

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

Trade Mark No. T1300669D
28 March 2017

IN THE MATTER OF A TRADE MARK APPLICATION BY

THEFACESHOP CO., LTD.

AND

OPPOSITION THERETO BY

CONSOLIDATED ARTISTS B.V.

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

Ms Francine Tan (Francine Tan Law Corporation) for the Opponents

Ms Candice Kwok (Marks & Clerk Singapore LLP) for the Applicants¹

GROUND OF DECISION

¹ The agent for the Applicants did not appear at the oral hearing; they made submissions in writing only (see below).

1 In this competitive consumer market, it is imperative that business owners create catchy trade marks for their wares in order to stand out from other traders.

2 Under the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”), one of the requirements for registration is that a mark must be distinctive². This is because the Act grants a monopoly over a registered trade mark; registration ought not to be granted over a common descriptive word since such a word should remain in the public domain for all to use³.

3 An interesting question arises as to whether a common word can ever be regarded as distinctive? The answer to this question lies in the *relationship* between the common word and the goods / services for which this common word is sought to be registered. Thus, while clearly “Apple” cannot be registered for apples, “Apple” for computers would be regarded as sufficiently distinctive to secure registration. However, such a strategy can be a double-edged sword as illustrated by the current case.

4 In this case, Consolidated Artists B.V. (“the Opponents”) own the mark **MANGO** for many products, including clothing and cosmetics⁴ (Class 3). However, while the mark can be said to be distinctive of clothing in general, it is more difficult to show that it is distinctive for Class 3 products, since it may be descriptive of, for example, the main ingredient constituting such products.

5 The Opponents sought to rely on their earlier marks registered for cosmetics⁵, to oppose THEFACESHOP Co., Ltd’s (“the Applicants”) trade mark, T1300669D (“Application Mark”):

**MANGO
SEED
THEFACESHOP**

sought to be protected for the following goods in Class 3:

Cosmetics; skin lotions (cosmetics); moisturizing skin lotions; non-medicated skin astringents for cosmetic purposes; facial creams (cosmetic); facial moisturizers (cosmetic); facial preparations (cosmetic); cleansing emulsions; soap free washing emulsions for the body; after shave lotions; skin conditioners; blusher; perfumes; colognes; skin cleansing creams; make-up foundation in the form of powder; concealers; lipsticks; toilet water; eye shadow; eyebrow pencils; eye liners; nail polish; nail polish remover; beauty mask; sunblock skin creams (cosmetics); hair shampoo; hair rinse; hair spray; toilet soaps; bath soaps; body cleansers; fragrance mist for personal use; tonic mist for personal use (cosmetics); body gel; bath gel; body cream scrub; shampoos, soap; toothpaste.

² See section 7(1)(b).

³ In fact, this is the basis for the ground of objection under section 7(1)(c) of the Act.

⁴ Amongst others.

⁵ Amongst others.

in Singapore on 10 January 2013.

6 The Application Mark was accepted and published on 26 February 2014 for opposition purposes. The Opponents filed their Notice of Opposition to oppose the registration of the Application Mark on 23 April 2014. The Applicants filed their Counter-Statement on 22 August 2014. The Opponents filed evidence in support of the opposition on 13 April 2015. The Applicants filed evidence in support of the application on 13 October 2015.

7 On 29 October 2015, the Opponents raised an issue pertaining to the evidence filed by the Applicants. An interlocutory decision, *Consolidated Artists B.V. v The Faceshop Co. Ltd* [2016] SGIPOS 7 (“*Interlocutory Decision*”), was eventually issued on 6 September 2016 accepting the statutory declaration made by the Applicants’ deponent filed on 1 April 2016⁶. In the meantime, the Opponents filed their evidence in reply on 19 January 2016. Following the interlocutory decision, the Opponents filed supplementary evidence on 30 November 2016 to clarify that their evidence in reply also addressed the statutory declaration made by the Applicants’ deponent filed on 1 April 2016 (rather than the original version filed on 13 October 2015). The Pre-Hearing Review (“PHR”) was held on 11 January 2017. Following the PHR, the hearing was set for 28 March 2017⁷.

8 On 13 January 2017, the Applicants wrote to the Registrar to request for the words “MANGO SEED” in the Application Mark to be disclaimed. The Registrar wrote to the Opponents on 18 January 2017 asking for their comments, if any. The Opponents responded on 20 January 2017 that the entering of a disclaimer by the Applicants on the Trade Marks Register does not change the position in that they (the Opponents) are still proceeding with all grounds in the opposition.

9 In light of the above, the disclaimer was entered onto the Register on 1 February 2017.

10 The parties filed their written submissions for this case as follows:

- (i) Opponents written submissions filed on 28 February 2017 (OWS1);
- (ii) Applicants’ written submissions filed on 27 February 2017 (AWS); and
- (iii) Opponents rebuttal submissions tendered on 28 March 2017 (OWS2).

11 Only the Opponents elected to attend the hearing on 28 March 2017. The Applicants relied on their written submissions which had been filed earlier.

Grounds of Opposition

12 The Opponents rely on Sections 8(2)(b), 8(4) and 8(7)(a) of the Act in this opposition.

⁶ The Applicants in total filed three versions of their evidence and this was the 3rd version.

⁷ The Opponents confirmed at the PHR that they are not relying on Section 7(5) of the Act.

Opponents' Evidence

13 The Opponents' evidence comprises the following:

- (i) Statutory Declaration by Mr Jaume Passarell Beya, in-house lawyer of the Opponents, filed on 13 April 2015 ("Opponents' 1st SD");
- (ii) Statutory Declaration by Mr Beya, filed on 19 January 2016 ("Opponents' 2nd SD"); and
- (iii) Supplementary Statutory Declaration by Mr Beya, filed on 30 November 2016 ("Opponents' 3rd SD")⁸;

Applicants' Evidence

14 The Applicants' evidence comprises the following:

- (i) Statutory Declaration made by Mr Junsik Han, General Counsel of the Applicants, filed on 1 April 2016 ("the Applicants' 3rd SD")⁹.

Applicable Law and Burden of Proof

15 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

16 The Opponents submitted in their Notice of Opposition (at [1]) that they are the owner of the well-known MANGO trade mark which has been registered and used in many countries across the world, notably for fashion and fashion accessories. The Opponents submitted that the MANGO trade mark has been in use since 1984 when the first MANGO shop opened in Portal de l'Angel, Barcelona, Spain. In 1992, the 99th MANGO store in Spain was opened and from that time onwards, expansion into the international market began. The Opponents presently have approximately 2,420 stores in a total of 107 countries¹⁰. In the case of Singapore, the MANGO mark has been in use since 11 April 1996 when the first MANGO store opened in Singapore.

17 The Opponents rely on the following earlier marks which respectively is an "earlier mark" as defined in section 2 of the Act (collectively, *Opponents' Earlier Marks*):

⁸ This was following the *Interlocutory Decision* (above).

⁹ As indicated above, following the *Interlocutory Decision*, this 3rd version was the version which was accepted for the purposes of the current opposition proceeding.

¹⁰ Operating under marks such as MANGO, MNG and MNG by MANGO.

S/N	<i>Opponents' Earlier Marks</i>	Class
<i>Opponents' Earlier Mark 1</i>		
1	MANGO T0215724F	<u>Class 3</u> Bleaching preparations and other substances for laundry use; cleaning, polishing, grease removing and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.
2	MANGO T0215725D	<u>Class 9</u> Optical apparatus and instruments; eyewear, cases and frames thereof.
3	MANGO T0215726B	<u>Class 14</u> Precious metals and their alloys and goods made of or coated with these materials not included in other classes; jewellery, precious stones; timepieces and chronometric instruments.
4	MANGO T0215727J	<u>Class 18</u> Leather and imitation leather, goods made thereof not included in other classes; animal skins and hides; trunks and suitcases; umbrellas; parasols and walking sticks; whips and saddlery.
<i>Opponents' Earlier Mark 2</i>		
5	MANGO adorably T0509355I	<u>Class 3</u> Soaps, perfumery, essential oils, cosmetics, hair lotions; dentifrices.

18 The Applicants submitted ([6] and [7] of the Counter-Statement) that they are a South Korea-based skin care and cosmetics manufacturer, retailer and franchiser. They are a subsidiary of LG Household & Health Care, a division of LG Corporation. The Applicants have been in the business for more than a decade and have rapidly expanded to become the third largest cosmetics company in South Korea. The Applicants also expanded rapidly outside South Korea, with close to 1,000 stores in more than 20 countries.

Preliminary Issue

19 The Opponents have raised, as a preliminary issue that the Applicants had sought to enter a disclaimer on 13 January 2017, three years after the Application Mark has been filed (OWS2 at [3]).

20 The Opponents submitted, further, that the Applicants requested for the disclaimer to be entered without any explanation or notice to the Opponents. The Applicants also did not ask the Registrar for leave to do the same nor did the Applicants raise this issue at the PHR, which was held only two days earlier on 11 January 2017.

21 The Opponents' argued ([7] of OWS2):

- (i) After the issuance of acceptance and publication of the Application Mark, it would not have been possible to amend the Application Mark with the entering of the disclaimer as section 14 of the Act only specifies very limited situations under which a published application can be amended (*Issue 1*).
- (ii) The disclaimer was entered after the pleadings were closed, that is, after the boundaries of the dispute and the respective positions of the parties had been defined. There was no request to amend the Counter-Statement (*Issue 2*).
- (iii) The disclaimer effectively opens the way for the Applicants to leapfrog over the due process of the proper examination of the Application Mark (*Issue 3*).

22 The Opponents argued that the Opposition should be upheld on this basis alone, that is, on the basis that the Applicants sought to enter a disclaimer late in the Opposition proceedings, which is objectionable based on the three reasons above.

23 It is true that the Applicants raised this request only two days after the PHR. The PHR was the appropriate forum to raise this issue, having regard to the stage of the dispute. However, the Applicants' letter of 13 January 2017:

[3] ...we have been instructed by our client to disclaim the words "Mango Seed" for the [Application Mark]...

was *copied* to the Opponents, so the Opponents clearly had notice of the request.

24 Further, the Registrar wrote to the Opponents on 18 January 2017, asking them if they had *any comments* in relation to the request for a disclaimer. The Opponents responded on 20 January 2017:

[2] The entering of a disclaimer by the [Applicants] on the trade mark register does not change the position. Our client is therefore proceeding with all grounds in the opposition.

25 Therefore, it is not accurate to say that the Opponents had no notice of the request for the disclaimer. While it is true that the Applicants did not specifically write to the Opponents (which would be appropriate since the request was made in the midst of a contentious dispute), the Opponents did *in effect* have had notice of the request. They were also given an opportunity to respond to the request, to which they simply indicated that they were still proceeding with the opposition.

Issue 1 - Amendment of the Application Mark not allowed under section 14 of the Act

26 I start by commenting that section 14 is not the relevant provision of the Act for the purposes of a request to enter a disclaimer. In this regard, the Learned Principal Assistant Registrar (PAR) dealt with the issue of a disclaimer at length in *Christie Manson & Woods Limited v Chrित्रs Auction Pte. Limited* ("*Christie Mason*") [2016] SGIPOS 1. Although the factual situation was somewhat different from the current case (in *Christie Mason* it

was the Opponents who tried to rely on their earlier mark where there was a disclaimer), it is nonetheless relevant.

27 The Learned PAR in *Christie Mason* examined a list of both local and English cases before coming to his conclusion (see [45] – [63]). For the purposes of the instant case, I will only reproduce the relevant portions:

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


Registration subject to disclaimer or limitation


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

- (a) disclaim any right to the exclusive use of any specified element of the trade mark; or
- (b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation.

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

...



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

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

[49] The same approach was taken in *Coffee Club*, where it was held at [57] to [60] that “*the effect of a disclaimer..... is that other traders will be free to legitimately use these words..... However, the question of whether the Applicants’ and the*

Opponents' marks are confusingly similar such that a likelihood of confusion or deception arises will have to be determined regardless of the disclaimers imposed on the Opponent's marks." The Registrar cited an earlier edition of **Kerly's Law of Trade Marks and Trade Names**, namely the 12th Edition, paragraph 9-04 at page 142, which states: "The disclaimer does not appear on the mark as it is used, so that a mark which is deceptive as including matter distinctive of a competitor is not made less so by a disclaimer of that matter."

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

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

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

[52] However, neither the Applicants nor the Opponents cited *Pirelli* to me. At the same time, the Registrar in *Pirelli* did not consider either *Hu Kim Ai* or *Coffee Club*. For completeness, I should mention that these cases were each decided under different editions of the Trade Marks Act. However, the provisions relating to disclaimers appear to be very similar or identical.

...

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

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

...

[62] As can be seen, each of these UK cases expressly considered (and rejected) the Opponents' argument that disclaimers should only be taken into account in

infringement proceedings and not opposition proceedings. I find these cases sound in reasoning both from a construction and policy point of view. Accordingly, I am of the view that the Registrar’s decision in *Pirelli* reflects the correct position, and that disclaimers apply equally to registration/opposition proceedings as it does to infringement proceedings. Since the only possible point of similarity between the

CHRISTIE’S

佳
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Application Mark and the Opponents’ mark in Class 35 (“**佳士得**”) rests solely on the word “Christie’s”, which has been disclaimed, the opposition under Section 8(2)(b) relating to the Opponents’ mark in Class 35 must fail.

[63] For completeness, I should briefly mention that the [Singapore] *Pirelli* approach to the effect of a disclaimer is at *the mark similarity stage*. In contrast, the UK approach is relevant at the *likelihood of confusion assessment*. However, this does not arise from a different treatment of disclaimers...

[Emphasis as underlined mine].

28 In light of the above, the Opponents’ stance on this issue (that the presence of a disclaimer does not affect consumer perception since no consumer will be aware of the presence of the disclaimer) does not stand (see [5] of OWS2).

29 However, as mentioned above, it is noted that in this case, unlike the case in *Christie Mason*, it is the Applicants who requested for a disclaimer to be entered. The question is then what should be the position in the current situation?

30 On the one hand, if the disclaimer had been entered earlier at the registration stage, it is possible that such an action would have avoided the need for an Opposition action.¹¹ This means that the effect of a disclaimer with regard to the *comparison of marks* is the same *regardless* of whether the disclaimer relates to an earlier mark, or the application mark¹².

31 For ease of comparison the marks are as follows:

<i>Application Mark</i>	<i>Opponents’ Earlier Marks</i>
	<i>Opponents’ Earlier Mark 1</i>
	MANGO
	<i>Opponents’ Earlier Mark 2</i>

¹¹ My preliminary view is that even if the disclaimer has been entered at the application stage, the mark would still have proceeded to the publication for opposition stage.

¹² See further, *Law of Trade Marks and Passing Off in Singapore* (Sweet & Maxwell, Third Edition) by Tan Tee Jim, S.C. (“*Law of Trade Marks and Passing Off in Singapore*”) at [[6.124]:

...In practice, the ability to voluntarily disclaim would allow parties to use the disclaimer as a bargaining tool in negotiation as to whether or not a particular mark will be opposed. In particular, the use may be invoked in situations where a third person threatens to oppose a trade mark registration unless an element of the mark is disclaimed.

MANGO SEED THEFACESHOP	MANGO adorably
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32 Under this approach, since the only possible point of similarity between the Application Mark and the *Opponents' Earlier Marks* rests solely on the word “Mango”, and as “Mango Seed” has been disclaimed, the opposition under section 8(2)(b) must fail¹³.

33 On the other hand, the above interpretation would be unfair to the Opponents in that a voluntary restriction of rights by the Applicants should not affect the Opponents' ability to assert their rights; the Opponents have not disclaimed the word “Mango” in the earlier marks which they are relying on.

34 There were no substantial submissions by both parties on this issue (except that of the Opponents at [5] of OWS2 which has been dealt with by *Christie Mason* above and the Opponents' reference to *Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide* [2014] 1 SLR 911 (“*Staywell*”) at [90])¹⁴. Thus, this issue is best dealt with in another case where there are proper submissions on the same. For the purposes of the current case, this issue is *moot* as I am of the view that in the event the disclaimer cannot be taken into account, the marks are still more dissimilar than similar (see discussion below).

Issue 2 - No request was made to amend the boundaries of the dispute via an amendment of pleadings

35 At first blush, the Opponents' contention that the request to enter a disclaimer was entered after the pleadings were closed, that is, after the boundaries of the dispute and the respective positions of the parties had been defined, such that the opposition should be allowed on the basis of the request alone, sounds tenable¹⁵.

36 However, the Opponents did not raise this objection in their response of 20 January 2017, when the Registrar sought comments from the Opponents following the Applicants' request to enter the disclaimer on 3 January 2017. In light of the above, it is not appropriate for the Opponents to raise this argument at this juncture.

37 In any event, the Opponents had submitted ([8] of OSW2 and see above as well), that the inclusion of the disclaimer does not affect the opposition proceedings and I am

¹³ This is in contrast to an action for passing off, where the disclaimer would not apply since it only pertains to a trade mark sought to be registered or already registered under the Act.

¹⁴ With regard to the reference to *Staywell* at [90], I am doubtful if it applies to the current situation.

¹⁵ As I understand it, assuming the entry of the disclaimer required an amendment of the pleadings (such that the scope of the opposition would have been amended), since the pleadings have not been amended, the scope of the opposition should remain as is, and the disclaimer should be disregarded. Since the Applicants proceed with the inclusion of a disclaimer (with no amendment to the pleadings), the Opposition proceeding should be allowed on this basis alone.

proceeding on that basis as well, although my reasons as to such an approach differs (above) from the Opponents.

Issue 3 – Abuse of process

38 The Opponents argued that it is an abuse of process for the Applicants to seek to enter the disclaimer at this late stage of the opposition proceedings. This is on the basis that, if the Applicants had sought to enter the disclaimer at the examination stage, the examiner could have possibly have come to a different conclusion, including that the Application Mark was not distinctive.

39 It would have been ideal if the Applicants had requested to enter the disclaimer during the examination process. However, section 30 of the Act suggests that it is possible to request for a disclaimer at any stage of the registration process:

Registration subject to disclaimer or limitation

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

- (a) disclaim any right to the exclusive use of any specified element of the trade mark...

[Emphasis as underlined mine]

40 Having regard to the above, I will proceed to consider the main grounds of objection below.

MAIN DECISION

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

41 Section 8(2)(b) provides as follows:

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

42 In *Staywell*, the Court of Appeal re-affirmed the 3-step test approach in relation to an objection under section 8(2)(b) (see [15] and [55]):

- (i) The first two elements - namely similarity or identity of the marks and similarity or identity of the services - are assessed individually before the final element which is assessed in the round. An appropriate application of the step-by-step approach necessitates that the court reach a meaningful conclusion at each stage of the inquiry;
- (ii) Once the 2 threshold requirements have been met, the issue of the likelihood of confusion arises and the tribunal / court is directed to look at (a) *how* similar the marks are, (b) *how* similar the goods / services are, and (c) given this, how likely the relevant segment of the public will be confused.

43 Further, the Court of Appeal in *Staywell* provided as follows ([15] to [20]):

- (i) The minimal similarity 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.
- (ii) The three aspects of similarity (i.e. visual, aural and conceptual similarities) are meant to guide the court's inquiry. Trade-offs can occur among the three aspects of similarity in the marks-similarity inquiry.
- (iii) The assessment of marks similarity is mark-for-mark without consideration of any external matter¹⁶.
- (iv) The court must ultimately conclude whether the marks, when observed in their totality, are similar rather than dissimilar.

Similarity of Marks

44 In relation to this issue, the following points are to be noted (see *Staywell* at [25], [26] and [30]):

- (i) Technical distinctiveness is an integral factor in the marks-similarity inquiry. A mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it.
- (ii) 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.

¹⁶ This means that how the marks are actually used is irrelevant. For example, by making comparison to the way the Application Mark contrasts with the other marks in the Applicants' "seed line" products (for example, see [20] OWS1).

- (iii) 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.

45 Last but not least, the Court of Appeal set out the following principles in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] SGCA 26 at [40] ("*Hai Tong*"):

- (i) The relevant 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.
- (ii) Furthermore, it is assumed that the average consumer has “imperfect recollection”. 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.

46 Purely for ease of comparison, the marks are as follows:

<i>Application Mark</i>	<i>Opponents’ Earlier Marks</i>
MANGO SEED THEFACESHOP	<i>Opponents’ Earlier Mark 1</i>
	MANGO
	<i>Opponents’ Earlier Mark 2</i>
	MANGO adorably

Distinctiveness

47 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, *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 Mark 1

48 The Opponents argued, at [19] of OWS1, that the ***Opponents' Earlier Mark 1*** has significant technical distinctiveness and therefore enjoys a high threshold before the competing sign (i.e. the Application Mark) will be considered dissimilar to it. In particular, the Application Mark does not meet the necessary threshold to be considered dissimilar to the ***Opponents' Earlier Mark 1***. The word THEFACESHOP (comprising merely a joining of non-distinctive words forming a descriptive term) is a descriptor appearing at the very bottom of the Application Mark.

49 I agree that the ***Opponents' Earlier Mark 1*** has some level of distinctiveness especially in light of its particular font but I am of the view that the level of distinctiveness is not high insofar as the relevant goods in Class 3 are concerned. The ***Opponents' Earlier Mark 1*** is not highly distinctive for the simple reason that, apart from its particular font, it can be considered to be descriptive of the products, in that, for example, they are 'mango' flavoured or scented products (see above for the full list of the goods)¹⁷. At this juncture I would mention that the local sales / promotional figures provided by the Opponents do not assist as it is unclear what goods the figures relate to.

50 The same argument applies to the Application Mark in relation to the words "Mango" and "Seed"¹⁸. However, that is clearly not the end of the story for the Application Mark, for there is the word THEFACESHOP at the bottom of the Application Mark¹⁹.

51 In relation to this component of the Application Mark, I disagree that the word THEFACESHOP is descriptive of the relevant goods. I am of the view that the particularly long word "THEFACESHOP", with no spaces in between the words "THE", "FACE" and "SHOP", is allusive and can be regarded as distinctive of the relevant goods. I clarify that I draw the above conclusion without having regard to any acquired distinctiveness of Trade Mark Reg. No. T0517082J for "THEFACESHOP" in Class 3 (which is the Applicants' house mark – see [15] AWS). I do not see the need to resort to acquired distinctiveness²⁰.

52 However, for clarity, I am of the view that should I need to so find acquired distinctiveness, the sales / promotional figures pertaining to T0517082J can be relied on, in that I am of the view that the stylisation of T0517082J does not prevent it from being relied upon.

¹⁷ On the other hand, if the mark is used for, say, apple flavoured or scented products, it would be deceptive. For the same reason, the case of *Caesarstone Sdot-Yam Ltd v Ceramiche Caesar SpA* [2016] SGHC 45 does not apply (see [26] of OWS2). Unlike ***Opponents' Earlier Mark 1***, "Caesar" while not being an invented word, has no direct reference to the goods at all.

¹⁸ As the comparison is mark for mark, reference cannot be made to the "seed line" of the Applicants ([20] OWS1 – see above).

¹⁹ Nor can any reference be made to the house mark T0517082J which comprises the word "THEFACESHOP" as correctly pointed out by the Opponents ([20] and [23] OWS2).

²⁰ See [20] and [23] OWS2.

53 The next question is whether the words “THEFACESHOP” and “Seed” serve to differentiate the Application Mark from the *Opponents’ Earlier Mark 1*. In this regard, I note that the decision of the Court of Appeal in *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] SGCA 30²¹ (“*Caesarstone CA*”), is instructive as to the relevant principles (even though the facts are different):

[41] We agree with the Appellant that the word “stone” is merely descriptive of the goods in Class 19...we do not think that the presence of such a **descriptive** element can fairly be regarded as being effective to displace similarity.

[42] ...The question is not so much one of the distinctiveness of the Respondent’s CAESARSTONE Mark on its own. Rather, the real question here is whether the word “stone” serves to *sufficiently and substantially distinguish* the Respondent’s CAESARSTONE Mark from the Appellant’s CAESAR Mark (see [32] above). In our judgment, and as we have explained in the previous paragraph, because the word “stone” is merely descriptive of the goods in Class 19, it does not.

[Emphasis in italics in the original and emphasis in bold mine]

54 In this case, I am of the view that the word THEFACESHOP in the Application Mark (and, to some extent, the word “Seed” as well) *sufficiently and substantially distinguishes* the *Opponents’ Earlier Mark 1* from the Application Mark such that the Application Mark meets the necessary threshold to be considered dissimilar to the *Opponents’ Earlier Mark 1*.

Opponents’ Earlier Mark 2

55 The above principles apply accordingly to the “Mango” component of the *Opponents’ Earlier Mark 2*. With regard to technical distinctiveness, the word “adorably” does add to the distinctive quality of the *Opponents’ Earlier Mark 2* such that overall, the *Opponents’ Earlier Mark 2* can be said to have a greater level of distinctiveness in relation to the relevant goods in Class 3 compared to the *Opponents’ Earlier Mark 1*.

56 Similarly, I am of the view that the word THEFACESHOP in the Application Mark (and, in that regard, the word “Seed” as well) *sufficiently and substantially distinguishes* the *Opponents’ Earlier Mark 2* from the Application Mark.

Visual Similarity

Opponents’ Earlier Mark 1

²¹ It is noted that the Applicants refer to *Caesarstone Sdot-Yam Ltd v Ceramiche Caesar SpA* [2016] SGHC 45 in their bundle of authorities. The Court of Appeal decision was issued on 26 April 2017 which was after the full hearing on 28 March 2017. However, the principles with regard to the mark-similarity analysis discussed in *Caesarstone CA* are clarificatory in nature.

As a starting point, I note that the Application Mark is a 3-word mark while the *Opponents' Earlier Mark 1* consists of simply a lone word.

57 As discussed earlier, the *Opponents' Earlier Mark 1* is of a low level of distinctiveness while the main distinctive component of the Application Mark is the word THEFACESHOP. In addition, the presentation of the marks differs. The *Opponents' Earlier Mark 1* consists of a lone word while the three words of the Application Mark are stacked one on top of the other. Further, the final word at the bottom of the Application Mark is “strikingly long” as submitted by the Applicants ([13] of AWS).

58 I clarify that I am of the view that the word THEFACESHOP is the distinctive component of the Application Mark despite the word THEFACESHOP being at the *bottom* of the Application Mark (while the words “Mango” and “Seed” respectively occupy the first and second lines of the Application Mark). This is so as the word THEFACESHOP is particularly long relative to “Mango” and “Seed” respectively, and there are no spaces in between the words “THE”, FACE” and “SHOP”.

59 It was held in *Stora Enso OYJ v Pt Purinusa Ekapersada and PT Pabrik Kertas Tjiwi Kimia TBK* [2016] SGIPOS 12 at [35]:

[35] ...where there is a common denominator, it is important to look at the *differences* between the marks to decide if the marks can be regarded as similar or dissimilar. In this regard, it does not matter whether the differences lie in the challenged mark or the earlier mark...

[Emphasis in the original]

60 It is also noted that the *Opponents' Earlier Mark 1* is in a particular font. As submitted by the Applicants ([12] of AWS), the *Opponents' Earlier Mark 1* resembles letters that have been printed with a stencil.

61 Overall, I am of the view that the Application Mark and the *Opponents' Earlier Mark 1* are visually more dissimilar than similar.



Opponents' Earlier Mark 2

62 As mentioned above, the “Mango” component of the *Opponents' Earlier Mark 2* is only of a low level of distinctiveness, although the word “adorably” adds to the overall distinctive quality of the *Opponents' Earlier Mark 2*.

63 Taking into account the positioning and the font of the words “Mango” and “adorably” respectively (the word “adorably” takes up about 40% of the *Opponents' Earlier Mark 2*), I am of the view that the word “adorably” can be regarded to be as

distinctive as the word “Mango”. This in effect, renders the *Opponents’ Earlier Mark 2* different from the Application Mark as a whole²².

64 Finally, the *Opponents’ Earlier Mark 2* is only a “two-tiered” mark, in contrast to the Application Mark which is a “three-tiered” mark. In this regard, the Opponents sought to argue that the layout of the marks is similar ([25] and [26] of OWS1). The Opponents relied on *MediaCorp News Pte Ltd v Astro All Asia Networks PLC* [2009] 4 SLR(R) 496 (“*MediaCorp*”) where the relevant marks were:

Respondent’s marks	Appellant’s mark
	

65 The Opponents submitted (see [25] OWS1):

[25]...The High Court held, notwithstanding the difference in the words appearing therein, that the marks were visually similar. **Similarity was found, inter alia, in the positioning of a triangular or “A” device above the name and the prominence of the triangular device.** The Court held, taking into account “the consumer’s ‘imperfect recollection’ and that the marks are not to be compared side-by-side, there seem[ed] to be some visual similarity between the two marks, especially since both shared *the same general layout (of having an “A” device above their names), colour (red) and have added features on the right limb of the device (the swirls for the Astro Mark and the hook for the CNA Mark).* It is quite unlikely that a consumer with imperfect recollection, and further, who is not comparing the two marks side-by-side, will be able to recall the relevant distinguishing features”.

[Emphasis in bold mine]

66 I am of the view that *MediaCorp* can be distinguished. In *MediaCorp* the distinctiveness, prominence and centrality of the positioning of the “*triangular or “A” device above the name*” in the earlier mark cannot be denied and this has been substantially taken. However this is not so in the current case. While I accept that the *Opponents’ Earlier Mark 2* can be regarded to be distinctive as a whole, it is not of such a degree as

²² See *Stora Enso OYJ v PT Purinusa Ekapersada and PT Pabrik Kertas Tjiwi Kimia TBK Ltd* [2016] SGIPOS 12 at [35] (above).

the Appellant's mark in *MediaCorp*. Specifically, I do not consider "stacking"²³ the words as being a particularly distinctive way of depiction.

67 In this regard, it is not appropriate for the Opponents to rely on the Opponents' related marks ([21] of the OWS1), at least in relation to this objection, as the earlier marks relied on for the purposes of this objection are only the *Opponents' Earlier Marks*.

68 Having regard to all of the above, the *Opponents' Earlier Mark 2* is visually more dissimilar than similar (and more so than the *Opponents' Earlier Mark 1*) when compared to the Application Mark.

Conclusion

69 I come to the conclusion that the *Opponents' Earlier Marks* are both visually more dissimilar than similar in comparison to the Application Mark.

Aural Similarity

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

71 This is elaborated by the Court of Appeal in *Caesarstone CA* as follows at [47]:

[47] Under the first approach, we consider that, for the purposes of the aural analysis, *the dominant component of the Respondent's CAESARSTONE Mark is again the word "caesar"*. The device is obviously irrelevant in the aural analysis, *while what we have said in relation to the word "stone" in the context of the visual analysis (see [41]–[42] above) applies with equal force in this context*. The dominant component of the Appellant's CAESAR Mark, which, without doubt, is the word "caesar", is identical...

[Emphasis in italics mine]

72 Under the Dominant Component Approach, the analysis with regard to the visual aspect (except for the device) applies with equal force. As the marks in the current case do not include any devices, it means that my analysis with regard to the respective dominant components in relation to the visual facet is on all fours here.

Opponents' Earlier Mark 1

²³ As mentioned above, I stress that whether or not the Application Mark forms part of the "seed line" of products by the Applicants is irrelevant to the analysis. See also [11] and [12] of OWS1.

73 For the *Opponents' Earlier Mark 1*, the only dominant component (if any) can be “Mango”, although the level of distinctiveness is not high having regard to the goods of interest in the current case²⁴.

74 On the other hand, with regard to the Application Mark, I am of the view that “THEFACESHOP”, which is a particularly long word with no spaces in between the words “THE”, “FACE” and “SHOP” is allusive and can be regarded as distinctive of the relevant goods such that it is the distinctive and dominant component of the Application Mark rather than “Mango” and “Seed”. In coming to this conclusion, I have considered the fact that the word “THEFACESHOP” is at the bottom of the “three-tiered” Application Mark.

75 Having regard to the above, applying the Dominant Component Approach, the marks (“MANGO” vs “THEFACESHOP”) are clearly aurally dissimilar.

76 Applying the Quantitative Assessment Approach, the Application Mark consists of six syllables, of which only two of the six syllables are common to that of the *Opponents' Earlier Mark 1* ([19] of AWS). The irresistible conclusion is that using this approach, the marks are also aurally more dissimilar than similar.

Opponents' Earlier Mark 2

77 Again, applying the Dominant Component Approach, I am of the view that the marks are aurally dissimilar (see above in relation to the visual aspect).

78 Applying the Quantitative Assessment Approach, the word “adorably” further differentiates the *Opponents' Earlier Mark 2* from the Application Mark. While the *Opponents' Earlier Mark 2* also consists of six syllables, again only two of the six syllables are common with the Application Mark such that the marks are aurally more dissimilar than similar.

Conclusion

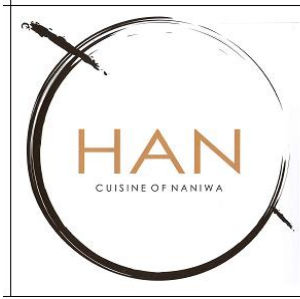
79 In light of the above, regardless of the approach being applied, both the *Opponents' Earlier Marks* are aurally more dissimilar than similar in comparison to the Application Mark.

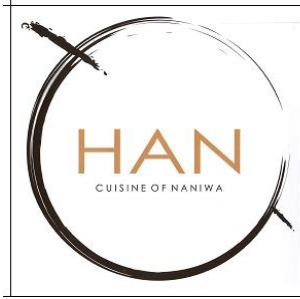
80 Before I leave this element, the Opponents referred to *Han's (F & B) Pte Ltd v Gusttimo World Pte Ltd* [2015] SGHC 39 (“*Han's*”) ([23] of OWS1 and [22] of OWS2):

[23] In the words of George Wei, JC in *Han's (F&B) Pte Ltd v Gusttimo World Pte Ltd* [2015] SGHC 39 (TAB 10) at [137], we submit that “it is doubtful that the average consumer would make constant reference to the [6-syllable “MANGO SEED THE FACE SHOP”] phrase every time he refers to it”. What the average consumer is likely to remember of the Application Mark is the word(s) MANGO or MANGO SEED and [that is] how he/she would aurally refer to the Applicant's mark.

²⁴ The font of the *Opponents' Earlier Mark 1* is to be disregarded here.

81 I do not think that it is appropriate to apply *Han's* in this instance. It is to be recalled



that the mark in *Han's* is , where it is clear that the words “Cuisine of Naniwa” are of a much smaller font than the word “HAN” which is in a central and prominent position. The situation is clearly different in the present case where the font of the words in the Application Mark are all of the same size and are all placed in the centre of the mark.

Conceptual Similarity

82 The Court of Appeal 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...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]

83 *Caesarstone CA* has also clarified that the design of a mark only affects the visual but not the conceptual aspect of the analysis (see [23] of AWS).

Opponents' Earlier Mark 1

84 It is obvious that the *Opponents' Earlier Mark 1* simply conveys the idea of a mango fruit. On the other hand, the Application Mark conveys the idea of the seed of a mango fruit, as well as the idea of a shop that sells facial products ([22] of AWS).

85 Thus, conceptually, they are dissimilar.

Opponents' Earlier Mark 2

86 The *Opponents' Earlier Mark 2* conveys the idea of a mango fruit, and the idea of being lovable or endearing ([22] of AWS). Taken as a whole, I am of the view that the *Opponents' Earlier Mark 2* can be considered to be even more conceptually dissimilar to the Application Mark in comparison to the *Opponents' Earlier Mark 1*.

Conclusion on the similarity of marks

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

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

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

[Emphasis as underlined mine]

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

Opponents’ Earlier Mark 1

89 I am of the view that the ***Opponents’ Earlier Mark 1*** in comparison to the Application Mark is visually and aurally more dissimilar than similar and conceptually different.

Opponents’ Earlier Mark 2

90 With regard to the ***Opponents’ Earlier Mark 2***, it is even more dissimilar (in terms of degree) to the Application Mark in comparison to the ***Opponents’ Earlier Mark 1*** in all aspects. Thus, it is visually and aurally dissimilar and conceptually distinct in contrast to the Application Mark.

91 In light of the above, this ground of opposition (section 8(2)(b)) fails at the first stage of the 3-stage analysis. However, for completeness, I shall proceed to the other stages.

Similarity of Goods / Services

92 In relation to this limb, the Court of Appeal in *Staywell* at [43] referred to ***British Sugar Plc v James Robertson & Sons Ltd*** [1996] RPC 281, and emphasized that the question is how the goods or services are regarded, as a practical matter, for the purposes of trade.

93 For ease of reference, the relevant goods are as follows:

S/N	<i>Opponents’ Earlier Mark 1</i>	<i>Application Mark</i>
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1	T0215724F	<u>Class 3</u> Bleaching preparations and other substances for laundry use; cleaning, polishing, grease removing and abrasive preparations; <i>soaps</i> ; <i>perfumery</i> , essential oils, <i>cosmetics</i> , <i>hair lotions</i> ; <i>dentifrices</i> .	<u>Class 3</u> <i>Cosmetics</i> ; <i>skin lotions (cosmetics)</i> ; moisturizing skin lotions; <i>non-medicated skin astringents for cosmetic purposes</i> ; <i>facial creams (cosmetic)</i> ; <i>facial moisturizers (cosmetic)</i> ; <i>facial preparations (cosmetic)</i> ; cleansing emulsions; soap free washing emulsions for the body; after shave lotions; skin conditioners; <i>blusher</i> ; <i>perfumes</i> ; <i>colognes</i> ; skin cleansing creams; <i>make-up foundation in the form of powder</i> ; <i>concealers</i> ; <i>lipsticks</i> ; <i>toilet water</i> ; <i>eye shadow</i> ; <i>eyebrow pencils</i> ; <i>eye liners</i> ; <i>nail polish</i> ; <i>nail polish remover</i> ; <i>beauty mask</i> ; sunblock <i>skin creams (cosmetics)</i> ; hair shampoo; hair rinse; hair spray; <i>toilet soaps</i> ; <i>bath soaps</i> ; <i>body cleansers</i> ; <i>fragrance mist for personal use</i> ; <i>tonic mist for personal use (cosmetics)</i> ; body gel; bath gel; body cream scrub; shampoos, <i>soap</i> ; <i>toothpaste</i> .
<i>Opponents' Earlier Mark 2</i>			
5	T0509355I	<u>Class 3</u> <i>Soaps</i> , <i>perfumery</i> , essential oils, <i>cosmetics</i> , <i>hair lotions</i> ; <i>dentifrices</i> .	

94 The Applicants have conceded, at [31] and [32] of AWS, that there is some overlap between the Applicants' goods and the Class 3 goods covered by the ***Opponents' Earlier Mark 1*** and ***Opponents' Earlier Mark 2***. For ease of reference the overlapping goods have been italicised and emboldened above.

95 For clarity, "overlapping" goods means *identical* goods. Thus I think what the Applicants had sought to argue at [31] AWS:

[31] The items "*Soaps, perfumery, cosmetics, hair lotions, dentifrices*" covered by the Opponent's Reg. Nos. T0215724F **MANGO** and T0509355I adorably in Class 3 overlap with the Applicant's Goods...

[Emphasis as underlined mine]

is that the goods as italicised are *similar* (which includes identical goods).

96 I am of the view that the goods as italicised and emboldened in [93] above are identical while the rest of the goods sought to be registered for the Application Mark can be said to be similar to those italicised and emboldened in [93] for the ***Opponents' Earlier Marks***. For example, *body cleansers* can be regarded to be similar to *soap*.

97 In light of the above, it is quite clear that this element has been satisfied and there is no need to dwell in detail on the similarity of the rest of the goods in Class 3.

98 I will proceed to examine the last element under section 8(2)(b).

Likelihood of Confusion

99 The relevant principles for assessing likelihood of confusion have been expounded by the Court of Appeal in *Staywell* at [60], [64], [83] and [96]. In summary, they are as follows:

- (i) 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.
- (ii) 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. However, the plain words of section 8(2) do *not* have the effect of making a finding of confusion automatic upon the establishment of similarity of marks and goods or services.
- (iii) On the effect of the foregoing (i.e. similarity of marks and goods or services) 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.
- (iv) The following represents a non-exhaustive list of factors which are regarded as admissible in the confusion inquiry:
 - (a) Factors relating to the impact of marks-similarity on consumer perception:
 - (1) the degree of similarity of the marks themselves;
 - (2) the reputation of the marks (a strong reputation does not necessarily equate to a higher likelihood of confusion, and could in fact have the contrary effect);
 - (3) the impression given by the marks; and
 - (4) the possibility of imperfect recollection of the marks.

- (b) Factors relating to the impact of goods-similarity on consumer perception (factors concerning the very nature of the goods without implicating any steps that are taken by the trader to differentiate the goods²⁵).
- (1) The normal way in, or the circumstances under which, consumers would purchase goods of that type;
 - (2) Whether the products are expensive or inexpensive items;
 - (3) Whether they would tend to command a greater or lesser degree of fastidiousness and attention on the part of prospective purchasers; and
 - (4) The likely characteristics of the relevant consumers and whether the relevant consumers would or would not tend to apply care or have specialist knowledge in making the purchase.

[Emphasis as underlined mine]

100 Before I proceed any further, I am of the view that the relevant consumer in this case, having regard specifically to the overlapping goods as indicated above, would be, the general public and, in particular, the female gender among the general public²⁶.

Factors relating to the impact of marks-similarity

Opponents' Earlier Mark 1

101 With regard to the ***Opponents' Earlier Mark 1***, I have concluded above that in terms of the factors relating to the impact of marks-similarity on consumer perception, the marks are visually and aurally more dissimilar than similar while being conceptually different. As the relevant goods are Class 3 products and in particular the area of overlap is cosmetics and self-care products, it is the visual aspect of the marks which is most important. Therefore, the overall impression left by the marks is that they are visually more dissimilar than similar.

102 Even taking into account the possibility of imperfect recollection, there is no likelihood of confusion, when the respective marks are considered as wholes.

103 The Opponents had sought to argue ([46] – [49] of OWS1) that they have reputation, both in Singapore and worldwide. However, my comments in relation to the evidence are as follows.

²⁵ Thus, as correctly indicated by the Opponents at [42] OWS1, the fact that the Applicants are currently selling their wares in standalone shops cannot be taken into account.

²⁶ However, for the avoidance of doubt, my analysis below is also applicable for the general public, including the male gender therein and in relation to similar goods as described above.

104 I refer to the Opponents' 1st SD at [15], which provides sales figures in Singapore²⁷:

S/N	Year	Net sales turnover (EUROS)	Net sales turnover (SGD ²⁸)
2	2012	18,163,555.19	29,368,652.39
3	2011	10,533,494.85	17,031,607.82
4	2010	14,596,503.88	23,601,087.12
5	2009	12,476,923.42	20,173,937.48
6	2008	13,233,065.87	21,396,544.21

105 In this regard, I refer to Exhibit JPB-10 of the Opponents' 1st SD which contains specimen copies of the invoices for the years 1998 – 2002²⁹. I have gone through the invoices in detail and they do not reflect any sales of Class 3 goods at all (further, only a *handful* of the documents in the exhibits are dated on or before the relevant date of 10 January 2013).

106 In relation to promotional expenditure, I refer to the Opponents' 1st SD at [19] (only the figures relating to Singapore are reproduced here)³⁰:

S/N	Spring / Summer (SGD)	Fall / Winter (SGD)	Total SGD
2008	454,475	332,796	787,271
2009	412,274	361,544	773,818
2010	463,248	569,752	1,033,000
2011	677,951	507,120	1,185,070
2012	656,024	535,608	1,191,632

107 Similarly, it is unclear if the promotional figures relate to Class 3 goods in Singapore. In this regard, it is noted that Exhibit JPB-12 of the Opponents' 1st SD does not relate to Class 3 goods at all (further, only *some* of the documents (i) relate to the **Opponents' Earlier Marks**; (ii) are dated on or before the relevant date of 10 January 2013; and (iii) pertain to Singapore). I also refer to Exhibit JPB-13 of the Opponents' 1st SD and note that the Opponents have catalogues which relate to the **Opponents' Earlier Mark 1** being used on perfumes. However, it is not clear if the catalogues were circulated in Singapore. In short, the extent to which the advertising figures above relate to the promotion of Class 3 goods in the local context is unclear.

108 In light of the above, I am of the view that the Opponents have not made out their claim for reputation in relation to Class 3 goods in Singapore. In any event, it is to be

²⁷ The figures for 2014 and 2013 are excluded as the relevant date is 10 January 2013. In this regard I am mindful that, in theory, 10 days' worth of the figures for 2013 should be taken into account. However, I am of the view that it is more practical to discount the figure for the year 2013.

²⁸ The Opponents had only provided the figures in €. For ease of reference, I have computed the equivalent in Singapore Dollars, based on the exchange rate on 10 January 2013 from xe.com, which is 1.6169.

²⁹ The payment notes for the years 2013 and 2014 have been disregarded for the same reason that the relevant date is 10 January 2013.

³⁰ As above, I have excluded the figures for 2013 and 2014.

recalled that the Court of Appeal in *Staywell* has cautioned that a strong reputation does not necessarily equate to a higher likelihood of confusion, and could in fact have the contrary effect (see *Staywell* at [96(a)] quoting *McDonald's Corp v Future Enterprises Pte Ltd* [2005] 1 SLR(R) 177 at [64]). Whether this is so will depend on the actual circumstances of the case.

Opponents' Earlier Mark 2

109 In relation to the ***Opponents' Earlier Mark 2***, I have concluded above that the marks are even more dissimilar to the Application Mark in comparison to the ***Opponents' Earlier Mark 1*** in all aspects. It is visually and aurally more dissimilar than similar and conceptually distinct in comparison to the Application Mark. Thus, the conclusion in relation to the ***Opponents' Earlier Mark 2*** is that the marks are (even) more dissimilar than similar. Again, as the relevant goods are Class 3 products and the areas of overlap are, in the main, cosmetics and self-care products, it is the visual aspect which is most important.

110 In relation to the arguments relating to the overall impression of the respective marks and the possibility of imperfect recollection, following the above conclusion that the ***Opponents' Earlier Mark 2*** is even more dissimilar than similar in totality from the Application Mark (in comparison to the ***Opponents' Earlier Mark 1***), they clearly do not assist the Opponents.

111 Last but not least, I am of the view that the Opponents have not established that there is reputation in the local market with respect to Class 3 goods. My reasons set out above apply accordingly here. In addition the following are the added concerns when it comes to the ***Opponents' Earlier Mark 2***.

112 Firstly, I note that *none* of the invoices contained in Exhibit JPB-10 of the Opponents' 1st SD relate to the ***Opponents' Earlier Mark 2*** (they all reflect the ***Opponents' Earlier Mark 1***). The same comment applies to the Exhibits at JPB-12 of the Opponents' 1st SD in that *none* relate to the ***Opponents' Earlier Mark 2***. With regard to the Exhibits at JPB-13 of the Opponents' 1st SD, while they do reflect the ***Opponents' Earlier Mark 2***, as indicated above, it is unclear as to the extent to which the advertisements relate to Singapore.

113 Before I conclude, I note that the Opponents argued as follows ([41] OWS1):

[41] The likelihood of confusion that will ensue is further compounded by the fact that “confusion in trade mark law extends to consumers believing that the users of the competing marks are economically linked” (*Staywell* at [99]). It is foreseeable that members of the public would be misled to believe that there is an economic link between the Opponent and the Applicant of that the Application Mark is a sub-brand (*Kerly's Law of Trade Marks and Trade Names, 15th Ed.* At [9-060] (TAB 15). Co-branding is often utilized by trademark owners in the sphere of fashion and cosmetics to promote their products and brands (see examples at TAB 16).

114 I have considered the Opponents’ argument carefully. However, I am of the view that there is no risk of such misperception of co-branding. This is because the Opponents have *consistently* depicted their mark as follows:

<i>Application Mark</i>	<i>Opponents’ Earlier Mark 1</i>
MANGO SEED THEFACESHOP	MANGO
	<i>Opponents’ Earlier Mark 2</i>
	MANGO adorably

Specifically, the *Opponents’ Earlier Marks* both reflect the word “Mango” (and “Mango” only) in a particular font.

115 With the presence of the word “Seed” in the Application Mark, there can be no confusion in relation to the marks via confusion as to an economic link between the parties. In coming to this conclusion I accept that the word “Seed” is related to the word “Mango”. However, in light of the consistency with which the Opponents depicted the word “Mango” (and “Mango” only), and the emphasis via the particular font utilised for the word “Mango”, I am satisfied that there is no likelihood of confusion in the sense of an economic link between the parties.

116 In this regard, the Opponents sought to rely on *Staywell* at [102] and [103] for the issue of economic linkage via a common denominator ([40] of OWS2):

[102] Turning to the likelihood of confusion, the Judge considered a number of factors which might affect the ability of the customer to accurately discern the economic relationship (or lack thereof) between the parties’ hotels...But even confining our analysis to only the present, actual use of the marks on these particular types of hotels, we find it not unlikely that the public would be induced by the similarity of the marks and the common industry in which they are used into believing that there is at least some economic link between the ST. REGIS Singapore and the Park Regis Singapore. *This is especially so given that it is common for large hotel chains to operate differently branded hotels carrying different logos, united only by use of a common denominator in their names.* This signals to the public that the various hotels, though pitched at different segments of the market, are economically linked.

[Emphasis in italics mine]

117 In light of the above, it is clear that the above passage does not apply on the facts of the current case.

Factors relating to the impact of goods-similarity

118 For the purposes of this element, I will discuss the *Opponents' Earlier Marks 1 and 2* together.

119 For the factors relating to the impact of goods-similarity, the Opponents argued, at [52] OWS1:

[52]... the type of goods are, relatively speaking inexpensive and would command a low attention on the part of prospective purchasers...the goods are bought from off the shelf without the need for specialist knowledge or advice..the goods are not the type which commands a high degree of fastidiousness on the part of the prospective purchaser.

120 While I agree that the goods are not very expensive (although I am of the view that they are not cheap products either) and that they are generally bought off the shelves, I am of the view that consumers will be cautious about what they are purchasing. In this regard, the Applicants argued at [38] AWS:

[38] In addition, the Applicant's Goods that are similar to the goods covered by the Opponents' Marks are goods which are meant for *face and body care*. The selection and purchase of such goods involves an *intensely personal choice with possible adverse consequences if the wrong products are used*, e.g. allergies or acne breakouts. It is probable that the purchase will *not be made lightly*, and consumers *would be careful and pay greater attention* in selecting the brand³¹ of goods they wish to purchase. It is also probable that users of such goods would *put effort into taking care of their appearance*, and that they would be *cautious* in selecting the correct brand of goods to use on their face and body.

[Emphasis in italics mine]

121 I agree. In the present case, the products involved are Class 3 products, in particular, cosmetics and self-care products, which are highly *personal* products, *applied onto the face / body* and pertain to the appearance of a consumer. I echo the Applicants' submissions above that these products would entail a relentless scrutiny as to their suitability (for example, whether they are suitable for particular skin types) and quality (the consequences of a low quality product will be severe); a wrong purchase can have detrimental results.

122 Further, I am of the view that another aspect of the personal nature of Class 3 products is that consumers will be more particular about the origin or *marks* of such goods, as they are likely to trust certain brands more than others. In this regard, the Court of Appeal in *Caesarstone CA* explained at [66], [67] and [79]:

[66]...We begin with some brief observations on the distinction between brands, on the one hand, and marks, on the other. In essence, the latter is a *subset* of the former...

³¹ The Court of Appeal in *Caesarstone CA* had clarified that this should be the "mark" rather than the "brand" see [66] to [68].

[67] Similarly, the English High Court held in *O2 Holdings Ltd v Hutchison 3G Ltd* [2006] RPC 29 (at [4] and [7]) that:

Brands are big business...Defining a brand is not easy. A lawyer would tend to think of goodwill, trade marks and so on. But a brand includes more elements; such as image and reputation; the values that the brand owner tries to inculcate in the buying public. A brand is what customers choose to buy. Many decisions about brands are made by customers emotionally or intuitively rather than rationally. Successful brands create a relationship of trust between the customer and the brand.

[79]...Conversely, where consumers are especially sensitive towards the mark used in relation to the relevant goods or services...this would likely *point away* from a likelihood of confusion as consumers would pay more attention to the differences between the marks.

123 Last but not least, while these products are self-service items, such that a consumer would be able to take time to select the relevant products, generally specialists abound to assist in the purchase, having regard to the deeply personal nature of the same.

Conclusion

124 With regard to the ***Opponents' Earlier Mark 1***, I have concluded above that in terms of the factors relating to the impact of marks-similarity on consumer perception, the overall impression left by the marks is that they are more dissimilar than similar. In relation to the ***Opponents' Earlier Mark 2***, I have concluded above that the marks are even more dissimilar to the Application Mark (in comparison to the ***Opponents' Earlier Mark 1***) in all aspects.

125 With regard to goods-similarity, having regard to the price (mid-range), the nature of the products (personal, self-care products) and the mode of sale (self-service items with some level of assistance by specialists), I am of the view that *all* these factors, taken together, *point away* from a likelihood of confusion.

126 Taking all of the above into consideration, I am of the view that this element has not been made out, whether it be confusion as to origin or confusion as to being economically linked³².

127 The ground of opposition under section 8(2)(b) therefore fails.

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

128 Section 8(4) of the Act reads:

³² I clarify that there is no need to show actual confusion to find a *likelihood* of confusion ([40] AWS) as correctly pointed out by the Opponents ([36] and [46] OWS2).

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

129 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". This element is essentially the same as the similar element under section 8(2)(b) (see *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 (“*Sarika*”) (at [70] and [71])). I have already found that the Opponents have not satisfied this element.

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

Well-known in Singapore

131 The critical question is whether the *Opponents' Earlier Marks* are well known in Singapore as at the relevant date of 10 January 2013, which is the date of application of the Application Mark.

132 The starting point for this limb is sections 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.

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

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

[229] Finally, it will be recalled that it is not too difficult for a trade mark to be regarded as “well known in Singapore” – essentially, the trade mark in question need only be recognised or known by “any relevant sector of the public in

Singapore” [emphasis added] (see s 2(7)(a) of the current TMA), which sector could in certain cases be miniscule...

[Emphasis as underlined mine]

135 The Court of Appeal in *Caesarstone CA* clarified:

[101] Although we said in *Amanresorts* that it is “not too difficult” for a trade mark to be regarded as well known in Singapore (see [100] above), the Judge thought that this comment should not be taken to mean that the hurdle that trade mark owners had to cross was minimal. Rather, the comment had to be applied with judicious caution to the actual facts and circumstances of each case.

[102] We do not think that this comment in *Amanresorts* was made to lay down a general principle. In this regard, we agree with the Respondent’s submission that the context of this comment was the desire to clarify that, in order for a mark to be well known in Singapore, the relevant sector to which a mark must be shown to be well known can be any relevant sector of the Singaporean public, and this sector need not be large in size. Beyond this, it should not be read as suggesting (more generally) that the threshold for a trade mark to be regarded as well known in Singapore is a low one.

[Emphasis in italics in the original and emphasis as underlined mine]

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

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

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

[Emphasis as underlined mine].

138 The Opponents, at [56] of OWS1, argued:

[56] As stated hereinabove and with reference to the evidence submitted by the Opponent, it is clear that the Opponent has extensively, diligently and continuously used and marketed the MANGO trade mark in Singapore for many years. The MANGO trade mark undoubtedly more than satisfies the low threshold for meeting the requirement of Section 2(8). The MANGO trade mark is well known to those in the fashion industry and actual and potential consumers in Singapore...

Opponents' Earlier Mark 1

139 I have alluded to the issue of the Opponents' sales turnover in Singapore above. For ease of reference, they are as follows (Opponents' 1st SD at [15])³³:

Year	Net sales turnover (EUROS)	Net sales turnover (SGD³⁴)
2012	18,163,555.19	29,368,652.39
2011	10,533,494.85	17,031,607.82
2010	14,596,503.88	23,601,087.12
2009	12,476,923.42	20,173,937.48
2008	13,233,065.87	21,396,544.21

140 In this regard, for the purposes of this ground of objection, there is no restriction as to the goods to which the ***Opponents' Earlier Mark 1*** has been applied to. Thus the above figures (unlike for the purposes of the objection under section 8(2)(b)), can be taken into account.

141 Similarly, in relation to promotional expenditure in Singapore, as above, I refer to the Opponents' 1st SD at [19]³⁵:

S/N	Spring / Summer (SGD)	Fall / Winter (SGD)	Total SGD
2008	454,475	332,796	787,271
2009	412,274	361,544	773,818
2010	463,248	569,752	1,033,000
2011	677,951	507,120	1,185,070
2012	656,024	535,608	1,191,632

142 Similarly, with regard to the promotional figures, it is irrelevant as to the goods to which the above figures relate and they can be taken into account.

143 Finally, the Opponents also referred to the number of online visitors and visits ([18] of Opponents' 1st SD):

Year³⁶	Visits (Singapore)
2010	24,559,572
2011	148,012,896
2012	NA

144 In this regard, it is instructive to refer to the sales figures in ***Caesarstone Sdot-Yam Ltd v Ceramiche Caesar SpA*** [2016] SGHC 45 ("***Caesarstone HC***") (see [153]):

³³ The figures for 2014 and 2013 are excluded as the relevant date is 10 January 2013.

³⁴ Based on the exchange rate on 10 January 2013 from xe.com which is 1.6169.

³⁵ As above, I have excluded the figures for 2013 and 2014.

³⁶ The figures for 2013 and 2014 have been excluded as the relevant date is 10 January 2013.

Year	Singapore Sales (in SGD)
2002	3,390,094
2003	1,874,266
2004	935,055
2005	1,433,751
2006	203,634
2007	577,656

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

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

146 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 Respondents in *Caesarstone HC*. It is noted that the average annual store sales in Singapore for the period 2008 - 2012 for the Opponents in the current case is *SGD 22,314,365.80*. In contrast, the average annual sales figure for the Respondents in *Caesarstone HC* is *SGD 1,402,409.33*.

147 In relation to the promotional figures, the average annual local promotional expenditure for the period 2008 – 2012 for the Opponents in the current case is *SGD 994,158.20* while the worldwide promotional figures (including Singapore) for the period 2002 - 2007 in *Caesarstone HC* is *SGD 1,218,052.33*.

148 Finally, in relation to the number of hits, as submitted by the Applicants, it is curious that the Singapore figure is higher than the worldwide figures when one would expect the number of Singapore visitors to be a subset of the number of worldwide visitors (see [51] AWS). In any event, in light of my conclusion below, it is not necessary for me to dwell on this issue.

149 In *Caesarstone CA*, the Court of Appeal concluded as follows:

[114]...Based on what we have found at [103]–[113] above, it is evident that the evidence adduced by the Appellant is, on the whole, weak...As for the Appellant’s sales figures, we accept that they demonstrate that the Appellant had a tangible business in Singapore. However, this alone does not, in our judgment, suffice to establish that the Appellant’s CAESARMark is *well* known in Singapore. The fact that a trader has some business within Singapore will generally be insufficient in

itself to establish that the mark is well known. Accordingly, we find that the Appellant's CAESAR Mark is not well known in Singapore.

[Emphasis in italics in the original]

150 However, I am of the view that, in the current case, the Applicants have shown that they have more than a tangible presence in Singapore such that they are well known in Singapore. In particular, in light of the evidence above, the ***Opponents' Earlier Mark 1*** can be said to be well known to the relevant sector of the public in Singapore, in particular, the actual / potential consumers of the Opponents' goods.

Opponents' Earlier Mark 2

151 However, the same cannot be said of the ***Opponents' Earlier Mark 2***. As indicated above, the Opponents have not established that there is reputation in the local market. In particular, none of the corroborating invoices contained in JPB-10 of the Opponents' 1st SD relates to the ***Opponents' Earlier Mark 2*** (they all reflect the ***Opponents' Earlier Mark 1***). The same comment applies to the exhibits at JPB-12 of the Opponents' 1st SD; *none* of the corroborating excerpts of the magazines reflect the ***Opponents' Earlier Mark 2***. Finally, while the exhibits at JPB-13 of the Opponents' 1st SD do reflect the ***Opponents' Earlier Mark 2***, the extent to which the advertisements relate to Singapore is unclear.

Conclusion

152 In light of the above, I am of the view that this element has been made out for the ***Opponents' Earlier Mark 1*** but not for ***Opponents' Earlier Mark 2***.

Confusing connection

153 In relation to this element, the Court of Appeal in *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])....

154 Thus, I am of the view that there will be no confusing connection here for largely the same reasons that I have provided for my conclusion in relation to the likelihood of confusion under section 8(2)(b).

Likelihood of Damage

155 In light of my conclusion above that there is no confusing connection, there can be no damage since there would be no "mistaken purchase" nor would there be any misconception of co-branding.

156 The ground of opposition under section 8(4)(b)(i) therefore fails.

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

157 The relevant provisions of the Act read:

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

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

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

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

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

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

Similarity of marks

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

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

Well-known to the public at large

160 The critical question is whether the ***Opponents’ Earlier Marks*** are well known to the public at large (in Singapore) as at the relevant date of 10 January 2013, which is the date of application of the Application Mark.

161 In relation to the element, it is clear that the relevant provisions and case law which relate to the limb “well known in Singapore” (as referred to above) apply. Further, the Court in ***City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier*** [2010] 1 SLR 382 (“***City Chain***”) held:

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

[Emphasis as underlined mine]

162 In addition, the Court of Appeal in *Amanresorts* provided at [233]:

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

[Emphasis as underlined mine]

163 I have earlier found that the *Opponents’ Earlier Mark 2* is not “well-known in Singapore”, and it must follow that it is not well-known to the public *at large* in Singapore. The discussion below therefore relates to the *Opponents’ Earlier Mark 1*.

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

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

[Emphasis as underlined mine]

I would further clarify that the sales and promotional figures referred to above pertain to that in *Singapore* (see *Seiko Holdings Kabushiki Kaisha v Choice Fortune Holdings Limited* [2014] SGIPOS 8 at [15] and *Clinique Laboratories, LLC v Clinique Suisse Pte Ltd and another* [2010] SGHC 189 at [39]).

165 I have alluded to the issue of the Opponents’ turnover in Singapore above. It is clear that the Opponents enjoyed strong sales in Singapore with the average annual store sales in Singapore for the period 2008 - 2012 amounting to *SGD 22,314,365.80*. In addition, the average annual local promotional expenditure for the period 2008 – 2012 is *SGD 994,158.20*.

166 Further, the Opponents deposed in the Opponents’ 1st SD at [6] that there are about 19 local stores³⁷ in Singapore (although these are a combination of MANGO and MANGO Touch Stores):

S/N	Store location in Singapore
1	Isetan Scotts Shaw Centre
2	Isetan Scotts Shaw House
3	Ion Orchard
4	Takashimaya Shopping Centre
5	JEM
6	Isetan Serangoon Central – Nex Mall
7	Bugis Junction
8	Isetan Orchard, Wisma Atria
9	Raffles City
10	Isetan Tampines – Tampines Mall
11	Vivo City
12	313 Somerset
13	Isetan JE

167 The Opponents argued that ([66] of OWS1):

[66] These figures are very significant and comparable to (and in some cases exceed) the levels mentioned in [*Taylors*]...

168 In addition to the above, the Opponents also tendered the following evidence³⁸:

- (i) Number of countries in which the Opponents are operating their stores (and variations thereof) totalling 105 ([3] of the Opponents’ 1st SD);
- (ii) Collaborations with external designers and celebrities such as Penelope Cruz etc ([4] and Exhibit JPB-2 of the Opponents’ 1st SD);

³⁷ These are operated by the Opponents / their franchisees.

³⁸ It is irrelevant that the Opponents’ MANGO marks are “juxtaposed with those of other famous brands” in magazines ([48] OWS1).

- (iii) Total number of stores (2,731) as at the end of 2013³⁹ worldwide ([5] of the Opponents' 1st SD);
- (iv) Access via the Opponents' internet websites worldwide (average monthly number of monthly visitors stand at 10,000,000 and making approximately 20,000,000 visits per month) ([7] of the Opponents' 1st SD). In particular the figures are as follows ([18] of the Opponents' 1st SD)⁴⁰:

S/N	Year ⁴¹	Visits (Worldwide)
2	2012	NA
3	2011	102,012,896
4	2010	15,872,282

- (v) Ownership of the following domain names ([18] of the Opponents' 1st SD):

S/N	Creation date	Domain name
1	20 April 1997	www.mango.com
2	14 January 2000	www.mangoshop.com
3	11 October 2005	www.mangooutlet.com
4	18 October 2006	www.mangofashionawards.com

- (vi) Recognition by Interbrand as one of the top / most valuable / best performing European / Spanish retail brands the years 2008, 2009, 2011 and 2012⁴² ([11] and Exhibit JPB-7 of the Opponents' 1st SD);
- (vii) Recognition by a total of 8 Courts / tribunals worldwide⁴³, some of which were made in East Asian jurisdictions (for example, South Korea) ([12] and Exhibit JPB-8 of the Opponents' 1st SD);
- (viii) Estimated global sales for goods sold under the MANGO trade mark as follows ([14] of the Opponents' 1st SD):

S/N	Year ⁴⁴	Net sales (in thousands of EUROS)
2	2012	1,690,982
3	2011	1,408,413
4	2010	1,269,000
5	2009	1,145,156
6	2008	1,100,705
7	2007	1,020,356
8	2006	942,355

³⁹ The relevant date is 10 January 2013. Thus, the quantum, even if it can be taken into account, has to be discounted.

⁴⁰ There is also evidence with regard the Opponents' presence on social networking sites such as Facebook (8,676,214 Likes as at March 30, 2015) and Twitter (599,000 followers as at March 30, 2015) (see [7] of the Opponents' 1st SD). However, as they are both *after* the relevant date of 10 January 2013, they cannot be taken into account.

⁴¹ The figures for 2013 and 2014 have been excluded due to the relevant date being 10 January 2013.

⁴² The report for 2014 is excluded as the relevant date is 10 January 2013.

⁴³ However it is noted that some of the decisions were dated after the relevant date (see item viii of [12]).

⁴⁴ The figures for 2013 and 2014 have been excluded due to the relevant date being 10 January 2013.

9	2005	888,260
10	2004	831,679
11	2003	779,814

(ix) Worldwide publicity figures ([19] of the Opponents' 1st SD):

S/N	Year ⁴⁵	Advertising figures (in EUROS)
1	2012	80,267,028.06
2	2011	74,611,885.66
3	2010	32,656,784.32
4	2009	48,118,165.33
5	2008	50,946,908.23

169 With regard to the local figures, I accept that the sales figures are substantial. In this regard, I have summarised the factors listed in *Taylors* at [132] as follows:

S/N	Cases	Sales Figures	Promotional figures	Exposure	Survey Evidence
1	CLINIQUE	<u>\$10 million per annum for 4 years</u>	<u>\$3 million each year for 4 years</u>	13 stores	Yes
2	SEIKO	<u>\$14 million per annum for 5 years</u>	<u>\$4 million each year for 5 years</u>	100 optical shops	Yes – a 72% recognition rate
3	NUTELLA	<u>2 million units of "Nutella" bread spread sold every year</u>	-	94-98% of stores that sell food items	Yes, a 71.2% recognition rate.
4	<i>Current case</i>	<i>SGD 22,314,365.80 per annum on average for 5 years</i>	<i>SGD 994,1583.20 per annum on average for 5 years</i>	<i>19 MANGO (and MANGO Touch) Stores</i>	<i>No</i>

While the current case is close to the line, on balance and based on the evidence adduced in this case, I am unable to conclude that the *Opponents' Earlier Mark 1* is well-known to the public *at large* in Singapore⁴⁶.

170 In relation to the worldwide evidence, it is clearly no small feat to achieve the sales and promotional figures as indicated above. Further, to be recognised by Interband as one

⁴⁵ The figures for 2013 and 2014 have been excluded due to the relevant date being 10 January 2013.

⁴⁶ For the avoidance of doubt, I am not saying that having a survey is a requisite.

of the performing retail brands in Europe four times (2008, 2009, 2011 and 2012) is something to be reckoned with. However, the critical issue is that I am unable to find the *connection* between such fame and the local context⁴⁷. As the Court of Appeal in *Caesarstone CA* provided at [113] in relation to overseas successful enforcement of rights, amongst others, under the ground of objection under section 8(4)(b)(i)⁴⁸:

[113]...The crucial point, therefore, is that the Appellant has to show how...the successful enforcement of its rights has *led to* its mark being well known *in Singapore*.

[Emphasis in the original]

171 In this regard, the Opponents had sought to argue at [66] of OWS1 that such connection is established:

[66]...bearing in mind, that many Singaporeans *travel extensively* to Europe and many other countries where the Opponent's stores are located and extensively promoted as well...

[Emphasis in italics mine]

It is noted that the Opponents have not sought to support this statement in any way such that it remains a bare statement in their evidence.

172 It is to be recalled that the marks which are entitled to the "extensive level of protection" granted under section 8(4)(b)(ii) are of "a rare and exclusive class". I am unable to conclude that the *Opponents' Earlier Mark 1* has attained this "coveted" status on the basis of such a tenuous link.

173 As this element has not been made out (in addition to the conclusion that the marks are not similar), there is no need for me to look at the other limbs of dilution and unfair advantage.

174 The ground of opposition under section 8(4)(b)(ii) therefore fails.

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

175 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 —

⁴⁷ While there is some reference made to "Asia" and in particular, China (see page 267 the report pertaining to "The Most Valuable Spanish Brand 2012", there is no reference to Singapore. The same comment can be made for the report "The Most Valuable Spanish Brand 2011" at page 262.

⁴⁸ See the Opponents' argument at [42] OWS2.

(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)

176 In relation to this ground⁴⁹, it is clear that there are 3 elements to be established and they are:

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

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

It is the benefit and advantage of the good name, reputation, and connection of a business. *It is the attractive force which brings in custom.* It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing *unless* it has a power of attraction sufficient to bring customers home to the source from which it emanates.

[Emphasis in italics mine]

178 It is important to focus on goodwill in Singapore as the Court of Appeal in ***Staywell*** at [136] has clarified that the Singapore 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.

179 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 10 January 2013.

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

⁴⁹ As mentioned above, the issue of a disclaimer is irrelevant for the purposes of an action under passing off (above).

[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 in italics mine]

181 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]

182 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*”...

[Emphasis in italics mine]

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

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

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

[Emphasis in bold mine]

185 In relation to goodwill I have already dealt with the Opponents' sales and promotional figures in *Singapore*. It is not in dispute that the Opponents have the relevant goodwill in Singapore.

Misrepresentation

186 In relation to this element, the Court of Appeal in *Sarika* held that:

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

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

187 In addition, as mentioned above, for the purposes of an objection under passing off, the *get-up* of the Opponents (which includes the *Opponents' Earlier Marks*) can be taken into account. Thus the Opponents' marks as referred to at OSW1 at [21]:

Opponents' marks		
MANGO SPORT	MANGO Kids	MANGO DELIRIUM

can be taken into account. However, for largely the same reasons as I held in relation to the *Opponents' Earlier Mark 2* under the ground of objection under section 8(2)(b), I am of the view that there is no likelihood of confusion.

188 Further, I also clarify that for the purposes of this ground, it is not possible to take into account the way the Applicants actually use the Application Mark ([25] of the Opponents' 1st SD at Exhibit JPB-14).

189 In particular, I have considered the Opponents' agreement at [82] of OWS1:

[82] The Application Mark is deceptively similar to the Opponent's MANGO and adorably **MANGO** marks. The "MANGO" element is distinctive of the Opponent's goods and the Opponent's goodwill is in fact associated with that element. The misrepresentation, whilst subtle, does not detract from the Applicant's intended purpose of... "occasioning a confusion between the parties' businesses, eg by suggesting that the [Applicant's] business is an *extension*, ... or otherwise connected with the [Opponent's] business"...

[Emphasis in italics mine]

190 However, as mentioned above, I am of the view that in light of the presence of the word "Seed" in the Application Mark⁵⁰, and in light of the consistency with which the Opponents use the word "Mango" (and "Mango" only - see the *Opponents' Earlier Marks* and also other marks indicated above) as corroborated by the evidence⁵¹, I am satisfied that there is no likelihood of confusion in the sense of an economic link between the parties.

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

Damage

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

Conclusion

193 The ground of opposition under section 8(7)(b) therefore fails.

Conclusion

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

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⁵⁰ This is so even taking into account of the fact that "seed" is, and can be related to "mango".

⁵¹ The above observation is borne out by the evidence. See Exhibits JPB-10 and JPB-12 of the Opponents' 1st SD. See also Exhibit JPB-13 of the Opponents' 1st SD; it is unclear if this exhibit pertains to Singapore but it is still useful in showing the Opponents' overall strategy.