

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

Trade Mark No. 40201508728T
Hearing Date: 20 April 2018

IN THE MATTER OF A TRADE MARK APPLICATION BY

LUTONG ENTERPRISE CORP.

AND

OPPOSITION THERETO BY

ADIDAS INTERNATIONAL MARKETING BV

Hearing Officer: See Tho Sok Yee
Principal Assistant Registrar

Representation:

Ms Gillian Tan (Infinitus Law Corporation) for the Applicant

Ms Yvonne Tang and Ms Lorenda Lee (Drew & Napier LLC) for the Opponent

GROUND OF DECISION

1 Taiwan's economic growth in the latter half of the twentieth century has sometimes been hailed as a miracle, making Taiwan one of the "Four Asian Tigers" alongside Singapore, South Korea and Hong Kong. The means and methods behind its astounding transformation from an agrarian economy to a manufacturing powerhouse are fascinating subjects of study. Innovation, inspiration and imitation interlace the web of cultures, technologies and economies. The applicant in this dispute was one such enterprise from Taiwan – seeing an opportunity in the local demand for Western-styled

fashion, it positioned itself accordingly. Meanwhile, an established sportswear and sports equipment company has no less entrepreneurial roots. Its global business today was started humbly in 1920 by an athlete and shoemaker, Adi Dassler – his name was eventually combined to form “Adidas”. What happens when competitors from different ends of the world meet in the global marketplace? What are the rules of fair competition? How far should the law go to protect basic geometric shapes as trade marks? The story of these two parties is still playing out today in global markets (and tribunals) of interest to the parties. A short episode has just started in Singapore, in the instant case.

2 Lutong Enterprise Corp. (the “Applicant”), applied to register the trade mark



(the “Application Mark”) in Singapore on 22 May 2015 under Trade Mark No. 40201508728T (“the Application”) in Class 25 in respect of “Clothing; shoes, boots; footwear; headgear for wear; scarves; neckties; hats, caps; gloves [clothing]; hosiery, stockings, socks; belts [clothing]; all included in Class 25.”

3 The Application was accepted and published on 10 September 2015 for opposition. Adidas International Marketing BV (the “Opponent”), filed its Notice of Opposition to oppose the registration of the Application Mark on 11 January 2016. The Applicant filed its Counter-Statement on 11 May 2016.

4 The Opponent filed evidence in support of the opposition on 8 December 2016. The Applicant filed its evidence in support of the application on 7 April 2017. The Opponent filed its evidence in reply on 4 August 2017. Following the close of evidence, the Pre-Hearing Review (“PHR”) was held on 25 August 2017. Pursuant to my directions at the PHR to correct procedural irregularities, the evidence in support of the opposition and the evidence in support of the application were both re-executed. Subsequently, I also allowed the Applicant’s request for leave to file further evidence in a limited respect. The opposition was heard on 20 April 2018.

Grounds of Opposition

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

Opponents’ Evidence

6 The Opponent’s evidence comprises the following:

- (i) a Re-executed Statutory Declaration made by Sarah Talbot, Legal Representative of the Opponents on 19 September 2017 in Amsterdam, the Netherlands (“Talbot-1”);
- (ii) a Statutory Declaration made by Ralph Kotterer, Managing Director of adidas South East Asia and Pacific, which includes adidas Singapore Pte. Ltd., on 28 November 2016 in Singapore (“Kotterer-1”);
- (iii) a Statutory Declaration in Reply made by the same Sarah Talbot on 26 July 2017 in Amsterdam, the Netherlands (“Talbot-2”); and

- (iv) a Supplementary Statutory Declaration made by the same Sarah Talbot on 19 September 2017 in Amsterdam, the Netherlands to rectify a procedural irregularity in Talbot-2.

Applicants' Evidence

- 7 The Applicant's evidence comprises the following:
- (i) a Re-executed Statutory Declaration made by Chiang, Chen Ming-Chen, Legal Representative of the Applicants on 31 August 2017 in Taipei (Taiwan) ("Chiang-1"); and
 - (ii) a Supplemental Statutory Declaration made by the same Chiang, Chen Ming-Chen on 8 January 2018 in Taipei (Taiwan) to adduce English translations of certain exhibits in Chiang-1 that were not in English, and to provide the latest update of proceedings in Taiwan.

Applicable Law and Burden of Proof

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

Background

The Opponent

9 The Opponent is a multinational company in the business of manufacturing and retailing a variety of athletic products, from apparel to equipment. Originating in Germany in 1920, the Opponent now operates through an extensive network of related companies worldwide, and its products and services have been promoted and sold internationally under multiple brands. Sponsorship of various international sporting events, sports teams and personalities forms a substantial component of the Opponent's promotional and marketing activities.

10 The Opponent relies on the device, , (the "Opponent's Mark") as its earlier trade mark in these proceedings. This mark was designed in 1990, when Peter Moore,

the-then Creative Director of the Opponent, conceived the  logo (the "Adidas and Device Mark"). The Opponent's Mark was subsequently put into use on the Opponent's products, first in the United States and then in other territories worldwide.

The Opponent's Mark, , was later adopted as the Opponent's corporate logo in 1997. In 2002, a corporate decision was made to adopt "*a revolutionary new business strategy for the adidas brand*" (Exhibit ST-13 of Talbot-2). This entailed the

deployment of the following three marks:



11 Closer to home, the Opponent's Mark was first used in Singapore on clothing, footwear and headgear "*since shortly after the global launch of the Opponent's Mark*

in 1990” (Talbot-1 at [23]). The Opponent also registered  in Singapore, with details as follows:

TM No.	Class & Specification	Registration Date
T9907870B	<u>Class 18</u> Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.	28 July 1999
T9907871J	<u>Class 25</u> Clothing, footwear, headgear.	28 July 1999
T9907872I	<u>Class 28</u> Balls, games and playthings; gymnastic and sporting articles; parts and fittings for all the aforesaid goods.	28 July 1999
T0109414C	<u>Class 3</u> Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.	5 April 2001
T0109415A	<u>Class 9</u> Scientific, nautical, surveying apparatus and instruments; photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), lifesaving and teaching apparatus and instruments; electronic measuring apparatus; digital apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire extinguishing apparatus; spectacles, spectacle frames and sunglasses; spectacle cases.	5 April 2001
T0109416Z	<u>Class 14</u> Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, trinkets, precious stones; horological and chronometric instruments, sports watches and other timepieces for use in sports.	5 April 2001
T1409497Z	<u>Class 35</u> The bringing together, for the benefit of others, of a variety of goods (excluding transport thereof), enabling customers to conveniently view and purchase those goods from a retail outlet, or a wholesale outlet, or departmental stores, or shopping centers, from a general merchandise catalogue by mail order or by means of telecommunications, through a television shopping channel by means of telecommunications, or from a general merchandise web site in the global communications network or via the Internet.	19 June 2014

12 In Singapore, adidas Singapore Pte. Ltd. is licensed to use the Opponent’s Mark. adidas Singapore Pte. Ltd. (the “Singapore subsidiary”) is a Singapore subsidiary of Adidas AG (which also fully owns the Opponent). The Singapore subsidiary distributes the Opponent’s goods, including “clothing, footwear, headgear”, under the Opponent’s Mark in Singapore. These goods are marketed, advertised, promoted and sold online at

www.adidas.com.sg and offline. In its 2396 pages, Kotterer-1 provides details of: the annual net revenue and annual marketing expenditure in Singapore; the Singapore subsidiary's marketing campaigns; with supporting samples of print advertisements, product catalogues, sales invoices and the like. Most of the voluminous material relates to the Adidas and Device Mark rather than the Opponent's Mark, if any mark is discernible at all from the pages of evidence. As for the figures provided, these appear to pertain to the "adidas" business but not solely to sales and marketing of goods bearing the Opponent's Mark. I asked the Opponent's counsel at the hearing what proportion of the figures were derived from the Opponent's Mark alone, apart from the Adidas and Device Mark. She fairly answered that she had no answer, because this information was not in the evidence.

The Applicant

13 The Applicant is a Taiwanese company incorporated in 1979. The Applicant's primary business is the manufacture and sale of clothing, footwear, caps, hats and umbrellas. The Applicant was established at a time when there was an influx of clothing and footwear from America into Taiwan, but the price point of these goods made them out of reach for most of the Taiwanese public. The Applicant was therefore motivated to create a brand under which American-styled clothing and footwear could be sold to the public at more affordable pricing.

14 The Application Mark was conceived under commission. Four student designers from the Fine Arts Department of Chinese Culture University in Taiwan, guided by



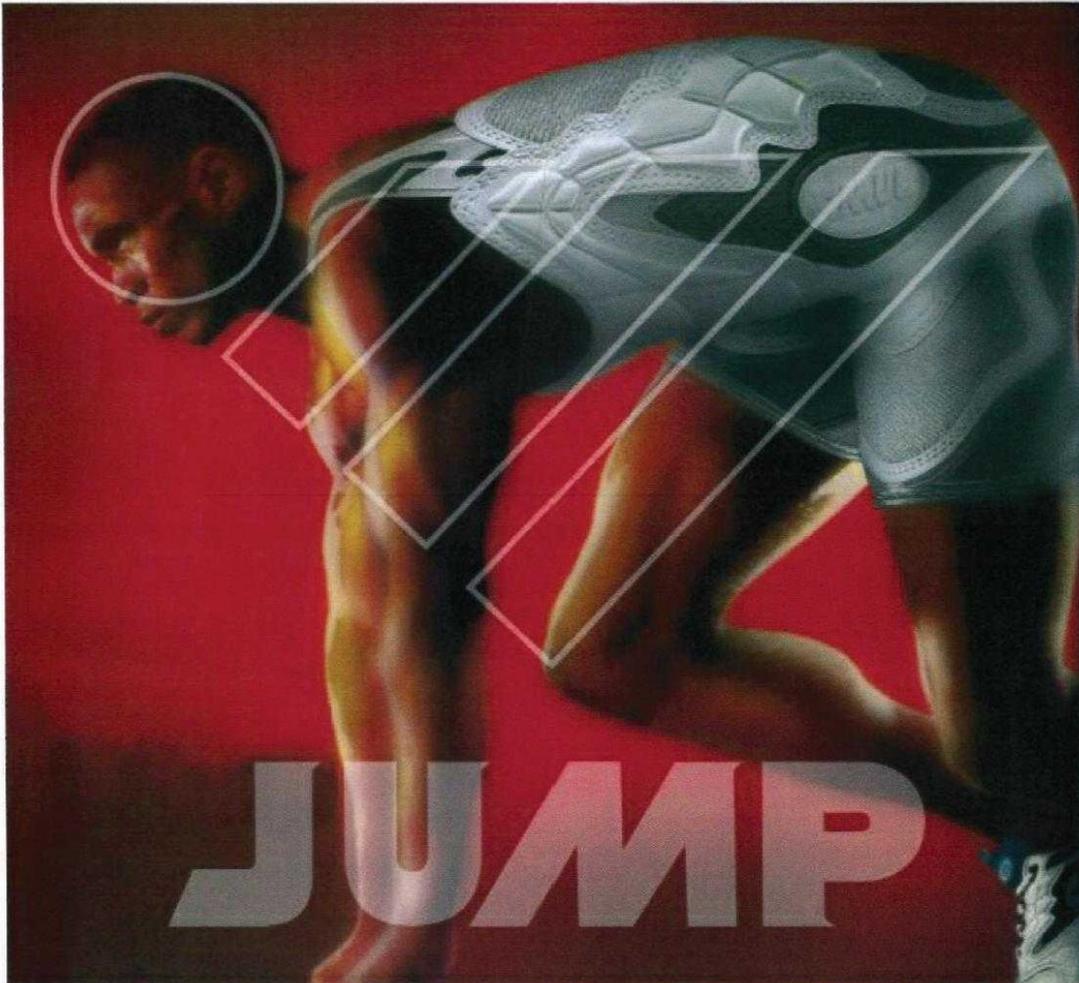
their professor, designed the **JUMP** logo (the "JUMP & Device Mark") some time in 1981-1982 (1981 being the year of commission and 1982 being the year the Applicant claims to have started using the Application Mark on its goods, as well as the year the Chinese Culture University held an exhibition featuring the design of the JUMP & Device Mark). The latter mark can be seen to fully incorporate the Application Mark. Chiang-1 sets out the background at [7] and supporting documents at Exhibit CCMC-1. The latter includes what appears to be a commemorative booklet, "The 16th Graduate Exhibition of Fine Arts Department of Chinese Culture University" (Taiwanese year 71, 2 to 8 May), featuring the four graduate students and the design process behind the JUMP & Device Mark. (Taiwanese year 71 converts into our year 1982.) That exhibition in 1982 showcased the inspiration and application of the JUMP & Device Mark, and photographs of the exhibition can be seen in Exhibit CCMC-1 of Chiang-1.

15 Chiang-1 explains at [7] that the primary idea behind the JUMP & Device Mark

associates the leaping action (represented by ) with the word "jump". The

circle in  represents the human head and the three diagonal stripes represent a crouched human body, poised to make a leaping movement. This is illustrated by the following page from Exhibit CCMC-1 of Chiang-1:

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商標含義:圓圈代表人頭,三條斜線代表身體

16 The Applicant's goods bearing the Application Mark are available in Taiwan, China, the United States, Canada and the Philippines. The Application Mark is used on the goods themselves (e.g. on the side or tongue of shoes), on the product packaging, and on marketing collateral. The JUMP & Device Mark, which fully incorporates the Application Mark as the device element, is used on shoe boxes containing the Applicant's footwear.

17 The Applicant also highlights its activity before 1990; the year being when the Opponent's Mark was designed ([10] above). Between 1986 and 1990, the Applicant's goods bearing the JUMP & Device Mark were heavily advertised in the United States and China (including Taiwan). Exhibit CCMC-4 of Chiang-1 comprises sample advertisements bearing the JUMP & Device Mark, the word mark "JUMP", and / or the Application Mark. These include print advertisements in magazines (such as GQ, FNM Footwear News Magazine, International Male, World Executive's Digest) and even street advertising on a billboard on the side of a building at Time Square, New York (though the latter displayed the Applicant's shoes from the perspective of the soles, such that only the word mark "JUMP" on the soles could be seen, and not the JUMP & Device Mark nor Application Mark). However, suffice it to say I am persuaded that the

Applicant’s business in sportswear, including footwear, using the Application Mark was already a going concern before the Opponent’s Mark was designed in 1990.

18 To summarise, I briefly set out my findings relating to the chronology of the Application Mark and the Opponent’s Mark below:

Year	History of the Application Mark,  , and the Opponent’s Mark, 
1981	 was commissioned.
1982	 was exhibited at the 16 th Graduate Exhibition of Fine Arts Department of Chinese Culture University. The Applicant started using the mark on its goods.
1986-1990	The Applicant’s goods bearing the JUMP & Device Mark,  , were heavily advertised in the United States and China.
1990	 was designed.
1997	 was adopted as the Opponent’s corporate logo

MAIN DECISION

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

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

(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.

The “Step-By-Step” Approach Under Section 8(2)(b)

20 The law in relation to Section 8(2)(b) is established – it is the “step-by-step” approach re-affirmed by the Court of Appeal in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 (“*Staywell*”). In *Staywell*, the Court of Appeal observed at [15] that it was “*clear from the plain words of ss 8 as well as 27 of the Act ... that the only relevant type of confusion for the purpose of grounding an opposition or an infringement action, is that which is brought about by the similarity of the competing marks and between the goods and services in relation to which the marks are used*”.

21 Under Section 8(2)(b), the tribunal therefore has to systematically consider the similarity of marks, similarity of goods or services, and the likelihood of confusion arising from the two similarities. The Court of Appeal in *Staywell* made it clear, at [15],

that “*the first two elements are assessed individually before the final element which is assessed in the round*”. If, for any one step, the answer is in the negative, the inquiry will end, and the opposition will fail.

Similarity of Marks

22 To assess the similarity of marks, the following principles from *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941 at [40] (also a decision of the Court of Appeal) and *Staywell* at [15]-[30] are instructive:

- (i) The comparison between two competing marks is mark-for-mark, and as a whole, without consideration of any external matter.
- (ii) The comparison has regard to three aspects of similarity between the competing marks – visual, aural and conceptual. That said, the three aspects are not intended to be applied mechanistically: the law does not require that all three similarities be made out, nor that as long as one similarity is made out, not matter how weakly, then, there is marks-similarity. Neither is each aspect of similarity of equal importance. Trade-offs can be made between the three aspects. Ultimately, the question is whether the marks, when observed in their totality, are similar rather than dissimilar.
- (iii) 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.
- (iv) 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.
- (v) The comparison is made from the perspective 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.
- (vi) The average consumer, however, is assumed to possess “imperfect recollection” and cannot be expected to compare the contesting marks side by side and examine them in detail for the sake of isolating particular points of difference. Instead, it is the general impression that will likely be left by the essential or dominant features of the marks on the average consumer.

Visual Similarity

23 With the above in mind, I first consider whether the Application Mark is visually similar to the Opponent’s Mark.

24 The two marks under comparison are reproduced below only for ease of reference. I am very mindful that visual comparison is done through the lens of imperfect recollection

of the average consumer, and that the analysis itself should not be conducted with the marks side by side.

Application Mark	Opponent's Mark
	

25 The Application Mark is a geometric device formed by three sloping stripes in the shape of an isosceles (of two sides equal in length) right-angled triangle, with the right angle pointing downwards and a circle at the top left corner of the triangle.

26 On the other hand, the Opponent's Mark is made up of three sloping stripes, also substantially in the shape of a right-angled triangle, but with the right angle pointing upwards. The eagle-eyed may additionally notice that unlike the Application Mark, the Opponent's Mark is not an isosceles triangle; and also that the proportion of the thickness of their stripes and the white space between the stripes differs in both marks (but nothing turns on this – see principle at [22(vi)] above). There are no other elements in the Opponent's Mark apart from the three stripes.

27 In its submissions, the Opponent argues that the visual similarity between the marks lies in the three stripes that form the shape of a triangle. While it admits that there are differences, namely (i) the circle in the Application Mark; and (ii) the opposite orientation of the marks, the Opponent submits that these differences are minor and do not impact the overall similarity of the marks. In support of its contention, the Opponent relies on the two-pronged argument that (i) the Opponent's Mark is highly distinctive and therefore, it enjoys a high threshold before a competing sign will be considered dissimilar; and (ii) there are examples in case law to show how marks with small additional elements or opposing orientation are nonetheless considered similar. I now consider these twin prongs of argument in turn.

Distinctiveness of Opponent's Mark

28 The principle behind the Opponent's argument is well established. The Court of Appeal in *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 stated at [36] that if a mark was highly distinctive, “*there is a high threshold to be met in creating a sign or mark sufficiently dissimilar to it*”. Subsequently, the Court of Appeal in *Staywell*, at [25], reiterated the principle that “*a mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it*”. In other words, the degree of technical distinctiveness of a mark has a direct effect on the threshold of protection for that mark vis-à-vis other similar marks. Taking reference from this tribunal's decision in *Ceramiche Caesar S.p.A v Caesarstone Sdot Yam* [2015] SGIPOS 9, it is therefore possible to conclude that “*a mark which has a normal level of technical distinctiveness will only correspondingly enjoy a normal threshold before a competing sign will be considered dissimilar to it*”. These views were subsequently affirmed by the Court of Appeal in *Ceramiche Caesar S.p.A v Caesarstone Sdot Yam* [2017] 2 SLR 308 (“*Ceramiche Caesar*”) at [30].

(1) Inherent Distinctiveness

29 It is the Opponent's view that the Opponent's Mark has a high degree of technical distinctiveness because it is an entirely novel and invented device which has no meaning or significance in relation to the goods claimed. However, I am unable to agree. The

Opponent's Mark, , is a basic geometric device formed only by three trapezoidal stripes arranged in a triangular fashion. The description "novel and invented" may be true, respectively, in that it has not been adopted by other traders, and in the "copyright sense" of being "original" (which is a very low threshold, see the Court of Appeal's comment in *Asia Pacific Publishing Pte Ltd v Pioneers & Leaders (Publishers) Pte Ltd* [2011] 4 SLR 381 at [38]: "*originality simply means that the work was independently created by the author and that it possesses some minimal degree of creativity, the level of creativity required being extremely low: see George Wei at pp 84-85.*"); but in general, there is nothing to commend the Opponent's Mark to me as being sufficiently complex, elaborate or inventive (not being exhaustive indicators of distinctiveness), to convey a higher than average overall impression of distinctiveness. That being said, the Opponent's Mark is not undistinctive either – first, it has crossed the *prima facie* threshold during examination in order to be registered in the first place ([11] above), and this was without the need for evidence of use; second, in this opposition, I also independently assess the Opponent's Mark to possess a *normal* level of inherent technical distinctiveness.

(2) *Acquired Distinctiveness*

30 The Opponent additionally claims that, because of the acquired distinctiveness of the Opponent's Mark, the latter enjoys a high level of technical distinctiveness.

31 It has been observed by this tribunal that the law is unclear whether (and if so, how) evidence that an earlier trade mark has acquired greater distinctiveness through use plays a role in the assessment for marks-similarity in light of the prohibition against considering external matter at this first step, within the 3-step test of *Staywell*. It has been suggested that such evidence of alleged acquired distinctiveness can be considered at the third step, when likelihood of confusion is assessed (*Clarins Fragrance Group f.k.a. Thierry Mugler Pargums S.A.S. v BenQ Materials Corp.* [2018] SGIPOS 2 at [20] – [25]). The Court of Appeal in *Ceramiche Caesar* also observed, at [29], the difference in approach taken by the Principal Assistant Registrar of Trade Marks, at first instance, who accorded some weight to the evidence tendered in relation to acquired distinctiveness, and that by the High Court judge, on appeal, who only agreed with the earlier finding on inherent distinctiveness but did not make any express finding in relation to acquired distinctiveness. The Court of Appeal did not express a position on the correct approach, perhaps because the appellant there did not challenge the judge's findings on distinctiveness and also because it recognised that nothing turned on the issue of technical distinctiveness in that case. Since the legal position appears to be unclear, I will state my views on the Opponent's evidence in support of this alternative argument.

32 As I first observed at [12] above, Kotterer-1 gives details of: the annual net revenue and annual marketing expenditure in Singapore; the Singapore subsidiary's marketing campaigns; with supporting samples of print advertisements, product catalogues, sales invoices and the like. In spite of the voluminous evidence, where any trade mark is discernible, such evidence overwhelmingly reflected use of the Adidas and Device Mark,

 , instead of the Opponent's Mark,  . Talbot-1 and Talbot-2 also exhibit some examples of use in Singapore. For instance, ST-5 of Talbot-1 exhibits printouts from the Opponent's online store at <http://shop.adidas.com.sg>. These are essentially pages of its online catalogue of adidas-branded clothing, footwear and headgear. However, the marks

used are  , three stripes as appearing on the side of shoes like this 

,  ,  and "adidas" in word form. Likewise, ST-5 of Talbot-1 purports to exhibit profiles and photographs of Singapore sportsmen who have been sponsored by the Opponent, and who wear adidas-branded goods. I strain to see any use of the Opponent's Mark as such and asked the Opponent's counsel at the hearing to show me if there was any. She confirmed there was none.

33 The Opponent may well say that the Opponent's Mark is wholly subsumed within the Adidas and Device Mark, and thus, all the evidence showing use of the latter goes towards establishing acquired distinctiveness of the former – but, it is impossible for the average consumer to disregard the presence of the Opponent's name and brand "adidas" in the Adidas and Device Mark. At the hearing, the Opponent's counsel submitted that in

 , the word "adidas" was a lot smaller than the device. I understand the attempt to put forth the Opponent's best case in the circumstances, but, without delving too deeply into size comparison (I doubt that the word is smaller, let alone "a lot smaller", than the device), I think it fair to say that the primary dominant component in the Adidas and Device Mark is the word "adidas". The Opponent's corporate logo has changed over the years, but its name and brand, "adidas", has remained constant. Any impression derived from the Adidas and Device Mark cannot be divorced from the impact of the word "adidas". The upshot of this is that one cannot reasonably conclude how much of the use of the Adidas and Device Mark in Singapore translates into acquired distinctiveness of the

device element,  , alone. Given the dominance of the word element "adidas", it cannot be very much, if at all.

34 I have also commented, at [12], that the revenue and marketing figures pertain to the "adidas" business generally and did not seem confined to sales and marketing of goods bearing the Opponent's Mark only. The Opponent's counsel confirmed there was no information in the evidence on what proportion of the figures were derived from the Opponent's Mark alone, apart from the Adidas and Device Mark.

35 Therefore, apart from my reservations at [31] whether acquired distinctiveness was relevant at this stage, even if I were to consider the Opponent's evidence in relation to acquired distinctiveness, the evidence as it stands comes short of establishing that the Opponent's Mark has in fact acquired distinctive character.

36 Thus, the inquiry loops back to my conclusion at [29], that the Opponent's Mark possesses a *normal* level of inherent technical distinctiveness. As such, I conclude that it enjoys a *normal* threshold of protection before a competing sign is considered dissimilar to it.

Comparison with Factual Findings in Case Law

37 I go on to consider the second prong of the Opponent’s argument that there are examples in case law to show how marks with small additional elements or opposing orientation are nonetheless considered similar. In particular, the Opponent drew my attention to two decisions from the European Union (“EU”) – Case T-113/16 *Arctic Cat Inc v European Union Intellectual Property Office* (General Court, 30 January 2018) (“*Arctic Cat*”) and Case T-21/25 *Franmax UAB v European Union Intellectual Property Office* (General Court, 26 April 2016) [2016] ETMR 34 (“*Franmax*”).

38 The competing marks in *Arctic Cat* and *Franmax* are set out below for ease of reference:

Arctic Cat

Applicant’s Mark	Opponent’s Mark
	

Franmax

Applicant’s Mark	Opponent’s Mark
	

39 I am mindful that the General Court in *Arctic Cat* and *Franmax* (and in the EU, in general) adopts the “global appreciation test” to assess confusing similarity between competing marks. The Court of Appeal in *Staywell* opined, at [15], that “*Under the global appreciation approach the elements of similarity between marks and goods or services, whilst still necessary ingredients in the confusion inquiry, are elided with other factors going towards the ultimate question of whether there is a likelihood of confusion (see Sabel v Puma at 223–224, and Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117 at 132)*”. Further, our Court of Appeal noted that under this approach, “*the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion*” and “*a particular outworking of the focus on consumer perception is in the weighting of each element of mark-similarity in the course of the confusion inquiry.... In order to assess the degree of similarity between the marks concerned [for the purpose of the global assessment], the national court must determine the degree of visual, aural or conceptual similarity between them and, where appropriate, evaluate the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed*” (*Staywell* at [67]-[68]). The Court of Appeal however made it clear that it would not adopt the “global appreciation test” in Singapore, endorsing instead the “step-by-step approach” as it was “*... conceptually neater and more systematic and, importantly... more aligned with the requirements imposed under our statute*” (*Staywell* at [15]).

40 In view of the above difference of approach, one is mindful that any finding of marks-similarity in EU cases would be informed by considerations that are permissible under the “global appreciation test”, but not in the first step of the three-step test under *Staywell* in Singapore. I now consider the two decisions to elicit the analysis on visual similarity.

41 In *Arctic Cat* at [37]-[39], the General Court found that “*the overall impression is dominated, in both the signs concerned by the black silhouette of a member of the cat family represented in profile, conveying an impression of movement, characterised by the position of the fore- and hind legs extending from the central part of the body and not supporting it. Those similarities will be immediately noticed and easily remembered by the average and reasonably observant consumer... the animals are represented in both signs in a position that clearly conveys an impression of movement, jumping, in contrast to a resting position, moving at a slow pace or with legs tucked while running... In addition to the similarity of the silhouettes noted in paragraph 37 above, other elements – of secondary importance – are common to both signs, such as the position of the tail and the fact that the muzzle is open, which accentuate that similarity.*”

42 In *Franmax*, at p14, the General Court found similarity in the competing marks because of “*the imperfect image that the relevant public will recall of the marks at issue, namely the representation of a moving dinosaur giving the impression of a friendly, happy creature. Furthermore ... in so far as the dinosaur is walking to the right, while in the earlier mark it is walking to the left, it must be observed that, taking account of the fairly similar angles used in the signs at issue and the comparable relative dimensions (namely, the height to width ratio) of the figurative representation of the dinosaur in those signs, the visual comparison of those signs gives the impression of a certain symmetry ... , which is a factor of visual similarity between the two signs*”. Commenting on the relevance of the word element “Dino”, the General Court found, at p15, that “*given that the marks are perceived as a whole, consumers will also perceive, in the present case, the figurative representation of a dinosaur in the mark applied for, even if it is accompanied by a verbal element, namely, the word “dino”. In fact, as is clear from the contested decision, the figurative representation of a dinosaur being conceptually linked to the word “dino”, it will retain all its power to visually attract and will be remembered by consumers...*”.

43 It is clear that the competing marks in *Arctic Cat* and *Franmax* are relatively more similar to each other than the Application Mark and the Opponent’s Mark are in the present case. In *Arctic Cat* and *Franmax*, the competing marks are, respectively, devices of a large cat and a dinosaur. These are unambiguous representations which, practically, do not lose their form or structure even if they are inverted, or have a change in orientation. They are also significantly more complex in composition as compared to the simple geometric shapes of the competing marks in this case. The Opponent’s proposition that marks with opposing orientation are nonetheless considered similar may be true some of the time, but not all the time. I can see why the marks in *Arctic Cat* and *Franmax* were found similar in the EU despite the change in orientation (left-right) – and part, though not all, of the reason is attributable to assumptions made about the perception by the average consumer of the specific goods in question (which is not the approach in Singapore) – but it still remains for me to analyse whether the competing marks in the present opposition are more similar or more dissimilar.

Analysis of Visual Similarity

44 As summarised at [27] above, the Opponent argues that the visual similarity between both marks lies in the three stripes that form the shape of a triangle. While it admits that there are differences, namely (i) the circle in the Application Mark; and (ii) the opposite directions of the marks, the Opponent submits that these differences are minor and do not impact the overall similarity of the marks. The Opponent claims that because the three stripes in the Application Mark immediately occupy visual dominance in the mark, there is resultant visual similarity between the Opponent’s Mark and the Application Mark.

45 At this juncture, I pause to consider the issue of whether the Application Mark has a dominant component and if so, what it is. Likewise for the Opponent’s Mark. As described at [25] above, the Application Mark is a geometric device formed by three sloping stripes in the shape of a right-angled triangle, with the right angle pointing downwards such that it looks like the triangle is balancing on a point; with a circle at the top left corner of the shape. The Opponent would persuade me that the dominant

component of the Application Mark, , is the three-stripped triangle because it forms the bulk of the mark and therefore overshadows the proportionately smaller circle component. However, I do think the circle component, though smaller in size, is not smaller in impact on the imperfect (visual) recollection of the average consumer. The circle with no corners, no angles, is a counterpoint to the angular form of the three-stripped triangle. It is also positioned at one of the top corners of the triangle, which enhances its visual significance because it appears to “lead” or “point” the mark towards the left. It is not natural nor realistic to separate the triangular component and the circular component, as if it were a hallowed quest to find the holy grail of *the* distinctive and dominant component of the mark. In this case, I think there is no dominant *component* as such. Rather, the Application Mark *as a whole* leaves a distinctive and dominant impression on

the average consumer. As for the Opponent’s Mark, , the Opponent submits that this is largely a triangular device composed of three stripes that cannot be broken down into separate and individual components, and thus it is not necessary to identify the distinctive and dominant component. I generally agree with the gist of the Opponent’s submission that the Opponent’s Mark does not have a specific dominant component and should be apprehended as a whole.

46 The Opponent’s position hinges on the dominant commonality of the three-stripped triangle in both marks. With my conclusion that the Application Mark has no distinctive and dominant component (and that it is instead its *entirety* – not only the triangular element – that makes the impression on the average consumer), the writ is on the wall. Comparing

the Application Mark () and the Opponent’s Mark () visually, their respective dominant impressions are different. At [36], I have also concluded that the Opponent’s Mark possesses a *normal* level of inherent technical distinctiveness and thus enjoys a *normal* threshold of protection before a competing sign is considered dissimilar to it. The threshold is not raised such that the Application Mark has to fulfil more, so to speak, before it is considered dissimilar to the Opponent’s Mark. The combination of the circle device with a differently-orientated triangle suffices to distinguish it from the Opponent’s Mark as a whole.

47 At [43], I also alluded to another point related to the Opponent's submission on inversion of marks. The Opponent's proposition that marks with opposing orientation are nonetheless considered similar may be true some of the time, but not all the time. I had surmised why this was applicable in *Arctic Cat* and *Franmax*. Unlike the competing marks in those cases, however, the Application Mark and the Opponent's Mark here are formed by basic geometric shapes. It is possible that an inversion, or change in orientation or direction could result in a considerable modification to the impression conveyed visually by the shape. Shapes are defined by a combination of lines, angles, and dimensions. Therefore, where a variation is incorporated in the combination, how the shape comes across visually is also altered.

48 I find this to be the case for the Application Mark and the Opponent's Mark. That the right angle of the three-stripped triangular component points upwards in the Opponent's Mark but downwards in the Application Mark illustrates a significant variance between the two marks because both marks are geometric shapes for which orientation is a material component. A triangle whose right angle points upwards may give the visual impression of a mountain, or at least of something grounded. A triangle whose right angle points downwards gives a significantly different visual impression, that of something *en pointe*, perched or being balanced. Add to that the circle device, which cannot be hived off the consumer's impression, and the visual impression is even more different from the Opponent's Mark e.g. an average consumer could even plausibly see the Application

Mark, , as a shuttlecock. As such, the proposition that marks with opposing orientation are nonetheless considered similar does not hold true here.

49 To conclude the issue, I find that the competing marks are visually dissimilar when compared as wholes. The additional circle component in the Application Mark and the top-bottom inversion of the Application Mark (as compared to the Opponent's Mark) sufficiently distinguish the Application Mark beyond the normal threshold of protection which the Opponent's Mark enjoys.

Comment on Opponent's Supplementary Written Submissions and Authorities

50 For completeness, and as a note on proper practice, I would mention that the Opponent furnished supplementary written submissions at the hearing itself. These submissions came with seven additional case authorities from the UK Patent Office, IP Australia (the national IP office in Australia which oversees the registration of trade marks) and the now-renamed EU Intellectual Property Office.

51 HMG Circular No. 4/2015 states, at Part F, the proper practice relating to additional or supplementary written submissions and authorities. A party who wishes to tender additional or supplementary written submissions and authorities should file and serve the same on the counter-party at least two weeks before the hearing. This circular makes clear that if the above is not complied with, the Registrar will either disregard the submissions; or accept them and give the counter-party time to file reply submissions. The policy behind this is that parties are expected to articulate their best case through the written submissions and authorities due at least one month before the hearing: Rule 37 of the Trade Marks Rules (Cap 332, 2008 Rev Ed). They should not, as a matter of course, have a second bite at the cherry by tendering more submissions and / or authorities of a substantive nature

only at the hearing itself when these could have been filed at least one month earlier. A distinction is drawn between such submissions and / or authorities and basic rebuttal submissions which can be made at the hearing itself (HMG Circular No. 4/2015 does not require basic rebuttals to be filed and served two weeks in advance).

52 In the absence of good reasons why the Opponent's supplementary written submissions and authorities could not comply with HMG Circular No. 4/2015 and be filed two weeks before the hearing, I am not minded to accept the additional case authorities. I gave the Opponent the opportunity to be preliminarily heard on these additional authorities at the hearing, and conclude that they provide nothing more than further examples of device and composite marks which were found similar in foreign jurisdictions – their persuasive value is very limited, at best.

53 To conclude on this point, parties in proceedings before the Registrar are expected to comply with HMG Circular No. 4/2015. This serves to ensure fair and transparent play between parties in proceedings before the Registrar; and maintain the integrity of the framework which already gives parties fair opportunity to concretise their submissions at least one month before the hearing.

Aural Similarity

54 Having regard to the fact that the Application Mark and the Opponent's Mark are both device marks, neither of which possess any aural component, it is not possible to assess any aural similarity (or dissimilarity). This is therefore a neutral factor.

Conceptual Similarity

55 Conceptual similarity “*seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole*” (*Staywell* at [35], affirmed in *Caesarstone* at [48]).

56 The Applicant and the Opponent have stated the concept of their respective marks as follows:

- (i) It is the Applicant's evidence that the Application Mark, , is intended to convey the idea of a person crouching and poised to make a leaping movement, reminiscent of the posture adopted by an athlete about to perform a “long jump”. The circle device in the Application Mark represents the human head, while the downward pointing triangular device of three sloping stripes represents the crouched human body: *Chiang-1* at [7].

I appreciate that there is a slight difference between the above concept and the picture from Exhibit CCMC-1, reproduced at [15] above. Nevertheless, I accept that the idea of a leaping movement is consistent as between a long jumper and a runner at the starting block. The primary concept is still a leaping movement, which goes hand in hand with the brand conceived simultaneously – “Jump”.

- (ii) It is the Opponent's evidence that the Opponent's Mark, , is intended to convey the idea of a mountain, indicating the challenge to be faced and the goals to be achieved: Talbot-2 at [8] and Exhibit ST-13. It is inspired by adidas' three stripes that appear on the sides of adidas shoes.

57 The principle is clear that the perspective from which the conceptual similarity analysis is conducted is that of the consumer. In *Mediacorp News Pte Ltd v Astro All Asia Networks plc* [2009] 4 SLR(R) 496 ("*Mediacorp*"), the High Court at [39] states that "*the analysis of conceptual similarity will have to be done from the viewpoint of the consumer. It is unlikely that consumers will be able to appreciate the genesis of either mark as stated by the parties (above). Instead, what the consumers will likely conceptualise from seeing both marks is, as the PAR found, a 'triangular device ... similar in form and colour'*". It also observed that "*both marks were devoid of any semantic or symbolic content or meaning that could lead the consumer to distinguish the two marks conceptually*" and found the competing marks conceptually similar.

58 The Opponent argues that "*the only immediately apparent idea conveyed by both marks to the average consumer is that of geometrical elements combining to form the shape of a triangle.*" As it had done in submissions relating to visual similarity above, the Opponent maintains, in relation to conceptual similarity, its sole focus on the commonality of the triangular devices in both marks (and glosses over the significance of the circle device in the Application Mark). However, I cannot agree with this approach.

59 Applying the High Court's approach in *Mediacorp*, notwithstanding the parties' clear articulation of the thinking behind the conception and adoption of their respective marks, I very much doubt that the consumer will "get the same message" without prior education. What, then, would the average consumer perceive as the concept of the competing marks? There is no particularly distinctive and dominant component of the marks conceptually, so they are simply assessed as wholes. The consumer's conceptual impression of the Application Mark is likely to be that of a circle and a triangle; and that of the Opponent's Mark, a triangle. Overall, I adjudge that the marks are conceptually dissimilar.

60 Alternatively, if one were pressed to "*uncover the ideas*" and "*semantic or symbolic content*" behind the marks (beyond their geometrical shapes), I would think there is none that is unambiguous enough to the average consumer. In other words, the average consumer is not likely to perceive the marks conceptually. There is therefore no basis to compare the marks conceptually, and thus, as with aural similarity, this is a neutral factor.

Conclusion on Marks-Similarity

61 I have considered the three aspects of similarity above, and found (i) the competing marks visually more dissimilar than similar; (ii) the aural comparison leads to a neutral outcome; and (iii) the marks are either conceptually dissimilar, or cannot be compared conceptually and therefore, conceptual similarity is a neutral factor.

62 Bearing in mind that "*trade-offs can occur between the three aspects of similarity in the marks-similarity inquiry*" (*Staywell* at [18]) and that the tribunal must ultimately "*conclude whether the marks, when observed in their totality, are similar rather than*

dissimilar" (*Staywell* at [17]), I am of the view that, overall, the Application Mark is more dissimilar than similar to the Opponent's Mark.

Conclusion on Section 8(2)(b)

63 Given that the similarity of the competing marks is a "*threshold requirement that had to be satisfied before the confusion inquiry is undertaken*" (*Staywell* at [15]), my finding of dissimilarity between the Application Mark and the Opponent's Mark is sufficient to dispose of the matter under Section 8(2)(b) in favour of the Applicant.

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

Comment on Opponent's Internet Printouts and "Likelihood of Confusion" Argument

65 Although the conclusion on this ground has been reached, I would take the opportunity to mention that at the hearing, the Opponent submitted a bundle of internet printouts showing established apparel brands using (legitimate) inverted representations of their marks (including logos) on their clothing, footwear and headgear as a trend. Its counsel submitted that this observation of what was happening in the market could not be disregarded and must be considered when assessing the likelihood of confusion (in the third step of the three-step test). The point is that such inversion would naturally be discounted when seen on clothing, footwear and headgear (because it is expected, being a trend) and the likelihood of confusion is higher between the Application Mark and the Opponent's Mark.

66 I have not had to consider this submission further, as the inquiry effectively ended at the marks-similarity stage of the three-step test. However, on a procedural note, the proper approach would have been for the Opponent to seek leave to file further evidence to demonstrate what it says to be happening in the market for clothing, footwear and headgear. It is not sufficient for the Opponent to persuade me that, just because I could likewise conduct Google searches on the internet and glean the same content, the material ought to be taken into account without being adduced as sworn evidence. On the contrary, it is almost trite to state that this tribunal *cannot* base its decisions on internet searches on the state of the market, and on trends, additional to what is in evidence.

Ground of Opposition under Section 8(4)

67 Section 8(4) of the Act reads:

(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; or
- (ii) if the earlier trade mark is well known to the public at large in Singapore —
 - (A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or
 - (B) would take unfair advantage of the distinctive character of the earlier trade mark.

Similarity of Marks

68 Under Section 8(4), the preliminary element to be satisfied is that "*the whole or essential part of the trade mark must be identical or similar to an earlier mark*". If this element is not made out, the ground of opposition under any limb of Section 8(4) will fail.

69 At this juncture, I pause to highlight that while the language of Section 8(4) is worded differently from Section 8(2)(b), the High Court in ***Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd*** [2015] SGHC 216 made it clear that the similarity analysis nevertheless is essentially the same. Indeed, the High Court said, at [146], that "... little turns on the reference to 'essential part' in s 8(4). ... even under s 8(2)(b) where the phrase 'essential part' does not appear, it is clear that the court in making a mark-for-mark comparison is entitled (where relevant) to take into account the dominant features of the mark".

70 I have already found above, in the analysis under Section 8(2)(b), that the Application Mark is not similar to the Opponent's Mark. For the same reasons, the whole or essential part of the Application Mark is not identical with or similar to the Opponent's Mark under Section 8(4).

Conclusion on Section 8(4)

71 Since the Opponent has not satisfied the essential element of marks-similarity here, there is no necessity for me to consider the remaining elements, and the ground of opposition under the three limbs of Section 8(4) therefore fails.

72 In passing, I simply make a brief comment that the Opponent's evidence, particularly sales and marketing figures in Talbot-1 and Kotterer-1, pertains to the "adidas" business in general (see similar and more detailed comments at [12] above on Kotterer-1, and at [32]-[33] on acquired distinctiveness). The Opponent's Adidas and

Device Mark, , also appears overwhelmingly more often than the Opponent's Mark, , does in the Opponent's evidence of use. A conclusion cannot be drawn over how much of such evidence relates to the Opponent's Mark alone, and thus, there would be practical difficulties ascertaining whether the Opponent's Mark – divorced

from the name “adidas” – is well known in Singapore. However, this is not an issue that needs decision as the element of marks-similarity was not established.

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

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

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

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

The “Classical” Trinity

74 To satisfy a claim for passing off under Section 8(7)(a), the opponent must establish the “classical” trinity of goodwill, misrepresentation and damage (*Novelty Pte Ltd v Amanresorts Ltd and anor* [2009] 3 SLR 216 at [36]; also applied in the more recent Court of Appeal decisions of *The Audience Motivation Company Asia Pte Ltd v AMC Live Group China (S) Pte Ltd* [2016] SGCA 25 and *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] SGCA 33).

75 Having already found above that the competing marks are dissimilar, misrepresentation for the purposes of passing off cannot be established in this case. Equally, since misrepresentation cannot be established, the requirement of damage in a claim of passing off cannot be made out, whether or not the element of goodwill has been made out.

Conclusion on Section 8(7)(a)

76 The ground of opposition under Section 8(7)(a) therefore fails.

Ground of Opposition under Section 7(6)

77 Section 7(6) of the Act reads:

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

78 The Opponent’s pleading under this ground of opposition bears replicating in full below:

12 Further and / or in the alternative, the Application Mark has been filed in bad faith. The Opponent has successfully opposed or invalidated the Application Mark based on the Opponent’s Mark in many other jurisdictions such as South Korea, Germany and Hong Kong. In addition, the Applicant or its distributors or related companies offer footwear with designs which are identical or similar to that of the Applicant’s (*sic*) footwear. In light of the aforesaid, the filing of the Application Mark is an act of bad faith. Registration

of the Application Mark, if allowed, would be contrary to Section 7(6) of the Act.

Preliminary Points

79 In both theory and practice, there are several possible heads of bad faith under which Section 7(6) can be established. These include the applicant not being the owner of the mark nor entitled to register the mark; the applicant not having a *bona fide* intention to use the mark; and, possibly, the specification being too wide.

80 I now consider the Opponent's particulars of bad faith as pleaded in its notice of opposition by examining the paragraph replicated above:

- (i) *“Further and / or in the alternative, the Application Mark has been filed in bad faith.”*

This is a signpost to introduce another ground, further to the earlier pleaded grounds, which is based on bad faith.

- (ii) *“The Opponent has successfully opposed or invalidated the Application Mark based on the Opponent's Mark in many other jurisdictions such as South Korea, Germany and Hong Kong.”*

This tells us the factual outcomes of the Opponent's challenges, in general, to the Application Mark in other jurisdictions, without other details such as the basis for these outcomes. It does not tell us anything about the substance of the ground of bad faith being pleaded in Singapore.

- (iii) *“In addition, the Applicant or its distributors or related companies offer footwear with designs which are identical or similar to that of the Applicant's (sic) footwear.”*

This is the crux of the Opponent's pleading based on bad faith. It is centred on the Applicant's footwear designs being identical or similar to, presumably, the Opponent's (rather than the Applicant's, as reflected in the probable typographical error) footwear.

- (iv) *“In light of the aforesaid, the filing of the Application Mark is an act of bad faith. Registration of the Application Mark, if allowed, would be contrary to Section 7(6) of the Act.”*

This is a typical way to end each ground being pleaded and does not disclose the substance of the allegation of bad faith.

81 In comparison, the Opponent's written submissions on bad faith, at [138], centre around the allegation *“that the Application Mark was blatantly copied from the Appellant (sic). Such copying from falls short of the acceptable commercial behaviour observed by reasonable and experienced men in the relevant trade, and constitutes bad faith.”* In oral submissions at the hearing, the Opponent's counsel emphasized the

Applicant's business model to replicate Western styles and trends, and its look-alike shoe designs (compared to the Opponent's).

82 Although the Opponent's written submissions argue that the Application was made in bad faith because the Application Mark was copied from the Opponent, it is not appropriate to consider this line of argument as it falls outside the scope of what the Opponent has pleaded in the notice of opposition under the ground of bad faith. The Opponent's written submissions on bad faith are accordingly not of assistance. (In any event, as summarised in the table at [18] above, the Application Mark was commissioned and designed some eight to nine years before the Opponent's Mark was designed in 1990. It is hard to see how the Application Mark could have been "*copied from the Opponent*".) I therefore confine the scope of my inquiry to what was pleaded ([80(iii)] above) and note that the Opponent's oral submissions are, unlike the written submissions, at least consistent with the pleadings though slightly broader in describing the Applicant's alleged business model.

Whether the Application Was Made in Bad Faith Based on Comparison of Footwear Designs

83 The relevant evidence is set out at [36] and Exhibit ST-12 of Talbot-1. [36] states that Exhibit ST-12 is a compilation of photos comparing the Opponent's shoes and the Applicant's shoes. These photos are set out below:

[This space is intentionally left blank]

Jump look-a-likes of adidas 3 stripe shoe

ADIDAS SHOE	JUMP LOOK-A-LIKE
 <p data-bbox="475 640 608 667">FEROZA LOW</p>	 <p data-bbox="1002 573 1102 600">JUMP 508</p>
 <p data-bbox="459 976 619 1003">FEROZA SLIP ON</p>	 <p data-bbox="1002 846 1102 873">JUMP 396</p>
 <p data-bbox="475 1379 608 1406">BARRICADE III</p>	 <p data-bbox="1174 1245 1275 1272">JUMP 467</p>  

Application Mark



[annotation at shoe model Jump 508 in top right corner mine]

84 At the hearing, in seeking to correctly interpret the evidence, I referred to the above exhibit and observed that none of the pairs of shoes above (compared in rows) compare the use of the Application Mark versus the Opponent's Mark. Indeed, the Application Mark can only (barely) be discerned in shoe model Jump 508. The Opponent's counsel responded that the point of the exhibit is the similarity in shoe designs, because [36] of Talbot-1 is organised under the section of evidence on bad faith. She pointed out that, comparing the shoe designs, there is close similarity, not necessarily in the use of the respective marks but in the way that the shoes are designed.

85 This being an opposition to the registration of the Application Mark , there must be some nexus between the conduct (bad faith) complained of and the Application Mark. I now consider the evidence and conduct relied on by the Opponent, namely the design of the Applicant's footwear being allegedly similar to the Opponent's. The "design of the Applicant's footwear" here refers to the holistic appearance of the footwear, including but not limited to the shape, material, colour, patterns and marks used on the footwear. Even though the Application Mark is used in (only) one of the Applicant's shoe designs above (model Jump 508), the complaint, in relation to the Opponent's corresponding shoe design (model Feroza Low) appears to be that the overall shoe design is too similar – specifically the red background and positioning and angling of the multiple black stripes on the sides of the shoes. However,

the presence of the Application Mark  does *not* contribute to this overall impression of similarity in design; if anything, it makes the design less similar. As such, any nexus between the conduct complained of (copying shoe designs) and the Application Mark is too far removed and I find it difficult to conclude that the Application was made in bad faith.

86 Even the Opponent's more general argument that the Applicant's alleged business model is to replicate Western styles and trends does not, as such, lead to a

finding that the Application to register  was made in bad faith. Designs may be inspired by so called "Western styles and trends", but the *trade marks* involved have to veer close enough (essentially to amount to misappropriation), before such conduct under the business model is objectionable as being in bad faith. If the Opponent takes issue with the Applicant's shoe designs as a whole, its course of action could lie elsewhere, but not in an opposition to the registration of the Application Mark,

, here.

Conclusion on Section 7(6)

87 The ground of opposition under Section 7(6) therefore fails.

Overall Conclusion

88 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. The Application Mark will proceed to registration. The Applicant is also entitled to costs to be taxed, if not agreed.

Date of Issue: 20 July 2018

[An appeal from this decision to the High Court is pending.]