

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

Trade Mark Application No. T1306610G
19 January 2016

IN THE MATTER OF A TRADE MARK APPLICATION BY

B2K PET PRODUCTS PTE LTD

AND

OPPOSITION THERETO BY

PETS GLOBAL PTE LTD

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

Ms Denise Loh, Mr Jonathan Liang and Ms Nurul Asyikin (Ella Cheong LLC) for the
Applicants

Mr Zechariah Chan and Mr Jeremiah Chew (Lee & Lee) for the Opponents

Cur Adv Vult

GROUND OF DECISION

1 This is an opposition to the registration of the following trade mark T1306610G
 ("*Application Mark*");



in relation to the following goods in Class 31:

Cat Litter.

2 B2K Pet Products Pte Ltd (“the Applicants”) applied to protect the Application Mark in Singapore on 25 April 2013. The application was accepted and published on 25 October 2013 for opposition purposes.

3 On 21 February 2014, Pets Global Pte Ltd (“the Opponents”) filed their Notice of Opposition to oppose the registration of the Application Mark. The Applicants filed their Counter-Statement on 15 April 2014. The Opponents filed evidence in support of the opposition on 19 January 2015. The Applicants filed evidence in support of the application on 13 May 2015. The Opponents filed their evidence in reply on 18 September 2015. The Pre-Hearing Review (“PHR”) for the Opposition was conducted on 19 October 2015 and thereafter the hearing was set down for 19 January 2016.

Grounds of Opposition

4 The Opponents originally relied on Sections 8(2)(b), 8(7)(a) and Section 7(5) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”). However, at the PHR, the Opponents clarified that they would not proceed on Section 7(5).

Opponents’ Evidence

5 The Opponents’ evidence filed for this opposition proceeding comprises of the following statutory declarations:

- (1) Statutory Declaration by Raymond Lee, Chief Executive Officer of the Opponents, dated 8 January 2015 (“the Opponents’ 1st Evidence”);
- (2) Statutory Declaration in Reply by Raymond Lee, dated 16 September 2015 (“the Opponents’ 2nd Evidence”);

Applicants’ Evidence

6 The Applicants' evidence filed for this opposition proceeding comprises of the following statutory declaration:

- (1) Statutory Declaration by Koh Jek Sheng Kenneth, Director of the Applicants, dated 22 April 2015 ("the Applicants' 1st Evidence").


Applicable Law and Burden of Proof

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

Background

8 The Opponents deposed at paragraph 3 of the Opponents' 1st Evidence that they are a company incorporated in Singapore on 15 May 2006 and that they are in the business of manufacturing prepared animal feeds and the wholesale of pet birds and animals (including food and accessories). In particular they have been in the business of selling cat litter and cat food.

9 The Opponents relied on the following earlier mark ("Opponents' Earlier Mark"):

S/N	<i>Opponents' Earlier Marks¹</i>	Class 31
1	 T0800814E	Litter for animals namely, food for cats

10 On the other hand, the Applicants deposed at paragraphs 6 of the Applicants' 1st Evidence, that they are specialist pet products suppliers founded in 2008. They deposed that they are the largest pet products suppliers in Singapore and that they have strong marketing and sales capabilities globally and in Singapore.

MAIN DECISION

¹ The word beside the device of the cat is "Premium".

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

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

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

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

[18] We observed this in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] SGCA 26 (“*Hai Tong*”) at [40(a)]. Congruously, there is no prescribed requirement that all three aspects of similarity must be made out before the marks can be found to be similar: *MediaCorp News Pte Ltd v Astro All Asia Networks plc* [2009] 4 SLR(R) 496 (“*MediaCorp*”) at [32] and *Sarika Connoisseur Café Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 (“*Sarika*”) at [16]. In short, the criteria of visual, aural and conceptual similarities do not invite a formulaic consideration; rather, they are signposts towards answering the question of whether the marks are similar. Trade-offs can occur between the three aspects of similarity in the marks-similarity inquiry: *Ozone Community Corp v Advance Magazine Publishers Inc* [2010] 2 SLR 459 (“*Ozone*”), see also Bently and Sherman, *Intellectual Property Law* (Oxford University Press, 3rd Ed, 2009) (“*Bently & Sherman*”) at p 864.

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

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

[Emphasis as underlined mine.]

Similarity of Marks

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

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

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

...

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

[Emphasis as underlined mine.]



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

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

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

[Emphasis as underlined mine].

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

<i>Application Mark²</i>	<i>Opponents' Earlier Mark</i>
	

Visual Similarity

² The words above “Kit Cat” are “Super Premium”.

16 In considering visual similarity of composite marks, it is apposite to have regard to the Court’s guidance in *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

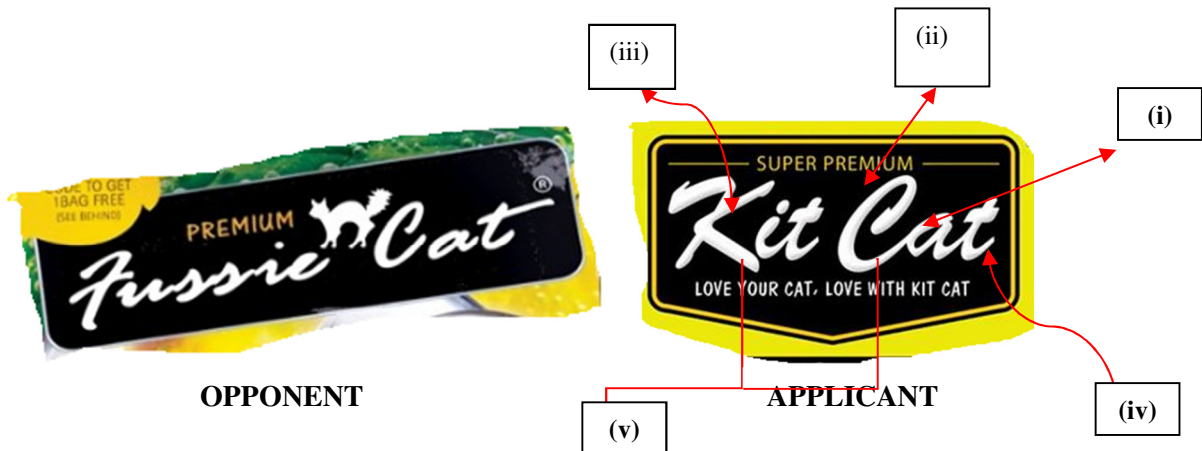
(vi) the device component is more likely to be perceived as a decorative element rather than as an element indicating commercial origin (see *Trubion* ([56] *supra*) at [45] and *Oberhauser* ([56] *supra*) at [47]; see also *Wassen* ([56] *supra*)).

[Emphasis as underlined mine]



17 The Opponents, at paragraph 26 (page 8) of their written submissions, argued that the marks are similar for the following reasons:

- (i) Both marks contain the words “CAT” in white stylized font,
- (ii) Both marks use the capitalised word “PREMIUM” in gold font at the top of the marks;
- (iii) Both marks employ the use of a contrasting white text in the foreground with the black background;
- (iv) Both marks use a visually striking and similarly (if not identically) styled white cursive font; and
- (v) The style of the words in both marks is such that the first letters of each mark is capitalized (“F” in the FUSSIE CAT Mark, and “K” in the Application Mark) are visually and strikingly similar.

18 In fact, the Opponents proceeded to depict the marks as follows in the same paragraph to aid the comparison above (“Depiction”).



19 Firstly, I do not think that the Depiction correctly reflects the respective marks. It is to be recalled that the mark-to-mark assessment is an exercise which encompasses a comparison of the marks as registered or applied for. The marks have been replicated above and for ease of reference they are as follows:

<i>Application Mark</i>	<i>Opponents' Earlier Mark</i>
	

It can be seen that there is an important, although subtle distinction between the marks as registered and as shown in the Depiction. The Opponents' Earlier Mark as registered is reflected as a “board” which is “hanging” from a “nail”.

20 With the above in mind, I will proceed to analyse the marks. I agree with the Opponents that both marks utilise a white cursive font against a black background. This black background appears, to some at least, to be a “signboard”. I describe it as such as I am of the view that the Application Mark can equally be regarded as a “badge” or “shield” (in the words of the Applicants at the hearing and as submitted by the Applicants at paragraphs 11(i) and 14 of their written submissions) rather than a “signboard”.

21 In relation to the fonts, I agree that the marks both utilise white cursive fonts. But to argue that the letter “F” in the Opponents’ Earlier Mark and the letter “K” in the Application Mark are visually strikingly similar requires too much of a stretch of the imagination.

22 The word “cat” appears in white cursive font in both marks. I am mindful of the Court’s guidance that at this stage, it is a mark-to-mark comparison only (see above) with no reference to the goods. However, in assessing the distinctiveness of marks there is a need to make reference to the goods. For example, “Apple” would not be distinctive in relation to an apple. However, “Apple” could be considered to be distinctive in relation to computers. In light of this, the fact that both marks contain the word “cat” is not of much significance since the goods in relation to which the marks are registered / sought to be registered, are cat related products, namely “Litter for animals namely, food for cats” and “Cat litter”. In any event, as marks are to be assessed as wholes, even if this particular component of the marks is similar, it is only one of the many factors to be taken into account.

23 Both marks also contain the word “premium” in gold. However, it is common knowledge that “premium” is a laudatory word which is frequently used by traders to promote their goods. The Opponents also strained to emphasise that the words “premium” / “super premium” in the respective marks are in gold. I accept this fact. However, this does not add much to the similarity analysis

24 The visual similarity ends here. It is to be noted that the words in the Application Mark “Kit Cat” takes a prominent position in the context of the whole of the Application Mark, having regard to the size of the font and the positioning of the words. Similarly, the words “Fussie Cat” also takes a prominent position in the context of the whole of the Opponents’ Earlier Mark, again, having regard to the size of the font and the positioning of the words.

25 In this regard, I agree with the Applicants at paragraph 12 of their written submissions that it is notable that the Opponents themselves refer to their mark as the “Fussie Cat mark” throughout the Statement of Grounds attached to Form TM 11 (see paragraph 3 of the Statement of Grounds onwards).

26 Further, the Applicants also argued at paragraph 12 of their written submissions that the words “Fussie Cat” and “Kit Cat” are the dominant and distinctive components of the marks as they possess inherent technical distinctiveness since the respective terms are meaningless in the context of the goods involved. I agree.

27 In this regard, I note the Opponents' submission that "Kit" is intended to refer to "kittens". While I do not discount the possibility of such an inference, I think it is more likely than not, that a consumer will look at "Kit Cat" and think that it is an allusive reference to the chocolate brand "Kit Kat". This is particularly so when one also takes into account of the slogan at the bottom of the Application Mark "Love your cat, Love with Kit Cat" which seems to vaguely resemble "Have a break, have a Kit Kat". At this juncture, it is to be pointed out that the significance of this vague allusion to "Kit Kat" ends here³. Aside from that discussed above, this allusion has no further impact on the case at hand. On the other hand, "Fussie Cat" is a play on the idea "Fussy Cat" and can be seen as either implying the idea of a fussy cat or simply connotes the idea of "a cat named "Fussie".

28 The Opponents had strenuously argued both at the hearing and at paragraph 34 (page 12) of their written submissions, in relation to the similarity with regard to the black background, the white cursive font, the depiction of a "signboard" as well as the word "premium" (or "super premium") in gold. As indicated above, I agree that there is some degree of similarity in that sense. However, surely, that cannot be the end of the analysis.

29 To begin with, as mentioned above, the background can be considered as a "signboard" *or otherwise*. Further, *even* if both backgrounds can be considered to depict a "signboard" they are different depictions of a "signboard". As mentioned above, the "signboard" in the Opponents' Earlier Mark is hanging askew from a nail unlike the "signboard" in the Application Mark.

30 The words "Kit Cat" and "Fussie Cat" which are the respective distinctive and dominant components, are clearly different. There is also the slogan in the Application Mark "Love your cat, Love with Kit Cat". To complete the analysis, I note that there is a device of a cat in the Opponents' Earlier Mark. The existence of the cat device in the Opponents' Earlier Mark in contrast to the non-existence of any such device in the Application Mark does to some extent buttress my view that the marks are visually more dissimilar than similar.

31 Further, I also find support for the conclusion that it is the words "Kit Kat" and "Fussie Cat" which are the respective distinctive components of the marks having regard to the Court's guidance above in *Hai Tong* at [62] and in particular, the Court's guidance at [62(d)]. Applying the Court's guidance in the said paragraph, the textual components of the marks are the dominant component of the marks having regard to the fact that (i) while the marks each contain a somewhat arguably similar device (ie, the "signboard / badge / shield), they bear words which are entirely different from each other (that is, the words "Kit" and "Fussie"); (ii) textual components are large and are in prominent positions and stand out from the background of the marks; and finally (iii) the composite

³ The Opponents argued at the hearing in relation to the element of misrepresentation that the Applicants are attempting to misrepresent another entity with such an allusion. However the Applicants countered that any such allusion is irrelevant for the current case.




marks are applied to goods or services marketed or sold primarily through online trade channels (see the Opponents 1st Evidence at Exhibits C and E and paragraph 12 and Exhibit E of the Applicants' Evidence).

32 The Opponents sought to rely on *Fox Street Wear Pte Ltd v Fox Racing, Inc.* [2014] SGIPOS 13 (the “Fox” case) in relation to the issue of visual similarity (paragraph 32 (page 12) of their written submissions). The Opponents relied on the following at [66]:

[66] I agree with the Opponents that the marks are visually similar. The dominant component of both marks is the “fox head” device within the word “FOX”. Furthermore, the overall graphic design and font style used for the textual features are similar, while the “fox head” devices strongly resemble each other.

[Emphasis as underlined mine]

33 For ease of reference, the marks in the *Fox* case are as follows:

Applicants' Mark	Opponents' Mark	
		

34 I do not think that the *Fox* case is helpful with this particular issue. It is to be noted that in the *Fox* case, the Applicants have taken the main distinctive component of the Opponents' Mark, which is the device of the fox head within the word “fox”. This *composite combination* of the device of the fox head within the word “fox” essentially comprises the *whole* of the Opponents' Mark. In particular, the fox head in the Application Mark is a *splitting image* of the fox head in the Opponents' Mark. Having regard to the above, it is understandable that the learned Principal Assistant Registrar came to the conclusion above.

35 The same cannot be said in the current case. As alluded to above, the only possible main points of similarity are the white cursive font against a black background with a device which could possibly be regarded as a “signboard” and the laudatory word “premium” in gold.

36 Having regard to all of the above, I am of the view that, the marks are visually more dissimilar than similar. I emphasize that I arrive at the above conclusion, having regard not only of the main distinctive components but also in assessing each respective mark as a whole (see *Caesarstone Sdot-Yam Ltd v Ceramiche Caesar S.p.A.* [2016] SGHC 45 (“*Caesarstone*”) at [52]-[53] where the Court reiterated the importance of assessing the mark as a whole where the mark is a composite mark).

Aural Similarity

37 With regard to aural similarity, I note the Court in *Staywell* stated at [31] and [32] that there are two approaches. One approach is to consider the dominant component of the mark and the other is to undertake a quantitative assessment as to whether the competing marks have more syllables in common than not. Further, the High Court in *Han's (F & B) Pte Ltd v Gusttino World Pte Ltd [2015] SGHC 39* ("*Hans*") has provided further clarification with regard to the application of the above principle in relation to composite marks:

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

[Emphasis as underlined mine]

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



39 For the Application Mark, the dominant component is the words "Kit Cat" (having regard to the prominence of the words in the context of the whole mark). Further, it is noted from the *Hans* case that words which are in much smaller fonts and in relatively less prominent positions are not taken into account in construing aural similarity. Thus, the words "Love your cat, Love with Kit Cat" as well as "Super Premium" are not taken

into account in considering this aspect of similarity. On the other hand, for the Opponents' Earlier Mark, it is the words "Fussie Cat" which is the dominant component of the mark such that the word "premium" is not taken into account.

40 It is noted that this is also the approach taken by the learned Principal Assistant Registrar in the *Fox* case. At [67], it was stated as such:

67 An interesting issue arises as to how the marks in the present case should be compared from the perspective of aural similarity. Should both marks be regarded simply as "FOX" for the purposes of this comparison? Or would the Opponents' marks be pronounced "F...X" instead? And, for the Application Mark, must we take into account the presence of the name "Fox Street Wear" and the slogan "What's stopping you?" as well?

...

70 It could be that the proper approach to take would depend on the facts of each individual case. In the current situation, I am of the view that both marks would be pronounced by the average consumer as "FOX". I therefore find that the marks are aurally similar (and arguably identical, from an aural perspective).

[Emphasis as underlined mine].

41 Comparing the dominant components of the respective marks ie "Kit Cat" versus "Fussie Cat", there are two syllables in "Kit Cat" namely "Kit-Cat" while there are three syllables for "Fussie Cat" namely "Fus-sie-Cat". Clearly, the only point of similarity is the word "cat" in both marks. Apart from this, there is no aural similarity between "Kit" and "Fussie" at all.

42 In light of the above, I am of the view that the marks are at most, aurally similar to a very low extent.

Conceptual Similarity

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

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

[Emphasis as underlined mine]

44 The Opponents argued, at paragraph 28 (page 9) of their written submissions:

28 Conceptually, both marks are similar as both marks superimpose the words in the mark against a black elongated “signboard” device. The white cursive font in the marks also gives the marks a playful, casual feel which is apt for the products concerned (cat litter and cat food).

45 Having regard to the Courts’ guidance above, I do not think the above analysis is sufficient. While I do not disregard the Opponents’ proposed analysis, the marks connote more ideas than that suggested above.

46 As mentioned above under the analysis of visual similarity, the Application Mark, regardless of whether it is intentional or not, makes an overt allusion to the chocolate brand “Kit Kat”. This is particularly so taking into consideration of two factors, namely the words, “Kit Cat” and the slogan at the bottom of the Application Mark “Love your cat, Love with Kit Cat”. The packaging of chocolate brand “Kit Kat” contains not only the words “Kit Kat”, but also the slogan “Have a break, have a Kit Kat”.

47 The Opponents also contended that there is a possibility of the word “Kit” being construed as a reference to “kittens” (this is also the submission of the Applicants at paragraph 15 of their written submissions). I accept that this is probable, having regard to all elements of the Application Mark, specifically, the slogan “Love your cat, Love with Kit Cat”.

48 On the other hand, I agree with the Applicants at paragraph 15 of their written submissions that the words “Fussie Cat” in the Application Mark, convey the idea of a fussy cat. There is a high probability that the word “fussie” is an intentional misspelling of “fussy”.

49 Having regard to all of the above, even if I accept the Opponents’ proposal of some conceptual similarity with regard to the idea of a black “signboard” (as alluded to above even if the background in both marks can be considered to be “signboards”, they are different types of “signboards”, with the “signboard” in the Application Mark being a “hanging signboard”) and white cursive writing which provides a playful feel, *overall*, I am of the view that the marks are conceptually more dissimilar than similar.

50 At this juncture, it is apposite to deal with the case of *Dial-An-Angel Pty Ltd v Sagitaur Services Systems Pty Ltd* (1990) 96 ALR 181 (*Dial-An-Angel*) which the Opponents rely to support their argument that there is conceptual similarity between the marks.

51 I agree with the Applicants in this regard that to begin with, the relevant provision in the above case, namely Section 62 of the Australian Trade Marks Act 1955 (which has been superceded) (ATMA) is rather different to that under our legislation. Section 62 of the ATMA provides:

‘62. (1) A registered trade mark is infringed by a person who, not being the registered proprietor of the trade mark or a registered user of the trade mark using by way of permitted use, uses a mark which is substantially identical with, or deceptively similar to, the trade mark, in the course of trade, in relation to goods in respect of which the trade mark is registered.

(2) In an action for infringement of a trade mark registered in Part B of the Register (not being an infringement occurring by reason of an act referred to in the next succeeding section), an injunction or other relief shall not be granted to the plaintiff if the defendant establishes to the satisfaction of the court that the use of the mark of which the plaintiff complains is not likely to deceive or cause confusion or to be taken as indicating a connexion in the course of trade between the goods in respect of which the trade mark is registered and a person having the right, either as registered proprietor or as registered user, to use the trade mark.

[Emphasis as underlined mine]

52 In fact, at paragraph (ii) of the holding of the case, the court held as such:

With respect to the trade mark of the logo and name, a side by side comparison demonstrated major differences such that the logos are not substantially identical. However, sharing the same essential feature, an angel, the respondent’s logo was deceptively similar to the applicant’s registered trade mark. Although there were differences the causal viewer would be more likely simply to notice and remember an angel caring for children.

[Emphasis as underlined mine]

53 Finally, the Opponents’ own argument at paragraph 31 (page 10) of their submissions also indicated as such:

31 While the Federal Court of Australia accepted that there were “major differences” between the two marks, it concluded that the marks were deceptively similar at pp. 192 – pp. 193, for the following reasons:

“In the present case the relevant marks share a common essential feature: an angel. It is true that the two angels are portrayed differently. One angel is engaged in doing nothing more taxing than serenely blessing two children; her celestial sister is extremely busy, simultaneously coping with a baby and a vacuum cleaner. The respondent's angel signifies loving care and security; she is the "guardian angel". Perhaps the applicant's angel would be more immediately seen as a "helpful angel" (as in "be an angel and do this for me"). But the distinction is not really so clear cut. The applicant's angel also has two children in her care. She is depicted in the

*home, a symbol of security. It may not be difficult for those who -- like the participants in this case -- have closely studied the appearances of these ethereal beings to distinguish between them. **But I think that the casual viewer would be more likely, in each case, simply to notice, and remember, an angel caring for children. Probably the detail of the children does not matter; but it happens that each mark contains outlines of two walking children.** In each case the elder is certainly a girl. In one case the younger is certainly a boy, and may also be so in the other.” (emphasis added)*

[Emphasis as underlined mine]

54 It is to be recalled that Section 8(2)(b) requires a likelihood of confusion to be made out on the basis of similarity of marks and similarity of goods / services.

55 In light of all of the above, I am of the view that *Dial-An-Angel* does not assist the current case.

Conclusion on the similarity of marks

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

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

57 I am reminded (above) that in coming to the conclusion with regard to similarity, this tribunal is to assume the 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. Further, the average consumer has “imperfect recollection” such that 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.

58 In this regard, the Opponents belaboured the point at paragraph 34 (page 12) of their written submissions) that allowance must be made for imperfect recollection of the average consumer in light of the distinctive and dominant components of the marks, that is, the white cursive font, the gold font and the black “signboard” device.

59 As alluded to above, the distinctive and dominant components of the marks are the words “Kit Cat” and “Fussie Cat”. In light of this conclusion and also in light of the reminder that the average consumer is one who would exercise some care and a measure of good sense in making his or her purchases and is not an unthinking person in a hurry, I am of the view that the marks are visually dissimilar, aurally similar to a very low extent and conceptually dissimilar such that overall, the marks are more dissimilar than similar.

60 In light of the above, it is not necessary for me to proceed to analyse the other two elements of similarity of goods and the likelihood of confusion.

Decision on Section 8(2)(b)

61 In light of all of the above, the ground of objection under Section 8(2)(b) fails.

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

62 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)

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

- (1) goodwill;
- (2) misrepresentation;
- (3) damage.

64 A widely-quoted description of goodwill is as follows (see *The Commissioners of Inland Revenue v Muller & Co's Margarine, Limited* [1901] AC 217, referred to at *Law of Intellectual Property of Singapore* (Sweet & Maxwell, 2014 Rev Ed) by 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].

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

66 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 25 April 2013 (page 23 and paragraph 58 of the Opponents' written submissions.

67 It is also important to note that passing off protects goodwill and not the mark used to promote it although the role of the mark remains important in the goodwill element (see *Law of Intellectual Property of Singapore* at [17.1.3]). Further, it is clear that under the law the “get up” can include various aspects of the business, including a mark, as per *Reckitt & Colman Products Ltd v Borden Inc [1990] 1 WLR 491*, and quoted in *Novelty Pte Ltd v Amanresorts Ltd [2009] 3 SLR(R) 216*, (“*Novelty*”) at [36]:

[36]...The second is a reformulation by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1WLR 491 (“the *Jif Lemon* case”) at 499, as follows (this particular passage was also cited by the Judge at [48] of the Judgment as well as by this court in *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR(R) 975 (“the *Millenia* case”) at [86]): The law of passing off can be summarised in one short general proposition – no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the getup is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by [the defendant] are the goods or services of the plaintiff. Whether the public is aware of the plaintiff’s identity as the manufacturer or supplier of the goods or services is immaterial, as long as [the goods or services] are identified with a particular source which is in fact the plaintiff. For example, if the public is accustomed to rely upon a particular brand name in purchasing goods of a particular description, it matters not at all that there is little or no public awareness of the identity of the proprietor of the brand name. Thirdly, he must demonstrate that he suffers or, in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff.

[Emphasis as underlined mine]

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

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

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

[Emphasis as underlined mine].

69 Last but not least, *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] SGHC 216 (“*Rovio*”) 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]

70 The Opponents submitted, at page 23, paragraph 58 of their written submissions, that by reason of the facts set out in paragraphs 5 – 13 (pages 2- 4) of their written submissions, they have the goodwill and reputation in the Opponents' Earlier Mark in Singapore as at the relevant date of 25 April 2013. The facts following the Opponents' submissions at paragraphs 5 – 13 of their written submissions are as follows:

- (1) The Opponents are an independent pet food company incorporated in Singapore on 15 May 2006 (see paragraph 3 of the Opponents' 1st Evidence).
- (2) The Opponents are and have, at all material times, been in the business of selling cat litter and cat food. In particular, the Opponents produce their own house brand of “Fussie Cat” cat litter and “Fussie Cat” cat food (paragraph 3 of the Opponents' 1st Evidence). The “Fussie Cat” products have been sold in the Singapore market since August 2006 (see paragraph

11 of the Opponents' 1st Evidence) and are some of its most well-known products in Singapore and around the world.

- (3) In addition to Singapore, the Opponents' "Fussie Cat" products can also be found in many independent pet stores across the United States and at online outlets. Elsewhere, the Opponents' "Fussie Cat" products have been well received in countries including Canada, Russia, Malaysia, Indonesia, Hong Kong and China. The Opponents are also in the process of preparing to roll out these products in South Korea, Japan, Taiwan and Thailand. Thus, the Opponents' "Fussie Cat" products have a dominant presence around the world (paragraph 10 of the Opponents' 1st Evidence).
- (4) The Opponents are at all material times the registered proprietor of the Opponents' Earlier Mark. In addition, there are trade mark applications and/or registrations for the "Fussie Cat" mark in various countries worldwide, which applications / registrations are valid and subsisting. These countries are the United States, Malaysia, Russia, Japan, South Korea, Taiwan and Thailand (paragraphs 4 and 6 of the Opponents' 1st Evidence).
- (5) The Opponents have invested strongly in the promotion of their "Fussie Cat" products to both consumers and retailers. In particular, the Opponents have used channels such as digital media marketing as well as social media to advertise and promote their business under the Opponents' Earlier Mark. Such marketing generates a great amount of word of mouth marketing (see paragraphs 14 and 15 of the Opponents' 1st Evidence).
- (6) In particular, the Opponents' Earlier Mark is prominently featured at various websites including www.petmobile.com.sg; www.polypet.com.sg; www.kohepets.com.sg; www.thewhitejack.com; www.fussiecat.com; and www.facebook.com/FussieCat (see paragraph 16 of the Opponents' 1st Evidence).
- (7) By reason of the extensive and continuous usage, marketing, promotion and advertising worldwide and in Singapore, the Opponents' Earlier Mark has become distinctive of and is instantly recognisable globally as a badge of origin, in that consumers would recognise goods provided under the said mark to be that of the Opponents and no other (paragraph 17 of the Opponents' 1st Evidence).
- (8) For the reasons set out above, the Opponents submitted that they have acquired substantial goodwill and reputation in the Opponents' Earlier Mark throughout the world including Singapore (paragraph 18 of the Opponents' 1st Evidence).

71 The Opponents also deposed that owing to its popularity worldwide, the Opponents' Earlier Mark is instantly recognisable globally as a badge of origin, in that consumers will recognise goods provided under the Opponents' Earlier Mark to be that of the Opponents and no other (paragraph 12 of the Opponents' 1st Evidence) and that the Opponents' Earlier Mark has been put to use on an extensive scale and the Opponents have derived substantive turnover worldwide specifically from such use (paragraph 13 of the Opponents' 1st Evidence).

72 On the other hand, the Applicants submitted, at paragraph 30 of their written submissions, that the evidence tendered by the Opponents does not support the Opponents' claim that they have acquired substantial goodwill in Singapore in relation to the Opponents' Earlier Mark, and neither does the evidence show any goodwill in relation to the get-up and packaging of the Opponents' products.

73 In this regard, the Applicants referred to *Rovio* at [180] which provided that the existence of goodwill is normally established with the following evidence:

(a) Figures on sales in Singapore: Actual sales figures must often be adduced to demonstrate the volume of sales in Singapore. It stands to reason that the greater the volume of sales and proven demand, the greater the likelihood that the claimed mark will be found to be a badge of recognition in the minds of the public.

(b) Marketing and advertising efforts in Singapore: These show the extent of public exposure of the particular brand or business in Singapore. The court will scrutinise the nature, extent and effectiveness of advertising in determining if the business in question has achieved some degree of notoriety (in the sense of recognition) in the minds of Singapore consumers.

74 Following the above, the Applicants submitted, at paragraph 33 of their written submissions, that the Opponents failed to produce, or produced insufficient, evidence as to the Opponents' sales and marketing efforts in Singapore. The Applicants submitted that the Opponents' evidence to show that they have established business activities in Singapore on or before the relevant date of 25 April 2013 is extremely thin.

75 The Applicants further submitted, at paragraphs 33 – 36 of their written submissions that:

- (1) While the Opponents claimed that the Opponents' Earlier Mark has been used in Singapore since August 2006, no evidence was produced to show such first use.
- (2) The Opponents have tendered neither evidence of having a brick and mortar shop in Singapore nor a business established on an internet website hosted in Singapore.

- (3) The evidence provided by the Opponents is limited to a few printouts dated 21 August 2014 from some websites.
- (4) Such websites include the Opponents' own website www.fussiecat.com as well as their facebook page www.facebook.com/FussieCat. The Applicants submitted these are hosted outside of Singapore. In this regard, the Applicants submitted that in *Novelty*, as cited in *Rovio* at [188], the Court of Appeal was cautious as to whether the existence of a domain name and website was sufficient to establish goodwill and held at [54] that proof of active steps taken to reach consumers in Singapore could make a difference and that such active steps include evidence of how many "hits" on the website came from internet users in Singapore. In this regard, no such evidence has been produced and the mere existence of the 2 websites / webpages is not sufficient to establish goodwill.
- (5) Aside from the above, the Applicants also referred to other websites referred to by the Opponents which were third party websites, namely www.petmobile.com.sg; www.polypet.com.sg; www.kohepets.com.sg; www.thewhitejack.com.
- (6) The Applicants submitted that aside from the above websites, the Opponents did not produce any other evidence relating to their sales and marketing efforts. In particular, the Opponents did not produce any sales and marketing figures nor sales volume in Singapore before the relevant date of 23 April 2013. No supporting invoices were tendered in evidence either.

76 Firstly, while it is common to show goodwill via sales and marketing figures with regard to the relevant mark / get-up as well as sales volume or any other evidence to demonstrate any marketing efforts, it is not fatal to the Opponents not to provide the *types* of evidence above. The key issue is whether the Opponents can prove goodwill within the jurisdiction, regardless of the modes of evidence.

77 Further, I note that the current case is not a case of any "pre-trading" activities as envisaged in *CDL* and *Staywell*. This is so since it is the Opponents' case that they have been in the local market since August 2006 (paragraph 11 of the Opponents' 1st Evidence).

78 However, I agree with the Applicants that aside from the above statements in the Opponents' 1st Evidence, the evidence tendered is extremely thin as to the goodwill of the Opponents in *Singapore* as at the relevant date. In this regard, aside from the two references in the Opponents' 1st Evidence (above) that the Opponents were incorporated locally on 15 May 2006 and that the Opponents' Earlier Mark has been in use in Singapore since August 2006, there is nothing to substantiate these statements in the form of, for example, sales figures or sample sales invoices.

79 It is acknowledged that the Opponents made a statutory declaration and thus would be subject to the penalties of the Oaths and Declarations Act (Cap 211, 2001 Rev Ed). However, it is also the case that where there is no supporting evidence to substantiate such statements, the weight to be accorded to such statements will be low. That this is the stance of the Registrar is clearly demonstrated in HMG Circular 3/2015.

80 It is not fatal to the Opponents not to have a brick and mortar shop in Singapore. However, there is a need to show there is business in Singapore regardless of the modality of the operation of the business. This has been succinctly stated in *Rovio* at [186]:

To establish that one has business activity in Singapore, it is not of course necessary to establish a brick and mortar shop in Singapore. A business established on an Internet website hosted in Singapore is still a business in Singapore. Where the website is hosted outside of Singapore, the question whether there is sufficient nexus to Singapore to constitute a business in Singapore (or business activity in Singapore) can be tricky. English cases such as *800-FLOWERS Trade Mark* [2000] FSR 697 and *Euromarket Designs Inc v Peters* [2001] FSR 20 stress the importance of questions such as the purpose of the website and advertisement, and who are the intended customers. Just because individuals in country X can access the website in country Y does not mean that the owner of the website has business activities in country X. The position may well be different where it is established that the proprietor took active steps to promote the goods or services in country X.

[Emphasis as underlined mine]

81 Curiously, the Opponents' own websites do not end with ".com.sg" even though the Opponents were incorporated in Singapore. Thus it would appear to be that, as argued by the Applicants, the Opponents' own website www.fussiecat.com as well as their facebook page www.facebook.com/FussieCat are both hosted outside of Singapore. In this regard the Opponents tendered a printout from their facebook page over the bench at the hearing. The Opponents clarified that they are not tendering this as evidence but for the Registrar to take judicial notice on the basis that such information is publicly available. The Opponents submitted at the hearing that their facebook page is targeted at the Singapore consumers (it is observed that the page is entitled "Fussie Cat SG Pet Supplies"). However, while I note that there are 1,123 "likes" on this page, there is no evidence tendered to show that these "likes" are made by the local consumers.

82 Separately, the Opponents emphasized at the hearing that the third party websites referred to in the evidence (which featured the Opponents' Earlier Mark as deposed by the Opponents) are targeted at Singapore consumers since they mostly end with ".com.sg". It is true that some of the third party websites referred to by the Opponents share the ".sg" top level domain (see paragraph 16 of the Opponents' 1st Evidence). However, even if it can be proven that the original intention of the websites to use

“.com.sg” is to target the Singapore market, there is still a need to show that these websites actually reach the Singapore market.

83 In this regard, I note that Justice Wei in *Rovio* concluded as follows on the facts of that case:

[184] In the Statutory Declaration of Harri Koponen (for the Opponent) at para 3, it is stated that “Angry Birds was first released in December 2009 as an iPhone game on Apple’s App Store”. By October 2011, it was claimed that there were more than one million downloads in Singapore alone. Whilst there was no independent evidence to support this claim, I note that the Applicant in its written submissions accepts that the Opponent’s business and hence goodwill were in computer games.

...

[188] In the present case, it appears that members of the public in Singapore were able to access and download copies of the Angry Bird game over the Internet...

[189] Whilst very little detail was provided (for example, as to whether the downloads were free or paid), it appears that the Angry Bird game thus downloaded (within the terms of the website) were provided to users in Singapore. There is nothing to suggest that the website was intended to target only users in Europe or elsewhere. That being so, whilst the evidence could have been much clearer, given that the Applicant appears to acknowledge that the Opponent had goodwill in respect of computer games, I accept that the Opponent has established goodwill in Singapore in the Red Bird Mark and the Angry Bird Word Mark.

[Emphasis as underlined mine].

84 The above sets this case apart from *Rovio*, in that in *Rovio*, there was evidence of access and downloads by the local audience and that the Applicant in *Rovio* appeared to acknowledge that the Opponent in that case had goodwill in respect of computer games.

85 For the same reasons as provided above, I am unable to accept the Opponents’ following submission at the hearing. The Opponents referred to Exhibit E of the Opponents’ 1st Evidence, which shows a page from www.polypet.com.sg, and pointed out that the Opponents’ products are within the top five best sellers in the said website. The Opponents attempted to use the above to buttress their case that they have the relevant goodwill in Singapore.

86 Since it cannot be conclusively shown that a website ultimately reaches the Singapore consumer simply by having a domain name which end with “.com.sg”, it also cannot be conclusively shown that such sales, shown on a website ending with “.com.sg”, are *made* by Singaporean consumers.

87 Similarly, with regard to advertising efforts in Singapore, there are no figures in the Opponents' evidence as to any expenditure made in relation to promotional efforts locally nor is there any document in the form of invoices rendered by advertising agencies, to substantiate the same.

88 The Opponents' only reference to their marketing activities in their evidence is at paragraphs 14 and 15 of the Opponents' 1st Evidence (above) where the Opponents deposed that the Opponents have used channels such as digital media marketing as well as social media to advertise and promote their business under the Opponents' Earlier Mark and that the Opponents' Earlier Mark is prominently featured on various websites, some of which end with ".com.sg". The Opponents deposed that such marketing generates a great amount of word of mouth marketing.

89 The same issues plague the Opponents' case in relation to this point. Having the Opponents' Earlier Mark on such websites does not conclusively show that they are targeted at the Singapore audience or that they reach the Singapore audience. More is needed, for example, how many "hits" on the website came from internet users in Singapore.

90 Finally, it is noted that all the websites included in Exhibit C of the Opponents' 1st Evidence as referred to in paragraph 16 of the same, are all dated after the relevant date of 25 April 2013.

91 Before I conclude on this issue, it is noted that the Applicants referred to *Romanson Co., Ltd. v Festina Lotus, S.A.* [2015] SGIPOS 3 ("*Romanson*") for the proposition that evidence of use from various third party websites (namely website printouts etc) was insufficient to support a finding of use. *Romanson* was overturned on appeal. However, the respondent did not appear at the hearing of the appeal and no written judgement was issued, so it is unclear as to the basis on which *Romanson* was overturned. In these circumstances, I will not rely on the proposition espoused in *Romanson* in this case.

92 For the above reasons, I am of the view that the Opponents have not shown that *prima facie*, they have goodwill in Singapore. However, in the event that I am wrong, I will proceed to examine the next element of misrepresentation.

Misrepresentation

93 The Opponents at paragraph 59 (page 23) of their written submissions submitted that the test for misrepresentation is similar to that of the element of "likelihood of confusion" under Section 8(2)(b). However, the Opponents submitted that in a passing off action, the likelihood of confusion "is to be assessed having regard to all the circumstances". In this regard, the Opponents drew a reference to *Hai Tong* at [110]. The Opponents' concluded in the same paragraph, that this means that, in addition to comparing the similarity between the parties' marks and the similarity between the parties' goods and services, the court is also entitled to consider the "extraneous factors

that relate to the actual and particular circumstances and ways in which the mark was used on the goods in question” (*Staywell* at [84] (this has been wrongly referred to as [96])

94 It is to be noted that there is a subtle distinction between *Hai Tong* and the current case. In *Hai Tong*, the action was a common law action of passing off while in the current case, it is an action brought under Section 8(7)(a) of the Act (above).

95 For ease of reference, Section 8(7)(a) reads as follows:

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.

[Emphasis as underlined mine]

The subtle but important distinction is that under Section 8(7)(a) of the Act, it is only in relation to the Opponents that the get-up, as well as the actual goods upon which the mark is used, can be taken into consideration. However, in relation to the Applicants, it is still the trade mark as applied for, and in relation to the specification under the proposed application, which can be considered. The above is so having regard to the difference between a “trade mark” and an “unregistered trade mark or other sign” in Section 8(7)(a) above.

96 A related issue is what constitutes use of the trade mark under Section 8(7)(a) (see above - “its use”). Such “use” is the “notional and fair use” of the Application Mark.

97 I refer to *Law of Trade Marks and Passing Off (Sweet & Maxwell, 3rd Ed)* by Tan Tee Jim, S.C. (“*Law of Trade Marks and Passing Off*”) at [8.159]:

[8.159] ...The question as to whether there is likely to be a misrepresentation is to be considered on the basis on notional and fair use of the applicant’s mark across the breadth of the goods or services for the mark sought to be registered...

98 I find support for this in *Rovio*:

[164] ...However, the opponent must still persuade the court that on the materials before it, there is at least a *prima facie* case that a passing off claim would be successful if, at the time of the application, the applicant mark were to be used in a normal and fair manner in respect of the goods or services for which the mark is sought to be registered.

I note that the words used in *Rovio*, that is, “normal and fair use” is slightly different to that from “notional and fair use”. However, it does not detract from the concept of use of the mark in a regular and fair manner.

99 As to the factors which should be taken into account, I refer again to *Law of Trade Marks and Passing Off* at [8.159]:

[8.159] The Opponents should adduce evidence directed at the following factors which would assist the court to determine whether deception or confusion is likely:

- (1) The nature and extent of the goodwill and reputation relied on;
- (2) The closeness or otherwise of the respective fields of activity in which the opponent and the applicant carry on business;
- (3) The similarity of marks;
- (4) The manner in which the applicant has used the mark (if any);
- (5) The manner in which the particular trade is carried out;
- (6) The class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

100 The Opponents then referred to their submissions in relation to the element of “mark similarity” and “similarity of goods” under the ground of objection under Section 8(2)(b) (see paragraph 60 (page 24) of their written submissions).

101 The issue of mark similarity has been dealt with above. In relation to goods similarity, it is not in dispute that under this ground of objection, the goods dealt with by both parties is the same, namely, cat litter.

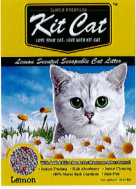

102 At paragraph 61 (page 24) of the Opponents’ written submissions, the Opponents sought to “highlight” the identical and/or strikingly visually “similar get-up and packaging of the Applicant’s cat litter products bearing the Application Mark”, when compared to the Opponent’s cat litter products bearing the Opponents’ Earlier Mark which “heighten” the likelihood of confusion as follows:

- (a) The packaging of both products is classified/identified by a primary colour (e.g. red, green, blue, yellow) depending on the scent/flavor of the cat litter;
- (b) The packaging of both products is primarily dominated by a picture of a cat in the foreground, with different types of flora in the background;
- (c) The packaging of both products display several bullet-point descriptive terms to describe the product, stretching horizontally across the lower half of the packaging; and

- (d) The packaging for both products also employs a circular-shaped photograph depicting the contents of the packaging.

[Emphasis as underlined mine]

103 In this regard, the Opponents sought to refer to Annex A of the Notice of Opposition which is replicated as Exhibit D of the Opponents 1st Evidence as follows:

<i>Application Get Up</i>	<i>Opponents' Earlier Get Up</i>
	

104 To the extent that the Opponents sought to take into consideration the *packaging* of the Applicants' products, it is erroneous, in light of the clarification above of the distinction between a common law action of passing off and the ground of objection under Section 8(7)(a). However, the Opponents sought to argue that under an objection under Section 8(7)(a), the "extraneous factors that relate to the actual and particular circumstances and ways in which the mark was used on the goods in question" can be taken into account under this element of misrepresentation (see above) unlike for the element of "likelihood of confusion" under Section 8(2)(b).

105 Curiously, although what is in contention is the Application Mark, it would appear that the packaging of the Applicants is sought to be taken into account under this element with this approach. However, as the Applicants did not dispute this, I will proceed with comparison between the two get-ups above, particularly as the result of this comparison does not have any effect on the outcome of the opposition proceedings. For the avoidance of doubt, I do not in any way suggest that this approach is correct, and leave it to another case for this issue to be examined further, preferably with the benefit of full submissions by the parties.

106 The Applicants argued, at paragraph 41 of their written submissions, that the two packagings are different as follows:

- (a) The image of the cat in the Applicants' packaging is different from that in the Opponents' packaging and positioned differently, and in any case, the packaging of cat litter products from many other brands is likely to have images of cats;
- (b) The foreground in the Applicants' packaging consists of flowers in a meadow while the foreground in the Opponents' packaging consists of fruits; and

- (c) The different scents/varieties of the Applicants' products (eg. "Lemon" and "Apple") are depicted differently from that of the Opponents' products (eg. "Lemon Refresh" and "Apple Delight").

I agree.

107 I would add that it is not uncommon for traders to:

- (a) utilise a colour scheme to classify the different flavours / scents of products in general;
- (b) employ a "window" to depict the contents of the packaging.

For an example of (b), see Exhibit C of the Opponents' 1st Evidence at page 28 – the last row, the second and third items from the left of the page.

108 In addition, I have previously concluded that the marks are not similar and I note that the marks take up about a third of the packaging respectively. Taking all of these considerations into account, I am of the view that the get-ups of the products above, in totality, are different.

109 I would also like to comment on the following arguments which buttress my conclusion that there is no misrepresentation. These arguments were made by parties in the context of the element of the likelihood of confusion under the ground of objection under Section 8(2)(b) but they are nonetheless applicable to the element of misrepresentation:

- (i) It is noted that these are self-service items which are sold in pet stores. Thus, it is the visual aspect of the marks / get-up which is important.
- (ii) At the oral hearing, the Opponents also argued that pet stores tend to be small and cramped. In this regard, they referred to page 105 of the Applicants' Evidence. I have taken the said page into consideration. First of all, having regard to the signboards in old Chinese characters hung from the ceiling, this picture, in all likelihood, represents one of the Applicants' distributors in Taiwan (see the Applicants Evidence at paragraph 10). In Singapore it is the simplified Chinese characters that are used. Secondly, even if this picture can be taken to be representative of the situation of pet stores in Singapore in general, I do not think that the store can be considered to be cramped. I am of the same view in relation to several of the pictures as contained in Exhibit C of the Applicants' Evidence – see pages 93, 109 and 112 of the same (it is not specified which pictures reflect the stores in Singapore).
- (iii) The Opponents argued, at paragraph 47 (page 20) of their written submissions, that as the price of such products are low, they tend to command a lower degree of fastidiousness on the part of the consumers. Whether price is an

important factor must be assessed on a case by case basis. I am of the view that, in this case, price is only one of many factors to be taken into account and may not necessarily be the decisive factor.

(iv) I agree with the Applicants, at paragraph 26 of their written submissions, that having regard to the very nature of the products, that is, cat-related products, the relevant public is likely to exercise a greater degree of care in selecting such products. The relevant public would tend to inspect such products closely in order to decide if the particular product is suitable for their cats, given that such products would affect the health and well-being of their cats. This is as such as different cats may have different allergies towards different types of cat products or different preferences. It is observed that nowadays it is rather common for pet owners treat their pets akin to their own children. This explains the degree of attention paid by such pet owners to any issues which may affect the general welfare of their pets.

110 To complete the analysis, I have also taken into consideration the Opponents' following arguments.

111 The Opponents argued at paragraph 63 (page 25) of their written submission that, in the market place, the Opponents' products are sold alongside the Applicants' products (see also Exhibit E of the Opponents' 1st Evidence). However, I am of the view that this does not assist the Opponents in light of the finding above as to the dissimilarity between the Application Mark / Get-Up and the Opponents' Earlier Mark / Get Up. Further, I note that the Court opined in the recent case of *Caesarstone* at [122]:

[122] ...If the goods under their respective brands are displayed side by side, in close proximity or on the same supplier's webpage, it will surely be easier even for the end-user to see the differences in the trade marks.

[Emphasis as underlined mine]

112 The Opponents also argued that the parties are in direct competition (paragraph 64 (page 25) of their written submission). However, I am of the view that this also does not assist the Opponents in light of the fact that the relevant consumers are likely to exercise a greater degree of caution due to the nature of the goods.

113 In light of all of the above, the element of misrepresentation has not been made out.

Damage

114 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

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

Dated this 15th day of April 2016

Sandy Widjaja

Principal Assistant Registrar of Trade Marks

Hearings and Mediation Group

Intellectual Property Office of Singapore