

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

Trade Mark Nos. 40201522634S and 40201523105X  
Hearing Date: 15 May 2018

**IN THE MATTER OF TRADE MARK APPLICATIONS BY**

**SWATCH AG (SWATCH SA) (SWATCH LTD.)**

**AND**

**OPPOSITION THERETO BY**

**APPLE INC.**

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

Representation:

Ms Denise Loh (Ella Cheong LLC) for the Applicant

Ms Amanda Lim (Lee & Lee) for the Opponent

**GROUND OF DECISION**

1 Everyone loves a good comeback story. Or two.

2 In 1985, Steve Jobs left the tech company he co-founded. More than ten years later, he was back at the helm at Apple Inc., at a time when the company itself was floundering. Once back onboard, he steered an ambitious ad campaign which turned the tide. For Apple Inc., and for the man. The rest, as they say, is history.

3 This opposition has its roots in that heady era. The “Think Different” ad campaign was a tribute to important historical and contemporary personalities – Albert Einstein, Martin Luther King Jr., Mahatma Gandhi and the hallowed list goes on. In print and outdoor use, black and white photos and Apple’s colourful apple logo were used, along

with the words “Think Different” instead of Apple Inc.’s name. The aim? To promote Apple’s brand and revive the counter-culture aura of its earlier days. The campaign was so successful that it ran between 1997 and 2002. One can easily understand, standing on American home ground, what the campaign and the slogan meant to Apple’s very core. And, hence, why Apple may be motivated to make a stand against another mark it thinks segues too closely to its slogan. Whether the latter is indeed the case is the subject of this decision.

4 Swatch AG (Swatch SA) (Swatch Ltd.) (“the Applicant”, also referred to as “Swatch”), filed two applications (“the Applications”) to register the trade mark:

Tick different

(“Application Mark”, also referred to as the “Tick different” Mark)  
in Singapore.

5 The relevant details of the Applications are as follows:

<b>TM No.</b>	<b>Filing Date</b>	<b>Class</b>
40201523105X	2 November 2015	9
<b>Specification</b>		
Apparatus for recording, transmission and reproduction of sound or images; electronic payment processing apparatus, apparatus for processing cashless payment transactions; magnetic recording media, sound recording disks; compact disks, DVDs and other digital recording media; apparatus enabling the playing of compressed sound files (MP3); calculating machines and data processing equipment, software; game software for mobile telephones, for computers and for digital personal stereos; electronic game software for mobile telephones, for computers and for digital personal stereos; computers, portable computers, handheld computers, mobile computers, personal computers, wrist computers, electronic tablets and mobile and computer devices, digital personal stereos, mobile telephones and new-generation mobile telephones incorporating greater functionality (smartphones); telecommunication apparatus and instruments; apparatus for recording, transmission, reproduction of sound or images, particularly mobile telephones and new-generation mobile telephones incorporating greater functionality (smartphones); handheld electronic apparatus for accessing the Internet and sending, receiving, recording and storing of short messages, electronic messages, telephone calls, faxes, video-conferences, images, sound, music, text and other digital data; handheld electronic apparatus for wireless receiving, storing and transmitting of data or messages; handheld electronic apparatus for monitoring and organizing personal information; handheld electronic apparatus for global positioning [GPS] and displaying maps and transport information; handheld electronic devices for detecting, monitoring, storing, surveillance and transmitting data relating to the user activity, namely position, itinerary, distance traveled, heart rate; covers for computers, portable and mobile telephones; optical apparatus and instruments, particularly spectacles, sunglasses, magnifying glasses; cases for spectacles, sunglasses and magnifying glasses; batteries for electronic apparatus and computers, batteries for timepieces and chronometric instruments.		

The above application in Class 9 shall be referred to as “the Class 9 Application” in these grounds of decision. The specification of goods shall be referred to as “the Class 9 Specification”.

<b>TM No.</b>	<b>Filing Date</b>	<b>Class</b>
40201522634S	2 November 2015	14
<b>Specification</b>		
Precious metals and their alloys and goods made of these materials or coated therewith included in this class, namely figurines, trophies; jewelry, namely rings, earrings, cufflinks, bracelets, charms, brooches, chains, necklaces, tie pins, tie clips, jewelry caskets, jewelry cases; precious stones, semi-precious stones; timepieces and chronometric instruments, namely chronometers, chronographs, clocks, watches, wristwatches, wall clocks, alarm clocks as well as parts and accessories for the aforesaid goods, namely hands, anchors, pendulums, barrels, watch cases, watch straps, watch dials, clockworks, watch chains, movements for timepieces, watch springs, watch glasses, presentation cases for timepieces, cases for timepieces.		

The above application in Class 14 shall be referred to as “the Class 14 Application” in these grounds of decision. The specification of goods shall be referred to as “the Class 14 Specification”.

6 The Applications were accepted and published on 11 March 2016 for opposition. Apple Inc. (“the Opponent”, also referred to as “Apple” above and below) filed its Notices of Opposition to oppose the Applications on 11 July 2016. The Applicant filed its Counter-Statements on 28 October 2016 and its amended Counter-Statements on 27 November 2017. The oppositions to the Applications were consolidated from the close of pleadings. As such, each party filed a single set of evidence in respect of the consolidated oppositions (hereafter referred to in the singular) to the Applications.

7 The Opponent filed evidence in support of the opposition on 23 February 2017. The Applicant filed evidence in support of the Applications on 22 June 2017. The Opponent filed evidence in reply on 10 October 2017. Following the close of evidence, the Pre-Hearing Review was held on 6 November 2017. Further to that, the Applicant was granted leave to file further evidence, which it did on 3 January 2018. In turn, the Opponent was allowed to file further evidence in reply, and it did so on 26 January 2018. The opposition was heard on 15 May 2018.

### **Grounds of Opposition**

8 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 its opposition to the registration of the Application Mark.

### **Opponent’s Evidence**

9 The Opponent’s evidence comprises three statutory declarations, all made in California, United States of America by Thomas R. La Perle, a Director in Apple’s legal department. They are dated 14 February 2017, 21 September 2017 and 16 January 2018. The earliest of these shall be referred to below as “La Perle-1”.

### **Applicant’s Evidence**

10 The Applicant’s evidence comprises two statutory declarations made in Biel/Bienne, Switzerland by Laurent Potylo, the Applicant’s authorized signatory. The deponent is the Head of Trademark and Designs at The Swatch Group AG (The Swatch Group SA) (The Swatch Group Ltd), which is the entity managing the Applicant’s trade marks. The two statutory declarations made by Laurent Potylo are dated 14 June 2017 and 16 November 2017. The earlier of these shall be referred to below as “Potylo-1”.

### **Applicable Law and Burden of Proof**

11 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**

12 Both parties need no introduction.

13 Apple is a Californian technology company founded in 1976. It designs, manufactures, markets and sells mobile communication and media devices, personal computers, portable digital music players, software, services, accessories, networking solutions and third party digital content and applications. Its key products include the iPhone, iPad, Mac and Apple Watch. As described in the introduction above, the company launched a wildly successful advertising campaign called “Think Different”. This ad campaign won the Emmy award, advertising awards and media recognition.

14 Apple, as the Opponent, relies on its earlier trade mark (“earlier trade mark”, also referred to as the “Opponent’s Mark” and the “THINK DIFFERENT” Mark) registered in Singapore, with details set out below:

<b>THINK DIFFERENT</b>		
<b>TM No.</b>	<b>Filing Date</b>	<b>Class</b>
T9907895H	28 July 1999	9
<b>Specification</b>		
Computers; computer hardware; computer peripherals; computer software; network servers; parts and fittings for all the aforesaid goods; all included in Class 9.		

The specification of goods above shall be referred to as “the Opponent’s Specification” in these grounds of decision.

15 Apple has also registered the “THINK DIFFERENT” Mark in a handful of other countries and regions, including in the United States of America, the European Union, Japan and South Korea.

16 Swatch is well established in the watch industry, incorporated in Switzerland but having a worldwide presence. Its corporate group (“the Swatch Group”) owns a stable

of Swiss watch brands such as Swatch, Omega, Tissot, Longines and Rado. The Swatch Group has distribution subsidiaries worldwide in Europe, the United States of America, the Middle East, Africa, Oceania and Asia. Swatch’s products were first launched in 1983 and it is claimed that these “*have since gone on to become phenomenally successful worldwide*”, and that “*the Applicant succeeded in making watches accessible to a much broader range of customers*”: see [6] of Potylo-1. As regards the derivation of the Application Mark, Swatch claims, at [8] of Potylo-1, that it “*was coined by the Applicant to reflect the Applicant’s long history and close association with timepieces. In this regard, the word “Tick” is widely known amongst English speakers to be a reference to the regular short, sharp sounds produced by clocks or other timepieces once every second of time.*” No further explanation was given for the choice of the word “Different” in combination with “Tick” to form the Application Mark. It is not evinced that Swatch used the Application Mark in Singapore; neither does the evidence show use anywhere else in the world.

## MAIN DECISION

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

17 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.

### *Three-Step Test*

18 The Court of Appeal decision, *Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide* [2014] 1 SLR 911 (“*Staywell*”), sets out the approach under Section 8(2)(b) of the Act. In *Staywell*, the court endorsed the “*step-by-step*” approach which may be summarised as follows:

- (i) The first step is to assess whether the respective marks are similar.
- (ii) The second step is to assess whether there is identity or similarity between the goods or services for which registration is sought as against the goods or services for which the earlier trade mark is protected.
- (iii) The third step is to consider whether there exists a likelihood of confusion because of the marks- and goods/services-similarities.

The court made it clear that “*the first two elements are assessed individually before the final element which is assessed in the round*” (*Staywell* at [15]). If, for any one step, the answer is in the negative, the inquiry ends, and the opposition will fail.

19 The above approach was applied by the same court most recently in *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 (“*Caesarstone*”). In the latter decision, the Court of Appeal gave further guidance on the application of the “*step-by-step*” approach and I shall make references to this in the present case.

### ***Marks-Similarity: Principles***

20 In assessing the marks for similarity, I have taken the following principles into account:

- (i) The assessment of marks similarity is mark-for-mark, without consideration of any external matter: *Staywell* at [20].
- (ii) The marks are to be compared “as a whole”: *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 (“*Hai Tong*”; also a Court of Appeal decision) at [40(b)]. When speaking of the assessment of a mark as a whole, the 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: *Staywell* at [23], [26].
- (iii) The marks are to be compared for visual, aural and conceptual similarities. There is no requirement that all three aspects of similarity must be made out before the marks can be found to be similar. Trade-offs can occur between the three aspects of similarity in the marks-similarity inquiry. The three aspects of similarity are but signposts meant to guide the inquiry and I must ultimately come to a conclusion whether the marks, when observed in their totality, are similar rather than dissimilar. This is inevitably a matter of impression: *Staywell* at [17] – [18].
- (iv) When assessing two contesting marks, I should bear in mind that the average consumer has imperfect recollection. Therefore, the two marks should not be compared side by side and examined in detail for the sake of isolating particular points of difference. This is because the person who is confused often makes a comparison from memory removed in time and space from the marks: *Hai Tong* at [40(d)], [62(a)].
- (v) The marks are considered from the viewpoint of the average consumer – *not* an unthinking person in a hurry, but rather, a person who would exercise some care and a measure of good sense in making his purchases: *Hai Tong* at [40(c)].

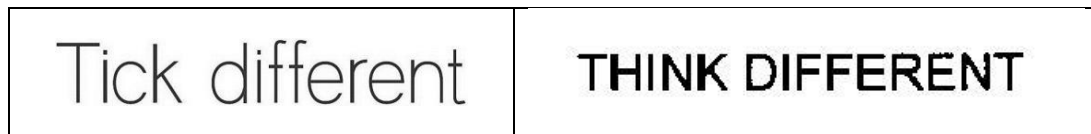
### ***Marks-Similarity: Analysis***

#### *Visual Similarity*

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

22 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.

<b>Application Mark</b>	<b>Opponent’s Mark</b>
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23 It is the Opponent’s submission that both marks have the same syllabic structure and number of words. There is significant overlap in the characters of the words in both marks, namely T, I, K, D, I, F, E, R, N and T. I also note that the beginnings and ends of each word in the marks are identical (T, K and D, T). In fact, the Opponent points out that the second word in each mark, “different”, is identical.

24 The Court of Appeal in *Caesarstone* opined at [32]:

In *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2005] 4 SLR(R) 816, Lai Kew Chai J held (at [26]) that “[i]n cases where there is a common denominator, it is important to look at the differences between the mark and the sign in order to decide whether the challenged sign has been able to distinguish itself sufficiently and substantially”. We agree with this.

25 In this connection, the main visual difference between the Application Mark and the earlier trade mark lies in the first word of each: “Tick” versus “THINK”. There is a minor visual difference in that the whole “THINK DIFFERENT” Mark is in upper case, compared to the “Tick different” Mark, where only the first letter is in upper case, and the remaining twelve letters are in lower case. The Application Mark is also shorter than the Opponent’s Mark by one character. To the average consumer, the extent of the difference in word length may not be immediately obvious (one character) but it would be clear on a casual visual perception that, in general, the “Tick different” Mark is shorter than the “THINK DIFFERENT” Mark. The marks also differ in the thickness of their font: the strokes in the Application Mark are more slender compared to the thicker block-like font of the Opponent’s Mark. However, as summarised in the principle at [20(iv)] above, not all the above differences are relevant in an assessment of visual similarity as the comparison of the marks is not made side by side, but based on the imperfect recollection of the average consumer.

26 Comparing the difference between “Tick” versus “THINK”, the Opponent highlights that the letters “H” and “N” in the latter are replaced with “c”; its point being that such a visual difference is insignificant and not easily perceivable. Conversely, the Applicant contends that the visual differences between the marks are clear and obvious, and would be noticed immediately even upon a cursory viewing.

27 In assessing mark similarity, I am to integrate the factor of “distinctiveness”: *Staywell* at [30], *Caesarstone* at [29]. The Applicant argues that the Opponent’s Mark is of low technical distinctiveness because it consists of two common words in the English language arranged in a manner in line with English grammar. Neither has the Opponent’s Mark acquired distinctiveness in Singapore by virtue of use. The Opponent’s submissions did not directly address this point under this ground; however, seeing as it argues that the “THINK DIFFERENT” Mark is well known under Section 8(4) of the Act, a strong inference can be made that it disagrees that the same mark is of *low* technical distinctiveness.

28 In a recent decision, *Adidas International Marketing BV v Lutong Enterprise Corp* [2018] SGIPOS 12, I expressed my reservations, at [31], whether acquired distinctiveness was relevant at this stage of the 3-step test *Staywell*. It has been suggested that such evidence of alleged acquired distinctiveness can be considered later, when likelihood of confusion is assessed: *Clarins Fragrance Group f.k.a. Thierry Mugler Parfums S.A.S. v BenQ Materials Corp.* [2018] SGIPOS 2 at [20] – [25]. The Court of Appeal in *Caesarstone* 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 Opponent in the instant case has not argued that its mark has acquired a higher than normal level of distinctiveness due to the use made of it (and hence ought to enjoy a higher threshold before a competing mark is found different from it), I will confine myself to assessing the inherent distinctiveness of the Opponent’s Mark and not consider acquired distinctiveness.

29 I observe that the “THINK DIFFERENT” Mark comprises two English words in plain font with no significant design feature that catches the eye. Accordingly, I am persuaded that, visually, the Opponent’s Mark is of a normal level of technical distinctiveness. It therefore enjoys (only) a normal threshold before a competing mark, such as the Application Mark, would be considered visually dissimilar to it.

30 I also consider “distinctiveness” in the sense of whether the respective marks contain distinctive and dominant components, and if so, what these may be. Apprehending the “THINK DIFFERENT” Mark as an average consumer, I do not think there is a distinctive and dominant component as such. Rather, it is the mark as a *whole*, being the combination of two words, “THINK” and “DIFFERENT”, that makes an impact. Likewise for the “Tick different” Mark, it is distinctive as a whole. This finding applies to the three-fold assessment of marks-similarity: visually, aurally and conceptually.

31 Thus, comparing both marks as wholes (with no specific distinctive and dominant components), I consider whether the differences highlighted above allow the Application Mark “*to distinguish itself sufficiently and substantially*” from the Opponent’s Mark.

32 The Applicant points out that the marks would be read from left to right. Thus, the average consumer would immediately perceive the difference between “Tick” and “THINK”. I am inclined towards this proposition. The competing marks here are plain word marks in the English language. It is well established that English words are ordinarily viewed and read from left to right. As such, the differences in the first words of both marks, “Tick” and “THINK”, being seen first, should have greater visual impact than the commonality in the second word, “different”.

33 As regards the Opponent’s argument that the difference between “Tick” and “THINK” lies only in the replacement of the letters “H” and “N” in the Opponent’s Mark, with the letter “c” in the Application Mark, I am not persuaded that the average consumer in Singapore would visually analyse the marks in this cold, clinical, bean-



counting manner. This would be contrary to the principle summarised at [20(iv)] above. Rather, he or she would see “Tick” and “THINK” as whole words that first appear in their line of vision, and that visually signal the difference between the marks. Consumers who recall the strong visual impact of the upper case used in the Opponent’s Mark as opposed to the mostly lower case letters in the Application Mark would perceive the difference more acutely, while those who do not will still likely see the marks as different overall. However the consumer regards the marks visually in his imperfect recollection, I think the Application Mark has “*distinguish(ed) itself sufficiently and substantially*” from the Opponent’s Mark based on a normal threshold.

34 Thus, I find that the Application Mark and the Opponent’s Mark are rather more dissimilar than similar visually.

#### *Aural Similarity*

35 I now consider whether the Application Mark is aurally similar to the Opponent’s Mark.

36 Again, I assess the technical distinctiveness of the Opponent’s Mark, this time aurally. The pronunciation of the “THINK DIFFERENT” Mark is likely to strike a chord with the average consumer because of the unexpected ending in adjectival form (“different”) rather than in adverbial form (“differently”) – the sound of the mark stops one syllable earlier than expected. It therefore leaves a greater than normal aural impact on the average consumer. As such, I am inclined to think that aurally, the Opponent’s Mark possesses a higher than normal level of technical distinctiveness, though not to a very large extent (because the above contra-expectation is, after all, nuanced). The mark therefore enjoys a higher than normal (but not by very much) threshold before a competing mark would be considered aurally dissimilar to it.

37 As for “distinctiveness” in the sense of whether the respective marks contain distinctive and dominant components, and if so, what these may be, I have found, above, that the “THINK DIFFERENT” Mark does not have a distinctive and dominant component as such. Rather, the Opponent’s Mark makes an impact as a *whole*, being the combination of two words, “THINK” and “DIFFERENT”. The impact of the mark would be different were any of the two words omitted. Similarly, the “Tick different” Mark is distinctive as a whole.

38 The Court of Appeal in *Caesarstone* succinctly describes the two approaches to assessing aural similarity, at [45]: “*The first is to consider the dominant component of the marks and the second is to undertake a quantitative assessment as to whether the competing marks have more syllables in common than not.*”

39 The Opponent highlights that the first word of each mark sounds almost identical because they both start with the “T” sound and end with the “K” sound. The second word of both mark is aurally identical because it is the same word, “different”. It also argues that “*Both marks are phonetically dominated by the second word ‘different’*” – presumably in application of both the approaches enunciated in *Caesarstone*. On the other hand, the Applicant contends that “*there will be stronger emphasis on the first word when each of these marks are uttered, which in turn sound very different (“tik” as opposed to “θɪŋk”)*”.

40 The natural rhythm of both marks is such that when they are articulated, the first word and syllable (“Tick” / “THINK”) corresponds to a beat, and the second and third syllables, forming the second word, “different”, make up the next beat. This is such that the first syllable (“Tick” / “THINK”) is aurally more impactful as it comes first and as a syllable, is longer, having one full beat compared to the second and third syllables (“different”) which share a beat. Arguably, the aural differences in the respective first syllables could be more significant to the average consumer than the aural commonality in the word “different”.

41 Having said that, I also recognise that “Tick” and “THINK” could sound slightly similar when pronounced by the average consumer, because of the common sounds of the “T” at the beginning and “K” at the end. Yet, the middle of the sound – “i” compared to “ij”, are clear and not likely to be slurred – renders the two words ultimately different when pronounced.

42 I also appreciate that the approaches to assessing aural similarity described above are proxies to ascertaining whether the average consumer would find the competing marks aurally more dissimilar or similar – the latter being the end, and the former, possible routes of inquiry towards the end. Any of these approaches could be more suited for certain factual scenarios; see, for example, the reasoning of the IP Adjudicator behind his approach to aural similarity in *Guccio Gucci S.p.A. v Guccitech Industries (Private Ltd)* [2018] SGIPOS 1 at [27] – [28].

43 I do not think the assessment here is as simplistic as the quantitative approach makes it appear. Realism should be incorporated into the assessment of how the average consumer would aurally perceive the marks. For instance, weight should be accorded to the rhythm (and stress) of both marks. Neither does the approach to consider the dominant component present itself an uncontrived fit here where I have found that both marks do not have a distinctive and dominant component as such. Thus, I have endeavoured to assess the degree of aural similarity of the marks based on first principles from the perspective of the average consumer, with my considerations outlined in [40] – [41] above.

44 Overall, I am persuaded that the “Tick different” Mark and the “THINK DIFFERENT” Mark are more aurally dissimilar than they are similar, even given that the Opponent’s Mark possesses a higher than normal level of technical distinctiveness. However, this dissimilarity is to a lesser extent than the visual dissimilarity (and conceptual dissimilarity, see below).

#### *Conceptual Similarity*

45 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]).

46 The Opponent pitches its argument here at a higher level of abstraction than the Applicant’s. It would have me find that “*both the Applicant’s Mark and Apple’s Mark convey the same idea and concept to customers – that of being different from the crowd/norm and being out-of-the-box*”. It also relies on a profile feature in Advertising

Age, a periodical, on cultural anthropologist, Robert Deutsch, who advised Apple on the “THINK DIFFERENT” Mark: La Perle-1 at [57] – [58] and Tab 15 of Exhibit TLP-1. According to the feature, the grammatical error of pairing a verb with an adjective (instead of an adverb) is intentional and significant. Deutsch “*argued that humans process ‘Think differently’ in three beats, which symbolize a beginning, middle and end, while the two-beat ‘Think different’ leaves consumers ‘open ended’ and with an open mind.*”

47 On the other hand, the Applicant delves into the granular, focusing on the meaning of the word “Tick”, which is clearly different conceptually from “THINK”. It also downplays the commonality of the word “different” in both marks, and submits that “*It would be reasonable to expect the concept of distinguishing oneself from one’s competitors to be common in the marketplace and hence no distinctive conceptual similarity can arise from the word ‘DIFFERENT’*”. The derivation of the “Tick different” Mark was noted at [16] above: it “*was coined by the Applicant to reflect the Applicant’s long history and close association with timepieces*”.

48 In assessing the technical distinctiveness of the Opponent’s Mark, from a conceptual perspective, I accept the Opponent’s point above that the grammatical error in “THINK DIFFERENT” is significant. At the same time, I think there is an alternative way for the average consumer to perceive the Opponent’s Mark conceptually. Instead of interpreting the word “different” as a grammatical error, it is possible to apprehend it as a quasi-noun (which should have been accompanied by punctuation) in the vein of “Think ‘big’” and “Think ‘beautiful’”. Either way, I assess that the Opponent’s Mark is conceptually distinctive above the normal level, but, as with aural distinctiveness, not to a very large extent because the conceptual twist is nuanced. The mark therefore enjoys a higher than normal (but not by very much) threshold before a competing mark would be considered conceptually dissimilar to it. I have also earlier found that the competing marks are both distinctive as *wholes*.

49 It is clear that the conceptual meanings of “Tick” and “THINK” are very different from each other. Would this allow the Application Mark “*to distinguish itself sufficiently and substantially*” from the Opponent’s Mark (*Caesarstone* at [32]) or would the conceptual commonality of (i) the word “different” and of (ii) the pairing of a verb with an adjective (or a quasi-noun, in the alternative interpretation) override the difference between “Tick” and “THINK”?

50 Again, I put myself in the shoes of the average consumer and consider what the natural conceptual apprehension of the marks would be. I am inclined to think that the concept of each mark is anchored by the verb. What follows is still an integral part of the concept, but is always perceived in relation to the preceding verb – “different” derives its context from the preceding verb (“Tick” or “THINK”). Thus, while both marks are distinctive as wholes with no separable distinctive and dominant components, the different conceptual meanings of “Tick” and “THINK” can nevertheless suffice to distinguish the competing marks. In fact, the conceptual distance between “Tick” and “THINK” is such that even though the Opponent’s Mark enjoys a higher than normal (but not by very much) threshold before a competing mark would be considered conceptually dissimilar to it, the Application Mark does cross this threshold.

51 Although not argued by the Opponent, I had also briefly considered that “Tick” and “THINK” may share a tenuous idiomatic connection: when someone is “thinking” about something, it could be said that his mind is “ticking”. However, in the absence of argument, I doubt this interpretation has sufficiently significant traction with the average consumer.

52 On the balance, I find that the marks are conceptually more dissimilar than similar, and to a higher degree than the visual and aural assessment.

*Conclusion on Marks-Similarity*

53 Overall, I have found that the Application Mark and the Opponent’s Mark are:

- (i) visually more dissimilar than similar;
- (ii) aurally more dissimilar than similar, but to a lesser extent than (i) and (iii); and
- (iii) conceptually more dissimilar than similar, to a greater extent than (i) and (ii).

54 As recognised at [20(iii)] above, trade-offs can occur between the three aspects of similarity in the marks-similarity inquiry. The three aspects of similarity are but signposts meant to guide the inquiry and I must ultimately come to a conclusion whether the marks, when observed in their totality, are similar rather than dissimilar. This is inevitably a matter of impression, as the Court of Appeal in *Staywell* highlights (at [17] – [18]).

55 The conceptual dissimilarity of the marks is the starkest, and bears heavily on the impression of the average consumer. With this, accompanied by visual and aural dissimilarities to a lesser extent, I am persuaded that the average consumer would conclude that the marks are, overall, more dissimilar than similar.

56 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 ground of opposition under Section 8(2)(b) in Swatch’s favour.

57 Nevertheless, I would make a few observations in passing on the second and third steps of the three-step test under Section 8(2)(b). These are *obiter* in nature.

*Identical or Similar Goods*

58 The second step of the three-step test in *Staywell* requires identity or similarity of goods to be established.

59 As set out in [14] above, the Opponent’s Specification is:

Computers; computer hardware; computer peripherals; computer software; network servers; parts and fittings for all the aforesaid goods; all included in Class 9.

60 There is no issue that there is overlap between the Opponent’s Specification and the Applicant’s Class 9 Specification claimed under the Class 9 Application. Examples of

goods in the latter that are clearly identical or similar to goods in the Opponent's Specification include "computers, portable computers, handheld computers, mobile computers, personal computers, wrist computers, electronic tablets and ... computer devices" and "handheld electronic apparatus for wireless receiving, storing and transmitting of data or messages".

61 Swatch does point out that its Class 9 Specification is much wider in nature and scope than the specification of the Opponent's Mark. It therefore argues that the goods "*are more dissimilar than similar to the Opponent's Goods*". However, this is not the test for goods-similarity. The inquiry is concerned with whether there are items in the respective specifications that are identical or similar to each other (with a binary outcome – either yes or no), and not the *extent* to which the specifications as wholes are identical or similar to each other.

62 Further, beyond Class 9, Apple argues that there is similarity between the goods claimed under the Opponent's Mark and those in the Applicant's Class 14 Specification claimed under the Class 14 Application.

63 In support of its argument, Apple cites the example of its Apple Watch – a wearable wrist computer which can run computer applications, operate a digital wallet, connect to wifi, reply emails and so on. This would place the Apple Watch within Apple's specification in Class 9 above. At the same time, the Apple Watch also tells the time as a watch, and this is identical or similar to goods such as "watches, wristwatches" in the Applicant's Class 14 Specification. Hence, the Opponent's argument goes, there is similarity between the Applicant's Class 14 Specification and the goods in respect of which the Opponent's Mark is registered insofar as timepieces, in particular watches, are concerned.

64 Swatch, on the other hand, denies that the Opponent's Specification includes smartwatches. These, in any case, are submitted by Swatch to be very different in nature and functionalities when compared to classic watches in Class 14. It would also be an "*unreasonable and unfair expansion*" of the Opponent's Specification and the Opponent's monopoly rights in relation thereto.

65 As underscored above, these observations relating to goods-similarity are *obiter* in nature and will not pre-judge future situations where specifications similar to those in the present case are compared.

66 I would first note that since the 10<sup>th</sup> Edition of the Nice Classification<sup>1</sup> (2016 version) came into force in Singapore on 1 January 2016, "smartwatches" have been recognised in Class 9 and are no longer acceptable in Class 14. Before this, as a matter of practice, the Registry of Trade Marks accepted "smartwatches" in both Class 9 and Class 14.

67 The relevant date in this opposition is 2 November 2015, being the application date of the Applicant's Class 9 Application and Class 14 Application. Hence, the 10<sup>th</sup> Edition

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<sup>1</sup> The Nice Classification (to which Singapore is a contracting party) is an international system used to classify goods and services for the purposes of the registration of trade marks. It is administered by the World Intellectual Property Organization, a specialised United Nations agency. The Nice Classification is regularly reviewed and revised.

of the Nice Classification (2016 version) would not apply. In any case, the abovementioned development in classification practice does not provide a straightforward answer here. This is because the competing specifications of goods are already in Class 9 (the Opponent's Mark) and Class 14 (the Application Mark). The real question is whether "Computers; computer hardware" in Class 9 and "watches, wristwatches" in Class 14 are similar goods. On that question, the oft-cited *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281, 286 offers non-exhaustive factors for consideration.

68 Further, there may be an issue whether, when the application to register the Opponent's Mark was filed almost twenty years back in 1999, it was reasonably envisaged that "Computers; computer hardware" would encompass computers in the form and nature of "watches, wristwatches" in another class of goods. This is such that I would not dismiss offhand the Applicant's submission that it would be an "unreasonable and unfair expansion" of the Opponent's Specification and the Opponent's monopoly rights in relation thereto, if I were to find "Computers; computer hardware" and "watches, wristwatches" similar. However, in the absence of more in-depth submissions from parties, I make no finding on the point.

69 I am also aware of the UK Intellectual Property Office's decision in *Swatch AG (Swatch SA) (Swatch Ltd) v Apple Inc.* O-307-16 which found, at [55], "a high degree of similarity between watches in class 14 and smart watches in class 9, and therefore between 'horological and chronometric apparatus and instruments' and 'computers; computer hardware; wireless communication devices'". That decision in 2016 concerned the marks IWATCH (in Class 9) and iswatch (in Class 14), and the relevant marks were filed before the 10<sup>th</sup> Edition of the Nice Classification (2016 version) came into force. The main reasons for the finding of a high degree of goods-similarity were due to overlaps in purpose, nature and method of use.

70 On appeal, however, the UK High Court disagreed, explaining, at [21] of *Apple Inc v Swatch AG* [2017] EWHC 713 (Ch): "an error has arisen because the hearing officer took into account an incidental attribute of a device (that it can be used to tell the time) which for other reasons fall within the specification of goods for which the Applicant seeks registration, thus condemning all such devices ('computers; computer hardware; wireless communication devices' claimed in Class 9) even though they do not have that incidental characteristic." (underlined words in brackets mine, for clarity) The conclusion (at [24]) was that "for those goods where the Hearing Officer found a high or medium degree of similarity, there is only a low degree of similarity". I note that both fora found some similarity of goods, but differed on the degree of that similarity; and that the UK dispute was adjudicated using the global appreciation test (which our Court of Appeal rejected in *Staywell* at [15]) where the questions of marks- and goods-similarity were "elided with other factors going towards the ultimate question of whether there is a likelihood of confusion".

71 This area is indeed a fertile field for ploughing and, perhaps, sectional harvest. However, this is not an issue that needs a decision today as marks-similarity was not established under Section 8(2)(b). I therefore leave it to parties in future to present their best arguments to support the Court or this Tribunal in adjudication.

### ***Likelihood of Confusion***

72 In passing, my thought on this third step of the three-step test in *Staywell* is that there is, in any case, no reasonable likelihood of confusion. My comments, applying the permissible extraneous factors at [94] and [96] of *Staywell*, are as follows:

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

(i) Degree of similarity of the marks

As found above, the marks are more dissimilar than similar when compared as wholes. However, putatively for the consideration of the “likelihood of confusion” element, I proceed on the premise that the marks are only *marginally* more similar than dissimilar. As such, the degree of similarity between the marks is low. “Clearly, the greater the similarity between the marks, the greater the likelihood of confusion” ([96] of *Staywell*) and conversely, the lower the degree of similarity between the marks, the lower the likelihood of confusion. This factor lies in the Applicant’s favour.

(ii) Reputation of the marks

For reasons elaborated under Section 8(4) below, in my observations on Apple’s claim that the “THINK DIFFERENT” Mark is well known in Singapore, I find it difficult to accept on the evidence before me that the Opponent’s Mark has a reputation in Singapore. As for the “Tick different” Mark, there is no evidence of its use or reputation in Singapore. This factor is neutral.

(iii) Impression of the marks and possibility of imperfect recollection

Apple argues that with the launch of its Apple Watch, the public will be confused if Swatch were to use “Tick different” in an advertising campaign in relation to watches (on the premise that “THINK DIFFERENT” and “Tick different” are similar). This is allegedly because consumers may believe that Apple and Swatch share a collaborative commercial relationship, or that Swatch watches offered under the “Tick different” Mark are sourced from Apple or the same economically-linked sources as Apple.

I find the above rather speculative. The impressions left by the marks are distinct and independent of each other, even if it is assumed they are marginally similar. Swatch itself is an established watchmaker and it is not likely for the public to expect the Swatch Group to source for watches externally. On the other hand, as indicated at (ii) above, there is some difficulty in finding that the “THINK DIFFERENT” Mark has a reputation in Singapore, whether in relation to any computer-related goods, or to the Apple Watch. Thus, it is even more unlikely that the public perception would connect Swatch’s goods under “Tick different” with Apple in a collaborative relationship (allegedly due to similarity with “THINK DIFFERENT”). This factor is at best neutral, though it could also arguably be in the Applicant’s favour because of its own established status as watchmaker (mitigating against likelihood of confusion).

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

- (iv) Normal way in or circumstances under which consumers would purchase the relevant goods

The goods in the Opponent's Specification are essentially computers and computer-related goods such as software and network servers.

The Applicant's goods under the Class 9 Specification and the Class 14 Specification are broad in scope. The Class 9 Specification (set out in full at [5] above) includes apparatus for various functions e.g. recording, transmission and reproduction of sound or images; wireless receiving, storing and transmitting of data or messages. It also includes computer-related goods, such as personal computers, software, handheld electronic apparatus for monitoring and organizing personal information, batteries for computers; and optical apparatus and instruments.

The Applicant's Class 14 Specification (set out in full at [5] above) includes precious metals and their alloys, jewelry, precious stones, timepieces and chronometric instruments.

Despite the broad scope of the relevant specifications above, the normal circumstances under which consumers would purchase the goods in those specifications can be readily discerned. Except, perhaps, for jewelry, precious stones in the Applicant's Class 14 Specification, the other types of goods will require the purchaser to have an idea of his specifications – or, at least, technical needs – before he embarks on selection and purchase of the product he wants. The purchaser may also be aided by a salesperson at the point of selection and purchase, because of the technical nature of the goods. This factor is in the Applicant's favour.

- (v) Whether the products are expensive or inexpensive items

Having regard to the range of goods (described at (iv) above), I generally infer that the products tend to be more expensive than inexpensive (though no evidence from either party has been tendered on this point), taking into account goods such as computers, timepieces, jewelry and precious stones. I recognise that the concept of "expensive" can be relative, and even among generally "expensive" computer-related goods, there can be goods sold at the lower end of the price spectrum (e.g. computer cables would be much cheaper than computer laptops).

However, the main point of this factor is to direct the inquiry to how the purchasing public would behave when exposed to both marks and the goods on which they are to be used. If the goods are more expensive, consumers will be more likely to exercise greater care and attention in their selection and purchase (and less likely to be confused). This factor is therefore in the Applicant's favour.

- (vi) Nature of the goods and whether they would tend to command a greater or lesser degree of fastidiousness and attention on the part of prospective purchasers



The nature of the goods, such as computers, timepieces, jewelry and precious stones, are such that they would tend to command a relatively high degree of fastidiousness and attention by the prospective purchasers. These are either technical goods or personal, decorative goods – or both.

As also considered under (iv) above, the technical goods would naturally require prospective purchasers to be circumspect in what features they need for their purposes, before making their selection and purchase. Personal, decorative goods such as watches, jewelry and precious stones would also generally be purchased after careful thought and selection, and not usually bought in a hurry with little regard for the eventual selection. This factor is in the Applicant's favour.

- (vii) Likely characteristics of the relevant consumers and whether they would or would not tend to apply care or have specialist knowledge in making the purchase

Consumers of goods such as computers, timepieces, jewelry and precious stones may or may not have specialist knowledge. If they do, they will exercise that specialist knowledge in the selection and purchase of the goods. If they do not, they are likely to be assisted by salespersons who have some specialist knowledge. This context mitigates against a likelihood of confusion. The factor is therefore in the Applicant's favour.

- (viii) Whether the transactions are routine or infrequent

Having regard to the range of goods (described at (iv) above), I tend to think that the transactions are more infrequent than routine, as compared to, for instance, groceries and fuel. In general, where transactions are infrequent, consumers typically pay more attention and care to the purchase. This factor is in the Applicant's favour.

73 In view of the above, even if I had found that there was marks-similarity, I would not have found a reasonable likelihood of confusion.

***Conclusion on Section 8(2)(b)***

74 As there is no marks-similarity, an essential element of Section 8(2)(b) has not been made out. If I am wrong on this, I have also expressed my reservations in relation to goods-similarity between the Opponent's Specification and the Applicant's Class 14 Specification; and also my view that there is, in any case, no reasonable likelihood of confusion.

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

**Ground of Opposition under Section 8(4)**

76 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 1<sup>st</sup> 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***

77 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.

78 I observe that the language of Section 8(4) on marks-similarity is worded differently from Section 8(2)(b). However, the High Court in ***Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd*** [2015] 5 SLR 618 made it clear that the similarity analysis nevertheless is essentially the same, opining, 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 the mark-for-mark comparison is entitled (where relevant) to take into account the dominant features of the trade mark*".

79 It has been found, 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).

### ***Well Known Earlier Trade Mark***

80 Since the Opponent has not satisfied the essential element of marks-similarity here, there is no necessity for me to consider the remaining elements. However, in passing, I briefly comment on the Opponent's evidence in support of its claim that the "THINK DIFFERENT" Mark is a well known earlier trade mark under Section 8(4).

81 The relevant date in this opposition is 2 November 2015. The burden is on Apple to show that the “THINK DIFFERENT” Mark is well known in Singapore on the relevant date.

82 While Apple’s evidence, especially in La Perle-1, is extensive on a global basis, it stops short of establishing a nexus to Singapore sufficient to support Apple’s claim that its “THINK DIFFERENT” Mark is well known in Singapore. The closest, most direct evidence is the claim, at [49] of La Perle-1, that “*Since 2009, Apple have sold over 120,000 iMac computers featuring the “THINK DIFFERENT” Mark in Singapore, generating sales in excess of US\$170 million. The box packaging for iMac computers sold in Singapore has the “THINK DIFFERENT” Mark printed on it.*” The box packaging is set out below in two parts. Figure 1 shows the box packaging label as a whole, with the barcode at the bottom right corner for scanning. Figure 2 shows part of the same box packaging label magnified where the red arrow in Figure 1 points, which is where the “THINK DIFFERENT” Mark is placed.

Figure 1

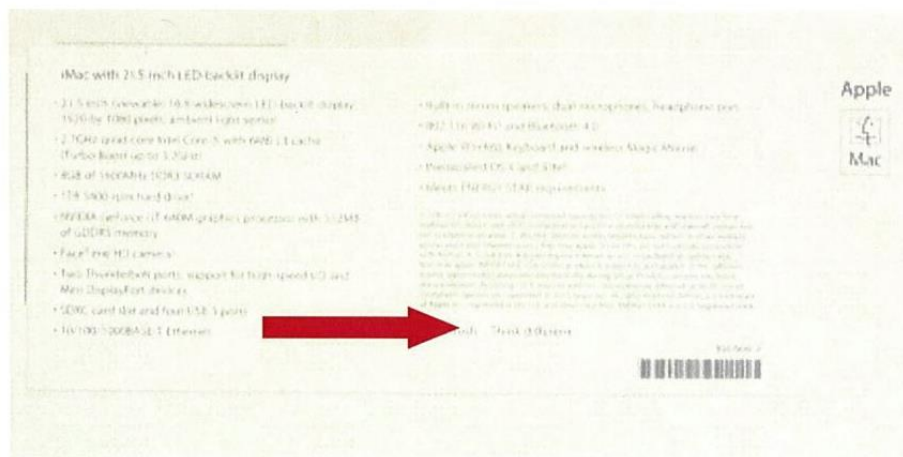
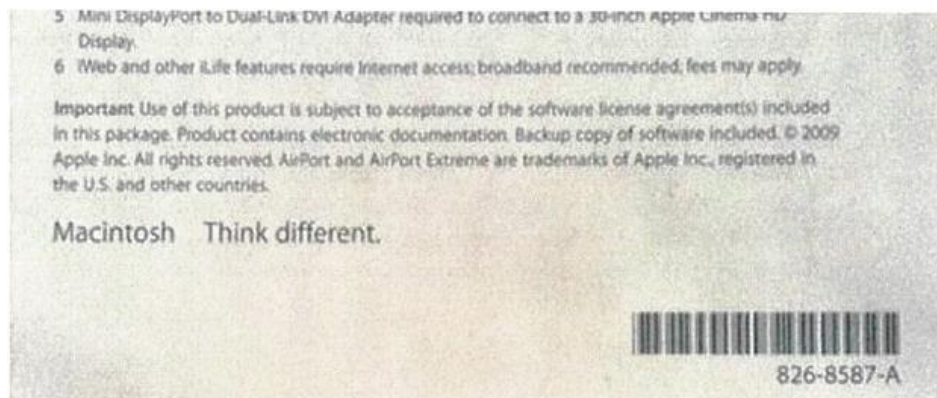


Figure 2

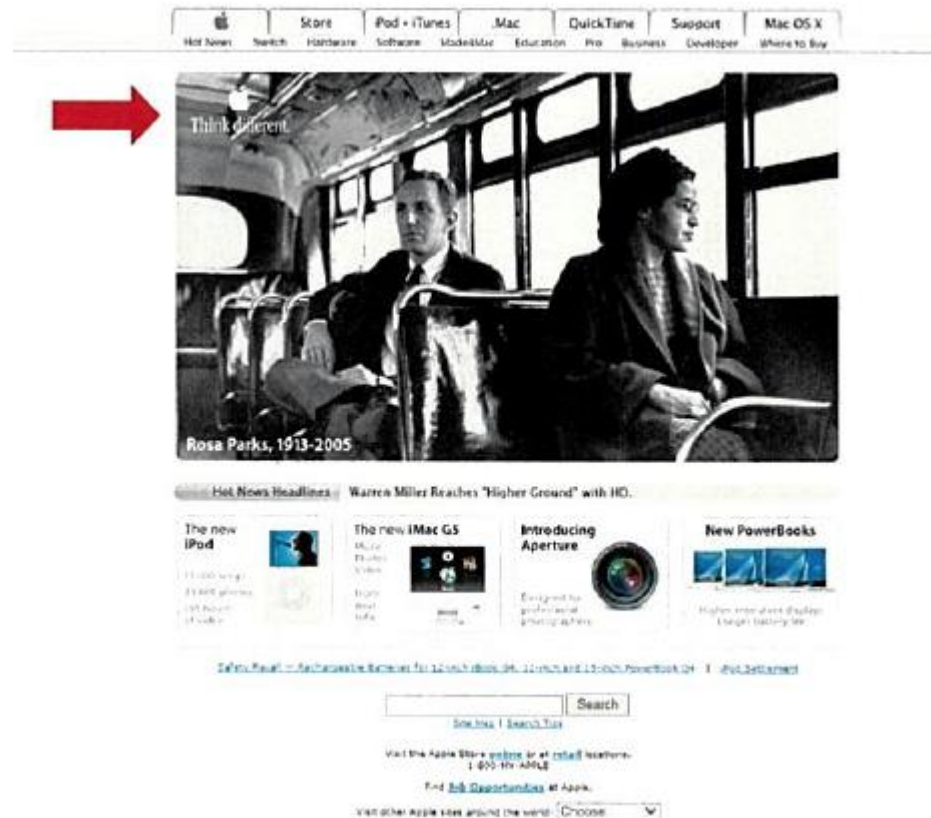


83 At the hearing, I asked Apple’s counsel to specify which parts of the evidence on the use of the “THINK DIFFERENT” Mark pertain to Singapore. She identified the website screenshots at [30] of La Perle-1 and submitted that these webpages on Apple’s

homepage at [www.apple.com](http://www.apple.com) were accessible from Singapore. [30] of La Perle-1 declares that *“On at least three separate occasions, the Apple homepage featured images of the following notable figures, alongside the words ‘Think Different’”*:

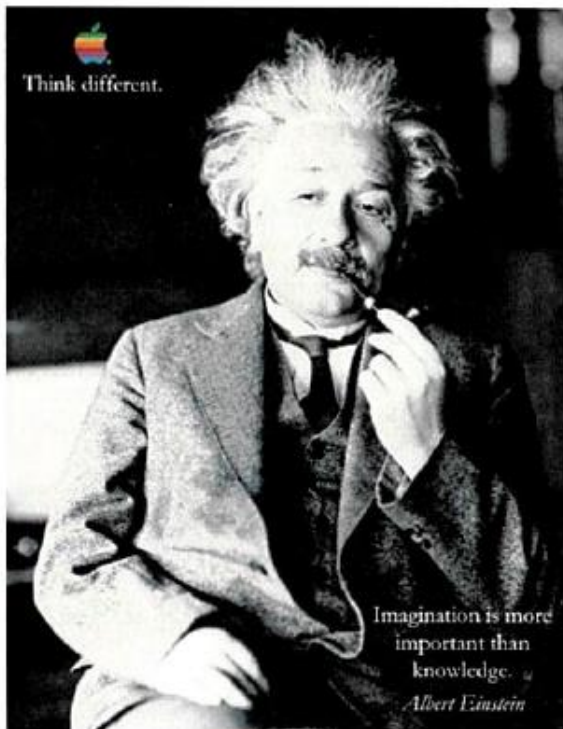
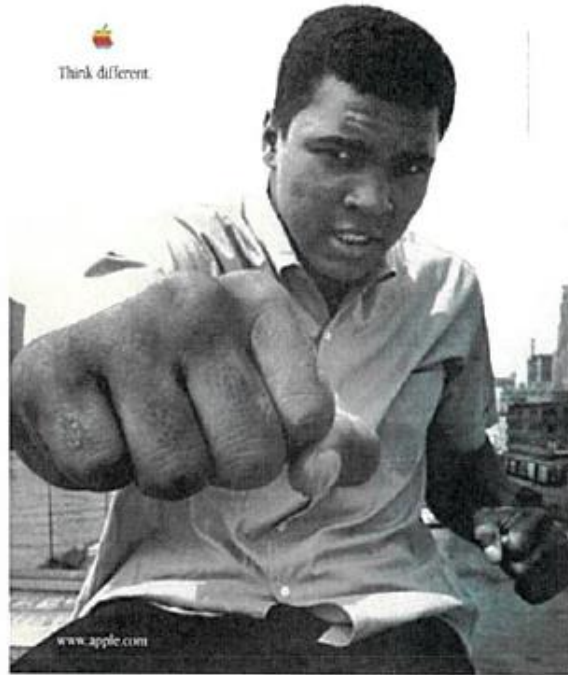
- a. 2002: when Jimmy Carter won the Nobel Peace Prize;
- b. 2003: when Gregory Hines died; and
- c. 2005: when Rosa Parks died.”

The screenshot for c. above is set out here by way of illustration:




84 Apple’s counsel also highlighted that Apple’s goods have been sold in Singapore since 2009 with the “THINK DIFFERENT” Mark (as I have described above at [82]), and with the brochures and posters as set out at [25] of La Perle-1. However, when I enquired further, she could not point me to evidence that these posters were used in Singapore. Examples of these posters are set out below.

[This space is intentionally left blank]



85 All the above examples of use serve to demonstrate the nature and form of the “THINK DIFFERENT” Mark’s use (generally on a global basis), and underscore my earlier observation that while extensive (and at times, evoking admiration), this use falls short of showing whether, how and to what extent it impacts the Singapore public such that the “THINK DIFFERENT” Mark is well known to it. Part of the difficulty lies in discerning which aspect of the global use extended to Singapore specifically; another lies in the nigh impossible task (based on limited evidence) of apportioning global or regional figures (e.g. global advertising figures at [42] of La Perle-1, sales figures of Apple products and services in Asia Pacific at [48] of La Perle-1) to the Opponent’s

Mark in question; and yet another difficulty stems from the mixed use of various indicia of origin emanating from Apple (e.g. “Apple”, “Macintosh”, “iMac”, ) with the “THINK DIFFERENT” Mark. I appreciate that the Opponent’s Mark could enjoy a high degree of recognition in its home country. However, the Opponent’s evidence and submissions have not led me to see how this translates to the public *in Singapore*.

86 Similar sentiments have been expressed by the Court of Appeal in *Caesarstone* at [113], that “*the ultimate inquiry is whether a trade mark is well known in Singapore*” and that the evidence should show how it has “*led to its mark being well known in Singapore*”.

#### ***Conclusion on Section 8(4)***

87 Since the Opponent has not satisfied the essential element of marks-similarity here, and there are doubts whether the “THINK DIFFERENT” Mark is well known in Singapore, the ground of opposition under all three limbs of Section 8(4) fails.

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

88 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

#### ***Classical Trinity***

89 To succeed on the ground of opposition under Section 8(7)(a), an 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] 3 SLR 517 and *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86).

90 Because the Application Mark has been found more dissimilar than similar to the Opponent’s Mark, misrepresentation cannot be established here. (Even if the marks were similar, my observations above on “Likelihood of Confusion” under Section 8(2)(b) similarly apply here and I would not have been persuaded that there would be misrepresentation.) Consequently, if there is no misrepresentation, the requirement of damage in a claim of passing off cannot be made out, whether or not the element of goodwill has been demonstrated.

#### ***Conclusion on Section 8(7)(a)***

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

#### **Ground of Opposition under Section 7(6)**

92 Section 7(6) of the Act reads:

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

93 The Opponent's pleading under this ground of opposition bears replicating in full below:

42 Further and/or in the alternative, the Application was made in bad faith.

43 As mentioned above, long before the filing date of the Application Mark, the THINK DIFFERENT Marks (including the Registered THINK DIFFERENT Mark) have been extensively used in Singapore and elsewhere such that they are and have become reputable, well-known and distinctive of Apple and its goods and services in Singapore and elsewhere. In these circumstances,

- (1) it is unlikely that the Applicant was not aware of the use, reputation, fame and/or distinctiveness of the THINK DIFFERENT Marks at the filing date; and
- (2) it is likely that the Application was filed with the *intention to ride upon Apple's substantial goodwill and reputation* in the THINK DIFFERENT Marks and *to benefit from a favourable association* with Apple and/or the THINK DIFFERENT Marks.

44 Thus, the Applicant *cannot validly claim to be the bona fide proprietor* of the Application Mark.

(italics mine)

### ***Preliminary Points***

94 In theory and practice, there are several possible heads of bad faith under which Section 7(6) can be established. Examples 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.

95 I am mindful that the Opponent's pleaded head of bad faith under Section 7(6) is very specific, as it ought to be. The heart of the claim resides in [44] of the grounds of opposition set out above, that "*the Applicant cannot validly claim to be the bona fide proprietor of the Application Mark*".

96 Other mental elements linked to this allegation are found in the preceding paragraph, at [43(2)] of the grounds of opposition: "the Application was filed with the *intention to ride upon Apple's substantial goodwill and reputation* in the THINK DIFFERENT Marks and *to benefit from a favourable association* with Apple and/or the THINK DIFFERENT Marks" (italics mine).

97 Hence, although the Opponent contends, in submissions based on its evidence (see [69] of La Perle-1), that (i) the Applicant is a "troll" that tries to "*agitate Apple with trademarks instead of competition*", and (ii) that the Applications were an act of

retaliation “*by registering the Application Marks to prevent any potential use of any variation(s) of the “THINK DIFFERENT” mark to complement any marketing campaign for the Apple Watch*”, it is not appropriate to consider these lines of arguments which fall outside the scope of what the Opponent has pleaded above.

98 The Opponent’s submissions also made a fresh claim (not pleaded nor declared in evidence) that the Applicant had not demonstrated any *bona fide* use or intended use of the Application Mark. The Opponent linked this line of argument to its hypothesis that Swatch had a *modus operandi* of registering several of Apple’s famous marks and slogans even though it allegedly had no rights nor any intention to use these marks. In connection with this, the Opponent used the phrase “trade mark squatting” in its submissions. However, again, the allegation of no use nor intention to use was not pleaded at all. I also echo the words of my counterpart at the UK Intellectual Property Office in his decision *Apple Inc. v Swatch AG (Swatch SA) (Swatch Ltd)* O-531-17 at [57] that “*what does strike me is that having no intention to use ... is diametrically opposed to the pleaded allegation which suggests that some form of use will be made, otherwise there would be no ... benefit from reputation.*” (That UK decision pertained to the two marks “SWATCH ONE MORE THING” and “ONE MORE THING”).

99 During the hearing, after the Opponent’s oral submissions on the ground of bad faith, I made clear that I would confine my determination to the particulars of bad faith pleaded in the grounds of opposition and not consider the other allegations in the two preceding paragraphs. The Opponent, through its agents, acknowledged this and the hearing continued without incident.

***Whether the Applications were filed with the intention to ride upon Apple’s goodwill and reputation in the “THINK DIFFERENT” Mark***

100 I now direct my mind to the pleaded case, which is whether the Applications were filed with the intention to ride upon Apple’s goodwill and reputation in the “THINK DIFFERENT” Mark and to benefit from a favourable association with Apple and/or the “THINK DIFFERENT” Mark, such that the Applicant cannot validly claim to be the *bona fide* proprietor of the Application Mark.

101 I have found, under the grounds above, that there is no marks-similarity, and consequently no likelihood of confusion nor misrepresentation. Hence, I struggle to see how there is any benefit to be had from riding on Apple’s goodwill and reputation and from any favourable association with Apple or the “THINK DIFFERENT” Mark.

102 Approaching it from the other end of Apple’s hypothesis, from its conclusion that Swatch is not the *bona fide* proprietor of the Application Mark (the implied premise being that Swatch had no right to the “Tick different” Mark), I had also found that the “Tick different” Mark and the “THINK DIFFERENT” Mark were more dissimilar than similar. That Apple claims rights to the latter is not inconsistent with Swatch laying legitimate claim to the former. Accordingly, Apple’s hypothesis against Swatch cannot stand.

***Conclusion on Section 7(6)***

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



**Overall Conclusion**

104 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. Both Applications will proceed to registration. The Applicant is also entitled to costs to be taxed, if not agreed.

Date of Issue: 14 August 2018