

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

Trade Mark Application No. T1308820H
17 May 2016

IN THE MATTER OF A TRADE MARK APPLICATION BY

MMC INTERNATIONAL SERVICES PTE LTD

AND

OPPOSITION THERETO BY

ABERCROMBIE & FITCH EUROPE SAGL

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

Ms Eileen Chong (Drew & Napier LLC) for the Opponents

Cur Adv Vult

GROUND OF DECISION

1 This is an opposition to the registration of the following trade mark T1308820H ("Application Mark"):



in relation to the following goods in Class 09:

Anti-dazzle spectacles; bars for spectacles; bows adapted for spectacle frames; carrying cases adapted for spectacles; cases adapted for spectacles; chains for spectacles; computer programs for use in fitting spectacles; containers for spectacles; cords for spectacles; devices for supporting spectacles; devices in the nature of spectacles for displaying televised images; devices in the nature of spectacles for viewing recorded video images; devices in the nature of spectacles for viewing televised images; finished lenses for spectacles; fitted cases for spectacles; frames for spectacles; lenses for spectacles; lorgnettes (spectacles); optical lenses for use with spectacles; optical spectacles; protective glasses (spectacles); protective spectacles; safety spectacles; spectacle cases; spectacle chains; spectacle frames; spectacle frames having elastic hinges; spectacle holders; spectacle lenses; spectacle mountings; spectacle support bands, chains, cords, and straps; spectacles; spectacles (optics); spectacles for sports; spectacles used in information science; sport glasses (protective spectacles); sport glasses (spectacles); sports glasses (spectacles); straps for spectacles; sun spectacles.

2 MMC International Services Pte Ltd (“the Applicants”) applied to protect the Application Mark in Singapore on 4 June 2013. The application was accepted and published on 30 January 2014 for opposition purposes. Abercrombie & Fitch Europe SA (now known as Abercrombie & Fitch Europe SAGL) (“the Opponents”), filed their Notice of Opposition to oppose the registration of the Application Mark on 23 May 2014. The Applicants filed their Counter-Statement on 18 July 2014. The Opponents filed evidence in support of the opposition on 20 March 2015. The Applicants filed evidence in support of the application on 21 September 2015. The Opponents subsequently filed their evidence in reply on 17 December 2015. The Pre-Hearing Review was held on 19 January 2016 and the hearing was set for 17 May 2016.

Grounds of Opposition

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

Opponents’ Evidence

4 The Opponents’ evidence comprises the following:

- (i) Statutory Declaration by Mr Reid M. Wilson, Authorised Representative of the Opponents, dated 16 March 2015 (“the Opponents’ 1st Evidence”);
- (ii) Statutory Declaration in Reply by Mr Reid M. Wilson, dated 9 November 2015 (“the Opponents’ 2nd Evidence”);

Applicants’ Evidence

5 The Applicants’ evidence comprises a Statutory Declaration made by Mr Neo Teck Joo, Director of the Applicants dated 18 September 2015 (“the Applicants’ Evidence”).

Applicable Law and Burden of Proof

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

Background

7 The Opponents are a subsidiary of Abercrombie & Fitch Co., as is Abercrombie & Fitch Trading Co. Abercrombie & Fitch Trading Co. is the holding company for trade mark applications and registrations in the United States of America (USA) and Canada. The Opponents are the holding company for trade mark applications and registrations worldwide, excluding USA and Canada, but including Singapore (see paragraph 10 of the Opponents’ written submissions). Thereafter, the term “Opponents” will be used to refer to the Opponents as well as their related entities as provided above.

8 The Opponents deposed at paragraph 7 of the Opponents’ 1st Evidence that the trade mark “A & F” is a well-known acronym of the Opponents’ brand and that trade mark “Abercrombie & Fitch” has been in use in the USA since at least 1902 while the “A & F” trade mark has been in use in the USA since at least as early as 1978.

9 At paragraph 8 of the Opponents’ 1st Evidence, the Opponents deposed that the “A & F” trade mark has been in use in Singapore since at least 2002 when goods purchased on the Opponents’ website were shipped to Singapore. Further, the Opponents deposed at paragraph 9 of the Opponents’ 1st Evidence that the Opponents’ boutique in Orchard Road opened in 2011 such that goods bearing the “A & F” trade mark have been sold from the physical boutique since then.

10 In relation to the device of a moose () (“the Moose Device”), the Opponents deposed at paragraph 19 of the Opponents’ 1st Evidence that it has been in use in the USA since 2002. In relation to Singapore, the Opponents deposed at paragraph 20 of the Opponents’ 1st Evidence that the Moose Device has been in use in Singapore since

2002 when goods purchased on the Opponents' website were shipped to Singapore. Further, as mentioned above, the Opponents' boutique in Orchard Road opened in 2011 such that goods bearing the Moose Device have also been sold from the physical boutique since then (paragraph 21 of the Opponents' 1st Evidence).

11 The Opponents relied on the following earlier marks ("collectively the Opponents' Earlier Marks", "Opponents' Earlier "A&F" Mark" and "Opponents' Earlier Moose Device Mark" respectively as indicated in the table below - paragraphs 4 and 5 of the Opponents' 1st Evidence):

S/N	<i>Opponents' Earlier Marks</i>	Class
<i>Opponents' Earlier "A&F" Marks</i>		
1	A&F T1117126D	<p>Class 14 Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewelry, precious stones; timepieces and chronometric instruments.</p> <p>Class 18 Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins; trunks and traveling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.</p>
2	A&F T0002872D	<p>Class 03 Personal care products, namely, nail polish, nail polish remover, nail stencils, hard artificial nails, shower gel, bubble bath, fragrant body splash, hand lotion, body lotion, face lotion, hand soap, body soap, face soap, hair shampoo, hair conditioner, hair styling gel, hair spray, hair dyes, hair rinses, perfume, cologne, body glitter, mascara, blush, eye shadow, lip stick, lip gloss, make-up, make-up remover, eyecream, hand cream, body cream, face cream, astringent for the face, face cleanser, bath oil, bath beads, body powder, face powder, liquid talcum powder, non-medicated blemish stick, shaving cream, deodorant, potpourri, air freshening room spray, incense, sachets, scented beads, body and face suntanning lotion, body and face sunless tanning lotion, body and face pre-suntanning lotion and body and face after suntanning lotion in International Class 3.</p>
3	A&F T0002873B	<p>Class 25 Clothing, footwear, headgear.</p>

4	A&F T0002874J	Class 35 Retail store services in relation to clothing and personal care products; all in Class 35.
5	A&F T0202014C	Class 35 The bringing together, for the benefit of others of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise catalogue by mail order.
6	A&F T0721760C	Class 25 Clothing, footwear, headgear; clothing, namely, bathrobes, beach cover-ups, beachwear, belts, blazers, blouses, body shapers [foundation garments], body suits, boxer shorts, bras, bustiers, camisoles, caps, coats, dresses, footwear, foundation garments, garter belts, girdles, gloves, gowns, halter tops, hats, headbands, hosiery, jackets, jeans, jogging suits, knee high stockings, knit shirts, knit tops, leotards, lingerie, loungewear, mittens, negligees, night gowns, night shirts, pyjamas, panties, pants, pantyhose, sarongs, scarves, shirts, shorts, skirts, slacks, sleepwear, slippers, socks, stockings, suits, sweat pants, sweat shirts, sweat shorts, sweat suits, sweaters, swim wear, t-shirts, tank tops, tap pants, teddies, ties, tights, underpants, undershirts, underwear and vests.
7	A&F T1111521F	Class 35 Advertising; business management; business administration; office functions; retail store services connected with clothing, footwear, headgear, soaps, perfumes, essential oils, cosmetics, hair lotions, jewellery and bags; online retail store services connected with clothing, footwear, headgear, soaps, perfumes, essential oils, cosmetics, hair lotions, jewellery and bags.
<i>Opponents' Earlier Moose Device Marks</i>		
8	 T1314410H	Class 24 Textiles and textile goods not included in other classes; bed and table covers.
9	 T0721747F	Class 03 Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; personal care products, namely, nail polish, nail polish remover, nail stencils, hard artificial nails, shower

		<p>gel, bubble bath, fragrant body splash, hand lotion, hand soap, body soap, face soap, hair shampoo, hair conditioner, hair styling gel, hair spray, hair dyes, hair rinses, perfume, cologne, aftershave lotion, aftershave balm, toilet water, talcum powder, face lotion, body lotion, hair lotion, bath oil, scented sachets, shaving soap, shaving cream, body shampoo, body glitter, mascara, blush, eye shadow, lip stick, lip gloss, make-up, make-up remover, eyecream, hand cream, body cream, face cream, astringent for the face, face cleanser, bath beads, body powder, face powder, nonmedicated blemish stick, deodorant, potpourri, air freshening room spray, incense, scented beads, body and facesuntanning lotion, body and face sunless tanning lotion, body and face pre-suntanning lotion and body and face after suntanning lotion.</p> <p>Class 14 Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments; jewelry, namely, necklaces and bracelets.</p> <p>Class 18 Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; backpacks, duffel bags, gym bags, handbags, tote bags, travel bags, purses, wallets, luggage, key cases, credit card cases, brief cases, cases for toiletries and umbrellas.</p> <p>Class 25 Clothing, footwear, headgear; clothing, namely, bathrobes, beach cover-ups, beachwear, belts, blazers, blouses, body shapers [foundation garments], body suits, boxer shorts, bras, bustiers, camisoles, caps, coats, dresses, footwear, foundation garments, garter belts, girdles, gloves, gowns, halter tops, hats, headbands, hosiery, jackets, jeans, jogging suits, knee high stockings, knit shirts, knit tops, leotards, lingerie, loungewear, mittens, negligees, night gowns, night shirts, pyjamas, panties, pants, pantyhose, sarongs, scarves, shirts, shorts, skirts, slacks, sleepwear, slippers, socks, stockings, suits, sweat pants, sweat shirts, sweat shorts, sweat suits, sweaters, swim wear, t-shirts, tank tops, tap pants, teddies, ties, tights, underpants, undershirts, underwear and vests.</p> <p>Class 35 Retail store services in relation to clothing, footwear, headgear, bags, accessories and personal care products.</p>
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Based on the above list, it would appear that the Opponents do not have any marks in Class 9, nor any “composite” marks comprising the letters “A&F” and the Moose Device. This will be discussed further below.

12 The Applicants did not provide any information as to their background whether in the Counter-Statement, Applicants’ Evidence or written submissions. In this regard, please see comments below.

Preliminary Comment

13 As a preliminary comment, the Applicants did not attend the hearing. The Applicants indicated, via an email letter dated 14 April 2016 enclosing their written submissions, that they would not be attending the hearing. The Applicants submitted that all the relevant information has been provided, via the documents tendered, in relation to the case. In this regard, the documents tendered from the Applicants’ end are (i) the Counter-Statement; (ii) the Applicants’ Evidence; and (iii) the Applicants’ written submissions.

14 Further, a look at the documents referred to above will reveal that very little information has been provided. As alluded to above, the Applicants did not provide any information as to their corporate background nor any other further information in relation to the Application Mark (for example, how the Application Mark was derived), except for some representation as to how the Application Mark, or at least a variation of the same, will be applied to the goods. In this regard, reference is made to the Applicants’ Evidence at pages 2 - 6. It can be seen that the Application Mark is used on lenses on the glasses while only the Applicants’ moose device is replicated on the frame of the glasses.

15 Further, at the outset, it is noted that the Applicants have appeared to repeat their main arguments in their Counter-Statement, Applicants’ Evidence as well as their written submissions. In the main, the Applicants argued that:

- (i) the Application Mark is in Class 9 and none of the Opponents’ Earlier Marks are in Class 9;
- (ii) the Applicants have a first mover advantage.

The details of the Applicants’ submissions will be considered below.

MAIN DECISION

Ground of Opposition under Section 7(6)

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

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

Decision on Section 7(6)

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

The combined test for bad faith

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

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

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

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

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

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

35 ... Bad faith is to be judged according to the combined test of dishonesty for accessory liability [for] breach of trust set out by the majority of the House of Lords in *Twinsectra Ltd v Yardley* [2002] 2 A.C.

164, with *Gromax Plasticulture* [(103) *supra*] ... providing the appropriate standard namely, acceptable commercial behaviour observed by reasonable and experienced persons in the particular commercial area being examined.

...

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

This court in *Wing Joo Loong* then applied at [107]–[117] the combined test of bad faith which, to reiterate, contains both a subjective element (viz, what the particular applicant knows) and an objective element (viz, what ordinary persons adopting proper standards would think). It is therefore apparent to us that bad faith as a concept is context-dependent. In the final analysis, whether bad faith exists or not hinges on the specific factual matrix of each case.

[Emphasis as underlined mine]

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

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

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

A plea of fraud should not be lightly made ... and if made should be *distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the facts* (see *Davy v. Garrett* [1878] 7 CH.D 473 at 489). In my judgment precisely the same considerations apply to an allegation of ... bad faith made under

section 3(6) [of the UK Trade Marks Act 1994]. *It should not be made unless it can be fully and properly pleaded and this will rarely be possible by a process of inference.* [Emphasis added; emphasis in original omitted]

20 However, the above is not an absolute prohibition. In this regard, I refer to *Law of Intellectual Property of Singapore (Sweet & Maxwell, 2014 Rev Ed)* by Professor Ng-Loy Wee Loon (“*Law of Intellectual Property of Singapore*”) at [21.4.1]). The author pointed out, at footnote 109, that the High Court in *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 (“*Festina*”) at [115] indicated that a finding of bad faith is largely, if not invariably, based on circumstantial evidence.

21 Finally, bad faith should also be determined as at the date of the application: *Festina* at [100]) – in this case, as of 4 June 2013.

22 The Courts have provided some guidelines and indicators in the factual inquiry. In this regard, I refer to *Law of Intellectual Property of Singapore*”) at [21.4]):

- (i) Knowledge of the trade mark applicant that there existed another trade mark belonging to the party opposing the application. While this knowledge alone does not amount to bad faith, whether there is bad faith in a case where the trade mark applicant possesses this knowledge depends on whether, in light of all the other circumstances, an ordinary, honest person possessing this knowledge would have considered it appropriate to apply to register the mark (see *Law of Intellectual Property of Singapore* at [21.4.5]).
- (ii) Bad faith is a distinct and independent concept from the issue of confusing similarity between the marks such that bad faith can exist even where use of the trade mark sought to be registered would not result in the public being confused (see *Law of Intellectual Property of Singapore* at [21.4.6]).
- (iii) However, resemblance between the marks has some relevance as the notion of bad faith cannot be decided in vacuum and has to be decided in the context of some link or nexus between the parties in dispute. Where the two competing trade marks are identical or similar, whether or not this similarity is liable to cause confusion, this resemblance can go towards establishing the nexus between parties (see *Law of Intellectual Property of Singapore* at [21.4.7]).
- (iv) Where the trade mark applicant has “hijacked” the trade mark he is seeking to register, such conduct is highly suggestive of bad faith (see *Law of Intellectual Property of Singapore* at [21.4.12]).

23 I will proceed to apply the above principles to the current case.

Knowledge of the trade mark applicant

24 The Opponents deposed, at paragraph 7 of the Opponents' 1st Evidence, that the trade mark "Abercrombie & Fitch" has been in use in the United States (US) since at least 1902 and that the "A&F" trade mark has been in use in the (US) as well since at least 1978. On the other hand, the Moose Device has been in continuous use in the US as early as 2002 (paragraph 19 of the Opponents' 1st Evidence).

25 In this regard, the total annual sales of the Opponents' goods worldwide from 2000- 2013 is as follows (paragraph 25 of the Opponents' 1st Evidence):

Worldwide Sales Figures		
Year	USD	SGD
2000	1,229,868,225.41	1,537,270,000
2001	1,331,434,374.59	1,664,230,000
2002	1,446,033,686.44	1,807,470,000
2003	1,392,961,733.85	1,741,130,000
2004	1,437,432,431.77	1,796,720,000
2005	1,768,953,097.75	2,211,100,000
2006	1,920,942,875.84	2,401,080,000
2007	2,109,973,952.47	2,637,360,000
2008	1,951,997,241.05	2,439,900,000
2009	1,615,451,121.98	2,019,230,000
2010	1,875,678,709.11	2,344,500,000
2011	2,063,038,124.17	2,578,690,000
2012	2,086,699,659.52	2,608,270,000
2013	1,893,955,283.60	2,367,350,000

26 The amount spent on advertising worldwide, including Singapore, from 2002 – 2013 is as follows (paragraph 27 of the Opponents' 1st Evidence):

Worldwide Promotional Figures		
Year	USD	SGD
2002	27,509,834	34,385,900
2003	23,967,919	29,958,700
2004	25,262,602	31,577,000
2005	33,110,621	41,386,600
2006	33,783,977	42,228,300
2007	35,490,521	44,361,400
2008	33,493,017	41,864,600
2009	25,334,552	31,666,900
2010	26,130,264	32,661,500
2011	32,894,649	41,116,700
2012	44,743,064	55,926,600

2013	41,748,874	52,184,000
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27 In relation to Singapore, the Opponents deposed, at paragraphs 8 and 20 of the Opponents' 1st Evidence that the Opponents' Earlier Marks have been in use in Singapore since at least 2002 when goods purchased from the Opponents' website were shipped to Singapore. Further, the Opponents deposed at paragraphs 9 and 21 of the Opponents' 1st Evidence, that the Opponents' boutique in Orchard Road opened in 2011 such that goods bearing the Opponents' Earlier Marks have been sold from the physical boutique since then.

28 In relation to the use of the Opponents' Earlier Marks in Singapore, I refer to paragraph 23 of the Opponents' 1st Evidence. The total annual sales of goods from the Opponents' website to Singapore from 2002 to 2013 are as follows:

Total annual sales of goods from the Opponents' website to Singapore¹			
S/N	Year	USD	SGD²
1	2002	26,557.47	33,237.20
2	2003	62,072.94	77,685.50
3	2004	148,584.01	185,956
4	2005	101,986.71	127,638
5	2006	180,818.36	226,298
6	2007	355,643.19	445,095
7	2008	436,469.23	546,250
8	2009	350,604.88	438,789
9	2010	474,497.04	593,843
10	2011	407,801.04	510,371
11	2012	432,927.46	541,817
12	2013	1,083,701.53	1,356,270

29 Total annual store sales in Singapore from 2011 – 2013 is as follows (paragraph 24 of the Opponents' 1st Evidence):

Total annual store sales in Singapore³			
S/N	Year	USD	SGD⁴
1	2011	5,262,914.80	6,869,260.95
2	2012	23,952,609.20	29,832,456.64
3	2013	20,356,348.71	25,564,691.09

30 One point to note about the figures above is that they pertain to sales and promotion of the Opponents' whole host of goods in relation to a whole range of brands owned by the Opponents, *including* Opponents' Earlier Marks.

¹ The column on "Merchandise Orders" have been excluded.

² Exchange rate from oanda as at 15 May 2014.

³ The column on "Merchandise Orders" have been excluded.

⁴ Exchange rate from oanda as at 15 May 2014.

31 The opening of the Opponents' boutique in Orchard Road attracted much publicity (paragraph 9 of the Opponents' 1st Evidence). In this regard, I refer to the following articles in Exhibit 2 of the Opponents' 1st Evidence (in chronological order):

Sample publications in the media in relation to the Opponents in Singapore				
S/N	Date	Publication	Title	Page in Opponents' 1st Evidence
1	25 Aug 2011	Straits Times	<i>New Fashion Entrants to shake up Orchard Road</i>	94
2	30 Sep 2011	Straits Times	<i>Singapore Finds Abercrombie & Fitch's Banner Offensive</i>	45
3	29 Sep 2011	mrbrown.com	<i>Abercrombie & Fitch ad at Orchard Road Suspended</i>	46
4	29 Sep 2011	Marketing-interactive.com	<i>Update: Authorities Mull Fate of A&F Ad</i>	55
5	30 Sep 2011	Yahoo! News Singapore	<i>MDA backs ASAs Call to Remove Abercrombie & Fitch ad</i>	47
6	30 Sep 2011	The Sitch on Fitch http://anfnewsnow.blogspot.com/2011/09/abercrombie-fitch-too-fierce-in.html	<i>Abercrombie & Fitch Too Fierce in Sexuality for Singapore</i>	57
7	1 Oct 2011	Straits Times Online	<i>Advertising Watchdog Denies Claims of "Double Standards"</i>	51
8	1 Oct 2011	AsiaOne news	<i>Waxing Firm's Ad More Vulgar than Abercrombie & Fitch's</i>	53
9	4 Oct 2011	Today Online	<i>This Ad is Okay in a Pluralistic Society</i>	61
10	4 Oct 2011	AsiaOne news	<i>Too hot? Too much?</i>	62
11	8 Oct 2011	Straits Times Online	<i>Abercrombie & Fitch 'ad ab-solutely by the book'</i>	65
12	7 Oct 2011	Yahoo! Entertainment Singapore	<i>To buy or not to buy into Abercrombie & Fitch's ways</i>	67
13	8 Oct 2011	SGLinks.com	<i>Abercrombie & Fitch 'ad ab-solutely by the book'</i>	66
14	9 Oct 2011	The Sunday Times	<i>Furore over Ad may Benefit</i>	73

			<i>A&F's Image, say Experts</i>	
15	12 Oct 2011	Asia One News	<i>Preparations Underway to Remove A&F Poster</i>	72
16	12 Oct 2011	My Paper	<i>Preparations Underway to Remove A&F Poster</i>	75
17	14 Oct 2011	The Straits Times – Urban	Undress for Success	74
18	21 Nov 2011	Yahoo! Entertainment Singapore	<i>Abercrombie & Fitch to open in S'pore on 15 December</i>	80
19	23 Nov 2011	His Style Diary	<i>A & F Singapore opens on 15 December</i>	82
20	25 Nov 2011	Youth.sg	<i>Your take: "Shirtless greeters" for store opening</i>	84
21	28 Nov 2011	Star blog on STOMP	<i>15 of Dec is marked on my calendar</i>	87
22	12 Dec 2011	Lifestyle	<i>Abercrombie & Fitch opens in Singapore</i>	90
23	15 Dec 2011	http://Sg.entertainment.yahoo.com	<i>Hundreds flock to Abercrombie & Fitch Launch</i>	96
24	Undated	The Wall Street Journal Online	<i>Abercrombie & Fitch Tests Taste Limits in Singapore</i>	70
25	Undated	Not Specified	<i>Abercrombie & Fitch on hunt for attractive staff</i>	76
26	Undated	Not Specified	<i>Abercrombie & Fitch believes all publicity is good publicity</i>	77
27	Undated	Not Specified but it would appear to be an SPH publication see writer's email at the end of the article	<i>Ads watchdog to work with agencies</i>	78
28	Undated	Not Specified	<i>Watchdog to vet ads before they go public</i>	79
29	Undated	Not Specified	<i>Chinese article and no translation provided</i>	95

32 It is observed that the publicity above spans a period from 25 August 2011 – 15 December 2011 which is a period of approximately 3.5 months. Further, it is also noted that the publicity ranges from the mainstream media such as, for example, the Straits Times and Asia One, to online news sources (Yahoo! Entertainment Singapore).

33 It will be apparent from the evidence above that the publicity is not in relation to the Opponents products *per se*, but that a good part of it is in relation to the banner of

the Opponents which was displayed across the front window of the Opponents' 4-level store at Knightsbridge, Orchard Road. The banner includes a picture of a man wearing jeans exposing his well-built body. The advertisement shows the model's chest and torso, drawing attention to his hands pushing down his low-slung jeans (see page 46 of Exhibit 2 of the Opponents' 1st Evidence). Related to this is also the Opponents' choice of hiring "shirtless greeters" in line with the said advertisement (see page 84 of Exhibit 2 of the Opponents' 1st Evidence).

34 The Advertising Standards Authority of Singapore (ASAS) called for the banner to be removed and the Media Development Authority (MDA) backed this call (see page 47 of Exhibit 2 of the Opponents' 1st Evidence). ASAS said that the advertisement was suspended "due to breach of the Singapore Code of Advertising Practice guidelines on decency" (see page 48 of Exhibit 2 of the Opponents' 1st Evidence). The public's reaction towards the advertisement has been mixed (see page 50 of Exhibit 2 of the Opponents' 1st Evidence). Some were offended while others were simply amused.

35 Regardless of the public reaction to the Opponents' advertisement, the point is that with that much publicity about the Opponents' entry into the local market, during such an extended period of time, and via various media platforms, the Applicants would have been aware of the Opponents, at the very latest, by this time, even if the Applicants were not aware of the Opponents previously (it is the Opponents' evidence that the trade mark "Abercrombie & Fitch" has been in use in the US since at least 1902, the "A&F" trade mark since at least 1978, and the Moose Device since 2002).

Bad faith is a distinct and independent concept from the issue of confusing similarity / Resemblance between the marks

36 I will deal with the two issues together as they are related.

37 I refer to the Opponents' submissions at paragraph 15 where the Opponents referred to *Festina* at [115]:

[115] The categorisation by Bently & Sherman as seen above hints that despite the broad nature of the notion of bad faith, one must show some sort of nexus between the parties in dispute. Otherwise, the notion of bad faith would have to be decided in a vacuum. **A clear-cut example of such a nexus would be an outright copying of the proprietor's mark such that the two competing marks are practically identical.** However, the nexus may be in the guise of something more subtle. In finding a nexus between the parties, a parallel may be drawn between ss8(2)(b) and s7(6) TMA. For example, there may be cases where although there is some similarity of marks or of the goods or services, it falls short of confusing similarity (i.e., no likelihood of confusion) within the meaning of s8(2)(b) TMA. Nevertheless, the evidence of this similarity may be taken into account and considered against the background facts from which bad faith may be inferred. In other words, while the finding of bad faith is largely, if not invariably, based on circumstantial evidence, the party alleging bad faith needs to show some

link between the parties, perhaps by way of a pre-existing relationship or some acts of association with the proprietor or some nexus between the two competing marks.

[116] There may be a fine line between being inspired by another’s trade mark as **opposed to blatant copying or copying with some modifications made to the mark**. The former would not attract punitive measures whereas **the latter would lead to the mark being rejected...**”

[Emphasis in bold the Opponents’ and emphasis as underlined mine]

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

TABLE 1		
S/N	<i>Application Mark</i>	<i>Opponents’ Earlier “A&F” Mark</i>
1.		A&F
2.		<i>Opponents’ Earlier Moose Device Mark</i>
		

39 In this regard, the Opponents have provided evidence as to the derivation of the Opponents’ Earlier Marks. While this information is not as critical as the derivation of the Application Mark, it does add legitimacy, and support, to the Opponents’ case.

40 The Opponents have deposed, at paragraph 7 of the Opponents’ 1st Evidence (and referred to above) that “A & F” is an acronym of the Abercrombie & Fitch brand. At paragraph 15(i) of the Opponents’ 1st Evidence, it was deposed that David Abercrombie and Ezra Fitch were the founders of the Opponents. In this regard, I am of the view, contrary to the Opponents’ submissions at paragraph 29 of their written submissions, that “A&F” is not invented, unlike, for example, “VOLVO”. However, I do agree with the Opponents’ arguments at paragraph 29 of their written submissions, that the Opponents’ Earlier “A&F” Mark has no meaning at all in relation to the goods and services claimed thereunder (aside from that described above) and as such enjoy a high degree of technical distinctiveness.

41 In relation to the Opponents’ Earlier Moose Device, the Opponents also argued, at paragraph 32 of their written submissions, that it is invented and has no meaning or significance in relation to the goods and services claimed thereunder. Again, I do not think that the Opponents’ Earlier Moose Device Mark can be said to be invented, since

it is simply a device of a common animal, although it could be argued that the specific depiction of the moose is invented (see below). However, I do agree that it has no significance in relation to the goods and services claimed and as such enjoy a high degree of technical distinctiveness.

42 Specifically, in relation to the Moose Device, I refer to the Opponents' 1st Evidence at paragraphs 11 – 15.

43 The Opponents deposed that the author and creator of the Moose Device is one Mr Tom Ward. Mr Ward was the Senior Director for graphics concept design for the Opponents. Before that, Mr Ward was an art director for the Opponents. Mr Ward was with the Opponents from 2000 – 2009. He has since left the Opponents and is no longer an employee of the Opponents such that the Opponents are unable to locate his whereabouts.

44 The Opponents submitted as Exhibit 4 of the Opponents' 1st Evidence, a copy of Mr Ward's declaration made under oath in the US, in the case of *Abercrombie & Fitch Co. and Abercrombie & Fitch Trading Co., v Moose Creek, Inc. and Juno of California*, L.L.C. 486 F.3d 629 (9th Cir. 2007).

45 The Opponents summarised the salient points in Mr Ward's declaration as follows:

- (i) The Moose Device was created by Mr Ward after the Opponents planned on featuring a silhouette moose design in its Christmas 2001 catalogue and magazine.
- (ii) Following the successful reaction to several items on which the Opponents used the silhouette moose design in 2001, the then CEO Michael Jeffries told Mr Ward that he wanted the Opponents to trade mark a silhouette moose design.
- (iii) Mr Ward began the design process by referring to the silhouette moose design used in 2001 and to a clip art website, clipart.com to which the Opponents subscribed, which featured different versions of a moose device. As with the version used in 2001, he worked with the silhouette of a moose.
- (iv) Mr Ward then tweaked the silhouette by hand to make it more recognisable as a moose. He altered the positioning of the legs, modified the antlers and eliminated the beard above the neck. These changes were driven by the need for the moose to be discernible regardless of whether it was embroidered or printed on a small scale. The design that he rendered conveyed a clean and distinctly unmistakable image of a moose.

- (v) Thus the Moose Device was Mr Ward's original creation. The antlers were arranged so that both racks were displayed. This three-quarter view of two separable and distinct antlers next to a side view of the face is atypical. The Moose Device also lacks a tail and a beard so that the lines are cleaner and the image more defined.
- (vi) Mr Ward also independently created a "back story" about the moose known as "The Legend of the Moose" to enliven the moose iconography. This story was used on hangtags, tissue paper and on the Opponents' website during the 2003 holiday period. "The Legend of the Moose" is a fictionalised account of an encounter that the Opponents' founders, David Abercrombie and Ezra Fitch, had with a moose in the Adirondacks in 1901 in which the moose spared their lives.

46 Further, the Opponents also deposed, at paragraph 16 of the Opponents' 1st Evidence, that they are the rightful and legal owner of the copyright subsisting in the Moose Device as it was created by Mr Ward in the course of his employment with the Opponents. In this regard, the Opponents tendered Certificate of Registration (VA 1-231-955) issued by the Copyright Office in the US (COUS) on 22 September 2003 tendered as Exhibit 5 of the Opponents' 1st Evidence. The Certificate was issued to A & F Trade Mark Inc, a subsidiary of the parent company, Abercrombie & Fitch Co.

47 Finally, the Opponents also deposed, at paragraph 18 of the Opponents' 1st Evidence, that A & F Trade Mark Inc, also owns the copyright in graphic design consisting of the Moose Device and "A&F" trade mark, again, registered in the COUS, on 18 December 2001 (VAu 542-906), tendered as Exhibit 6 of the Opponents' 1st Evidence.

48 At the hearing, the Opponents' attention was drawn to paragraph H of Circular 3 of 2015:

H. Evidence Filed in Related Proceedings

Where a party wishes to rely on an SD, affidavit or witness statement filed in related proceedings, as far as possible, the same evidence should be re-declared (that is, to declare a fresh SD with the same content) by the same deponent for the purposes of the proceedings before the Registrar.

The Registrar *may* accept the SD, affidavit or witness statement appended as an exhibit to an SD filed for the purposes of proceedings before the Registrar, but will give the appropriate weight to that exhibit.

49 In light of the above, the Registrar will have the ultimate discretion as to the weight to be accorded to Mr Ward's declaration since it was filed for another proceeding. However, the fact that Mr Ward is no longer in the employ of the

Opponents such that the Opponents are unable to locate Mr Ward will be taken into account.

50 As mentioned, the above information does legitimise and support the Opponents' claim in relation to the Opponents' Earlier Marks. In particular, it explains why (i) the characters "A&F" were chosen; (ii) the Moose Device was chosen; and (iii) the fact that the Moose Device is portrayed the way it is (clean cut without a tail and a beard to assist in replicating the device on the goods).

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

TABLE 1		
S/N	<i>Application Mark</i>	<i>Opponents' Earlier "A&F" Mark</i>
1.		A&F
2.		<i>Opponents' Earlier Moose Device Mark</i>
		

52 In relation to the depiction of the moose device, there is an uncanny resemblance between the Application Mark and the Opponents' Earlier Moose Device Mark. In this regard, the devil is in the details. The following aspects have been noted to be very similar:

- (i) The positioning of the legs;
- (ii) There is no beard above the neck;
- (iii) There is no tail;
- (iv) The arrangement of the antlers.

53 While the Opponents have provided their reasons as to why the depiction is as such, the Applicants did not provide any reason at all. In the current case there is no derivation provided by the Applicants for the Application Mark. As indicated above, the Applicants did not attend the hearing. Further, and more importantly, as alluded to above, there is nothing in the documents filed by the Applicants relating to the derivation of the Application Mark.

54 It is noted that at paragraph 3 of the Applicants' Evidence, the Applicants deposed that the Applicants' application is for "an animal silhouette and common alphabets and symbols characters". While I accept that the moose device is not an invented device (or animal) and that "A&F" consists of common alphabets, surely, there must be a reason

as to why the moose device and the “A&F” characters are chosen? What is needed is for the Applicants to provide an explanation as to the *choice* as well as the particular *depiction* of the Applicants’ moose device and the characters “A&F” for the relevant goods.

55 In this regard, it is observed that “A&F” cannot be an acronym of the Applicants since they are “MMC International Services Pte Ltd”. Further, the deponent, who is a director of the Applicants, is one Mr Neo Teck Joo (see paragraph 1 of the Applicants’ Evidence) such that it cannot be his initials either. Or perhaps it could be the initials of his alias. But that is precisely the problem, in that it would appear that the Applicants did not deem it important enough to provide an explanation, in order to defend their case.

56 In relation to the Applicants’ moose device, as mentioned above, while the moose device is not an invented device (in that the moose is not an invented animal), the *choice* of the device of the moose (and well as the specific *depiction*) is peculiar in relation to the goods claimed by the Applicants.

57 The Opponents, at paragraph 16 of their written submissions, further submitted that in *Festina*, the Court held, at [122] and [123], that the respondent’s failure to furnish a credible explanation of how “ESTINA” in its mark “J.ESTINA” was derived could only lead to the irresistible conclusion that the word “ESTINA” was copied from the Appellant:

[122] In my opinion, the Respondent’s brand story on the name “J.ESTINA” appears extremely contrived. Firstly, the use of Princess Jovanna’s name (compressed to “J.”) only explains the use of the letter “J”. It does not explain why the meaningless word “ESTINA” was chosen. The six letters in “ESTINA” are not even the initials of “Jovanna Elizabeth Antonia Romana Marie” nor do they have any nexus with the tiara or the pet cat “Jenna” which were repeatedly referred to whenever the question of derivation of the brand name was raised. The brand story certainly does not answer any of the queries regarding the derivation of “ESTINA”. As mentioned at [91] above, giving a European setting to the story merely reinforces the association between the two competing marks.

[123] The graphs which supposedly illustrate the process of ultimately choosing the name “J.ESTINA” also do not explain in any way how the word “ESTINA” came into being. As the Respondent has conceded, “ESTINA” is an invented word with no meaning. The failure to furnish the court with a credible explanation of how “ESTINA” in the brand name “J.ESTINA” was derived, where the explanation is particularly pertinent since six out of seven letters are in identical sequence in the two competing marks, can only lead to the irresistible conclusion that the word “ESTINA” was blatantly copied from the Appellant by a “cut and paste” job. The adding of “J” with a dot just before “ESTINA” makes little difference to the final name as both words in the competing marks (including the Appellant’s other marks) would still look alike and sound remarkably similar

whether “J.ESTINA” is pronounced “jay-estina” (with the “jay” sound likely to be slurred) or “jes-tina”. Such outright copying of the Appellant’s mark is an act that falls short of the acceptable commercial behaviour observed by reasonable and experienced men in the relevant trade.

[Emphasis as underlined mine]

58 In the *Festina* case, the portion which was copied was a meaningless word “ESTINA”. The Respondents in *Festina* had provided a brand story but Justice Tay (now Judge of Appeal Tay) was of the view that the Respondent’s brand story on the name “J.ESTINA” appeared extremely contrived and did not explain why the meaningless word “ESTINA” was chosen (Justice Tay opined “[t]he six letters in “ESTINA” are not even the initials of “Jovanna Elizabeth Antonia Romana Marie”). Justice Tay was of the view that the failure to furnish the court with a credible explanation of how “ESTINA” in the brand name “J.ESTINA” was derived (“ESTINA” is an invented word with no meaning) where the explanation is particularly pertinent since six out of seven letters are in identical sequence in the two competing marks, can only lead to the irresistible conclusion that the word “ESTINA” was blatantly copied from the Appellant by a “cut and paste” job. Such outright copying of the Appellant’s mark was an act that falls short of the acceptable commercial behaviour observed by reasonable and experienced men in the relevant trade.

59 In the current case, the Applicants proffered no reasons at all, as to the choice of the characters “A&F” and the Applicants’ moose device, as well as their specific depiction. I have already mentioned above that while the Opponents’ Earlier “A&F” Mark and the Opponents’ Earlier Moose Device Mark are not invented *per se*, they are of no significance in relation to the goods claimed and are as such of a high degree of technical distinctiveness. The failure of the Applicants to provide any explanation at all, where an explanation is very pertinent since the Application Mark is simply a combination of the Opponents’ Earlier “A&F” Mark and the Opponents’ Earlier Moose Device Mark (there is *no* modification whatsoever) can only lead to the irresistible conclusion that the Application Mark was slavishly copied from the Opponents by a “cut and paste” job.

60 Applying *Festina*, I can only conclude that such outright copying of the Opponents’ Earlier Marks is an act that falls short of the acceptable commercial behaviour observed by reasonable and experienced men in the relevant trade.

Where the trade mark applicant has “hijacked the trade mark - no intention to use the mark

61 I refer to *Law of Intellectual Property of Singapore* at [21.4.12] where the learned author gave some examples of where the trade mark applicant has “hijacked” the mark:

- (i) The applicant has no *bona fide* intention to use the trade mark but wishes to prevent a competitor from using the mark or one similar to it;

- (ii) The applicant has no present intention or fixed intention to use the mark but wishes to stockpile the mark for use at some indeterminate time in future;
- (iii) The applicant becomes aware that someone plans to use the mark and files a pre-emptive application with a view to selling it.

At [21.4.13], the author referred to the case of *PT Swakarya Indah Busana v Dhan International Exim Pte Ltd* [2010] 2 SLR 109 (“*PT Swakarya*”) as a variation of scenario (a) above.

62 In this regard, I refer to the *Festina* case which also referred to *PT Swakarya* at [105]:

[105] In the case of *PT Swakarya Indah Busana v Dhan International Exim Pte Ltd* [2010] 2 SLR 109, Lai Siu Chiu J found that after registering the mark “EMPEROR MARTIN” in 2002, the defendant did not intend to use the mark. Instead, on the shirts sold by the defendant was the defendant’s tailored mark (as opposed to the registered mark) which showed the word “MARTIN” in a much more prominent font than that of “Emperor”. Lai J found that there was an obvious and conscious effort on the part of the defendant to copy the plaintiff’s mark in the usage of the word “MARTIN”. The plaintiff had a total of six marks registered in Singapore (all of which included the name “MARTIN”) and there was a deliberate preference to use the defendant’s tailored mark instead of the defendant’s registered mark. Thus, the lack of bona fide intention to use the mark in the form that was applied to be registered was found to be an act of bad faith.

[Emphasis as underlined mine].

63 Further, the following is noted at [90] in the case of *PT Swakarya*:

[90] It is noteworthy that Sanjay and/or Neeraj made no attempt to offer any explanation at all as to why the defendant chose to use the word MARTIN in the defendant’s mark. Sanjay’s explanation for adopting the word EMPEROR as a prefix was unbelievable in any case as the clear emphasis in the defendant’s tailored mark was on the word MARTIN and not on the word EMPEROR. Further, Sanjay did not elaborate on what he meant by marketing strategy in the difference in font size used for the words EMPEROR and MARTIN nor why the word MARTIN was so obviously highlighted.

[Emphasis as underlined mine].

64 The Opponents argued, at paragraph 64 of their written submissions (albeit for the ground of objection under Section 8(2)(b)) that there is “relatedness” between the Opponents’ goods on the one hand and the Applicants’ goods on the other.

65 In this regard, although the Opponents do not themselves apply the Opponents' Earlier Marks on glasses, the Opponents sought to tender evidence to show that it is common for clothing retailers to branch out into fashion accessories including glasses and sunglasses. I refer to Exhibit 14 of the Opponents' 1st Evidence. For example, at pages 1543 - 1544, it shows pictures of glasses of the brand "Armani Exchange". It is noted that either "Armani Exchange" (page 1543 – first row, left most column) or "AX" (page 1544 – second row, left most column) is reflected on the frame of the glasses. On pages 1549 - 1550, it shows pictures of glasses of the brand "Burberry". Again it is noted that "Burberry" (page 1549 – first row, right most column) is reflected on the frame of the glasses. Finally, at the oral hearing, the Opponents referred to pages 1568 – 1602; these pages show pictures of glasses of the brand "Prada". In particular, the Opponents pointed out that "Prada" (page 1568 – second row, right column) was reflected on the frame of the glasses as well as a thin film on the lenses. In this regard, it is also noted that *Festina* decided that clothing and spectacles can be regarded as similar (see below).

66 The Opponents also sought to highlight how the Applicants intend to apply the Application Mark onto their products. The Opponents referred to the Applicants' Evidence (Appendix A) where the Applicants sought to show that they have market-ready products such that they are in a more advanced stage of commercialising their products. Most of the glasses in the Appendix reflect the Applicants' moose device *only* on the frame and the Application Mark which consists of the device of the moose and the words "A&F", on the thin film on the lenses (see pages 2 – 6 of the Applicants' Evidence).

67 In this regard, the Opponents at paragraph 75 of their written submissions (although this argument was made in the context of the objection under Section 8(2)(b)), sought to argue that the Application Mark is not always used as applied for such that the Applicants' moose device *only* is applied onto the frames of the glasses. As alluded to above, this moose device on the frame is virtually identical to the Opponents' Earlier Moose Device Mark. The fact that only the Applicants' moose device is applied onto the frames heightens the similarity between the marks (I also note that the thin film will be removed when the glasses are used, thus leaving only the Applicants' moose device on the frames when the glasses are actually in use).

68 I note that there could be plausible reasons why only the Applicants' moose device is replicated on the frame. However, the issue is that the Applicants did not provide any explanation as to why this is so.

69 Applying the case of *PT Swakarya*, the lack of *bona fide* intention to use the mark in the form that was applied to be registered was found to be an act of bad faith (it is noted that the thin film will be removed when the glasses are used, thus leaving only the Applicants' moose device on the frames when the glasses are actually in use).

Conclusion

70 I am mindful of the warning in *Royal Enfield* above that an allegation of bad faith should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctly proved and this will rarely be possible by a process of inference. However, taking into account *all* of the above, I am convinced that in the present case, a strong inference of bad faith has been made out.

71 I come to this view having regard to the Applicants' arguments in their written submissions that:

- (i) the Opponents have no prior interest in Class 9 before the Application Mark;
- (ii) the Applicants should not be penalised for their "first mover advantage" for the Opponents' "mistake and carelessness" by not registering in Class 9;
- (iii) the Opponents are trying to take advantage of the Applicants' business idea to expand into Class 9.

72 The Applicants argued in their written submissions, that the Applicants "[h]aving come up with an *original* business plan and taking the first initiative, it would now be a flaw in the system if the [O]pponents is allowed to take a second bite at the cherry just because they are a multi-million dollar company". Taking into account the evidence above in relation to the expansion of clothing retailers' product line into sunglasses and glasses, I do not think that it is accurate to say that the Applicants could have given the Opponents the business idea to expand into Class 9, nor could it be said that such an idea is "original".

73 Further, while I accept the possibility that the Opponents may have been careless in terms of their overall expansion strategy, by not applying for Class 9 all these years and that the Opponents may have been jolted into action to file a relevant application in Class 9 (overseas) upon realisation and awareness of the Application Mark (see page 349 of Exhibit 7 of the Opponents' 1st Evidence, which appears to be an English translation of a registration in Switzerland where the application date was indicated as 21 August 2013), I also do not think that it would be accurate to say that the Applicants are penalised for "first mover advantage".

74 To begin with, the "first mover advantage" is not absolute. This is the reason that the opposition process is part and parcel of the registration procedure and that it is also possible to initiate post-registration actions to challenge a registration. Whether or not the Applicants are penalised for "first mover advantage" must be seen in the light of the surrounding circumstances.

75 In the current case, taking *all* of the circumstances above into consideration, namely:

- (i) the possible knowledge by the Applicants of the Opponents;
- (ii) the striking similarity of the marks;

- (iii) the expansion route of clothing retailers; and
- (iv) the evidence pertaining to how the Applicants intend to use the Application Mark on the goods,

I am of the view that bad faith has been made out.

76 The ground of objection under section 7(6) succeeds.

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

77 The relevant provisions of the Act are Section 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

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

79 In relation to similarity of marks, the Court in *Staywell* 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.]

80 Further, the Court provided the following principles in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] SGCA 26 at [40] (“*Hai Tong*”):

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

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

[Emphasis as underlined mine].

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

TABLE 1		
S/N	<i>Application Mark</i>	<i>Opponents’ Earlier “A&F” Mark</i>

1.		A&F
2.		<i>Opponents' Earlier Moose Device Mark</i>
		

As a preliminary point, it has been verified in *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2014] SGIPOS 10 (“*Rovio I*”) at [49] that the above approach (Table 1) and not the approach below (Table 2), is the correct approach for an analysis of the marks.

TABLE 2		
S/N	<i>Application Mark</i>	<i>Opponents' Earlier “A&F” Mark</i>
		A&F
		<i>Opponents' Earlier Moose Device Mark</i>
		

It is clear that the method for comparison is mark-for-mark or to put it another way, it is [a] mark-for-[a] mark.

82 With the above approach in mind, I will proceed to analyse the marks.

Distinctiveness

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

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

[Emphasis as underlined mine].

Opponents' Earlier "A&F" Mark

84 The Opponents submitted at paragraph 29 of their written submissions that the Opponents' Earlier "A&F" Mark is invented and has no meaning at all in relation to the goods and services claimed thereunder such that the Opponents' Earlier "A&F" Mark has a high degree of technical distinctiveness.

85 Further, the Opponents argued, at paragraph 30 of their written submissions, that the extensive use of the Opponents' Earlier "A&F" Mark in Singapore has enhanced their distinctiveness.

86 As mentioned above, the Opponents have deposed, at paragraph 7 of the Opponents' 1st Evidence that "A & F" is an acronym of the Abercrombie & Fitch brand. At paragraph 15(i) of the Opponents' 1st Evidence, it was deposed (albeit in the context of explaining the derivation for the Moose Device) that David Abercrombie and Ezra Fitch were the founders of the Opponents. In this regard, "A&F" is not invented, for example, like "NUTELLA". However, I agree that the Opponents' Earlier "A&F" Mark has no meaning at all in relation to the goods and services claimed thereunder (aside from that described above) and thus I agree that the Opponents' Earlier "A&F" Mark possesses a high level of technical distinctiveness.

87 In relation to the use of the Opponents' Earlier "A&F" Mark in *Singapore*, I have referred to the same above. One point to note about the figures above is that they pertain to sales and promotion of the Opponents' whole host of goods in relation to a whole range of brands owned by the Opponents, *including* the Opponents' Earlier Marks (see paragraphs 26 of the Opponents' 1st Evidence, which referred to photographs of goods bearing the Opponents' Earlier Marks, reflected at Exhibit 10 of the Opponents' 1st Evidence as well as paragraph 27 of the Opponents' 1st Evidence, which referred to sample promotional emails sent to customers, including those in Singapore, reflected at Exhibit 11 of the Opponents' 1st Evidence). Therefore, the extent of the figures which can be apportioned to the Opponents' Earlier Marks can only be an approximate.

88 So for example, in terms of photographs of goods bearing the Opponents' marks, pages 578 and 584 of Exhibit 10 show use of the Opponents' Earlier "A&F" Mark while page 589 shows use of the Opponents' Earlier Moose Device Mark. On the other hand, page 591 shows "A & Fitch" and Opponents' Earlier Moose Device Mark below.

89 In relation to promotional emails as attached to Exhibit 11, pages 1190 and 1315 show use of Opponents' Earlier "A&F" Mark. On the other hand, pages 718 and 724 show the Opponents' Earlier Moose Device Mark. Further, pages 627 and 632 of the same show "abercrombie" while page 626 shows "Abercrombie & Fitch". Finally, on pages 601 and 604, there are depictions of the Opponents' Earlier Moose Device Mark as well as "Abercrombie & Fitch".

90 In relation to the above issue, reference is made to HMG Circular No. 3/2015. In particular, I refer to Part C and D of the said Circular as follows:

C. Evidence of Sales

Statements of account; or figures given in the main body of SDs as supported by sample invoices in the exhibits, are generally acceptable. However, the *weight* to be given to such evidence will vary depending on the relevance of the documents. For example, where the sample invoices do not reflect the subject mark in relation to the specification in question, the weight to be given to such invoices, if any, is low. This in turn affects the weight of the assertions on annual sales volume which is purportedly supported by the invoices.

D. Evidence of Advertising Expenditure

Advertising expenditure figures given in the main body of SDs as supported by sample invoices in the exhibits are generally acceptable. However, as with C. above, the *weight* to be given to such evidence will vary depending on the relevance of the documents. For example, where there is no demonstrable link between the sample invoices, the advertisements themselves and the subject mark in relation to the specification in question, the weight to be given to such invoices, if any, is low. This in turn affects the weight of the assertions on the amount of advertising expenditure which is purportedly supported by evidence over the years.

In light of the above, while I would give some weight as to the above evidence, such weight as accorded will not be as high.

91 The above is so taking into consideration that the totality of the sales and promotional figures tendered in Singapore was / is rather substantial. In particular, with regard to the annual store sales in Singapore for the period 2011- 2013 (above), it is noted that the average annual sales figures in Singapore for that 3-year period is **SGD 20,755,469.56** (this figure *excludes* sales from the Opponents' website).

92 For completeness, in addition to Exhibits 10 and 11 of the Opponents' 1st Evidence dealt with above, I also refer to paragraph 23 of the Opponents' 1st Evidence which referred to random samples of shipping confirmations as provided at Exhibit 8 of the Opponents' 1st Evidence. The Opponents also deposed, at paragraph 8 of the Opponents' 1st Evidence, that as the Opponents only began to retain the shipping confirmation emails relating to their online sales from 2009 onwards, no shipping confirmation emails relating to sales in 2002 are available.

93 For example, at page 388 of Exhibit 8, the first item "Reid", reflects the Opponents' Earlier "A&F" Mark, while the third ("Payton"), fourth and fifth (both "Christine") items reflect the Opponents' Earlier Moose Device Mark.

94 On the other hand, at page 397 of Exhibit 8, the third item shows a T-shirt “Bradley Pond” which reflects simply “Abercrombie” on the front of the shirt. On page 403 of the same Exhibit, the second item shows a sweater, “Little Moose Mountain” reflects “ANF” on the front of the sweater. Last but not least, on page 405 of the same Exhibit, the last item shows a T-shirt “Cellar Mountain” which reflects “Abercrombie and Fitch” on the front of the shirt

95 As mentioned above, one point to note is that the figures do not simply reflect the Opponents’ Earlier “A&F” Mark, but they reflect as well other marks of the Opponents in relation to a whole hosts of goods, including those claimed under the relevant marks in the current case. Therefore, in trying to come to a conclusion as to the extent of *de facto* distinctiveness of the Opponents’ Earlier “A&F” Mark, the figures as provided above cannot be taken literally.

96 Most importantly, I am of the view that, regardless of the extent to which the figures above can be attributed to the Opponents’ Earlier “A&F” Mark and as such the weight to be accorded to the same to establish *de facto* distinctiveness, the Opponents’ Earlier “A&F” Mark, in itself is inherently distinctive and enjoys a high level of technical distinctiveness as it is meaningless in relation to the goods and services claimed.

Opponents’ Earlier Moose Device Mark

97 In relation to the Opponents’ Earlier Moose Device Mark, the Opponents also argued, at paragraph 32 of their written submissions, that it is invented and has no meaning or significance in relation to the goods and services claimed thereunder such that it also has a high degree of technical distinctiveness. Again I do not think that the Opponents’ Earlier Moose Device Mark can be said to be invented, since it is simply a device of a common animal. However, I do agree that it has no significance in relation to the goods and services claimed.

98 Similarly, the Opponents also argued that the extensive use of the Opponents’ Earlier Moose Device Mark has enhanced its distinctiveness (paragraph 33 of the Opponents’ written submissions). In relation to this argument, the same comments apply. That is, in trying to come to a conclusion as to the extent of *de facto* distinctiveness of the Opponents’ Earlier Moose Device Mark, the figures as provided above cannot be taken literally.

99 However, having said the above, as is the case for the Opponents’ Earlier “A&F” Mark, I am of the view that, regardless of the extent to which the figures above can be attributed to the Opponents’ Earlier Moose Device Mark and as such the weight to be accorded to the same to establish *de facto* distinctiveness, the Opponents’ Earlier Moose Device Mark, in itself is inherently distinctive and enjoys a high level of technical distinctiveness as it is meaningless in relation to the goods and services claimed.

100 With the above in mind, I will proceed to analyse the marks.

Visual Similarity

101 For ease of comparison, I reproduce the marks again as follows:

TABLE 1		
<i>S/N</i>	<i>Application Mark</i>	<i>Opponents' Earlier "A&F" Mark</i>
1.		
2.		<p style="text-align: center;"><i>Opponents' Earlier Moose Device Mark</i></p> 

102 As a starting point, I note that the Application Mark is a composite mark while the Opponents' Earlier "A&F" Mark is a word only mark while the Opponents' Earlier Moose Device Mark consists only of a device.

103 The Opponents, at paragraph 36 of their written submissions, referred to the case of *Hai Tong* at [62]:

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

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

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

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

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

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

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

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

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

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

(i) the device is significant and large (see, *eg*, the decision of the European General Court in *New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (Case T-415/09) (29 September 2011));

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

(iii) the device component is of a complicated nature (see, *eg*, *Waseem Ghias t/as Griller v Mohammed Ikram t/as The Griller Original, Esmail*

Adia t/as Griller King, Shahzad Ahmad t/as Griller Hut, Griller Original Limited, Griller Hut Limited [2012] EWPC 3).

But usually not where:

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

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

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

[Emphasis as underlined mine]

104 I note that the above guidelines are generally applicable to composite marks while in this case, the Opponents' Earlier "A&F" Mark is a word only mark while Opponents' Earlier Moose Device Mark is a device only mark. However, the above is still useful as a general guide.

105 The Application Mark has taken up the whole of the Opponents' Earlier "A&F" Mark. The characters "A&F" take up about a third of the Application Mark. As referred to earlier, the Opponents' Earlier "A&F" Mark, in itself is inherently distinctive and enjoys a high degree of technical distinctiveness as it is meaningless in relation to the goods and services claimed. .

106 The Opponents also argued, at paragraph 39 of their written submissions, applying the principle in *Staywell* at [25] (replicated above), that "a mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it". In light of this, I am of the view that the marks are visually similar to some extent despite that fact that the words "A&F" only take up about a third of the Application Mark.

107 Similarly, the Application Mark has taken up the whole of the Opponents' Earlier Moose Device Mark. The moose device takes up about two thirds of the Application Mark. As referred to earlier, the Opponents' Earlier Moose Device Mark in itself is inherently distinctive and enjoys a high degree of technical distinctiveness as it is meaningless in relation to the goods and services claimed.

108 Similarly, applying the principle in *Staywell* at [25], that “a mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it”, I am of the view that the marks are visually similar.

Aural Similarity

109 With regard to aural similarity, the Court in *Staywell* stated at [31] and [32] that there are two approaches in this regard. One approach is to consider the dominant component of the mark and the other is to undertake a quantitative assessment as to whether the competing marks have more syllables in common than not (see also the Opponents’ written submission at paragraph 45).

110 In relation to the Opponents’ Earlier “A&F” Mark, the Opponents submitted, at paragraphs 46 and 47 of their written submissions that the sole aural element of both marks is the word “A&F” such that applying, in particular, the dominant component approach assessment, both marks are aurally identical. Alternatively, applying the quantitative approach, it is clear that the marks have more syllables in common – in fact, the syllables are identical.

111 I am more inclined to accept the quantitative approach and in that regard, I agree with the Opponents that the marks, that is, the Application Mark and the Opponents’ Earlier “A&F” Mark are aurally identical.

112 In relation to the Opponents’ Earlier Moose Device Mark, as submitted by the Opponents at paragraph 49 of their written submissions, it has no verbal element (since it is a device only mark). The Opponents thus concluded in the same paragraph of their written submissions that an aural comparison merely results in a neutral conclusion rather than that the marks are aurally dissimilar. I agree. This is also the approach taken in *Rovio 1* at [60].

Conceptual Similarity

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

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

[Emphasis as underlined mine]

114 In relation to the Opponents' Earlier "A&F" Mark, the Opponents argued, at paragraph 52 of their written submissions that both marks convey the idea of a pair of initials, such that they are conceptually similar.

115 It has been referred to above that for the Opponents' Earlier "A&F" Mark, it is an acronym of the surnames of the founders of the Opponents, David Abercrombie and Ezra Fitch.

116 In relation to the Application Mark, it is noted that the Application Mark also contains a moose device, which takes up about two thirds of the Application Mark, in addition to the initials "A&F". Further, as alluded to in the preliminary comments above, there is no information provided, as to the genesis of the Application Mark, in particular, as to what "A&F" stands for.

117 In light of the above, having regard to the Court's guidance above, I can only conclude that there is a low level of conceptual similarity between the Opponents' Earlier "A&F" Mark and the Application Mark, due to the presence of the common denominator, "A&F" in both marks.

118 With regard to Opponents' Earlier Moose Device Mark, the Opponents argued at paragraph 53 of their written submissions the marks are conceptually similar as they both convey the idea of a moose.

119 While the moose device is the common denominator for both marks, I am mindful that for the Application Mark, there are also the characters "A&F" (which take up about a third of the Application Mark) and the fact that there has been no explanation proffered as to what the characters stand for.

120 In light of the above, and again, having regard to the Court's guidance, I can only conclude that there is some conceptual similarity between the Opponents' Earlier Moose Device Mark and the Application Mark, due to the presence of the common denominator, the moose device, in both marks.

Conclusion on the similarity of marks

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

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

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

[Emphasis as underlined mine]

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

123 In light of the analysis above, I am of the view that the Opponents’ Earlier “A&F” Mark and the Application Mark are visually similar to some extent, aurally similar and conceptually similar to a low extent such that the marks are more similar than dissimilar in totality.

124 By the same token, in relation to the Opponents’ Earlier Moose Device Mark and the Application Mark, in light of the analysis above, I am of the view that they are visually similar, aurally neutral and conceptually similar to some extent such that the marks are more similar than dissimilar in totality.

Similarity of Goods / Services

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

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

126 The factors set out in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 are as follows:

- (a) the respective uses of the respective goods or services;
- (b) the respective users of the respective goods or services;
- (c) the physical nature of the goods or acts of service;
- (d) the respective trade channels through which the goods or services reach the market;
- (e) in the case of self-serve consumer items, whether in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) the extent to which the respective goods or services are competitive.

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

S/N	<i>Opponents’ Earlier “A&F” Marks</i>	<i>Application Mark</i>
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1	T1117126D	<p><u>Class 14</u> Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; <i>jewelry</i>, precious stones; timepieces and chronometric instruments.</p>	<p><u>Class 9</u> Anti-dazzle spectacles; bars for spectacles; bows adapted for spectacle frames; carrying cases adapted for spectacles; cases adapted for spectacles; chains for spectacles; computer programs for use in fitting spectacles; containers for spectacles; cords for spectacles; devices for supporting spectacles; devices in the nature of spectacles for displaying televised images; devices in the nature of spectacles for viewing recorded video images; devices in the nature of spectacles for viewing televised images; finished lenses for spectacles; fitted cases for spectacles; frames for spectacles; lenses for spectacles; lorgnettes (spectacles); optical lenses for use with spectacles; optical spectacles; protective glasses (spectacles); protective spectacles; safety spectacles; spectacle cases; spectacle chains; spectacle frames; spectacle frames having elastic hinges; spectacle holders; spectacle lenses; spectacle mountings; spectacle support bands, chains, cords, and straps; <i>spectacles</i>; spectacles (optics); spectacles for sports; spectacles used in information science; sport glasses (protective spectacles); sport glasses (spectacles); sports glasses (spectacles); straps for spectacles; sun spectacles.</p>
2	T0002872D	<p><u>Class 03</u> Personal care products, namely, nail polish, nail polish remover, nail stencils, hard artificial nails, shower gel, bubble bath, fragrant body splash, hand lotion, body lotion, face lotion, hand soap, body soap, face soap, hair shampoo, hair conditioner, hair styling gel, hair spray, hair dyes, hair rinses, perfume, cologne, body glitter, mascara, blush, eye shadow, lip stick, lip gloss, make-up, make-up remover, eyecream, hand cream, body cream, face cream, astringent for the face, face cleanser, bath oil, bath beads, body powder, face powder, liquid talcum powder, non-medicated blemish stick, shaving cream, deodorant, potpourri, air freshening room spray, incense, sachets, scented beads, body and face suntanning lotion, body and face sunless tanning lotion,</p>	

		body and face pre-suntanning lotion and body and face after suntanning lotion in International Class 3.
3	T0002873B	<u>Class 25</u> <i>Clothing, footwear</i> , headgear.
4	T0002874J	<u>Class 35</u> Retail store services in relation to clothing and personal care products; all in Class 35.
5	T0202014C	<u>Class 35</u> The bringing together, for the benefit of others of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise catalogue by mail order.
6	T0721760C	<u>Class 25</u> <i>Clothing, footwear</i> , headgear; clothing, namely, bathrobes, beach cover-ups, beachwear, belts, blazers, blouses, body shapers [foundation garments], body suits, boxer shorts, bras, bustiers, camisoles, caps, coats, dresses, footwear, foundation garments, garter belts, girdles, gloves, gowns, halter tops, hats, headbands, hosiery, jackets, jeans, jogging suits, knee high stockings, knit shirts, knit tops, leotards, lingerie, loungewear, mittens, negligees, night gowns, night shirts, pyjamas, panties, pants, pantyhose, sarongs, scarves, shirts, shorts, skirts, slacks, sleepwear, slippers, socks, stockings, suits, sweat pants, sweat shirts, sweat shorts, sweat suits, sweaters, swim wear, t-shirts, tank tops, tap pants, teddies, ties, tights, underpants, undershirts,

		underwear and vests.	
7	T1111521F	<u>Class 35</u> Advertising; business management; business administration; office functions; retail store services connected with clothing, footwear, headgear, soaps, perfumes, essential oils, cosmetics, hair lotions, jewellery and bags; online retail store services connected with clothing, footwear, headgear, soaps, perfumes, essential oils, cosmetics, hair lotions, jewellery and bags.	
<i>Opponents' Earlier Moose Device Marks</i>			<i>Application Mark</i>
8	T1314410H	<u>Class 24</u> Textiles and textile goods not included in other classes; bed and table covers.	<u>Class 9</u> Anti-dazzle spectacles; bars for spectacles; bows adapted for spectacle frames; carrying cases adapted for spectacles; cases adapted for spectacles; chains for spectacles; computer programs for use in fitting spectacles; containers for spectacles; cords for spectacles; devices for supporting spectacles; devices in the nature of spectacles for displaying televised images; devices in the nature of spectacles for viewing recorded video images; devices in the nature of spectacles for viewing televised images; finished lenses for spectacles; fitted cases for spectacles; frames for spectacles; lenses for spectacles; lorgnettes (spectacles); optical lenses for use with spectacles; optical spectacles; protective glasses (spectacles); protective spectacles; safety spectacles; spectacle cases; spectacle chains; spectacle frames;
9	T0721747F	<u>Class 03</u> Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; personal care products, namely, nail polish, nail polish remover, nail stencils, hard artificial nails, shower gel, bubble bath, fragrant body splash, hand lotion, hand soap, body soap, face soap, hair shampoo, hair conditioner, hair styling gel, hair spray, hair dyes, hair rinses, perfume, cologne, aftershave lotion, aftershave balm, toilet water, talcum powder, face lotion, body lotion, hair lotion, bath oil, scented sachets, shaving soap, shaving cream, body shampoo, body glitter,	

		<p>mascara, blush, eye shadow, lip stick, lip gloss, make-up, make-up remover, eyecream, hand cream, body cream, face cream, astringent for the face, face cleanser, bath beads, body powder, face powder, non medicated blemish stick, deodorant, potpourri, air freshening room spray, incense, scented beads, body and face suntanning lotion, body and face sunless tanning lotion, body and face pre-suntanning lotion and body and face after suntanning lotion.</p>	<p>spectacle frames having elastic hinges; spectacle holders; spectacle lenses; spectacle mountings; spectacle support bands, chains, cords, and straps; <i>spectacles</i>; spectacles (optics); spectacles for sports; spectacles used in information science; sport glasses (protective spectacles); sport glasses (spectacles); sports glasses (spectacles); straps for spectacles; sun spectacles.</p>
		<p><u>Class 14</u> Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments; <i>jewelry, namely, necklaces and bracelets.</i></p>	
		<p><u>Class 18</u> Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; backpacks, duffel bags, gym bags, handbags, tote bags, travel bags, purses, wallets, luggage, key cases, credit card cases, brief cases, cases for toiletries and umbrellas.</p>	
		<p><u>Class 25</u> <i>Clothing, footwear, headgear; clothing, namely, bathrobes, beach cover-ups, beachwear, belts, blazers, blouses, body shapers [foundation garments],</i></p>	

	<p>body suits, boxer shorts, bras, bustiers, camisoles, caps, coats, dresses, footwear, foundation garments, garter belts, girdles, gloves, gowns, halter tops, hats, headbands, hosiery, jackets, jeans, jogging suits, knee high stockings, knit shirts, knit tops, leotards, lingerie, loungewear, mittens, negligees, night gowns, night shirts, pyjamas, panties, pants, pantyhose, sarongs, scarves, shirts, shorts, skirts, slacks, sleepwear, slippers, socks, stockings, suits, sweat pants, sweat shirts, sweat shorts, sweat suits, sweaters, swim wear, t-shirts, tank tops, tap pants, teddies, ties, tights, underpants, undershirts, underwear and vests.</p> <p><u>Class 35</u> Retail store services in relation to clothing, footwear, headgear, bags, accessories and personal care products.</p>	
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128 The Opponents sought to rely specifically on the case of *Festina* (paragraph 58 of the Opponents’ written submissions). The Opponents submitted, that in *Festina*, the goods in comparison were as follows (see *Festina* at [64]):

Relevant goods claimed under application mark	Relevant goods under Appellant’s registrations
<p><u>Class 14</u> ...necklaces; rings; bracelets; earrings; medals; brooches</p>	<p><u>Class 9</u> <u>Spectacles</u></p>
	<p><u>Class 18</u> Leather and imitation leather; goods made of these materials and not included in other classes; animal skins and hides; trunks and suitcases; umbrellas; parasols...</p>
	<p><u>Class 25</u> <u>Clothing and footwear</u></p>

129 The Opponents further referred to paragraphs [71] and [72] in *Festina*:

[71]...there is a growing phenomenon of brands expanding into goods of various kinds in recent years. Sometimes, the crossing-over takes place between goods that one does not commonly associate with each other, for instance, cigarettes and clothing. The idea of licensing out one's trade mark or engaging in a sister brand or diffusion line has inevitably led to the same trade mark being found on a multitude of goods available in the market. In this regard, **there is force in the Appellant's submissions that there is a sense of "relatedness" between goods such as necklaces and clothing and a broad classification of these items as "fashion accessories" or "lifestyle goods" may be justified.**

[72] Applying the *British Sugar* ([66] *supra*) test to the present facts, it would be reasonable in the modern context to regard the goods in **Classes 9, 14, 18 (trunks and suitcases and, in some instances, even umbrellas and parasols) and 25 as complementary in nature and are likely to be of similar uses, targeting almost identical end users and employing similar if not identical trade channels by which the goods reach the market.** Thus, there is some similarity between "necklaces, rings, bracelets, earrings, medals and brooches" in the Respondent's application and the goods for which the Appellant's other marks are registered in Classes 9, 18 (the items specified above) and 25.

[Emphasis in bold the Opponents' and emphasis as underlined mine]

130 The High Court concluded as follows in at *Festina* [75]:

[75] To summarise the findings thus far:

...

(c) There is similarity between "necklaces, rings, bracelets, earrings, medals and brooches" in the Respondent's application and the Appellant's goods in Classes 9, 18 (trunks and suitcases and, in some instances, even umbrellas and parasols) and 25.

[Emphasis as underlined mine]

131 The Opponents submitted, at paragraph 63 of their written submissions, that the classes of goods to be compared here are practically on all fours with the classes of goods compared in *Festina*.

132 I refer to the goods for which the Application Mark and the Opponents' Earlier Marks are registered for (above). For ease of reference, the pertinent goods in light of *Festina* have been underlined above and for ease of reference indicated below:

<i>Opponents' Earlier "A&F" Marks</i>	<i>Application Mark</i>
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	T1117126D	<p><u>Class 14</u> Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; <u>jewelry</u>, precious stones; timepieces and chronometric instruments.</p>	<p><u>Class 9</u> Anti-dazzle spectacles; bars for spectacles; bows adapted for spectacle frames; carrying cases adapted for spectacles; cases adapted for spectacles; chains for spectacles; computer programs for use in fitting spectacles; containers for spectacles; cords for spectacles; devices for supporting spectacles; devices in the nature of spectacles for displaying televised images; devices in the nature of spectacles for viewing recorded video images; devices in the nature of spectacles for viewing televised images; finished lenses for spectacles; fitted cases for spectacles; frames for spectacles; lenses for spectacles; lorgnettes (spectacles); optical lenses for use with spectacles; optical spectacles; protective glasses (spectacles); protective spectacles; safety spectacles; spectacle cases; spectacle chains; spectacle frames; spectacle frames having elastic hinges; spectacle holders; spectacle lenses; spectacle mountings; spectacle support bands, chains, cords, and straps; <u>spectacles</u>; spectacles (optics); spectacles for sports; spectacles used in information science; sport glasses (protective spectacles); sport glasses (spectacles); sports glasses (spectacles); straps for spectacles; sun spectacles.</p>
	T0002873B	<p><u>Class 25</u> <u>Clothing, footwear, headgear.</u></p>	
	T0721760C	<p><u>Class 25</u> <u>Clothing, footwear, headgear;</u> clothing, namely, bathrobes, beach cover-ups, beachwear, belts, blazers, blouses, body shapers [foundation garments], body suits, boxer shorts, bras, bustiers, camisoles, caps, coats, dresses, footwear, foundation garments, garter belts, girdles, gloves, gowns, halter tops, hats, headbands, hosiery, jackets, jeans, jogging suits, knee high stockings, knit shirts, knit tops, leotards, lingerie, loungewear, mittens, negligees, night gowns, night shirts, pyjamas, panties, pants, pantyhose, sarongs, scarves, shirts, shorts, skirts, slacks, sleepwear, slippers, socks, stockings, suits, sweat pants, sweat shirts, sweat shorts, sweat suits, sweaters, swim wear, t-shirts, tank tops, tap pants, teddies, ties, tights, underpants, undershirts, underwear and vests.</p>	

<i>Opponents' Earlier Moose Device Marks</i>	
T0721747F	<p><u>Class 14</u> Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments; <u>jewelry, namely, necklaces and bracelets</u></p> <hr/> <p><u>Class 25</u> <u>Clothing, footwear, headgear</u>; clothing, namely, bathrobes, beach cover-ups, beachwear, belts, blazers, blouses, body shapers [foundation garments], body suits, boxer shorts, bras, bustiers, camisoles, caps, coats, dresses, footwear, foundation garments, garter belts, girdles, gloves, gowns, halter tops, hats, headbands, hosiery, jackets, jeans, jogging suits, knee high stockings, knit shirts, knit tops, leotards, lingerie, loungewear, mittens, negligees, night gowns, night shirts, pyjamas, panties, pants, pantyhose, sarongs, scarves, shirts, shorts, skirts, slacks, sleepwear, slippers, socks, stockings, suits, sweat pants, sweat shirts, sweat shorts, sweat suits, sweaters, swim wear, t-shirts, tank tops, tap pants, teddies, ties, tights, underpants, undershirts, underwear and vests.</p>

133 In light of the above, I agree that the classes, and specifically the particular specification of goods (as underlined) to be compared here are practically on all fours with the classes of goods (and the particular specification of goods as underlined above)

compared in *Festina*. Having regard to the fact that I am bound by *Festina*, I conclude that there is similarity here with regard to the goods as claimed under the marks as underlined.

134 The Opponents also submitted, at paragraph 64 of their written submissions, that there is evidence that it is common for clothing retailers to branch out into fashion accessories including glasses and sunglasses. However, I do not think it is necessary to delve into this argument at this juncture for the purposes of this element under this ground of objection.

Likelihood of Confusion

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

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

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

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

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

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

(b) Factors relating to the impact of goods-similarity on consumer perception: it would be legitimate to take into account factors concerning the very nature of the goods without implicating any steps that are taken by the trader to differentiate the goods. This includes the normal way in or the circumstances under which consumers would purchase goods of that type (see [20] above, Mystery Drinks at [48], Lloyd Schuhfabric Meyer v Klijsen Handel BV, Case C-342/97 [1999] 2 CMLR 1343 at 1352; and Philips-Van Heusen Corp v OHIM [2004] ETMR 60 at [55]). This factor is not directly dependent on the marketing choices that the trader makes. As alluded to at [94] above, it would also be relevant to have regard to whether the products are expensive or inexpensive items, the nature of the goods and whether they would tend to command a greater or lesser degree of fastidiousness and attention on the part of prospective purchasers (see generally Hai Tong at [85(c)(i)]), and the likely characteristics of the relevant consumers and whether they would or would not tend to apply care or have specialist knowledge in making the purchase. We refer here to In the matter of an Application by the Pianotist Company for the Registration of a Trade Mark (1906) 23 RPC 774 (“Pianotist”) where it was observed that, having regard to the nature of the article in question (musical instruments), the (high) price at which it was likely to be sold, and the nature of the consumers who are likely to purchase such products (“generally persons of some education”), a man of ordinary intelligence was unlikely to be confused (at 778). The price of the type of product being sold is distinct from the issue of price disparity between the parties’ products. The former consideration directly impinges on the degree of care the consumer is likely to pay to his purchase and therefore his ability to detect subtle differences. As observed in Reed Executive Plc v Reed Business Information Ltd [2003] RPC 12 at [103], “a 50 pence purchase in the station kiosk will involve different considerations from a once-in-a-lifetime expenditure of 50,000 pounds”. On the other hand, superficial price disparity between the competing goods, which speak more about the trader’s marketing choices rather than differences in the nature of the goods themselves, is not a factor we find relevant to the inquiry.

[Emphasis as underlined mine].

136 With regard to the Opponents' Earlier "A&F" Mark and the Application Mark, I have concluded above that in terms of the factors relating to the impact of marks-similarity on consumer perception, the marks are visually similar to some extent, aurally similar and conceptually similar to a low extent such that the marks are more similar than dissimilar in totality. In this regard, as the relevant goods are retail items (jewellery and spectacles), it is the visual and aural aspects which are more important.

137 I have also concluded above that the Opponents' Earlier "A&F" Mark is not only inherently distinctive but also possesses a high level of technical distinctiveness. In addition, the Opponents' Earlier "A&F" Mark has been claimed to have acquired *de facto* distinctiveness having regard to the use of the Opponents' Earlier "A&F" Mark (although the extent to which the sales and promotional figures in Singapore which can be accorded to it can only be an approximate).

138 It is also noted that the Courts have cautioned that "a strong reputation does not necessarily equate to a higher likelihood of confusion, and could in fact have the contrary effect". Whether this is so will depend on the actual circumstances of the case. Suffice it to say that in the current case I am of the view that the reputation of the Opponents' Earlier "A&F" Mark would be one factor which enhances the likelihood of confusion.

139 In relation to the Opponents' Earlier Moose Device Mark, I have concluded above that the marks are visually similar, aurally neutral and conceptually similar to some extent such that the marks are more similar than dissimilar in totality.

140 Similarly, I have also concluded above that the Opponents' Earlier Moose Device Mark is not only inherently distinctive but also has a high level of technical distinctiveness. Additionally, the Opponents' Earlier Moose Device Mark has been claimed to have acquired *de facto* distinctiveness having regard to its use (although the extent to which the sales and promotional figures in Singapore which can be accorded to it can only be an approximate).

141 Last but not least, I am of the view that the reputation of the Opponents' Earlier Moose Device Mark in this case would be a factor which increases the likelihood of confusion.

142 In relation to the issue of goods similarity, I am mindful of the case of *The Polo/Lauren Company, L.P. v United States Polo Association* [2015] SGIPOS 10 ("*Polo*") where the learned IP Adjudicator concluded as follows at [109] and [110]:

[109] Having clarified this matter, though, I do not think that it is necessary in every case to focus on the price of the type of goods concerned. Ultimately, the aim of the exercise is to determine the degree of care that the average consumer is likely to pay when purchasing that type of goods. In this exercise, there may be factors other than price which are more useful.

[110] In my view, eyewear is a type of goods the purchase of which involves a fairly high degree of care regardless of their price range, for the following reasons. First, eyewear as a type of goods is not purchased on a regular or frequent basis. Second, eyewear as a type of goods is usually bought through salespersons particularly, as the Opponents have pointed out, when they are sold in optical shops. Third, eyewear is a type of goods that will command a higher degree of fastidiousness on the part of a consumer who is likely to inspect the product closely in order to decide if the particular spectacle frame fits well in terms of comfort level (e.g. whether the nose pad of the spectacle frame sits comfortably on the consumer's nose bridge).

...

[112] ...Where similarity of the marks is concerned, it should be noted that eyewear are usually purchased based on visual inspection and hence the visual aspect of the marks is likely to have a greater impact on the consumer: see [101(c)(i)] above...

[Emphasis as underlined mine]

143 However, despite the above, I am of the view that the similarity between the marks is likely to cause confusion. The Applicants have essentially combined the *whole* of the Opponents' Earlier "A&F" Mark and the *whole* of the Opponents' Earlier Moose Device Mark. It ill behoves them to argue that: (a) on the one hand that there is no (or little) likelihood of confusion with the Opponents' Earlier "A&F" Mark as the Application Mark also incorporates the Opponents' Earlier Moose Device Mark; and (b) on the other hand that there is no (or little) likelihood of confusion with the Opponents' Earlier Moose Device Mark as the Application Mark also incorporates the Opponents' Earlier "A&F" Mark. This is discussed in more detail below when considering the ground of opposition under Section 8(7)(a) (specifically, when discussing the issue of misrepresentation).

144 The ground of opposition under Section 8(2)(b) therefore succeeds.

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

145 Section 8(4) of the Act reads:

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

- (a) the earlier trade mark is well known in Singapore; and*
- (b) use of the later trade mark in relation to the goods or services for which the later*

trade mark is sought to be registered —

(i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark...

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

Similarity of marks

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

147 In relation to this element, the Opponents repeat their submissions (see paragraph 91 of the Opponents' written submissions) in relation to the "similar" limb under Section 8(2)(b). In relation to this element, my view is primarily the same in relation to the "similar" element under Section 8(2)(b).

148 In short, I am of the view that this element has been made out.

Well-known in Singapore

149 The critical question is whether the Opponents' Earlier Marks are well known in Singapore as at the relevant date of 4 June 2013, which is the date of application of the Application Mark.

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

Section 2(7) of the Act states:

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

(a) the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;

(b) the duration, extent and geographical area of –

(i) any use of the trade mark; or

(ii) any promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied;

- (c) *any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application;*
- (d) *any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory;*
- (e) *any value associated with the trade mark.*

Section 2(8) of the Act reads:

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

Section 2(9):

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

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

151 Section 2(7)(a) is arguably the most crucial factor when determining whether a trade mark is well known in Singapore due to Section 2(8) of the Act which states that “[w]here it is determined that a trade mark is well known to any relevant sector of the public in Singapore, the trade mark shall be deemed to be well known in Singapore”: see [139] of *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] SGCA 13 (“*Amanusa*”).

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

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

153 However, despite the above, the High Court in *Caesarstone Sdot-Yam Ltd v Ceramiche Caesar SpA* [2016] SGHC 45 (“*Caesarstone*”) commented as follows at [159] and [160]:

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

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

It is noted that *Caesarstone* is subject to appeal to the Court of Appeal. However, as at the date of this decision, the High Court decision is still applicable.

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

155 Further, following *Amanusa* at [137]:

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

[Emphasis as underlined mine].

156 In relation to this ground of objection, the Opponents submitted, at paragraph 84 of their written submissions, that the relevant sector of the public in Singapore is the actual and potential consumers of goods bearing the Opponents’ Earlier Marks (ie consumers of fashion accessories and clothing), the persons involved in the distribution of goods bearing the Opponents’ Earlier Marks and the businesses and companies in Singapore dealing with goods bearing the Opponents’ Earlier Marks.

157 In particular, the Opponents argued that the following factors are relevant (paragraphs 86 – 90 of the Opponents’ written submissions):

- (i) The “A&F” trade mark has been in use in the USA since at least as early as 1978 while the Moose Device has been in continuous use in the USA since as early as 2002;
- (ii) The Opponents’ Earlier “A&F” Mark and the Opponents’ Earlier Moose Device respectively has been in use in Singapore since at least

- as early as 2002 when goods purchased on the Opponents' website were shipped to Singapore;
- (iii) The Opponents' boutique in Orchard Road opened in 2011 and goods bearing the Opponents' Earlier Marks have been sold from the physical boutique since then.
 - (iv) There was also a great amount of publicity regarding the opening of the Opponents' boutique in Singapore;
 - (v) The total annual sales of goods from the Opponents' website to Singapore for the period 2002 – 2013 are substantial (see above);
 - (vi) The total annual store sales at the Opponents' store in Singapore for the period 2011 – 2013 are also substantial (see above);
 - (vii) The total annual sales of Opponents' goods worldwide for the period 2000 – 2013 are very substantial (see above);
 - (viii) The Opponents' marks have been widely promoted worldwide and in Singapore and the total annual promotional expenditure, including for the Opponents' Earlier Marks for the period 2002 – 2013 are very substantial (see above);
 - (ix) The Opponents also argued that the "A&F" trade mark and the Moose Device have been extensively protected around the world through numerous trade mark applications / registrations as follows:
 - a. The "A&F" trade mark and the Moose Device have been protected in many countries for well over 50 years and this protection has been consolidated with on-going filings over the entirety of the brand's life.
 - b. The jurisdictions in which the Opponents and / or their predecessors own their registrations for the "A&F" trade mark and the Moose Device include, amongst others (i) USA; (ii) United Kingdom; (iii) China; (iv) Australia; and (v) the European Union.
 - (x) Finally, the Opponents sought to highlight the following:
 - a. The "A&F" trade mark has been recognised as being well-known in the following countries / territories:
 - (i) Korea Intellectual Property Office (KIPO);
 - (ii) Turkish Patent Institute;
 - (iii) Office for Harmonization in the Internal Market ("OHIM") (now known as European Union IP Office);
 - (iv) Supreme Court of France;
 - (v) Spanish Patent & Trade Mark Office; and
 - (vi) Swiss Federal Institute of Intellectual Property
 - b. The Moose Device has been recognised as being well-known by the following countries / territories:
 - (i) Korea;
 - (ii) Spain;
 - (iii) Taiwan; and
 - (iv) OHIM.

158 In light of the foregoing, the Opponents submitted (at paragraph 90 of their written submissions) that the Opponents' Earlier Marks are well known to the relevant sector of the public in Singapore and by virtue of Section 2(8) of the Act, the Opponents' Earlier Marks are deemed to be well known in Singapore.

159 I have mentioned the *local* sales and promotional expenditure of the Opponents above. The total worldwide sales and promotional figures of the Opponents have also been referred to above.

160 In contrast, the sales figures in *Caesarstone* are as follows at [153]:

Year	Singapore Sales (in SGD)	Worldwide sales (in SGD)
2002	3,390,094	119,929,925
2003	1,874,266	108,568,093
2004	935,055	119,036,242
2005	1,433,751	159,243,918
2006	203,634	173,550,987
2007	577,656	176,795,005

161 The promotional figures in *Caesarstone* are provided at [155] although it is noted that it is unclear as to the extent to which the figures relate to promotional activities in Singapore:

Worldwide Promotional Figures	
Year	Amount (SGD)
2002	273,387
2003	247,812
2004	1,339,131
2005	2,092,412
2006	2,234,788
2007	1,120,784

162 A comparison of the sales figures will show that the Opponents in the current case enjoy much stronger sales in Singapore in contrast to the Appellants in *Caesarstone*. It is noted that the average annual store sales in Singapore for the period 2011- 2013 for the Opponents in the current case is **SGD 20,755,469.56** (although, I am mindful of the fact that it is unclear as to the extent to which the figures above can be apportioned to the Opponents' Earlier Marks in the current case). In contrast, the average annual sales figure for the Appellants in *Caesarstone* is **SGD 1,402,409.33**.

163 The same is true for the promotional figures. I note that the average annual worldwide promotional expenditure (including for the Opponents' Earlier Marks) for the period 2002 - 2013 for the Opponents in the current case is **SGD 39,943,183.33** while the worldwide promotional figures (including Singapore) for the period 2002 - 2007 in *Caesarstone* is **SGD 1,218,052.33**.

164 I am mindful of the caution given by the High Court in *Caesarstone* above. However, I am of the view that, in light of the evidence above, the Opponents' Earlier Marks could be said to be well known to the relevant sector of the public, and in this case, all actual consumers and potential consumers / all persons involved in the distribution / all businesses and companies dealing with, in Singapore, of the goods or services to which the Opponents' Earlier Marks are applied, specifically, the Opponents' goods or services.

165 With the above in mind, I am of the view that this limb has been satisfied.

Confusing connection

166 In this regard, the Court at *Staywell* provided as such at [120]:

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

167 Further, as submitted by the Opponents, in *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2012] SGCA 56, the Court held that:

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

168 Having taken the above into consideration, I am of the view that there will be a confusing connection here for largely the same reasons that I have provided for my conclusion in relation to the likelihood of confusion under Section 8(2)(b) as well as for misrepresentation under the ground of objection for passing off, below.

Likelihood of Damage

169 In relation to this element, *Amanusa* provided at [234]:

[234] In the instant case, we agree with the Judge's finding (at [74] of the Judgment) that the tests to be adopted for the purposes of the "connection" requirement and the "likely to damage the [plaintiff's] interests" requirement in s 55(3)(a) of the current TMA would yield the same results as those obtained from applying the corresponding tests *vis-à-vis* the Respondents' claim for passing off...However, we pause to clarify that while the tests relating to misrepresentation and damage under the law of passing off are substantively the same as the tests relating to, respectively, the "connection" requirement and the "likely to damage the [plaintiff's] interests" requirement in s 55(3)(a) of the current TMA, the two sets of tests are not identical in one aspect. An important

distinction is that the tests relating to misrepresentation and damage in passing off actions concern the plaintiff's goodwill (see [69] above), whereas the corresponding tests under s 55(3)(a) of the current TMA concern the *interests* of the plaintiff and *not* its goodwill (indeed, as the definition of "well known trade mark" in s 2(1) of the current TMA makes clear, the plaintiff's trade mark may be a "well known trade mark" for the purposes of s 55(3)(a) even if the plaintiff has no goodwill in Singapore).

[Emphasis as underlined mine]

170 With regard to this element, the Opponents argued at paragraph 95 of their written submissions

95 One well-recognised head of damage is where there is "*an identical field of business activity giving rise to direct competition*" (see *Hai Tong* at [118]). On the present facts, it is important to bear in mind that the goods covered by the Application Mark and the Opponent's "A & F" Marks and  Marks are closely related. We have also shown that there is a real likelihood of confusion. The "*real likelihood of damage*" arises from the potential diversion of sales from one party to another if consumers of the relevant segment of the public were led to believe that the goods under the Application Mark were associated with or connected with the Opponent.

171 I do not think that there will be any "diversion of sales". I am of the view that the likelihood of damage comes in the form of restriction on the Opponents to expand into eyewear. In this regard, the Court of Appeal in *Amanusa* provided as such:

[117] We accept the principle that a plaintiff who has established goodwill in one form of commercial activity ("the established activity") may be entitled to protection from passing off *vis-à-vis* another form of commercial activity which is a natural expansion of the first ("the extended activity"). Thus, in *Alfred Dunhill Limited v Sunoptic SA* [1979] FSR 337, it was understandable why the English Court of Appeal prevented the defendant from marketing sunglasses under the name "Dunhill" given that the plaintiff, a well-known producer of tobacco goods under the same name, had expanded its business to include the sale of luxury goods for men, likewise under the name "Dunhill". The plaintiff had also showed that although it had not sold sunglasses in England, it was planning to produce sunglasses itself.

[118] It is, however, important to stress the close connection which must exist between the established activity and the extended activity for that connection forms the foundation for this head of damage. Wadlow in *The Law of Passing-Off* ([73] *supra*) cites (at para 4-42) the following extract from the American case of *S C Johnson & Son, Inc v Johnson* 116 F 2d 427 (2nd Cir, 1940) at 429 (*per Hand J*) as being representative of the English position in this regard:

It is true that a merchant who has sold one kind of goods ... sometimes finds himself driven to add other 'lines' in order to hold or develop his existing market; in such cases he has a legitimate present interest in preserving his identity in the ancillary market, which he cannot do ... if others make his name equivocal there. But if the new goods have no such relation to the old, and if the first user's interest in maintaining the significance of his name when applied to the new goods is nothing more than the desire to post the new market as a possible preserve which he may later choose to exploit, it is hard to see any basis for its protection [*ie*, for the protection of the merchant's name in the new market]. The public may be deceived, but [the merchant] has no claim to be its vicarious champion; his remedy must be limited to his injury and by hypothesis he has none.

In our view, this passage is representative of the position in Singapore as well.

[121] In our view, in the instant case, the Respondents' field of business (which, in the context of this appeal, is the high-end hotel and resort business (see [65] above)) and the Appellant's field of business (*viz*, the residential accommodation business) are closely connected. Both fields concern accommodation. The fact that the Respondents have already expanded into the residential accommodation business overseas (see [8]–[9] above) buttresses this conclusion... The use by the Appellant of the name "Amanusa" or of other names similar to the "Aman" names in the field of residential accommodation in Singapore would prevent the Respondents from expanding into the residential accommodation business in this country. For this reason, we hold that this head of damage (*viz*, restriction on the Respondents' expansion into the residential accommodation business) has been proved.

[Emphasis as underlined mine]

172 As mentioned above, the Opponents sought to tender evidence to show that it is common for clothing retailers to branch out into fashion accessories including glasses and sunglasses. This is reflected in Exhibit 14 of the Opponents' 1st Evidence, which I have already referred discussed in detail above.

173 Further, as noted above, the Opponents have, albeit belatedly, sought to apply for marks in relation to Class 9 overseas, the details of which have been referred to briefly above. One example is their registration in Switzerland and the details are as follows:

- (i) Registration No. 652031
- (ii) Application Date: *21 August 2013*
- (iii) Class: 9
- (iv) Specification: Eye glasses; sunglasses...
- (v) Mark: Moose Device

174 Taking all of the above into account, I am of the view that the element of likelihood of damage has been made out.

175 The ground of opposition under Section 8(4) therefore succeeds.

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

176 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)

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

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

178 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* 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].

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

180 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 4 June 2013.

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

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

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

[Emphasis as underlined mine]

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

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

[Emphasis as underlined mine]

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

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

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

184 Last but not least, the High Court in *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] SGHC 216 (“*Rovio 2*”) 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].

185 In relation to goodwill I have already dealt with the Opponents’ sales and promotional figures in *Singapore*. As mentioned above, a point to note in relation to the figures above is that the figures do not simply reflect the Opponents’ Earlier Marks, but other marks of the Opponents as well and in relation to a range of the Opponents’ goods, and not just in relation to the relevant goods claimed under the Opponents’ Earlier Marks. However, as elucidated above, under this ground of objection for passing off, the Opponents can rely not only on the Opponents’ Earlier Marks but also any other relevant get-up as well.

186 Further, the Opponents are also not restricted to the relevant goods claimed under the Opponents’ Earlier Marks. The only issue is that the different goods to which the Opponents’ get-up have been applied to may affect the issue of the proximity of the fields the parties are engaged in and in turn affect the element of misrepresentation. This is dealt with below.

187 In light of the above, I am of the view that, the Opponents have shown that they have the relevant goodwill in Singapore, at the very latest, by 2011, when the Opponents’ physical store was opened in Singapore. This is so, especially in light of the High Court’s guidance above that the Opponents only need to show a *prima facie* case of passing off.

Misrepresentation

188 Some of the more pertinent factors under this element in relation to this case are as follows (see *Law of Intellectual Property of Singapore* at [18.3.13] – [18.3.16]):

- (i) The nature of the relevant public has been identified as not unobservant morons in a hurry but ordinary sensible people using ordinary care. This level of ordinary care will vary depending on various factors including:
 - a. Whether the goods / services are expensive
 - b. The length and complexity of the purchase transaction

- c. Whether the goods / services are of a specialised nature which are purchased by professionals
- d. Level of education of the purchaser.

Using the factors including those above, the court will calibrate the degree of "consumer sophistication" of the ordinary or average person in the relevant public to determine the level of care that this person would exercise when making purchasing decisions.

- (ii) The question whether there would be confusion is a matter to be decided by the judge.
- (iii) The finding of confusion is a question of fact to be determined by the court in light of surrounding circumstances. Some factors which have been applied by the Courts are as follows:
 - a. Degree of similarity between the parties' get-ups
 - b. Degree of distinctiveness of the plaintiff's get-up
 - c. Price differences between the parties' goods or services
 - d. Proximity of the parties' fields of activity.

189 I propose to deal with the factors listed in item (iii) first.

Degree of distinctiveness of the Opponents' get-up

190 The issue of distinctiveness of the Opponents' Earlier Marks has been discussed extensively above. In essence, I am of the view that the Opponents' Earlier Marks are inherently distinctive and enjoys a high degree of technical distinctiveness as they are meaningless in relation to the relevant goods claimed.

191 The above is bolstered by the use of the Opponents' Earlier Marks in Singapore. The local sales and promotional figures have been provided above and will not be repeated here. It has also been commented above that the figures as provided above cannot be taken literally to simply reflect use of the Opponents' Earlier Marks *per se*.

192 Nevertheless, as mentioned above, for the purposes of an objection under passing off, the get-up of the Opponents (which includes the Opponents' Earlier Marks) can be taken into account. In this regard, the Opponents' get up includes, for example, "Abercrombie & Fitch" or the Opponents' Earlier Moose Device Mark together with "Abercrombie & Fitch" (see Exhibit 11 of the Opponents' 1st Evidence, pages 605 and 601 respectively). See also for example, Exhibit 8 at page 508 – third item which shows a T-shirt, with the moose device in between the two characters "A" and "F" as well as at page 528 of the same Exhibit, the third item, which shows the Opponents' Earlier "A&F" Mark on top and the Opponents' Earlier Moose Device Mark below. Finally, reference is made to Exhibit 10 at page 591, which shows "A & Fitch" and the Opponents' Earlier Moose Device Mark below.

193 Needless to say, it would be obvious that, for example, the Opponents' Earlier Moose Device Mark together with "Abercrombie & Fitch" would be inherently distinctive in relation to the goods.

194 To conclude this issue, I am of the view that in light of the inherent and *de facto* distinctiveness of the Opponents' get-up, the Opponents' get-up can said to be highly distinctive.

Degree of similarity between the parties' get-ups

195 For ease of comparison, the relevant marks are as follows:

TABLE 1		
S/N	Application Mark	Opponents' Earlier "A&F" Mark
1.		A&F
2.		<i>Opponents' Earlier Moose Device Mark</i>
		

196 The striking similarity between the moose device in the Application Mark and the Opponents' Earlier Moose Device Mark has been commented on above and I will not repeat it here.

197 In short there is an uncanny resemblance as follows:

- (i) The positioning of the legs;
- (ii) There is no beard above the neck;
- (iii) There is no tail;
- (iv) The arrangement of the antlers.

198 In addition, it has been mentioned above that the Opponents' get-up includes, for example, the Opponents' Earlier Moose Device Mark together with "Abercrombie & Fitch" (see Exhibit 11 of the Opponents' 1st Evidence at 601). When compared with the Application Mark, this increases the similarity of the marks / get-up as the consumer is likely to think that the characters "A&F" are simply the acronym of "Abercrombie & Fitch".

199 Thus such actual use would enhance the similarity between the Application Mark and the Opponents' get-up.

Proximity of the parties' fields of activity

200 In relation to this issue, Justice Wei in **Rovio 2** provided as follows:

[199] Whilst the law of passing off no longer requires that the parties are competing in the same or common field of activity, a relevant factor in deciding whether any misrepresentation is likely to cause confusion is how close or far apart the fields of activity are. Much will depend on the actual facts and circumstances. As was said in *Ng-Loy Wee Loon* at para 18.3.28:

The closer the defendant's field of business activity is to that of the plaintiff, the greater is the risk of confusion. However, it does not automatically follow from this that confusion cannot arise if the parties are in completely different fields of activity.

[200] In general, the fact that the defendant used a similar mark in a wholly unrelated field will lessen the likelihood of confusion, and, indeed, damage. But, equally, where the plaintiff's mark is well established and the fields of activity (whilst not identical) are close or related, a likelihood of confusion and damage may still be found. Other relevant factors in determining misrepresentation and confusion include whether the plaintiff has already started using the mark in that different field of activity.

[Emphasis as underlined mine]

201 In the current case I have already concluded under the ground of Section 8(2)(b) that the relevant goods in question are similar. This is on the basis of **Festina**, which is binding on me.

202 Further, as alluded to above, the Opponents argued, at paragraph 64 of their written submissions (albeit for the ground of objection under Section 8(2)(b)) that there is "relatedness" between the Opponents' relevant goods on the one hand and the Applicants' goods on the other. The Opponents' evidence in this regard was tendered as Exhibit 14 of the Opponents' 1st Evidence. The evidence has been discussed in detail above and will not be repeated here.

203 In light of the above, the parties can be considered to be in related fields of business and thus illustrate the proximity of the activities.

Price differences between the parties' goods or services / Level of care

204 I will deal with price difference and level of care (see item (i) above) together as they are inter-related.

205 In relation to the above factors, I am mindful of *Polo* where the learned IP Adjudicator concluded as follows at [109] – [112]:

[109] Having clarified this matter, though, I do not think that it is necessary in every case to focus on the price of the type of goods concerned. Ultimately, the aim of the exercise is to determine the degree of care that the average consumer is likely to pay when purchasing that type of goods. In this exercise, there may be factors other than price which are more useful.

[110] In my view, eyewear is a type of goods the purchase of which involves a fairly high degree of care regardless of their price range, for the following reasons. First, eyewear as a type of goods is not purchased on a regular or frequent basis. Second, eyewear as a type of goods is usually bought through salespersons particularly, as the Opponents have pointed out, when they are sold in optical shops. Third, eyewear is a type of goods that will command a higher degree of fastidiousness on the part of a consumer who is likely to inspect the product closely in order to decide if the particular spectacle frame fits well in terms of comfort level (e.g. whether the nose pad of the spectacle frame sits comfortably on the consumer’s nose bridge).

[112] ...Where similarity of the marks is concerned, it should be noted that eyewear are usually purchased based on visual inspection and hence the visual aspect of the marks is likely to have a greater impact on the consumer: see [101(c)(i)] above...

[Emphasis as underlined mine]

206 However, in this case, I am of the view that the striking similarity between the get-ups, as well as the proximity of the relevant goods are likely to cause confusion *even* in light of, for example, the normal circumstances of purchase of such goods as highlighted in *Polo*. In this regard, the Opponents went further to argue that even the sales person would be confused in light of the two factors as discussed.

207 In relation to the price of the products, the Opponents argued at the oral hearing that eyewear is considered as “mid-range” products. The Opponents sought to argue that in relation to eyewear, it is the lenses which constitute the bulk of the price such that the frames can only be considered as “mid-range” products. It is not necessary to go into such details. Suffice to say that I am of the view that eyewear in general (in totality, frames and lenses included) can be considered as “mid-range” products, that is, somewhere between “a 50 pence purchase in the station kiosk” and a musical instrument.

208 In any case, as elucidated by the IP Adjudicator in *Polo* “[u]ltimately, the aim of the exercise is to determine the degree of care that the average consumer is likely to pay

when purchasing that type of goods. In this exercise, there may be factors other than price which are more useful.”

Conclusion in relation to misrepresentation

209 Taking into account all of the surrounding factors, I am of the view that, on a balance of probabilities, there is a likelihood of misrepresentation that the Applicants and the Opponents are one and the same or that they are economically linked.

Damage

210 For the same reason that I am of the view that the element of likelihood of damage is made out under the ground of objection under Section 8(4)(b)(i) above, I am of the view that this element has been satisfied here. Specifically, I am of the view that the damage comes in the form of restriction on the Opponents to expand into eyewear.

Conclusion

211 In light of all of the above, the ground of opposition under Section 8(7)(a) therefore succeeds.

Conclusion

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

Dated this 16th day of August 2016

Sandy Widjaja

Principal Assistant Registrar of Trade Marks

Hearings and Mediation Group

Intellectual Property Office of Singapore