there is some aural similarity. Further, there is no conceptual similarity between the *Opponents' Earlier “Curve” Mark* and the *Application Mark*. Thus in conclusion, in relation to *Opponents' Earlier “Curve” Mark*, the marks are more dissimilar than similar.

***Opponents' Earlier “Sunburst” Marks***

79 With regard to the *Opponents' Earlier “Sunburst” Marks*, they are even more visually dissimilar than similar to the *Application Mark* (in comparison to the *Opponents' Earlier “Curve” Mark*). Aurally, just like the *Opponents' Earlier “Curve” Mark*, there is some aural similarity, having regard to the fact that for the *Opponents' Earlier “Sunburst” Mark 2*, the word “rethink.” can be disregarded. Finally, there is no conceptual similarity between the *Opponents' Earlier “Sunburst” Marks* and the *Application Mark*. Thus in conclusion, in relation to *Opponents' Earlier “Sunburst” Marks*, the marks are even more dissimilar than similar.

*Similarity of Goods / Services*

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

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

81 The factors set out in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 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.

82 For ease of reference, the relevant goods / services are as follows:

S/N	<i>Opponents’ Earlier “Curve” Mark</i>		<i>Application Mark</i>
1	T9905677F	<b><u>Class 19</u></b> Building materials (non-metallic); all included in Class 19.	<b><u>Class 16</u></b> <i>Paper</i> , cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; <del>photographs;</del> <del>stationery;</del> <del>adhesives for stationery or household purposes;</del> <del>artists’ materials;</del> <del>paint brushes;</del> <del>typewriters and office requisites (except furniture);</del> <del>instructional and teaching material (except apparatus);</del> <del>plastic materials for packaging (not included in other classes);</del> <del>food wrapping film;</del> <del>industrial packaging containers of paper;</del> <del>printers’ type;</del> <del>printing blocks</del>
2	T9905676H	<b><u>Class 16</u></b> <i>Paper</i> and board, newsprint, magazine paper, printing paper, writing paper, kraft papers, corrugated papers, laminated papers, paper for bags and sacks, wrapping paper, packaging paper, packaging board, paperboard and cardboard, liquid packaging board, paper and board boxes and bags and/or in combination with plastic or foils, coreboard and cores, fine paper including writing and drawing	



		paper, copying paper, offset paper, continuous stationery paper, label paper, envelope paper, paper for use in the graphic arts industry, paper for use in the manufacture of wall paper.	
3	T9905675Z	<b><u>Class 1</u></b> Pulp, paperpulp, fluffpulps.	
<b><i>Opponents' Earlier "Sunburst" Mark 1</i></b>			<b><i>Application Mark</i></b>
4	T1114805Z	<p><b><u>Class 1</u></b> Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; chemical substances for preserving foodstuffs; pulp; paper pulp; fluff pulp made from wood.</p> <p><b><u>Class 16</u></b> <i>Paper</i>, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); <i>printers' type; printing blocks</i>; paper; cardboard; paper and cardboard for multiple purposes; paper and cardboard for packaging purposes; paper and cardboard for graphic and printing purposes; corrugated paper and cardboard; tubes and cores made from paperboard, cardboard and heavyweight paper; paperboard, cardboard and heavyweight paper for</p>	<p><b><u>Class 16</u></b> <i>Paper</i>, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); <del>food wrapping film; industrial packaging containers of paper; printers' type; printing blocks</del></p>

		making tubes and cores; book and printing paper.	
		<p><b><u>Class 19</u></b></p> <p>Building materials including sawn timber for use in joinery, furniture and construction, sawn timber for use as building materials for furniture, beams, doors, door frames, windows, window frames, interior panels, interior and exterior walls and wall elements, partition elements, flooring, roofing, ceiling, scaffoldings, garden furniture, exterior claddings, saunas, rough and semi-finished sawn wood products and components; laminated building materials; prefabricated construction elements for external and internal walls, ceilings and roofs.</p>	
<b><i>Opponents' Earlier "Sunburst" Mark 2</i></b>			<b><i>Application Mark</i></b>
5	T1114806H	<p><b><u>Class 1</u></b></p> <p>Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; chemical substances for preserving foodstuffs; pulp; paper pulp; fluffpulp (raw material) made from wood.</p> <p><b><u>Class 16</u></b></p> <p><i>Paper</i>, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except</p>	<p><b><u>Class 16</u></b></p> <p><i>Paper</i>, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); <del>food wrapping film; industrial packaging containers of paper;</del> <i>printers' type; printing blocks</i></p>

		<p>apparatus); plastic materials for packaging (not included in other classes); <i>printers' type; printing blocks</i>; paper; cardboard; paper and cardboard for multiple purposes; paper and cardboard for packaging purposes; paper and cardboard for graphic and printing purposes; corrugated paper and cardboard; tubes and cores made from paperboard, cardboard and heavyweight paper; paperboard, cardboard and heavyweight paper for making tube and cores; book and printing paper.</p>	
		<p><b><u>Class 19</u></b>  Building materials including sawn timber for use in joinery, furniture and construction, sawn timber for use as building materials for furniture, beams, doors, door frames, windows, window frames, interior panels, interior and exterior walls and wall elements, partition elements, flooring, roofing, ceiling, scaffoldings, garden furniture, exterior claddings, saunas, rough and semi-finished sawn wood products and components; laminated building materials; prefabricated construction elements for external and internal walls, ceilings and roofs.</p>	

83 In this regard, the Applicants have conceded, at paragraphs 56 and 60 of their written submission, that there is some *direct overlap* in relation to Class 16 (for example, the item “paper” is *identical*). These have been indicated above (italicised).

84 In general, I agree with the Applicants as to the extent of the overlap except that in relation to the *Opponents' Earlier "Sunburst" Marks*, I am of the view that there is also a direct overlap for specifications in relation to *printers' type; printing blocks*. For ease of reference, these have been italicised above as well.

85 Having regard to the above, it is quite clear that this element has been satisfied such that I do not see the need to dwell in detail on the similarity of the rest of the goods in Class 16 nor the similarity of other goods in other classes.

86 By this I am not saying that these goods which I am not dealing with, are dissimilar. In this regard, I note that the Opponents argued at paragraph 23 of their written submission:

*In Redsun Singapore Pte. Ltd. v Tsung-Tse Hsieh [2015] SGIPOS 1, the PAR noted that “the fact that goods are not in the same class does not necessarily mean that they are not similar goods”...*

I agree. However, all I am saying is that having regard to the direct overlap in relation to some of the goods in Class 16 in the instant case, there is no need for me to analyse the other goods in Class 16 as well as the goods in other classes.

87 In light of the above, I will proceed to examine the last element in the objection under Section 8(2)(b).

#### *Likelihood of Confusion*

88 The relevant principles for assessing the likelihood of confusion are expounded by the Court in *Staywell* at [60], [64], [83] and [96]:

[60] Accordingly in opposition proceedings the inquiry must take into account the full range of the competing monopoly rights that are already enjoyed on the one hand, namely the actual and notional fair uses to which the incumbent proprietor has or might fairly put his registered trade mark, and compare this against the full range of such rights sought by the applicant by reference to any actual use by the applicant (assuming there has been prior use) as well as notional fair uses to which the applicant may put his mark should registration be granted...

[64] ...Once similarity between the competing marks and goods or services has been established, the *impact* of these similarities on the relevant consumers’ ability to understand where those goods and services originate from falls to be considered. The only relevant confusion is that which results from the similarity between marks and goods or services. Our courts have consistently recognised this since Lai Kew Chai J articulated it in *Polo (HC)* at [15]. Equally however, the plain words of ss 8(2) and 27(2) do not have the effect of making a finding of confusion automatic upon the establishment of similarity of marks and goods or services. If that was what was intended, as observed in *Polo (CA)* at [25] and in *Sarika* at [60], Parliament would have provided that once such similarity is found the matter ends there without any need to examine whether there is a likelihood of confusion as a result. However, we reiterate that the statute requires that any likelihood of confusion must arise from the similarity of marks and goods or services.

[83] On the effect of the foregoing on the relevant segment of the public – extraneous factors may be considered to the extent that they inform the court as to how the similarity of marks and goods will likely affect the consumer’s perception as to the source of the goods...

[96] Based on these considerations, the following represents a non-exhaustive list of factors which we regard as admissible in the confusion inquiry:

(a) Factors relating to the impact of marks-similarity on consumer perception: the degree of similarity of the marks themselves (see Hai Tong at [85(c)(iii)]), the reputation of the marks (see Polo (CA) at [34]), the impression given by the marks (see Polo (CA) at [28]), and the possibility of imperfect recollection of the marks would all be relevant. Clearly, the greater the similarity between the marks, the greater the likelihood of confusion. As to the reputation of the mark, Mobil Petroleum Co, Inc v Hyundai Mobis [2010] 1 SLR 512 (“Mobil”) at [74] makes it clear that a strong reputation does not necessarily equate to a higher likelihood of confusion, and could in fact have the contrary effect as in McDonald’s Corp v Future Enterprises Pte Ltd [2005] 1 SLR(R) 177 (see at [64]).

(b) Factors relating to the impact of goods-similarity on consumer perception: it would be legitimate to take into account factors concerning the very nature of the goods without implicating any steps that are taken by the trader to differentiate the goods. This includes the normal way in or the circumstances under which consumers would purchase goods of that type (see [20] above, Mystery Drinks at [48], Lloyd Schuhfabric Meyer v Klijsen Handel BV, Case C-342/97 [1999] 2 CMLR 1343 at 1352; and Philips-Van Heusen Corp v OHIM [2004] ETMR 60 at [55]). This factor is not directly dependent on the marketing choices that the trader makes. As alluded to at [94] above, it would also be relevant to have regard to whether the products are expensive or inexpensive items, the nature of the goods and whether they would tend to command a greater or lesser degree of fastidiousness and attention on the part of prospective purchasers (see generally Hai Tong at [85(c)(i)]), and the likely characteristics of the relevant consumers and whether they would or would not tend to apply care or have specialist knowledge in making the purchase. We refer here to In the matter of an Application by the Pianotist Company for the Registration of a Trade Mark (1906) 23 RPC 774 (“Pianotist”) where it was observed that, having regard to the nature of the article in question (musical instruments), the (high) price at which it was likely to be sold, and the nature of the consumers who are likely to purchase such products (“generally persons of some education”), a man of ordinary intelligence was unlikely to be confused (at 778). The price of the type of product being sold is distinct from the issue of price disparity between the parties’ products. The former consideration directly impinges on the degree of care the consumer is likely to pay to his purchase and therefore his ability to detect subtle differences. As observed in Reed

Executive Plc v Reed Business Information Ltd [2003] RPC 12 at [103], “a 50 pence purchase in the station kiosk will involve different considerations from a once-in-a-lifetime expenditure of 50,000 pounds”. On the other hand, superficial price disparity between the competing goods, which speak more about the trader’s marketing choices rather than differences in the nature of the goods themselves, is not a factor we find relevant to the inquiry.

[Emphasis as underlined mine].

*Factors relating to the impact of marks-similarity*

***Opponents’ Earlier “Curve” Mark***

89 With regard to the *Opponents’ Earlier “Curve” Mark*, I have concluded above that in terms of the factors relating to the impact of marks-similarity on consumer perception, the marks are visually more dissimilar than similar while there is some aural similarity. Further, there is no conceptual similarity such that the conclusion is that in relation to the *Opponents’ Earlier “Curve” Mark* the marks are more dissimilar than similar. In this regard, as the relevant goods are Class 16 products and in particular the area of overlap is paper-related products, it is the visual aspect which is most important.

90 Following the above conclusion that the marks are more dissimilar than similar in totality, the overall impression left by the marks is not similar. Taking into account of the fact that the respective marks, when considered as wholes, are different, there is no likelihood of confusion even taking into account the possibility of imperfect recollection.

91 The Opponents had sought to argue at paragraphs 32 to 34 of their written submission, that they have the requisite reputation, in particular, in the local context. However for reasons that will be apparent later, I am of the view that this has not been made out. In any event, it is to be recalled that the Court of Appeal has cautioned that a strong reputation does not necessarily equate to a higher likelihood of confusion, and could in fact have the contrary effect (see *Staywell* at [96(a)] quoting *McDonald’s Corp v Future Enterprises Pte Ltd* [2005] 1 SLR(R) 177 at [64], above). Whether this is so will depend on the actual circumstances of the case.

***Opponents’ Earlier “Sunburst” Marks***

92 In relation to the *Opponents’ Earlier “Sunburst” Marks* I have concluded above that the marks are even more visually dissimilar than similar to the *Application Mark* (in comparison to the *Opponents’ Earlier “Curve” Mark*). Aurally, just like the *Opponents’ Earlier “Curve” Mark*, there is some aural similarity, having regard to the fact that for the *Opponents’ Earlier “Sunburst” Mark 2*, the word “rethink.” can be disregarded. Finally, there is no conceptual similarity between the *Application Mark* and the *Opponents’ Earlier “Sunburst” Marks*. Similarly, the conclusion in relation to the *Opponents’ Earlier “Sunburst” Marks* is that the marks are (even) more dissimilar than similar.

93 Further, as the relevant goods are Class 16 products and the areas of overlap are, in the main, paper-related products and stationery, it is the visual aspect which is most important.

94 In relation to the arguments with regard to the overall impression of the respective marks and the possibility of imperfect recollection, following the above conclusion that the *Opponents' Earlier "Sunburst" Marks* are even more dissimilar than similar in totality from the *Application Mark* (in comparison to the *Opponents' Earlier "Curve" Mark*), they clearly do not assist the Opponents.

95 Last but not least, I am of the view that the Opponents have not established that there is reputation in the local market, having regard to my reasons set out below.

*Factors relating to the impact of goods-similarity*

96 For the factors relating to the impact of goods-similarity, the Opponents argued, at paragraph 38 of their written submission, that as the price of the type of product sold directly impinges on the degree of care the consumer is likely to pay for his purchase and therefore his ability to detect subtle differences, and as paper products are relatively inexpensive, the care and consideration that a consumer would put into the purchase of such products is lower than the degree of care that would be put into the purchase of higher value and more expensive goods.

97 In addition to the above, at the oral hearing, the Opponents sought to argue that the goods in Class 16 tend to be related to the household. If so, the relevant consumer for Class 16 would necessarily *include* the general public. Further, there is no specialist knowledge required for the purchase of such paper products, for example, paper for the use of one's printer at home. Finally, such paper products are self-service items placed on the relevant shelves in stationery shops.

98 I have concluded above that the *Opponents' Earlier Marks* are in totality more dissimilar than similar. Specifically, having regard to the extent, in particular, of the visual dissimilarity, I am of the view that there is no likelihood of confusion, even if the degree of care in relation to paper products is not high and having regard to the factors discussed above.

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

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

100 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...

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

#### *Similarity of marks*

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

102 In relation to this element, my view is primarily the same in relation to the similar element under Section 8(2)(b). In short, I am of the view that this element has been not been made out.

103 In light of the above, there is no need for me to look into the other elements of this ground of objection. However, in the event that I am wrong, I will proceed to analyse the rest of the factors in any case.

#### *Well-known in Singapore*

104 The critical question is whether the *Opponents' Earlier Marks* are well known in Singapore as at the relevant date of 28 August 2012, which is the date of application of the *Application Mark*.

105 The starting point for this limb is Section 2(7), (8) and (9) of the Act.

Section 2(7) of the Act states:

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

- (a) the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;
- (b) the duration, extent and geographical area of —
  - (i) any use of the trade mark; or



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

Section 2(8) of the Act reads:

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

Section 2(9):

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

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

106 Section 2(7)(a) is arguably the most crucial factor when determining whether a trade mark is well known in Singapore due to Section 2(8) of the Act which 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”: see [139] of *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] SGCA 13 (“*Amanresorts*”).

107 It is to be remembered that the Court in *Amanresorts* provided at [229]:

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

108 However, despite the above, the High Court in *Caesarstone* commented as follows at [159] and [160]:

[159] ...Whilst the Court of Appeal has commented that it is “not too difficult” for a trade mark to be considered well-known in Singapore (*Amanresorts* at [229]), this should not be taken to mean that the hurdle that trade mark owners have to cross is minimal.

[160]...I am of the view that the statement of the Court of Appeal in *Amanresorts* that it is “not too difficult” for a trade mark to be considered as well-known, especially on a sectorial basis, must be applied with judicious caution to the actual facts and circumstances of each case.

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

110 Further, following *Amanresorts* at [137]:

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

[Emphasis as underlined mine].

111 The Opponents, at paragraph 50 of their written submission referred to paragraphs [44] – [48] of their written submission. In particular, the following submissions and evidence are relevant.

112 The Opponents submitted that the Opponents first used the “STORAENSO” trade marks in Singapore in 1999. The Opponent has several of such registrations in various classes in Singapore. In this regard, the Opponents referred to Exhibit 2 of the Opponents’ Evidence. The Opponents also deposed that the Opponents’ “STORAENSO” trade mark was first used in Singapore in 1999 as the company name of Stora Enso Singapore Pte Ltd. Stora Enso Singapore Pte Ltd changed its name to Stora Enso South East Asia Pte. Ltd. in 2008, and is a wholly owned subsidiary of the Opponents. Stora Enso South East Asia Pte. Ltd. is one of the Opponents’ most important group companies (paragraph 7 and Exhibits 4 and 5 of the Opponents’ Evidence).

113 The Opponents also submitted that they have consistently and continually advertised, marketed and promoted their products offered under the “STORAENSO” trade marks and the *Opponents’ Earlier Marks*. In this regard, the Opponents referred to Exhibit 6 of the Opponents’ Evidence which included samples of the advertisements of the Opponents’ products offered under the “STORAENSO” trade mark circulated in Singapore

and worldwide. Further the Opponents also referred to Exhibit 7 of the Opponents' Evidence for examples of how the Opponents use their "STORAENSO" trade mark on their packing labels, calendars, envelopes and letterheads.

114 Finally, the Opponents referred to their worldwide revenue figures of the Opponents' paper production business under the "STORAENSO" brand set out in paragraph 9 of the of the Opponents' Evidence:

S/N	Year	Sale (in EUROS Millions)
1	2003	12,172.3
2	2004	12,395.8
3	2005	13,187.5
4	2006	12,957.2
5	2007	11,848.5
6	2008	11,028.8
7	2009	8,945.1
8	2010	10,296.9
9	2011	10,964.9
10	2012	10,814.8
11	2013	10,544.0
12	2014	10,213.0

115 The Applicants argued, at paragraph 83 of the Applicants' written submission, that the fact that the "STORAENSO" trade mark is used as part of the Opponents' company name does not show that the Opponents are using the *Opponents' Earlier Marks* to promote and sell goods in Singapore and thus does not assist to show that the *Opponents' Earlier Marks* are well known in Singapore.

116 The Applicants also countered, at paragraph 84 of the Applicants' written submission, that the sample advertisements included in Exhibit 6 of the Opponents' Evidence are fraught with the following issues (the Opponents' Evidence is not paginated):

- (i) the telephone numbers as set out at the bottom [right] hand corner of the brochure "Redesigning the Future with Renewable Packaging" are not local numbers such that there is no indication that the materials have been circulated in Singapore.
- (ii) Two advertisements provided are from The Star and Sin Chew Jit Poh, both of which are Malaysian publications. Specifically, there are no advertisements from Singapore publications.
- (iii) Most of the brochures post-date the filing date of the *Application Mark*, that is, 28 August 2012. For example:
  - (a) the brochure for "Chromocard" bears the note "Issued: 03.2013";
  - (b) the brochure for "Cupforma Ice" bears the note "Issued: 10.2014";
  - (c) the brochure for "Coated Papers-TerraPress Silk" bears the note "updated: 23 September 2014" at the bottom right hand corner;

- (d) the brochure for “Coated Papers-NeoPress for Rotogravure” bears the note “Updated: 25 April 2014” at the bottom right hand corner;
- (e) the brochure “Coated Papers-CosmoPrint Matt” bears the note “Updated: 22 April 2014” at the bottom right hand corner.

117 In relation to Exhibit 7 of the Opponents’ Evidence, the Applicants pointed out as follows at paragraph 85 of their written submission (the Opponents’ Evidence is not paginated):

- (i) The calendar is for the Year 2015, thus it post-dates the Application Date.
- (ii) The use of the *Opponents’ Earlier Marks* on the envelopes and packing labels merely indicate that the mail were sent by the Opponents, and do not show use of the *Opponents’ Earlier Marks* as a trade mark in relation to the Opponents’ goods.
- (iii) No letterheads were appended in this Exhibit 7, even though paragraph 8 of the Opponents’ Evidence states “*Annexed hereto and marked as Exhibit-7 are examples of how the Opponent uses its “Stora Enso” trade mark on its... letterheads*”.

118 Importantly, the Opponents’ revenue figures at paragraph 9 of the Opponents’ Evidence (and appended copies of the financial reports included under Exhibit 8) are not indicative of the extent (if any) to which the *Opponents’ Earlier Marks* have permeated the Singapore market. The figures (and financial reports) evidence the revenue of the Opponents’ business under the *Opponent’s Earlier Marks* worldwide and *not* Singapore alone.

119 In relation to this, the Opponents sought to submit revenue figures from the sale of paper and boards from 2008 to 2012 by Stora Enso South East Asia Pte Ltd, which is located in Singapore and is a wholly owned subsidiary of the Opponents as follows (paragraph 33 of the Opponents’ written submission):

<b>Year</b>	<b>US Dollars</b>
2008	220,975,935
2009	156,548,811
2010	175,630,210
2011	203,746,787
2012	190,504,288

120 At the oral hearing, the Applicants submitted their rebuttal submissions. In relation to this issue, they submitted that this is the first time that these figures and claims have been submitted (paragraph 6 of the Applicants’ rebuttal submission). The Applicants strongly objected to the inclusion of the above figures as evidence in the Opponents’ written submission (paragraph 9 of the Applicants’ rebuttal submission). The Applicants submitted at paragraphs 9 and 10 of their rebuttal submissions that the figures were not tendered via a statutory declaration as mandated under Rule 69 of the Trade Marks Rules

(Cap 332, 2008 Rev Ed) for evidence before the Registrar. They have not been verified or attested to by any authorised representative of the Opponents. Thus the figures should be disregarded.

121 In support of their submissions, the Applicants referred to *The Polo/Lauren Company, L.P. v United States Polo Association* [2015] SGIPOS 10 at [34] (paragraph 12 of their rebuttal submission):

[34] In my view, *if* the contents in AWS Paragraph [4.05.03] constitute new evidence, there would be a more fundamental problem with this paragraph: it is set out in the Applicants' Written Submissions, as opposed to a statutory declaration. Tendering any evidence via written submissions is against the general rule set out in Rule 69 of the Trade Marks Rules (Cap 332, 2008 Rev Ed) ("the Rules"). Rule 69 provides as follows:

**69.**—(1) In any proceedings before the Registrar under the Act or these Rules, evidence shall be given by way of a statutory declaration, unless otherwise provided by the Act or these Rules or directed by the Registrar.

[Emphasis as underlined mine]

122 I agree. In light of the above, the figures as tendered above purporting to be the revenue figures from 2008 to 2012 by Stora Enso South East Asia Pte Ltd must be *disregarded*.

123 In light of the above, there is no need for me to consider the Applicants' alternative argument, at paragraph 11 of their rebuttal submission that even if the above figures were accepted as properly adduced, as the Opponents did not furnish any evidence to substantiate the same. Further, since the Opponents did not expressly state that the revenue figures pertain to sales in Singapore, the figures could well pertain to export sales to countries outside Singapore.

124 Having regard to the above, we are mainly left with the worldwide revenue figures as tendered via paragraph 9 of the of the Opponents' Evidence (reproduced above), financial reports via Exhibit 8 of the Opponents' Evidence, Exhibits 4 and 5 which shows the fact that the "STORAENSO" trade mark is used as part of the name of the Opponents' local subsidiary, Exhibit 6 which pertains to sample advertisements circulated in Singapore *and* worldwide and Exhibit 7 which pertains to purported use of the *Opponents' Earlier Marks* on their various stationery.

125 Before I proceed, I note that there are *no* figures tendered in relation to the promotional expenditure for the Opponents' "STORAENSO" trade marks and the *Opponents' Earlier Marks*, whether worldwide or in Singapore.

126 It is observed that the Opponents' worldwide revenue figures are rather substantial (see above). However, it does not assist in that it is unclear to what extent, if any, these

figures pertain to sales *in Singapore*. In this regard, I agree with the Applicants at paragraph 87 of their written submission that “the figures and financial reports [Exhibit 8 of the Opponents’ Evidence] are not indicative of the extent (if any) to which the [Opponents’ Earlier Marks] have permeated the Singapore market”.

127 In relation to the fact that the “STORAENSO” trade mark is used as part of the name of the Opponents’ subsidiary, I am of the view that the *mere* fact that the “STORAENSO” trade mark is used as part of the name of the Opponents’ local subsidiary, without more, does not assist the analysis.

128 In relation to the issues pertaining to Exhibit 6, I agree with the Applicants that there are no publications which relate to Singapore and most of the brochures post-date the relevant date of 28 August 2012 and thus should be disregarded. In relation to the fact that the telephone numbers as set out at the bottom right hand corner of the brochure “Redesigning the Future with Renewable Packaging” are not local numbers such that there is no indication that the materials have been circulated in Singapore, the Opponents argued, at paragraph 33 of their written submission, that “[t]he use of non-local telephone numbers in the brochures does not mean that they have not or cannot have been circulated in Singapore”. I agree that this may be a possibility. But I am of the view that it is highly unlikely as a practical matter. Last but not least, it is noted that most of the marks which are depicted in this Exhibit 6 are the *Opponents’ Earlier “Sunburst” Mark 2*.

129 In relation to the issues pertaining to Exhibit 7, I agree with the Applicants that the calendar is for the Year 2015. Thus it post-dates the Application Date. In this regard, it is observed that the majority of Exhibit 7 consist of the different aspects of the Opponents’ 2015 calendar. However, in relation to the use of the *Opponents’ Earlier Marks* on their stationery, I am of the view that it is plausible that such stationery is used as a mode of promotion of the *Opponents’ Earlier Marks* such that it is acceptable in this sense. In any event, in the event that I am wrong in relation to this issue, it is noted that such acceptance of this evidence does not assist much with regard to the Opponents’ cause. Finally, it is noted again that most of the marks which are depicted in this Exhibit 7 are the *Opponents’ Earlier “Sunburst” Mark 2*.

130 In light of the above, the evidence pertaining to sales and promotion in *Singapore* is minimal, and having regard to the High Court’s caution in *Caesarstone*, I am of the view that this element has not been made out.

131 In the event that I am wrong, I will proceed to examine the next element.

#### *Confusing connection*

132 In relation to this element, the Court at *Staywell* provided as such at [120]:

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

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

134 Again, in the event that I am wrong, I will proceed to examine the last element below.

#### *Likelihood of Damage*

135 In relation to this element, *Amanresorts* provided at [234]:

[234] In the instant case, we agree with the Judge’s finding (at [74] of the Judgment) that the 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 Respondents’ claim for passing off...However, we pause to clarify that while the tests relating to misrepresentation and damage under the law of passing off are substantively the same as the tests relating to, respectively, the “connection” requirement and the “likely to damage the [plaintiff’s] interests” requirement in s 55(3)(a) of the current TMA, the two sets of tests are not identical in one aspect. An important distinction is that the tests relating to misrepresentation and damage in passing off actions concern the plaintiff’s goodwill (see [69] above), whereas the corresponding tests under s 55(3)(a) of the current TMA concern the *interests* of the plaintiff and *not* its goodwill (indeed, as the definition of “well known trade mark” in s 2(1) of the current TMA makes clear, the plaintiff’s trade mark may be a “well known trade mark” for the purposes of s 55(3)(a) even if the plaintiff has no goodwill in Singapore).

[Emphasis as underlined mine]

136 With regard to this element, the Opponents argued at paragraph 52 of their written submission that given the strength of the *Opponents’ Earlier Marks*, the public would, upon exposure to the Applicants’ goods, be confused into thinking that the Applicants’ goods originate from the Opponents or that the Opponents have authorised the use of the *Application Mark* on the goods. This confusion damages the interests of the Opponents because the Applicants’ goods would be wrongly associated with the Opponents and consumers may mistakenly purchase the Applicants’ goods instead of the Opponents’. The Opponents are also concerned that if the Applicants encounter any issues with the Applicants’ goods, the public may somehow think that the Opponents are associated with the Applicants’ goods because of the similarity in the marks.

137 Having regard to my conclusion above that there is no confusing connection, there can be no damage since there would be no “mistaken purchase” nor would there be any misconception of authorisation by the Opponents (for the avoidance of doubt, in light of

my conclusion, there would also not be any possible “association” drawn to the Opponents should there be any quality issues with the Applicants’ goods).

138 The ground of opposition under Section 8(4)(b)(i) therefore fails.

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

139 The relevant provisions of the Act read:

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

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

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

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

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

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

##### *Similarity of marks*

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

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

##### *Well-known to the public at large*

142 The critical question is whether the *Opponents’ Earlier Marks* are well known to the public at large (in Singapore) as at the relevant date of 28 August 2012, which is the date of application of the *Application Mark*.

143 In relation to the element, it is clear that the relevant provisions and case law which relate to the limb “well known in Singapore” (as referred to above) apply. Further, the



Court in *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 (“*City Chain*”) held:

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

[Emphasis as underlined mine]

144 In addition, the Court in *Amanresorts* provided at [233]:

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

[Emphasis as underlined mine]

145 In *Taylor’s Wines Pty Ltd v Taylor, Fladgate & Yeatman Limited* [2014] SGIPOS 11 at [132], the learned Assistant Registrar provided a useful summary of the type of evidence tendered for marks held to be well-known to the public at large as at the date of her decision, which still serves as a useful guide in the instant case:

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

I would further clarify that the sales and promotional figures referred to above pertain to that in *Singapore* (see *Seiko Holdings Kabushiki Kaisha v Choice Fortune Holdings*

*Limited* [2014] SGIPOS 8 at [15] and *Clinique Laboratories, LLC v Clinique Suisse Pte Ltd and another* [2010] SGHC 189 at [39]).

146 In addition to their arguments above in relation to the element of “well-known in Singapore” under Section 8(4)(b)(i), the following are the relevant submissions and evidence to be considered (paragraph 55 of the Opponents’ written submission referring to paragraphs [45] – [48] of their written submission).

147 The Opponents’ “STORAENSO” trade mark was first used in Finland in 1998. Further, the Opponents’ paper production business under the “STORAENSO” trade mark has consistently been a high revenue generator in the Opponents’ business, reaching over 10 million EUROS in 2013 (paragraph 9 of the Opponents’ Evidence). As mentioned in paragraph 4 of the Opponents’ Evidence, the Opponents have some 28,000 employees in more than 35 countries worldwide, and is a publicly traded company in Helsinki and Stockholm.

148 Further, the Opponents deposed that they have also registered their “STORENSO” trade mark in more than 60 countries throughout the world (paragraph 6 and Exhibit 3 of the Opponents’ Evidence). In this regard, the Opponents submitted that the Opponents’ earliest application for their “STORAENSO” mark was a Community Trade Mark application filed in 1998 (see Exhibit 3 of the Opponents’ Evidence (not paginated) at the 2<sup>nd</sup> page of the list of applications / registrations at the 10<sup>th</sup> and 13<sup>th</sup> items).

149 The Opponents submitted, based on the above evidence, that the Opponents’ “STORAENSO” trade mark is highly valuable, both in terms of the revenue and in terms of recognition of the strength of the brand in the industry. The Opponents highlighted that as set out in paragraph 4 of the Opponents’ Evidence, the Opponent’s sales in 2013 were 10.5 billion EUROS, with operational earnings before interest and tax of 578 million EUROS.

150 In response to the above, the Applicants submitted, at paragraphs 90 to 94 of their written submission:

- (i) the Opponents have not furnished documents supporting applications and/or registrations in the various countries listed in Exhibit 3 of the Opponents’ Evidence such that important details such as the specification of goods and/or services and status of the mark, for example, whether an application is still pending or has been registered, are omitted.
- (ii) In any event, registration of the “STORAENSO” trade marks in many countries and the duration of the registrations *per se* does not prove that the Opponents’ Earlier Mark is well known in Singapore. The Court of Appeal in *City Chain* stated at [95] that “*Although we observe that the Flower Quatrefoil mark has been registered in many countries and the duration of the registration has been substantial, that does not per se prove that it is well known, particularly in Singapore.*”

151 I have already concluded above that the evidence as to the sales and advertising in *Singapore* is marginal such that the *Opponents' Earlier Marks* cannot satisfy the element of being “well-known in Singapore” under the ground of objection under Section 8(4)(b)(i).

152 I have taken into account the additional factors as highlighted by the Opponents above. In particular, I am cognisant of the fact that the Opponents' worldwide sales revenue is quite substantial, standing at an average of 11,280.7 million EUROS which is about 11 billion EUROS per annum. Unfortunately, even with this extent of sales revenue worldwide, I am unable to determine, based on the evidence tendered, the extent to which this can be attributed to Singapore.

153 In light of the above, I am unable to conclude that the *Opponents' Earlier Marks* are well known to the public at large in Singapore.

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

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

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

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

**8.** —(7) A trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented —

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade.

#### ***Decision on Section 8(7)(a)***

157 In relation to this ground, it is clear that there are 3 elements to be established and they are:

- (i) Goodwill;
- (ii) Misrepresentation; and
- (iii) Damage.

158 A widely-quoted description of goodwill is as follows (see *The Commissioners of Inland Revenue v Muller & Co's Margarine, Limited* [1901] AC 217, referred to in *Law of Intellectual Property of Singapore (Sweet & Maxwell, 2014 Rev Ed)* by Professor Ng-Loy Wee Loon (“*Law of Intellectual Property of Singapore*”) at [17.1.1]):

It is the benefit and advantage of the good name, reputation, and connection of a business. It is the attractive force which brings in custom. It is the one thing which

distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has a power of attraction sufficient to bring customers home to the source from which it emanates.

[Emphasis as underlined mine].

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

160 It is important to note that the Opponents must establish that they have acquired goodwill as at the relevant date and this date is the date on which the defendant's conduct complained of started: *Law of Intellectual Property of Singapore* at [17.2.5]). Applying the principle to the current case, the relevant date in this instance is the date of the application of the *Application Mark* which is 28 August 2012.

161 Recently, the High Court in *Allergan, Inc and another v Ferlandz Nutra Pte Ltd* [2016] SGHC 131, referring to the Court of Appeal case of *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] SGCA 33 (“*Singsung*”), further clarified as such at [170] and [171]:

[170] Goodwill is the legal property protected by the law of passing off. Goodwill in the context of passing off is not goodwill in the mark, logo or get-up as such. Instead, goodwill is the trading relationship with his customers. Viewed from this perspective, passing off is concerned with goodwill in the business as a whole and not its constituent elements such as the mark, logo or get-up that it uses.

[171] The Court of Appeal in *Singsung* held (at [37]) that for conceptual clarity, the issue as to whether a mark or get up is distinctive of the plaintiff's product or services is best dealt with in the context of whether the defendant had made a misrepresentation. Further, at [55], the Court of Appeal emphasised that the goal of the tort is to prevent unfair competition brought about by deception or misrepresentation by the defendant as to, amongst other things, the origin of goods...

[Emphasis as underlined mine]

162 In relation to proving goodwill, the Court of Appeal provided as such in *Singsung* at [58]:

[58] Evidence of sales and income of the business are a “proxy for the attractive force of the business”...

[Emphasis as underlined mine]

163 Further, it is clear that under the law the “get up” can include various aspects of the business, including a mark, (see *Law of Intellectual Property of Singapore* at [17.2.10] – [17.2.11]):

[17.2.10]: The action for passing off is no longer anchored...to the name or trade mark of a product or business...The real issue is not what type of indicia is employed by the plaintiffs to market his goods or services, but whether the relevant public associates the indicia exclusively with the plaintiff’s goods or services.

[17.2.11] The different types of indicia used by the traders to distinguish their products or services are sometimes known generically as “get-up”...

164 Examples of such indicia include “a brand name or a trade description, or the individual features of labelling or packaging” see *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 WLR 491, quoted in *Amanresorts* at [36].

165 Last but not least, the High Court in *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] SGHC 216 at [164] clarified as follows:

[164] Having considered the statutory language of s 8(7)(a) of the TMA and the limited authorities on the matter, I am of the view that s 8(7)(a) of the TMA at the very least requires an opponent to adduce sufficient evidence to establish a prima facie case on goodwill, misrepresentation, and damage...

[Emphasis as underlined mine].

166 In relation to goodwill I have already dealt with the Opponents’ sales and promotional figures in *Singapore*. Specifically, the figures as tendered via the Opponents’ written submission at paragraph 33 purporting to be the revenue figures from 2008 to 2012 by Stora Enso South East Asia Pte Ltd must be *disregarded* such that we are mainly left with:

- (i) worldwide figures as tendered via paragraph 9 of the of the Opponents’ Evidence and replicated above;
- (ii) Exhibit 8 of the Opponents’ Evidence which pertains to financial reports;
- (iii) Exhibit 6 of the Opponents’ Evidence which pertains to sample advertisements circulated in Singapore *and* worldwide; and
- (iv) Exhibit 7 of the Opponents’ Evidence which pertains to purported use of the *Opponents’ Earlier Marks* on their stationery.

167 In relation to the above items, I have already alluded to the issues which pertain to each one. Specifically:

- (i) With regard to the Opponents' worldwide revenue figures (as supported by the financial reports), while they are rather substantial, they do not assist in ascertaining the extent of sales in *Singapore*.
- (ii) With regard Exhibit 6, having regard to the issues as discussed above, very few of the sample promotional materials can be said to relate to Singapore. To put it in context, as an approximate gauge, only about 4 brochures / promotional materials can be taken into account out of a total of 12. Out of the 4 documents, if the 1 document which include overseas numbers is excluded, it leaves us with only 3 brochures / promotional materials which can be taken into account.

168 With regard to Exhibit 7, having regard to the issues discussed above, the only materials which can be taken into account are the use of the *Opponents' Earlier Marks* on their stationery.

169 The Opponents at paragraph 73 of their written submission referred to their arguments at paragraphs [44] – [48] in relation to the element of “well-known to the public at large”. However, as mentioned above, it is a requirement that the goodwill must pertain to *Singapore*. In light of this, in addition to the items already discussed above, items such as:

- (i) Dates of first use in Finland;
- (ii) The fact that the Opponents employ some 28,000 employees in more than 35 countries worldwide (Opponents' Evidence at paragraph 4);
- (iii) The fact that the Opponents are a publicly traded company listed in Helsinki and Stockholm (Opponents' Evidence at paragraph 4);
- (iv) The fact of registration of the “STORAENSO” trade marks in more than 60 other countries around the world (Opponents' Evidence at paragraph 6) with the Opponents' earliest application for their “STORAENSO” mark being a Community Trade Mark application filed in 1998 (Opponents' Evidence at Exhibit 3).

cannot be taken into account.

170 Further, some information relating to Singapore also does not assist much in the analysis:

- (i) The fact that the Opponents' “STORAENSO” trade mark was first used in in Singapore in 1999 as the company name of Stora Enso Singapore Pte Ltd. (Exhibit 4 of the Opponents' Evidence).
- (ii) That Stora Enso South East Asia Pte. Ltd. (Stora Enso Singapore Pte Ltd changed its name to Stora Enso South East Asia Pte. Ltd. in 2008) is one of the Opponents' most important group companies (it is a wholly owned subsidiary of the Opponents) (Paragraph 7 and Exhibits 4 and 5 of the Opponents' Evidence).

- (iii) That the Opponents have several trade mark registrations for their “STORAENSO” trade mark in Singapore, with the earliest registration in Singapore dating from 1999 (Opponents’ Evidence at paragraph 5 and Exhibit 2 of the same).

The above evidence, without more, does not show the extent of the Opponents’ goodwill in Singapore.

171 In light of the above, while I am mindful that all the Opponents have to show is a *prima facie* case of passing off, in light of the evidence tendered, I am of the view that this element has not been made out.

172 In the event that I am wrong, I will proceed to examine the next element of misrepresentation.

#### *Misrepresentation*

173 In relation to this element, the Court of Appeal in *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2012] SGCA 56 held that:

(20) In the present case, there was the requisite confusing connection under s 55(3)(a) TMA. The test for the “connection” requirement was similar in substance to the test for the misrepresentation requirement in passing off, and the findings for the misrepresentation requirement were in turn based on the finding of a likelihood of confusion under s 27(2)(b) TMA...

Thus for largely the same reasons that I have found that the element of “confusing connection” and “the likelihood of confusion” has not been made out respectively under the objection under Sections 8(4)(b)(i) and 8(2)(b), I am of the view that it has not been made out under this element of misrepresentation as well.

174 In addition, as mentioned above, for the purposes of an objection under passing off, the get-up of the Opponents (which includes the *Opponents’ Earlier Marks*) can be taken into account. In this regard, I note from the Opponents’ Evidence at Exhibit 6 under the brochure entitled “*Stora Enso Renewable Packaging*” (the Opponents’ Evidence is not paginated), the Opponents simply describe themselves as “Stora Enso”. This is again reflected in the brochure entitled “Business of all flavours *Stora Enso* solutions for Chocolate & Confectionery packaging”.

175 For reasons largely provided above, even taking this indicia into account, I am of the view that there is no misrepresentation. As alluded to above, it cannot be said that “Enso” is the main dominant and distinctive component of the indicia. The word “Stora” is equally, if not more, dominant and distinctive than “Enso” having regard to the fact that “Stora” is at the beginning of the indicia and it is a longer word, that is, 5 letters, in comparison to “Enso”. For the avoidance of doubt, I note that when the Opponents describe themselves in the brochure above in Exhibit 6 of the Opponents’ Evidence, there

is a space between the word “Stora” and “Enso”. However, I do not think this factor makes any significant difference to my analysis above.

176 At the oral hearing, the Opponents referred to the case of *PT Bogamulia Nagadi v Glaxo Group Limited* [2004] SGIPOS 6 (“*PT Bogamulia*”) for the proposition that in some cases, the last component of the mark could be dominant such that in some instances, the similarity could lie in the second half of the marks.

177 The Applicants countered that *PT Bogamulia* was decided under the old law (the 1992 edition of the Act) and that the Act, which is the 2005 revised edition, is different. I agree. As indicated in the decision, the relevant provisions under consideration were sections 15 and 23 of the 1992 edition of the Act.

178 The Opponents submitted that regardless of the applicable law, the case shows that it is not inconceivable that when consumers look at the marks they may focus on the second half of the marks and think that the marks are related. I agree that this is a possibility. However I am of the view that the instant opposition is not such a case.

179 In this regard, the marks in *PT Bogamulia* were “Tempovate” (the Application Mark) versus “Betnovate”, “Dermovate”, “Eumovate” and “Otovate”. It is obvious that all the marks have a similar structure which is a three syllable X-Y-VATE. In addition, the last component “VATE” is identical for all the marks. It is thus not surprising that the Registrar decided the way she did.

180 In contrast, the *Application Mark* is “Enz” with an equilateral device, or “ENZA” or “ENZO”. I have already indicated above that I am inclined to construe the *Application Mark* as “Enz” with an equilateral triangular device or “ENZA”. However, in the event that the *Application Mark* is construed as “ENZO”, there are still elements which distinguish the *Opponents’ Earlier Marks* from the *Application Mark*.

181 To begin with, there is the “curve” device (*Opponents’ Earlier “Curve” Mark*) as well as the “sunburst” device (*Opponents’ Earlier “Sunburst” Marks*) which is respectively of a size which cannot be ignored and placed in a relatively prominent location. Further, it is not to be forgotten that the *Opponents’ Earlier “Sunburst” Mark 2* contains the word “rethink.” right in the middle of the “sunburst” device. In the event that the Opponents’ get-up is simply “Stora Enso” without any devices, there is still the additional word “Stora” placed before “Enso”, which, having regard to its length (5 letters), is longer than “Enso”, and would serve to differentiate the marks.

182 Further it was observed at [3] of the holding in *PT Bogamulia*:

[3] The Opponents’ marks have been in use since 1987, i.e. 11 years as at the date of the Applicants’ mark and have goodwill by virtue of long use...By the Opponents’ long use in the market, consumers will be aware of the Opponents’ marks and will associate the use of marks ending with “OVATE” or “VATE” with the Opponents.



[Emphasis as underlined mine].

I have already concluded above that having regard to the evidence, I am not able to conclude that the Opponents have the relevant goodwill in Singapore.

183 Last but not least, ***PT Bogamulia*** concerned pharmaceutical goods and there could be considerations which are peculiar in relation to this class of goods. For instance, having regard to the serious consequences of confusion, the Registrar may be cautious in her deliberation and thus decision.

*Conclusion in relation to misrepresentation*

184 Taking into account all of the surrounding factors, I am of the view that, on a balance of probabilities, there is no likelihood of misrepresentation that the Applicants and the Opponents are one and the same or that they are economically linked.

*Damage*

185 As I have found that the elements of goodwill and misrepresentation have not been made out, there is no need for me to look into the element of damage.

*Conclusion*

186 The ground of opposition under Section 8(7)(b) therefore fails.

**Ground of Opposition under Section 7(6)**

187 Section 7(6) of the Act provides that:

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

*Decision on Section 7(6)*

188 The Opponents did not apply to cross-examine the Applicants' deponent and the Registrar is therefore left to decide the issue of bad faith based on the documents filed.

*The combined test for bad faith*

189 The legal test for determining the presence of bad faith is fairly settled and is summarized in ***Valentino Globe BV v Pacific Rim Industries Inc*** [2010] 2 SLR 1203 ("***Valentino***") at [29], citing ***Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd*** [2009] 2 SLR(R) 814 at [105]-[106]:

[29] In *Wing Joo Loong* ([21] *supra*), this court observed at [105] that “[t]he test for determining the presence of bad faith, in the context of the English Trade Marks Act, was settled by the English Court of Appeal” [emphasis in original]. It would be useful to set out in full the observations of this court at [105]–[106] which are as follows:

105 The test for determining the presence of bad faith, in the context of the English Trade Marks Act, was settled by the English Court of Appeal in *Harrison v Teton Valley Trading Co Ltd* [2004] 1WLR 2577, where Sir William Aldous, with whom Arden and Pill LJ agreed, expressed the test as follows (at [26]):

The words ‘bad faith’ suggest a mental state. Clearly when considering the question of whether an application to register is made in bad faith all the circumstances will be relevant. However the court must decide whether the knowledge of the applicant was such that his decision to apply for registration would be regarded as [being] in bad faith by persons adopting proper standards.

This test, which was referred to by Sir Aldous (*id* at [25]) as the ‘combined test of bad faith, contains both a subjective element (*viz.* what the particular applicant knows) and an objective element (*viz.* what ordinary persons adopting proper standards would think).

106 Recently, this combined test of bad faith was succinctly explained in *Ajit Weekly Trade Mark* [2006] RPC 25 as follows (at [35] and [41]):

35 ... Bad faith is to be judged according to the combined test of dishonesty for accessory liability [for] breach of trust set out by the majority of the House of Lords in *Twinssectra Ltd v Yardley* [2002] 2 A.C. 164, with *Gromax Plasticulture* ([103] *supra*) ... providing the appropriate standard namely, acceptable commercial behaviour observed by reasonable and experienced persons in the particular commercial area being examined.

...

41 ... [T]he upshot of the Privy [Council’s] decision in [*Barlow Clowes International Ltd v Eurotrust International Ltd* [2006] 1WLR 1476] is: (a) to confirm the House of Lords’ test for dishonesty applied in *Twinssectra*, i.e. the combined test; and (b) to resolve any ambiguity in the majority of their Lordships’ statement of that test by making it clear that an enquiry into a defendant’s views as regards normal standards of honesty is not part of the test. The subjective element of the test means that the tribunal must ascertain what the defendant knew about the transaction or other matters in question. It must then be decided whether in the light of

that knowledge, the defendant's conduct is dishonest judged by ordinary standards of honest people, the defendant's own standards of honesty being irrelevant to the objective element ...

This court in *Wing Joo Loong* then applied at [107]–[117] the combined test of bad faith which, to reiterate, contains both a subjective element (viz, what the particular applicant knows) and an objective element (viz, what ordinary persons adopting proper standards would think). It is therefore apparent to us that 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.

[Emphasis as underlined mine]

190 Further, as stated in *Valentino* at [30] citing *Nautical Concept Pte Ltd v Jeffery Mark Richard and another* [2007] 1 SLR(R) 1071 at [15] that was in turn citing the English decision in *Royal Enfield Trade Marks* [2002] RPC 508 (“*Royal Enfield*”):

[30] Furthermore, it is pertinent to note that an allegation of bad faith is a serious claim to make and it must be sufficiently supported by the evidence (see *Nautical Concept Pte Ltd v Jeffery Mark Richard* [2007] 1 SLR(R) 1071 at [15] which we reproduced below):

An allegation that a trade mark has been applied for in bad faith is a serious one. In *Royal Enfield Trade Marks* [2002] RPC 508, it was held (at [31]) that:

A plea of fraud should not be lightly made ... and if made should be *distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the facts* (see *Davy v. Garrett* [1878] 7 CH.D 473 at 489). In my judgment precisely the same considerations apply to an allegation of ... bad faith made under section 3(6) [of the UK Trade Marks Act 1994]. *It should not be made unless it can be fully and properly pleaded and this will rarely be possible by a process of inference.* [Emphasis added; emphasis in original omitted]

191 The Opponents argued, at paragraph 82 of their written submission that in choosing a mark that is confusingly similar to the Opponents’ “STORAENSO” trade mark and the *Opponents’ Earlier Marks* the Applicants intend to take unfair advantage of the valuable and substantial goodwill and reputation in the Opponents’ “STORAENSO” trade mark and the *Opponents’ Earlier Marks*. The Opponents submitted that given the long and established use of the Opponents’ “STORAENSO” trade mark and the *Opponents’ Earlier Marks* in Singapore and throughout the world, and given the identity and overlap in the parties’ respective goods of interest and the field of activity, the Applicants would no doubt have heard or known of the Opponents’ “STORAENSO” trade mark and the *Opponents’ Earlier Marks*.

192 The Opponents submitted, that the Applicants only began promoting their products under the *Application Mark* in Singapore in 2011. It cannot be coincidental that the *Application Mark* adopts the word “ENZO”/ “ENZA”, which is similar to the word “ENSO” in the Opponents’ “STORAENSO” trade mark and the *Opponents’ Earlier Marks*, given that the Opponents have used their “STORAENSO” trade mark for almost two decades, and the Applicants and the Opponents operate in the same industries.

193 The Opponents thus concluded (paragraph 83 of their written submission) that the Applicants have deliberately copied the Opponents’ “STORAENSO” trade mark and the *Opponents’ Earlier Marks*, relying on the reputation and goodwill built up over the years in the Opponents’ “STORAENSO” trade mark and the *Opponents’ Earlier Marks* such that not only does the conduct of the Applicants in applying for the registration of the *Application Mark* in Singapore fall short of the normally accepted standards of commercial behaviour, but also the Applicants no doubt have heard or known of the Opponents’ “STORAENSO” trade mark and the *Opponents’ Earlier Marks* and the Applicants would have realised that their applying for the registration of the *Application Mark* in Singapore would fall short of the normally accepted standards of commercial behaviour.

194 The Applicants, at paragraphs 139 and 140 of their written submission, referred to the case of *In the Matter of a Trade Mark Application by Southern Rubber Works Sdn Bhd and Opposition thereto by Converse Inc.* [2015] SGIPOS 11 (“*Southern Rubber*”) and submitted that the Opponents have made only bald accusations of their fame vis-à-vis the Opponents’ Earlier Marks without any concrete evidence to show that the Applicants have acted in bad faith in applying for registration of the *Application Mark*.

195 I note that the IP Adjudicator commented at [91] of *Southern Rubber*:

[91] The Opponents have merely averred that their star logo has achieved fame around the world due to their extensive use and promotion, in particular on high cut basketball shoes, and that by virtue of the Applicants operating in the same industry, the Applicants cannot have been unaware of their marks, especially the star logo. The Opponents argued that because of this background, the Applicants are clearly seeking to ride on the coat-tails of the Opponents. Other than a mere assertion of their fame vis-à-vis the star logo, the Opponents have not surfaced any concrete evidence to show that the Applicants have acted in bad faith in applying for registration of the Application Mark.

[Emphasis as underlined mine]

I agree that the above consideration *alone* is insufficient to make out a case of bad faith.

196 Having regard to the warning in *Royal Enfield* that an allegation of bad faith should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctly proved and this will rarely be possible by a process of inference, I am of the view that the objection of bad faith has not been made out.

## **Conclusion**

197 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition fails on all grounds. Accordingly, the *Application Mark* shall proceed to registration. The Applicants are also entitled to costs to be taxed, if not agreed.

Dated this 25th day of November 2016

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Sandy Widjaja

Principal Assistant Registrar of Trade Marks

Hearings and Mediation Group

Intellectual Property Office of Singapore