

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

Trade Mark No. T1401233G  
22 February 2016

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

**DOOYEON CORP**

**AND**

**OPPOSITION THERETO BY**

**KIKO S.P.A.**

Hearing Officer: Ms See Tho Sok Yee  
Principal Assistant Registrar of Trade Marks

Mr Aaron Thng (Amica Law LLC) for the Applicants  
Ms Eunice Maaland (Drew & Napier LLC) for the Opponents

*Cur Adv Vult*

**GROUND OF DECISION**

1 This is an opposition to the registration of a trade mark (“Application Mark”) as follows:

<b>TM No.</b>	T1401233G
<b>Application Date</b>	27 January 2014
<b>Mark</b>	
<b>Class and Goods</b>	<u>Class 3</u> Eyebrow pencils, lip liner, mascara, make-up foundations, hair colorants, cosmetic preparations for baths, body lotions, bath lotions, shower gels, skin lotions, eyeliner, eye creams, face and body lotions, perfumes, hair gel, hair spray, make-up powder, make-up removing lotions.

2 The applicants seeking to register the Application Mark are Dooyeon Corp. (“the Applicants”) and the opponents to the registration of the Application Mark are Kiko S.p.A. (“the Opponents”).

3 The Application Mark was accepted and published on 21 May 2014 for opposition purposes. The Opponents opposed this application on 21 July 2014. The Applicants filed their Counter-Statement on 22 September 2014.

4 The Opponents filed evidence in support of the opposition on 9 March 2015. The Applicants filed evidence in support of the application on 6 August 2015. The Opponents elected not to file any evidence in reply by their deadline of 6 November 2015. At the pre-hearing review on 30 November 2015, there was no indication that the parties were in negotiations and thus, the opposition was fixed for a hearing on 22 February 2016. By way of letter on 7 December 2015, the Opponents informed the Registrar and Applicants that they would not pursue the ground of opposition under Section 7(6) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”).

### **Grounds of Opposition**

5 At the hearing, the Opponents relied solely on Section 8(2)(b) of the Act in their opposition to the registration of the Application Mark. Their earlier Notice of Opposition had additionally included a ground under Section 8(7)(a) but in their letter of 7 December 2015, the only ground that was abandoned was Section 7(6).

### **Opponents’ Evidence**

6 The Opponents’ evidence comprises a Statutory Declaration made by Stefano Percassi, CEO of the Opponents, on 11 February 2015 in Milan, Italy; as well as a Supplementary Statutory Declaration made by the same deponent on 2 March 2015 in Milan, Italy.

### **Applicants’ Evidence**

7 The Applicants’ evidence comprises a Statutory Declaration made by Kim Yong Woo, Deputy Department Head of the Applicants, on 3 August 2015 in Seoul, South Korea (“the Applicants’ SD”).

**Applicable Law and Burden of Proof**

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

**Background**

9 The Applicants are a Korean company and started their line of KICHO cosmetic products in 2013 in Seoul, Korea. Since then, the KICHO brand has expanded overseas to other countries, including Singapore. The Applicants’ evidence does not specify when the KICHO brand entered the Singapore market. However, it is noted that, in relation to Singapore, their advertising and promotion expenditure and their sales figures start, respectively, from 2013 and 2014. These are set out as follows.

<b>Year</b>	<b>Annual Advertising &amp; Promotion Expenditure (S\$)</b>	<b>Annual Sales (S\$)</b>
2013	60,000	-
2014	120,000	27,500
2015	600,000	7,000

10 The Opponents, an Italian entity, rely on the following trade mark registration ("the Opponents' Mark") in Singapore in this opposition:

<b>TM No.</b>	T1112769I
<b>Application Date</b>	12 July 2011
<b>Mark</b>	
<b>Class and Goods</b>	<u>Class 3</u> Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

11 The Opponents’ Mark has an application date of 12 July 2011, which is earlier in time than that of the Application Mark, 27 January 2014. It is undisputed that the Opponents’ Mark is an “earlier trade mark”, having regard to the definition of “earlier trade mark” in Section 2 of the Act.

12 The Opponents’ evidence has no information on the use of the Opponents’ Mark in Singapore, but nothing turns on this, as the sole ground of opposition is Section 8(2)(b) of the Act. This ground considers the notional and fair use of trade marks, and does not fail for lack of information on actual use of the earlier trade mark.

## MAIN DECISION

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

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

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*

14 The three-step test has been firmly entrenched in Singapore jurisprudence as the relevant test under Section 8(2)(b) of the Act. The Court of Appeal in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another and another appeal* [2014] 1 SLR 911 ("*Staywell*") laid down the step-by-step approach at [15] as follows:

To the extent that the Opponents' argument treated the similarity of competing marks as a threshold requirement that had to be satisfied before the confusion enquiry is undertaken, we agree. It is clear from the plain words of ss 8 as well as 27 of the Act that the only relevant type of confusion for the purpose of grounding an opposition or an infringement action, is that which is *brought about* by the similarity between the competing marks and between the goods and services in relation to which the marks are used. 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. Under the global appreciation approach the elements of similarity between marks and goods or services, whilst still necessary ingredients in the confusion inquiry, are elided with other factors going towards the ultimate question of whether there is a likelihood of confusion (see *Sabel v Puma* at 223–224, and *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 ("*Canon*") at 132). Whilst there have been suggestions that the two approaches might be distinct without being different, we maintain this dichotomy and endorse the step-by-step approach as being conceptually neater and more systematic and, importantly, as being more aligned with the requirements imposed under our statute (see *Polo (CA)*) at [8]).

15 Hence, to succeed under Section 8(2)(b), the Opponents have to establish three elements, namely:

- (a) the Application Mark is similar to the Opponents' Mark;
- (b) the Application is to be registered for goods identical with or similar to those for which the Opponents' Mark is protected; and
- (c) because of both (a) and (b), there exists a likelihood of confusion on the part of the public.

*Similarity of Marks: Principles*

*(i) Three aspects of similarity*

16 The Court of Appeal in *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 ("*Sarika*") at [16] (affirmed by the Court of Appeal in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941 ("*Hai Tong*") at [39]) held that:

The decided cases have established that the court will consider three aspects of similarity, *viz*, visual, aural and conceptual similarity: *Polo (CA)* at [24]; *Mobil Petroleum Co., Inc v Hyundai Mobis* [2010] 1 SLR 512 at [17]. However, it is not a pre-requisite that all three aspects of similarity must be made out before there can be a finding of similarity between the sign and the mark: *Mediacorp News Pte Ltd v Astro All Asia Networks plc* [2009] 4 SLR(R) 496 at [32] ("*Mediacorp*").

*(ii) Considerations in determining similarity*

17 The above approach to a determination of similarity of marks was endorsed and elaborated upon by the Court of Appeal in *Staywell* at [18], [20] and [26] as follows:

18 ... 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... 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...

20 ... the assessment of marks similarity is mark-for-mark without consideration of any external matter... 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...

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"...

18 I also have regard to the High Court decision in *Ferrero SPA v Sarika Connoisseur Cafe Pte Ltd* [2011] SGHC 176 ("*Ferrero*"), which applied the following principles at [50]:

(a) First, the court considers the two signs/marks "as a whole" (*Polo* at [8]; *City Chain* at [47], [50]). However, the court would not take into account "any external added matter or circumstances" because the comparison is "mark for mark" (*MediaCorp* at [33], citing *Caterpillar Inc v Ong Eng Peng* [2006] 2 SLR(R) 669 at [55] ("*Caterpillar*").

(b) Second, the signs/marks are considered from the viewpoint of the average consumer – *not* an unthinking person in a hurry, but rather, a person who would exercise some care and good sense in making his purchases (*Polo* at [34]).

(c) Third, when comparing the two signs/marks, what is relevant is the "imperfect recollection" of the customer (*MediaCorp* at [33], citing *Nautical Concept Pte Ltd v Jeffery Mark Richard* [2007] 1 SLR(R) 1071 at [30]). The court will not compare the two marks side by side and examine them in detail, because "the person who is confused often makes comparison from memory removed in time and space from the marks" (*MediaCorp* at [33], citing *Caterpillar* at [55]).

### (iii) *Distinctiveness*

19 As regards distinctiveness, the Court of Appeal in *Hai Tong* at [25] reiterated the explanation in *Sarika* at [20] that:

...the "distinctiveness" of the registered trade mark is a factor to be considered in the visual, aural and conceptual analysis to determine whether the allegedly infringing sign and the trade mark are similar. It stands to reason that the more distinctive the registered trade mark, the more it is necessary to show sufficient alterations to, or difference in, the sign in order that it may not be held to be similar to the trade mark.

The above principle similarly applies, beyond an infringement scenario, to an opposition where the similarity of the conflicting marks is in issue, such that the "distinctiveness" of the earlier trade mark relied on by an opponent is a relevant factor.

20 It was clarified in *Staywell* at [30] 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.

### *Similarity of Marks: Analysis*

#### (i) *Distinctiveness*

21 The parties had not made specific submissions on this point in the present case. There is no definition of the word “KIKO” in the English dictionary and it can essentially be treated as an invented word. Accordingly, I find that the Opponents’

Mark **KIKO** enjoys a high degree of inherent distinctiveness in relation to the specification claimed: soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices. Applying *Sarika*, it would be necessary to demonstrate a greater degree of difference in the Application Mark “*in order that it may not be held to be similar*” to the Opponents’ Mark.

(ii) *Visual Similarity*

22 The crux of the parties’ contention stems from the Applicants’ SD, which declared at paragraph 17 as follows:

The Applicant further disagrees with the Opponent’s assertion at paragraph 9 of the OSD that the stylization above the word “**KICHO**” in the Application Mark does not add to the distinctiveness of the Application Mark and that it is “merely decorative”. Firstly, the stylization is significantly larger than the

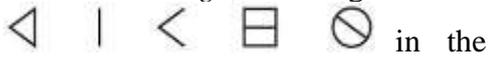


word “**KICHO**”: **K I C H O**. Secondly, the stylization is distinctive as it features a combination of unique shapes, including a triangle, divided rectangle and divided circle, which seem to spell out the word “**KICHO**”. Furthermore, the Applicant is seeking to register the Application Mark *as a whole*, including the stylization above the word “**KICHO**”, hence a visual comparison of both marks should also take into account *all forms of stylization* in the Application Mark.

23 The Opponents rely on [132] in *Han’s (F & B) Pte Ltd v Gustimo World Pte Ltd* [2015] 2 SLR 825 (“*Han’s*”), where Wei J opined that:

Where the mark and sign comprises nothing more than a word with the only difference being that the font in the sign is different, then the difference is immaterial given the holding that a mark registered in plain upper case text covers all stylistic permutations to the lettering.

24 They submit that the Opponents’ Mark is registered in “*plain upper case text*” and therefore “*covers all stylistic permutations to the lettering*”, inferring that this

included stylisation in the same font as  in the Application Mark. As the Applicants have claimed that  was a stylisation of the word “KICHO”, the Opponents argue that the Application Mark does not comprise design that is over and above typographical font so as to take the form of a logo. The comparison is therefore between the earlier mark “KIKO”



and the later mark, which, it was argued, could be taken as . The Opponents also took objection at the hearing that the Applicants now assert that

◁ | < ⊞ ⊙ was a device element, having declared in the Applicants' SD ([22] above) that this component was a stylised form of the word "KICHO".

25 On the other hand, the Applicants submit that ◁ | < ⊞ ⊙ is a device which is large and complicated, thus overshadowing the word element "KICHO". This is in contrast to the Opponents' Mark which does not contain any device element at all.

26 The Opponents' assertion cannot be right. The question is not whether the nomenclature "stylization", "font", "device" or "logo" is used. Neither can it be concluded that these terms are always mutually exclusive and in themselves determine the issue at hand, without inquiring what each party, or, even, the High Court, intended when such terms are used. It is also a stretch from the principles and findings in *Han's* for the Opponents to claim that since ◁ | < ⊞ ⊙ is a stylisation of the word "KICHO", with no additional decorative or design elements, the stylisation is not relevant for the purposes of mark comparison.

27 We will return to the marks-comparison analysis in *Han's* further below as we apply the principles of comparison between a word mark (the Opponents' Mark) and a composite mark (the Application Mark). If the Opponents' proposition that, in effect,

the marks under comparison were **KIKO** and **KICHO**  
KICHO, is not tenable, what is the correct approach to this inquiry?

28 The High Court decision in *Han's* is instructive in this regard, at [127] to [134]:

127 Composite marks, on the other hand, incorporate a dynamic range of visual elements, from graphics to colour to text. The words in a composite mark are but one of the numerous other elements that come together to produce the impression conveyed by the mark. Comparing a word mark with a composite mark is, in some senses, comparing apples with oranges.

128 The case law has taken two differing approaches to this comparison exercise. The first is where the court focuses *only* on the textual component of the composite mark and compares it against the word mark. This approach was adopted in *Doctor's Associates v Lim Eng Wah*. There, the court was comparing a registered word mark, "SUBWAY", with an allegedly infringing composite mark that incorporated the words "SUBWAY NICHE" as well as a graphic. For the purpose of determining visual similarity, the court appeared to consider *only* the textual components of the composite mark, "SUBWAY NICHE", with the registered word mark, "SUBWAY". The court concluded at [34] that both shared a common denominator in the word "SUBWAY" and were, therefore, similar. Further, the addition of the word "NICHE" made no difference to the question of similarity because of the distinctiveness of the "SUBWAY" mark. The court went on to say that the differences in font were irrelevant, for the reason mentioned above.

129 In *Doctor's Associates v Lim Eng Wah* ([123] *supra*), there was no express consideration of the graphical component of the “SUBWAY NICHE” composite mark, and whether that affected the similarity between the word mark and the composite mark.

130 A contrasting approach is seen in *Polo v Shop In*, where the court was comparing the registered word mark “POLO”, with an allegedly infringing composite mark that was a stylised depiction of the words “POLO PACIFIC”. The court took into account the “special font and *design*” [emphasis added] of the “POLO PACIFIC” composite sign in determining whether or not it was similar to the “POLO” word mark: *Polo v Shop In* at [24]. The court did not confine itself to a strictly textual analysis of the composite sign, as was done in *Doctor's Associates v Lim Eng Wah*.

131 I should also point out that the Court of Appeal eventually came to its decision on the back of the finding that the “POLO” trade mark comprised a common word that was lacking in inherent distinctiveness. Further, it was said that there was no evidence that distinctiveness had been acquired through use. It appears that it was the “low level” of distinctiveness in the “POLO” word mark that lay behind the Court of Appeal’s conclusion that the sign “POLO PACIFIC” in its special font and design was different from “POLO”.

132 In my view, what is required in carrying out the marks-similarity comparison is an assessment of *all aspects* of alleged similarities (aural, visual and conceptual) bearing in mind that the addressee is the reasonable or average consumer. In making the comparison, it is important to bear in mind the scope of the mark for which protection is claimed (is it a simple word mark or a mark comprising several words, are there visual elements built into the mark such as a logo or other device) and the scope of the defendant’s alleged sign. Is the sign simply a word or a word and a sentence or does it comprise design over and above typographical font such that it takes the form of a logo? Does the sign include a device of some sort, not by way of description, decoration or ornamentation but as part of the trade mark message of the sign – to indicate origin? Where the mark and sign comprises nothing more than a word with the only difference being that the font in the sign is different, then the difference is immaterial given the holding that a mark registered in plain upper case text covers all stylistic permutations to the lettering.

133 Returning to the facts of this case, I am of the view that the HAN sign is visually similar to the Han’s word marks. The shared common denominator “HAN” in both the HAN sign and the Han’s word marks is substantial. The only feature that separates them is the lack of a possessive modifier in the HAN sign. Further, the “HAN” word is a prominent part of the HAN sign. While the inclusion of “Cuisine of Naniwa” in the subtext and the *Kushikatsu* device decreases the similarity between the HAN sign and the Han’s word marks, I do not think they are sufficient to render the HAN sign visually dissimilar from the Han’s word marks.

134 In relation to the Han's composite marks, however, my conclusion is different. The composite marks depict the "Han's" lettering with considerable visual stylisation or embellishment that goes beyond mere font design. This is not a case where the word is expressed in plain block capitals. Indeed, one composite mark is limited to presentation in red colour. The addition of the stylisation has two effects. First, it decreases the similarity between the "HAN" text in the HAN sign, which is in a plain and minimalist font, and the "Han's" words, which are set out with considerable stylisation. Second, it emphasises the presence of the other visual elements in the HAN sign – the *Kushikatsu* device and "HAN" in gold lettering which add to the visual sophistication of the sign, as opposed to the Han's composite marks, which are simple, prominent and eye-catching.

29 It would also be pertinent to refer to the recent High Court decision in *Caesarstone Sdot-Yam Ltd v Ceramiche Caesar SpA* [2016] 2 SLR 1129 ("*Caesarstone*") (currently on appeal) as follows:

51 The starting point of the analysis is whether the common element of the competing marks is so dominant as to render the differing elements ineffective to obscure the similarity between them: see *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2005] 4 SLR(R) 816 at [26]-[27]. It bears recalling that the CAESARSTONE Mark is a composite of the device and the word "caesarstone" in lowercase. On the other hand, the CAESAR Mark consists of the word "CAESAR" in uppercase, encased within two dots, with a ligature between the letters "A" and "E".

52 The requirement to assess each mark as a whole merits some further discussion in the context of composite marks. In such cases, whilst it is permissible to examine the constituent elements of the composite mark as a step in the analysis, it is rightly stressed that the mark must ultimately be assessed as a whole: *Kerly's Law of Trade Marks and Trade Names* at para 8-072.

53 Where, however, all the other components are negligible, an assessment may be carried out solely on the basis of the dominant elements. It is, however, possible, as noted already, for a composite mark to not have any dominant feature. In *Ferrero SpA v Dochirnie Pidpriemstvo "Kondyterska Korporatsiia "Roshen"* [2015] SGIPOS 14, for instance, it was held at [41]:

Where both elements are equally dominant or significant in relation to each other, it will not be possible to compare just one of these elements (ie. "ROCHER") against the Applicants' ROSHEN Mark. *In order for me to do so, the element "ROCHER" must be considered to be dominant relative to the other elements in the mark as a whole. Only then can "special regard" be paid to it in determining similarity.* In the present case, the Opponents themselves do not draw this distinction between "ROCHER" and the other elements within the Opponents' Word Mark, or any of the other Opponents' Marks for that matter. In

view of the foregoing, I find that there is no dominant component in the Opponents' Word Mark. [emphasis added]

54 Particularly, in relation to a composite mark consisting of a word and a device, there is no presumption that the word speaks louder. Whether words do “talk” or indeed “shout” will depend ultimately on whether the words are the dominant element in the particular case in question: see *Hai Tong* at [62].

55 In *Hai Tong*, the Court of Appeal held that 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. It will be helpful to take a closer look at the case, in which the relative significance of the device and word elements of the following composite mark was considered:



56 The Court of Appeal set out a non-exhaustive list of principles that apply when assessing the visual similarity of composite marks (at [62]). In doing so, the Court of Appeal recognised that the device component of a mark may be of equal significance as the text or dominant where: (a) the device is significant and large; (b) the text is devoid of any distinctive character or purely descriptive of the device component; or (c) the device component is complicated. However, such dominance or co-dominance would not be found in cases where:

- (a) the device is simple and will not evoke any particular concept for the average consumer;
- (b) the device is commonly used in relation to the goods or services claimed; or
- (c) the device is more likely to be perceived as a decorative element than as an element indicating commercial origin.

57 In *Hai Tong*, the Court of Appeal found the rose device in the mark to be relatively insignificant for a few reasons (at [65]). First, the text was distinctive as the words “Lady Rose” conveyed no meaning and had no notional or allusive quality. The device, if anything, underscored the textual component by emphasising the “Rose” portion of “Lady Rose”. Second, the simple stylized rose did not draw any significant attention away from the text, and consumers would be far more likely to recall the text than the device. Moreover, the device was likely to be perceived as a decorative element as opposed to an indicator of origin.

30 In the present case, the composite mark consists of a device element  that is derived from the word element . The triangle in the device corresponds with the letter “K”; the vertical line is practically the same representation as the letter “I”; the sign  corresponds with the letter “C”;

the sign ☐ corresponds with the letter “H”; and, last, the sign ⊙ corresponds with the letter “O”.

31 Applying the principles above, I find that the device element and the word



element in the Application Mark <sup>K I C H O</sup> are equally dominant. (On the other side of the same coin, the Application Mark in effect has no dominant component.) The word element <sup>K I C H O</sup> itself conveys no meaning and is distinctive and dominant. The device element  is “significant and large”, and not “simple” (*Caesarstone* at [56]). Neither is it mere “decoration or ornamentation but ... part of the trade mark message of the sign – to indicate origin” (*Han’s* at [132]), especially since it echoes the word element “KICHO” in a highly stylised, and therefore visually allusive, form. Certainly, the device element “goes beyond mere font design” (*Han’s* at [134]). The High Court in *Caesarstone* also made clear, at [54], that “there is no presumption that the word speaks louder. Whether words do “talk” or indeed “shout” will depend ultimately on whether the words are the dominant element in the particular case in question”. In the present case, it would not be out of place to suggest that the device element visually “shouts” as loudly as the word element due to its placement above the latter, its larger size relative to the latter, and its evocative stylisation that draws the eye closer to it.

32 Having determined that, within the Application Mark, both device and word elements are equally dominant, I consider “whether the common element of the competing marks is so dominant as to render the differing elements ineffective to obscure the similarity between them” (*Caesarstone* at [51]).

33 It is trite that marks must be compared as wholes but, for a moment, we will compare the Opponents’ Mark with the word element “KICHO” in the Application Mark. The approach set out in *Ferrero* at [51] affords a handy, non-exhaustive checklist:

In the case of word marks, a determination of visual similarity typically involves looking at the (a) length of the marks; (b) structure of the marks (*i.e.*, whether there are the same number of words); and (c) whether the same letters are used in the marks (*Ozone Community* at [49], citing *Bently & Sherman, Intellectual Property Law* (Oxford University Press, 3rd Ed, 2009) at 865 (“*Bently & Sherman*”).

34 Length-wise, the Opponents’ Mark “KIKO” is four-letters long, one letter shorter than the Application Mark with five letters in the word element “KICHO”. Structurally, from the perspective of “whether there are the same number of words”, the respective marks both contain one word each. From another structural perspective, taking into account how each mark is composed, all the visual elements, such as shapes and layout, in the Application Mark combine to produce a visual impact that substantially differentiates the Application Mark from the Opponents’ Mark. Third, the issue whether the same letters are used in the marks is to be considered. The commonality between the Opponents’ Mark and the Application Mark lies in the letters “KI” at the start of the words and “O” at their end.

Conversely, the difference lies in one or two letters, “K” in the Opponents’ Mark and “CH” in the Application Mark. This exercise is conducted at a high degree of granularity, but it must be borne in mind that the objective of comparing the marks for common letters is to help ascertain whether these marks can be said to be visually similar *as wholes*. That there are more letters in common than not does not necessarily lead to a conclusion that the marks are therefore similar.

35 In *Han’s*, the following marks were found similar:

Han’s word marks (Plaintiffs’)	The HAN sign (Defendants’)
<p style="text-align: center;"><b>Han’s</b> <b>HAN’S</b></p>	

36 The reasons were articulated by the High Court at [133] of *Han’s*:

The shared common denominator “HAN” in both the HAN sign and the Han’s word marks is substantial. The only feature that separates them is the lack of a possessive modifier in the HAN sign. Further, the “HAN” word is a prominent part of the HAN sign. While the inclusion of “Cuisine of Naniwa” in the subtext and the *Kushikatsu* device decreases the similarity between the HAN sign and the Han’s word marks, I do not think they are sufficient to render the HAN sign visually dissimilar from the Han’s word marks.

37 In the present case, the features that separate the common letters “KI” and “O” in both the Opponents’ Mark and the Application Mark are more than a possessive modifier (as in *Han’s*). The words themselves are short, so the differences in letters (“K” versus “CH”) would be more amplified as compared to longer marks. The learned Wei J also considered the design elements and subtext of the defendants’ sign in *Han’s* and found them not sufficient to render the respective marks visually dissimilar. In contrast, in the present case, I have found that the device element ◁ | < ◻ ⊙ is as dominant as the word element K I C H O. Hence, the similarity in certain letters (“KI” and “O”) is readily outweighed by the dominance of the device element ◁ | < ◻ ⊙. As opined in another decision by the Assistant Registrar of Trade Marks, *Ferrero SpA v Dochirnie Pidpriemstvo "Kondyterska Korporatsiia "Roshen"* [2015] SGIPOS 14, at [41]:

Where both elements are equally dominant or significant in relation to each other, it will not be possible to compare just one of these elements (ie. "ROCHER") against the Applicants' ROSHEN Mark. In order for me to do so, the element "ROCHER" must be considered to be dominant *relative to* the other elements in the mark as a whole. Only then can "special regard" be paid to it in determining similarity.

The above observations were made in relation to the following marks, which were eventually found not visually similar:

Opponents' Word Mark FERRERO ROCHER	Applicants' ROSHEN Mark 
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38 Likewise, in the present case, it would not be possible to compare just the word element “KICHO” with “KIKO”. Regard must be had to the equally dominant



element in the composite mark . In an assessment of visual similarity, generally, “considerable visual stylisation or embellishment that goes beyond mere font design” is significant, as opined by Wei J in *Han’s* at [134]:

In relation to the Han’s composite marks, however, my conclusion is different. The composite marks depict the “Han’s” lettering with considerable visual stylisation or embellishment that goes beyond mere font design. This is not a case where the word is expressed in plain block capitals. Indeed, one composite mark is limited to presentation in red colour. The addition of the stylisation has two effects. First, it decreases the similarity between the “HAN” text in the HAN sign, which is in a plain and minimalist font, and the “Han’s” words, which are set out with considerable stylisation. Second, it emphasises the presence of the other visual elements in the HAN sign – the *Kushikatsu* device and “HAN” in gold lettering which add to the visual sophistication of the sign, as opposed to the Han’s composite marks, which are simple, prominent and eye-catching.

The above finding was made in relation to the following marks:

Han’s composite marks (Plaintiffs’) 	The HAN sign (Defendants’) 
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39 If the stylisation in the plaintiffs’ composite marks in *Han’s* had such a significant bearing on the divergence in visual impression between the marks under comparison, all the more, in the present case, the design element, being a whimsically stylised element derived from the word “KICHO”, serves to distinguish the visual

impression between the Opponents’ Mark  and the Application Mark



40 I also bear in mind my earlier finding at [21] that the Opponents’ Mark enjoys a high degree of inherent distinctiveness. However, even with a higher threshold of

difference required of the Application Mark “in order that it may not be held to be

similar” to the Opponents’ Mark, I am persuaded that  is not visually similar to .

(ii) Aural Similarity

41 A determination of aural similarity involves, as the Court of Appeal in *Sarika* opined at [28], “a quantitative assessment of the relative number of syllables which the two marks have in common”. At [30]-[31], the court also endorsed the consideration of “how an average Singaporean consumer would pronounce the respective words” and the making of “allowances for imperfect recollection and careless pronunciation and speech”.

42 In this regard, the Opponents argue that the letters “CHO” in the Application Mark may be pronounced as “KO”, or that “CH” may be pronounced as “K”. They rely on a list of 285 English words and names in which “CH” is pronounced as “K”. Examples include “anchor”, “character”, “epoch” and “technology”.

43 The Opponents point out that pronouncing “KICHO” as “KIKO” would result in complete identity of the Opponents’ Mark and the Application Mark aurally. They also rely on [137] in *Han’s* for the proposition that “Adequate allowance must be made for imperfect recollection and careless pronunciation and speech... the slightest mispronunciation would result in complete identity”. I note that in *Han’s*, the learned judge compared the aural pronunciations of “Han’s” versus “Han”, where obviously, “the slightest mispronunciation would result in complete identity”. The same is not so in the present case. Further, at the hearing, the Opponents were asked but were not able to point out any word in the English language (i) which contains both “ch” and “k” (such as “kitsch”); and (ii) where the “ch” component is pronounced “k”. The 285 English words on the Opponents’ list fulfilled the latter criteria but not the first as well. I would therefore hesitate to accept that an average consumer in Singapore is likely to pronounce “KICHO” as “KIKO”.

44 The Applicants submit that the relevant test is how the average consumer in Singapore would pronounce the words involved, and not simply whether “CH” could validly be pronounced “K”. They argue that even if it were technically possible that the syllable “CHO” may be pronounced as “KO”, that was by no means how the average Singaporean would instinctively pronounce the Application Mark. They suggest that the average consumer in Singapore would instinctively refer to simple and common words such as “poncho” or “macho” when pronouncing the Application Mark. The primary phonetic rule is that “CHO” would be pronounced the way it is in “poncho” and “macho”, whilst pronouncing “CHO” as “KO” would be the exception to the rule.

45 Alternatively, the Applicants submit, the average consumer in Singapore is brand conscious, citing the Registrar’s decision in *Kabushiki Kaisha Chantelle v Chantelle* [2003] SGIPOS 18 (“*Chantelle*”) at the top paragraph of page 6 of 11:

... However, whether educated or English speaking, one fair assessment of the average Singaporean consumer is that they are brand conscious. Even a person

who is not highly educated and/or who does not speak English commonly is likely to know how to pronounce Chanel and Elle...

This, the Applicants contend, means that the average consumer in Singapore is likely to be sensitive to the correct and intended pronunciation of consumer brand names, even if they are not dictionary words.

46 In connection with the foregoing point, the Applicants also tendered in evidence, as Exhibit D of the Applicants' SD, audio recordings from Korean radio broadcasts to demonstrate that the actual pronunciation of "KICHO" is "*kit-cho*". The Opponents, however, object to the relevance of this, since aural similarity should be determined from the perspective of the consumer in Singapore, not Korea. There is a nuance to the Applicants' submission, which is that the Applicants' advertising and promotion efforts *in Singapore* involve the promulgation of the accurate (Korean) pronunciation of the Application Mark such that, consequently, the average brand conscious consumer *in Singapore* would pronounce "KICHO" as "*kit-cho*" (though this is not supported by evidence). The Opponents' second objection is, then, that the Applicants' advertising and promotion efforts in Singapore are not relevant to a consideration of marks-similarity, relying on [20] of *Staywell*:

... the assessment of marks similarity is mark-for-mark without consideration of any external matter...

47 Indeed, how a mark is in fact marketed and promoted is not relevant at the first stage of the three-step test under Section 8(2)(b). (Differences in the parties' marketing methods and channels are also not permissible extraneous factors to be considered at the third stage of the inquiry, that of likelihood of confusion: *Staywell* at [102].) However, a consideration of how the average Singapore consumer would pronounce the marks is apposite. In this context, evidence that an average consumer in Singapore would be aware of the correct Korean pronunciation and is likely to pronounce "KICHO" as "*kit-cho*" would be relevant. Yet, the Applicants have not established this of the average consumer in Singapore. Exhibit D of the Applicants' SD does not go so far. There is in fact no evidence to suggest that the average consumer in Singapore is likely to pronounce "KICHO" as "*kit-cho*". It is more reasonable to believe that the consumer in Singapore would pronounce "KICHO" as "*key-cho*" (accepting the Applicants' submission described at [44] above). Neither the Applicants' alternative suggestion ("*kit-cho*") nor the Opponents' strained pronunciation ("*ki-ko*") comes to mind as the natural pronunciation by an average consumer in Singapore of the word "KICHO". Such consumers may be brand conscious (as found in *Chantelle* above), but one would not necessarily assume that they could always pronounce foreign consumer brand names accurately.

48 As such, the aural comparison of the Opponent's Mark and the Application Mark comes down to a comparison of the pronunciations "*ki-ko*" and "*key-cho*". While the first syllable of each mark is identical, their second syllables differ. However, even as between the different second syllables, I note that they share the same vowel, "O", and therefore rhyme.

49 Applying the "*quantitative assessment of the relative number of syllables which the two marks have in common*" in *Sarika*, there is no clear answer because both

marks have one syllable in common and one syllable not in common. However, as opined by Luxmoore LJ and cited with approval by the House of Lords in *Aristoc, Ld v Rysta, Ld* [1945] RPC 65, 72, "*the answer to the question whether the sound of one word resembles too nearly the sound of another... must nearly always depend on first impression.*" When the respective marks here are pronounced, it does appear to me that there is some aural similarity, albeit to a small degree. The first syllable is identical and the respective second syllables rhyme because of a common vowel. I may be slow to find another word with the same first syllable but a different vowel in the second syllable (such as "KICHA", "KICHI" or "KICHU") similar to "KIKO", but where the pronunciations "ki-ko" and "key-cho" are concerned, as a matter of "*first impression*", I am prepared to find that the Application Mark is marginally aurally similar to the Opponents' Mark.

(iii) *Conceptual Similarity*

50 The Opponents submit that although "KICHO" in the Application Mark and "KIKO" in the Opponents' Mark are invented words, they are still conceptually similar since both start with the letters "KI" and end with the letter "O" and are aurally identical.

51 The Applicants refer to the Court of Appeal decision in *Sarika* at [34] and submit that where two marks are meaningless, they cannot be said to be conceptually similar.

52 I am persuaded by the Applicants' submissions and conclude that there is no conceptual similarity between the Application Mark and the Opponents' Mark. It is trite law that conceptual similarity involves the consideration of the ideas that inform the marks in question. Where the marks are meaningless, they do not evoke any idea to a level of specificity as to possess what can be said to be a concept. Hence, there is no basis for a conceptual comparison of such marks in the first place. Therefore, such marks cannot be said to be conceptually similar.

(iv) *Conclusion on Similarity of Marks*

53 The Court of Appeal decision in *Staywell* made clear two points, among others, when concluding whether or not two marks are similar.

54 First, there is no "*particularly or notably low threshold of marks-similarity*", *Staywell* at [16]. The Court of Appeal went to some length to clarify at [17]-[18] as follows:

... 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.

... 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*...

55 Second, "*the assessment of marks similarity is mark-for-mark without consideration of any external matter*". The Court of Appeal elaborated at [20]:

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].

56 I therefore consider whether the respective marks, "*when observed in their totality, are similar rather than dissimilar*", noting the Court of Appeal's rejection of the suggestion that "*any modicum of similarity would compel the court to make a finding of marks-similarity*" at [19] of *Staywell*.

57 Earlier on, I have found that the respective marks were not visually nor conceptually similar but as a matter of "*first impression*" may be marginally aurally similar. Given that "*trade-offs can occur between the three aspects of similarity in the marks-similarity inquiry*" ([18] of *Staywell*), I find that the Application Mark and the Opponents' Mark are dissimilar rather than similar in their totality.

58 The similarity of the competing marks is a "*threshold requirement that had to be satisfied before the confusion inquiry is undertaken*": [15] of *Staywell*. Given that the threshold requirement has not been met, this is enough to dispose of the matter in favour of the Applicants.

59 Nevertheless, I will also consider the elements of goods-similarity and likelihood of confusion under Section 8(2)(b) in the event I am wrong in finding no marks-similarity.

#### *Identity or Similarity of Goods*

60 The Opponents submit that the Application Mark is sought to be registered in respect of goods in Class 3 (set out at [1] above) that are identical or similar to the goods for which the Opponents' Mark is registered in the same class (set out at [10] above).

61 The Applicants did not address this in their written submissions nor at the hearing, and understandably so. I am readily persuaded that the respective goods

claimed by the marks are similar. They are generally in the nature of cosmetics and hair products in Class 3.

62 Accordingly, I am satisfied that the second element of identity or similarity of goods under Section 8(2)(b) is made out.

*Likelihood of Confusion: Principles*

63 As indicated at [58] above, I have not found marks-similarity at the first stage of the 3-step enquiry under Section 8(2)(b) of the Act. The enquiry effectively ended then. However, in the event I am wrong on the lack of marks-similarity, I continue with a consideration of the likelihood of confusion at the third stage of the enquiry following an analysis of goods-similarity at the second stage. The following assessment is based on the premise that the Application Mark is *marginally* more similar to the Opponents' Mark than not.

64 The decision in *Staywell* is seminal for its clarification on major points in trade marks law. At [55] of *Staywell*, the Court of Appeal restated as follows:

... Once these threshold criteria have been met, the issue of the likelihood of confusion arises and this in our view directs the court to look at (a) *how* similar the marks are (b) *how* similar the services are and (c) given this, how likely the relevant segment of the public will be confused. In *Hai Tong* we said (at [85(c)]):

Having regard to the express terms of s 27(2), there are three specific elements that plainly must be considered. These are: (i) the similarity between the registered mark and the allegedly infringing mark; (ii) the similarity or identity between the goods or services in relation to which the marks are used; and (iii) the relevant segment of the public in relation to whom the court must consider the likelihood of confusion. Each of these elements can vary. The marks may be identical or similar, and if the latter, they can vary in their degree of similarity. In the same way, the goods or services in relation to which the marks are used may be identical or similar, and again, if the latter, they may vary in the degree or extent to which they are similar. ... And as to the relevant segment of the public, there may be characteristics that are particular to the group in question. Each of these factors will have a bearing on the likelihood of confusion. As an illustrative proposition, the likelihood of confusion must be greater where, say, the contesting marks are similar to a high degree, the goods are identical in nature and the segment of the public in question is undistinguished in its attention than would be the case if the marks and the goods are somewhat similar but not exceedingly so, and the relevant segment of the public happens to be highly knowledgeable and very fastidious. ...

*(i) Notional Fair Use*

65 The Court of Appeal in *Staywell* clarified the approach to determining likelihood of confusion at [60] and [62]:

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. This is the setting in which the question of whether there is a likelihood of confusion is assessed...

62 ... It would still be necessary to consider the wider question of whether the notional fair uses that the applicant might put the mark to could conflict with the notional fair uses to which the proprietor of the registered mark could put his mark to. As we have noted, this latter inquiry sets a higher threshold for the applicant than an inquiry that focuses only on whether the actual use is infringing, and it follows that as a practical matter, in opposition proceedings, the applicant will have to meet that higher threshold regardless of whether there has already been actual use. In essence, in such proceedings, he will be required to establish that the notional fair use of his mark would not infringe the notional fair use rights of the registered proprietor; whereas in infringement proceedings the only question is whether the actual use by the alleged infringer infringes the notional fair use rights of the registered proprietor of the mark...

66 Hence, while the Applicants may have used the Application Mark with other Korean text on their product packaging, advertisements and promotional material, thus highlighting the Korean heritage of their mark, the broader possibilities of notional fair use cannot be dismissed from consideration. For example, notional fair use of the Application Mark could involve its standalone use without Korean text or embellishments suggestive of Korea at all. The Applicants' argument that the different trade sources of goods using the Application Mark (Korea) and of goods using the Opponents' Mark (Milan, Italy) have an impact on the consumers and reduces the likelihood of confusion therefore does not go far.

(ii) *Extraneous Factors*

67 In *Staywell*, the Court of Appeal also affirmed the relevance of extraneous factors "*to the extent 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*", at [83].

68 On the specific types of extraneous factors that are permissible, we have guidance in the conclusion at [95]-[96] of *Staywell*:

95 Although the risk of origin-based confusion is the primary interest sought to be protected by trade mark law, there must be a limit to the range of external factors that may be taken into account to determine whether a sufficient likelihood of such confusion exists. The permissible factors are those which (a) are intrinsic to the very nature of the goods and/or (b) affect

the impact that the similarity of marks and goods has on the consumer. The impermissible factors are those differences between the competing marks and goods which are created by a trader's differentiating steps. In other words, factors which are not inherent in the goods, but are susceptible to changes that can be made by a trader from time to time, should not be permissible considerations. In particular, we are satisfied that it is unnecessary, unworkable and impermissible for the court to have regard to such issues as pricing differentials, packaging and other superficial marketing choices which could possibly be made by the trader. In contrast, extraneous factors that relate to the *purchasing practices* and *degree of care* paid by the consumer when acquiring goods of the sort in question, can be considered and assessed without descending into the details of particular differentiating steps which the trader might choose to take in relation to the goods and services falling within the specification.

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* ([18] *supra*) at [85(c)(iii)], the reputation of the marks (see *Polo (CA)* ([8] *supra*) 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* ([23] *supra*) at 1352; and *Phillips-Van Heusen Corp v OHIM* ([20] *supra*) 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 Limited for the Registration of a Trade Mark* (1906) 23 RPC 774 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.

*Likelihood of Confusion: Analysis*

*(i) Factors Relating to the Impact of Marks-Similarity on Consumer Perception*

69 Having regard to the degree of similarity of the marks themselves, I have held that the marks are not similar on the whole. However, if I were wrong on this and were to accept that there is marks-similarity, I would be inclined to say that the Application Mark is only marginally more similar to the Opponents' Mark than not. Hence, this factor in the consideration of likelihood of confusion lies in the Applicants' favour – "*Clearly, the greater the similarity between the marks, the greater the likelihood of confusion*" ([96] of *Staywell*) and conversely, the lesser the similarity between the marks, the lower the likelihood of confusion.

70 As to the reputation of the earlier marks, the Court of Appeal in *Staywell* cited with approval (at [96]) *Mobil Petroleum Co, Inc v Hyundai Mobis* [2010] 1 SLR 512 at [74], where it was made 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 (at [64]). In the present case, the Opponents have given no evidence on the reputation of the Opponents' Mark; and so nothing turns on this factor.

71 The impression given by the respective marks also differs. As examined at some length at the first stage of the three-step test, when visual similarity of the marks was considered, the design element of the Application Mark occupies a large part of the visual consciousness in the consumer's mind. The design element in



is placed above the word element in a more prominent position and is of a larger size than the word element. The contrast with the plain word mark that is the Opponents' Mark is great, and thus, the respective impression of each mark differs significantly from the other. It would be hard for a consumer to shake off the deep impression left by the design element  from his recollection, even given that such recollection could be imperfect. This factor is also in the Applicants' favour.

*(ii) Factors Relating to the Impact of Goods-Similarity on Consumer Perception*

72 The relevant goods under consideration here are those as claimed in the specifications of the Application Mark and the Opponents' Mark respectively set out at [1] and [10] above. The similar goods are generally in the nature of cosmetics and hair products in Class 3.

73 The Applicants have helpfully referred to the Registrar's decision in *Carita v Pardaco Trading Pte Ltd* [2009] SGIPOS 10 at [45]-[46], where the Registrar made the following observations on the relevant goods in that opposition:

45 It is not in dispute that the Applicant's and the Opponent's products are similar goods, that is, beauty products and cosmetics which include skincare and haircare products. These are personal products applied directly onto the face, body or hair for use. Consumers buy these products not only to maintain but more importantly, to enhance their looks. Higher-end or luxury cosmetic or skincare products are not generally bought at whim and are likely to be scrutinised before purchase, hence they are less susceptible to confusion for the degree of attention and amount of care is exercised by the consumer is greater.

46 The cosmetics and beauty industry is highly competitive in nature. One simply has to walk into the cosmetics and beauty hall of any departmental store and will be assaulted by the vast array of brands of beauty and cosmetics products. There is a proliferation of different brands and products to choose from; from the lower-end range to the much higher-end luxury products. Under such circumstances, consumers will be more likely to pay attention to the products and their marks in their quest to ensure that they are buying exactly what they are looking for. In general, beauty and cosmetics products are bought after much thought and consideration, and it is not unusual that consumers of these products would exercise some form of brand loyalty and will be more discerning; further lessening any likelihood of confusion.

74 Similar observations relating to the circumstances surrounding the selection and purchase of personal care products for the body were made in the Registrar's decision in *Sebapharma GmbH & Co v Cidore Holding Limited* [2010] SGIPOS 10.

75 On the other hand, the Opponents claim that the respective goods exist in an already crowded market. The typical consumers of such items are unlikely to spend a significant amount of time inspecting each offering, and as such, their attention to the details of the differences between the marks is likely to be lessened.

76 Having regard to the nature of the goods - cosmetics and hair products - I am inclined to believe that consumers would exercise a fair degree of care in their selection and purchase. These are not daily necessities, and while not necessarily luxuries, cosmetics and hair products are "nice-to-haves" that, when appropriately used, enhance or extend the consumer's self-image. This tends to suggest that the consumer of such goods would be rather purposeful and discriminating in selecting cosmetics or hair products suitable to himself or herself, even if the market is as relatively crowded as the Opponents claim.

77 Cosmetics and hair products can be self-serve, off-the-shelf items, or can be sold at beauty booths or beauty stores with the assistance of sales personnel, or can even be sold through hair and beauty salons by the recommendation of hair stylists and beauticians at these salons. Price-wise, cosmetics and hair products fall within a range, from schoolgirl-friendly prices to prices that could require some saving up by working adults. The upshot of this is that there is a variety of circumstances under which consumers would buy cosmetics and hair products. If it is a budget conscious consumer selecting a product from off the shelf, he or she would have the opportunity to spend “*a modicum of attention and reflect on what he is examining, at least for a moment that is longer than ‘in a flash’*”: see *The Polo/Lauren Company L.P. v United States Polo Association* [2002] 1 SLR 326 at [9]. If it is a consumer selecting cosmetics and hair products in the beauty hall of a department store, he or she would be exposed to a range of brands and products available, especially if with the assistance of sales personnel and brand ambassadors, and would have the opportunity to compare options in a deliberate way before selecting a personal product suitable for himself or herself. For higher end, more expensive cosmetics and hair products, the consumer would have even more opportunity to apprehend and discern the respective brands and exercise more care and fastidiousness before committing good money to the purchase.

78 Thus, the factors relating to goods-similarity are also in the Applicants’ favour.

*(iii) Korean Decision*

79 The Applicants would also have me give weight to the outcome of a similar dispute between the parties in Korea. The Korean Intellectual Property Office (“KIPO”) found that the same marks were not similar in visual appearance, concept and pronunciation. On the issue of confusion, KIPO found that “*concurrent use of both marks would pose no or little danger of causing any confusion or misperception as to the source or quality of the goods or misleading the consumers because they are not similar to each other.*” The Applicants submit that the applicable legal principles in Korea and Singapore were similar, and as such, the outcome in Korea should be persuasive in Singapore.

80 I have considered the grounds of decision by KIPO and noted the principles and considerations applied towards the finding that the competing marks were not confusingly similar. However, some considerations under Section 8(2)(b) of the Act are firmly rooted in the Singapore context. For instance, in determining aural similarity in the first stage of the three-step test, the reference point is how the average consumer *in Singapore* is likely to pronounce the marks. At the third stage of the three-step test, the assessment revolves around whether there is a reasonable likelihood of confusion *in Singapore*, again with the average Singapore consumer as a reference point. Therefore, while I have sight of the decision by the Korea IP Office, I am aware of the limitations to its relevance to the present proceedings. In coming to my conclusion on the likelihood of confusion below, I have not given any weight to the parallel proceedings in Korea.

*(iv) Conclusion on Likelihood of Confusion*

81 Taking into account the permissible extraneous factors, I do not find a reasonable likelihood of confusion by the consuming public in Singapore that goods bearing the Application Mark and the Opponents' Mark emanate from the same or economically linked undertakings.

### **Conclusion**

82 Having considered all the pleadings, evidence and submissions made in writing and orally, I find that the opposition fails on its sole ground under Section 8(2)(b) of the Act. Accordingly, the Application Mark shall proceed to registration.

83 The Applicants are also entitled to all costs to be taxed, if not agreed. For avoidance of doubt, as the Opponents abandoned their ground of opposition under Section 8(7)(a) after the Pre-Hearing Review without notice to the Applicants and Registrar before the written submissions were due, the Applicants are entitled to their costs thrown away for work done in relation to Section 8(7)(a).

Dated this 20<sup>th</sup> day of May 2016

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See Tho Sok Yee

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