

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

Trade Mark No. 40201507206W-01
Hearing Date: 6 November 2017

**IN THE MATTER OF A TRADE MARK APPLICATION BY
BENQ MATERIALS CORP.**

AND

**OPPOSITION THERETO BY
CLARINS FRAGRANCE GROUP F.K.A. THIERRY MUGLER
PARFUMS S.A.S.**

Hearing Officer: Ong Sheng Li, Gabriel
Assistant Registrar of Trade Marks

Representation:

Mr Samuel Wee and Mr Ryan Huang (Yusarn Audrey) for the Applicant
Mr Chua Shang Li (Donaldson & Burkinshaw LLP) for the Opponent

GROUND OF DECISION

Introduction

1 Humans have always been fascinated by things beyond their natural, everyday lives. It is no wonder, then, that while few would claim to have ever encountered an “angel” or a “devil”, words such as these remain in relatively common use in the English language.

2 It is against this backdrop that battle is joined: on one side, a trader wielding the registered trade mark “ANGEL” for perfumes and other goods in Class 3. On the other, a trader seeking to enter “*derma* *Angel*” onto the trade marks register in Class 3. The thrust of the former’s case is that the latter has taken the whole of its mark, “ANGEL”, and incorporated it into its own. The latter’s parry and counter is that one cannot simply disregard the first word “derma” as well as

the “” element in its trade mark. It presses forward its argument: when the marks are compared as wholes, they are dissimilar.

3 As some say, the devil (or here: angel) is in the details. I am mindful of the Court of Appeal’s reminder that although the assessment for marks similarity is a matter of impression (meaning that there is an element of subjectivity involved), the final analysis is one of legal correctness and entitlement. Put another way, a decision concerning marks similarity is not simply one that is up to the Registrar’s discretion. The task is to reach the correct result, having regard to the detailed guidance laid down by case law. (See *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] SGCA 30 (“*Caesarstone*”) at [17] – [18].)

4 And so it is to the details that I now turn.

Background

5 Clarins Fragrance Group f.k.a. Thierry Mugler Parfums S.A.S (“the Opponent”) is in the fragrance business. As its former corporate name suggests, the Opponent was founded by the designer, Thierry Mugler. It is based in Paris, France and has offices in various countries around the world, including Singapore.

6 Among the Opponent’s fragrances is a line, or range, of perfumes that bear the sign “ANGEL”. These perfumes have enjoyed a degree of commercial success, especially abroad, but I need not go into the details for now. There is some dispute concerning the Opponent’s evidence (and its effect) relating to the way the “ANGEL” sign was put to actual use, which I will come to later. The more important point is that the Opponent owns the trade mark “ANGEL” (TM No. T9901038E) (the “Opponent’s Mark”), registered in Class 3 in Singapore for the following goods:

Perfumes, eau de parfum, eau de toilette, colognes; products for personal hygiene and deodorants; toilet preparations including bath products, skin creams and skin lotions, perfumed talc, perfumed soaps; all included in Class 03.

7 BenQ Materials Corp. (“the Applicant”) is a company based in Taiwan and listed on the Taiwan Stock Exchange. It is a well-established company which is involved in various fields of business, including the manufacture and sale of healthcare and personal care products such as facial care products and contact lenses. In late 2014, the Applicant engaged a third party brand strategist to assist it in developing a brand name and strategy for its new line of skin care products which were eventually launched, advertised, and sold under the sign “”.

8 On 5 May 2015 (the relevant date in these proceedings), the Applicant applied in Singapore to register “” (TM No. 40201507206W-01) in Class 3 (the “Application Mark”), for the following goods:

Cosmetics; facial lotions; beauty masks; facial abrasive preparations; facial emulsions; facial and skin care creams; facial and skin care oil; lipsticks; lip gloss; lip creams; non-medicated massage gel; hand creams; hand emulsions; anti-wrinkle creams; facial and skin care cosmetics; skin soaps; non-medicated bath salts; facial and skin cleansing

preparations; personal cleansing preparations; body milks; body creams; skin creams; night creams; cold creams; skin cleansing milks; foundation makeup; sun tan lotions; make-up removers; medicated cosmetic preparations; facial cleansing soaps; facial cleansing milks; bath gel.

9 The Opponent subsequently filed to oppose the Application Mark.

Grounds of opposition

10 Initially, the Opponent relied on six grounds of opposition under the Trade Marks Act (Cap. 332, Rev Ed 2005) (“TMA”). They were: (a) Section 8(2)(b); (b) Section 8(4)(b)(i); (c) Section 8(4)(b)(ii); (d) Section 8(7)(a); (e) Section 7(6); and (f) Section 8(6) of the TMA. In the course of the proceedings, grounds (e) and (f) were dropped. Only the first four remain.

Evidence filed

11 The following statutory declarations (“SD(s)”) were filed in evidence:

- a. First SD of Isabelle Madec, General Counsel of the Opponent, dated 18 July 2016 (“Madec’s SD”);
- b. SD of Tsou Wei Yin, Senior Manager of the Applicant’s Brand Management Department, dated 21 December 2016; and
- c. Second SD of Isabelle Madec, dated 4 August 2017 (“Madec’s Reply SD”).

12 Neither party applied for cross-examination. Thus, the SDs before me form the totality of the evidence in this dispute.

Opposition under Section 8(2)(b) TMA

13 Section 8(2)(b) provides that:

“8.
(2) A trade mark shall not be registered if because —
(a) ...
(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.”

14 Here, the “*earlier trade mark*” is the Opponent’s Mark: “ANGEL”.

The step by step approach

15 In *Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide* [2014] 1 SLR 911 (“*Staywell*”), the Court of Appeal held that the provision requires a 3 step test: First, are the competing marks similar? Second, are the goods (or services) identical or similar? Third, is there a likelihood of confusion arising from (or to use the words of the section: *because of*) the foregoing? All three steps must be established for the opposition under this ground to succeed. If any one step cannot be established, the opposition under this ground will fail.

Whether the marks are similar?

Guiding principles

16 Under this first step, I must decide whether the competing marks “ANGEL” and “*derma Angel*” are similar. The comparison is mark-for-mark, without consideration of any external matter (see *Staywell* at [20]).

17 It is well established that three aspects of similarity are to be considered: the visual, aural, and conceptual. A finding of similarity does not mean that all three aspects have to be made out. Each aspect is a signpost and the ultimate question that I have to decide is whether the marks, when observed in their totality, are similar rather than dissimilar. (See *Staywell* at [17] – [18]; *Sarika Connoisseur Café Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 (“*Sarika*”) at [16].)

18 The viewpoint I must adopt is that of the average consumer who would exercise some care and a measure of good sense in making his or her purchases, not that of an unthinking person in a hurry. The average consumer has imperfect recollection and makes comparison from memory removed in time and space from the marks. For this reason, the competing marks cannot be compared or assessed side by side and examined in detail for the sake of isolating particular points of difference. Instead, what must be considered is the general impression that will likely be left by the essential or dominant features of the marks on the average consumer, since it is those features that tend to stand out in the consumer’s imperfect recollection. (See *Caesarstone* at [27]; *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 (“*Hai Tong*”) at [40(c)-(d)] and [62(a)]; and *Staywell* at [23].)

19 While not a separate element under the step-by-step test, distinctiveness is a factor that plays an integral role in the marks-similarity assessment. To briefly restate the key points, the term “distinctiveness” is used in two senses: (a) the ordinary and non-technical sense; and (b) the technical sense. The former refers to what is outstanding and memorable about the mark in question – i.e. the parts that tend to stand out in the consumer’s imperfect recollection. As for the latter, it carries a meaning that is the opposite of “descriptiveness”, and refers to the capacity of the mark to function as a badge of origin. Technical distinctiveness may be inherent (e.g. where the words comprising the mark are meaningless) or acquired (through long-standing or widespread use). (See *Staywell* at [23] – [24].)

Distinctiveness at the marks-similarity stage

20 Post-*Staywell*, there have been voices from this Tribunal expressing concerns about the precise role of technical distinctiveness in the marks-similarity assessment. It has been said that certain aspects of the law are unclear or not yet settled.

21 The crux of the matter is that on the one hand, the marks-similarity comparison is supposed to be a mark-for-mark assessment without consideration of any external matter. Yet, on the other hand, the question of technical distinctiveness involves: (a) reference to the goods for which the “earlier trade mark” is registered (in order to determine whether it is descriptive or inherently distinctive); and (b) consideration of whether the mark has acquired “greater” distinctiveness through actual use in the course of trade (which can only be proved by evidence

which some argue is external or extraneous matter that should not be taken into account at this stage).

22 In *Monster Energy Company v Mixi, Inc* [2017] SGIPOS 12 (“*Mixi*”), a case I decided recently, I considered the first of the two factors above, but not the second. (I did not consider whether evidence of actual use could be taken into account at the marks-similarity stage.) My view then (see *Mixi* at [37]), as it is now, is that it is permissible, notwithstanding the prohibition against external matter, to consider the respective goods/services to the extent that they are relevant to the issue of distinctiveness (in both its technical and non-technical senses).

- a. By this, I am by no means disregarding the guidance in *Staywell* (at [20]) that I should not consider the “*relative weight and importance of each aspect of similarity having regard to the goods*” at the marks-similarity stage. It is important to appreciate that that holding was aimed at confining arguments such as the “*significance of aural similarity in relation to beverages normally sold by oral order*” and “*visual similarity in relation to clothing normally sold based on the consumer’s direct perception*” to the likelihood of confusion analysis.
- b. Rather, all I am saying is that in assessing whether marks such as “ANGEL” are distinctive or descriptive for the purposes of the marks-similarity assessment, one may have regard to the relevant goods. (For authority, see *Staywell* at [31], where the Court of Appeal observed that: “*At least in relation to hotels and hospitality services, “Regis” enjoys a substantial degree of technical distinctiveness*”. See also *Caesarstone* where the Court of Appeal analysed the “stone” element in  by reference to the goods for which registration was sought.)

23 While the correct approach to the first factor appears to be relatively clear (at least in my view), there have been concerns relating to the second.

- a. In *Monster Energy Company v Chun-Hua Lo* [2017] SGIPOS 17, the learned Principal Assistant Registrar (“PAR”) observed that the question of whether the actual use of the opponent’s mark (via sales and promotion of products bearing the mark) is considered external matter and as such excluded from the analysis at the marks-similarity stage was one that had not been examined in detail thus far. She found it unnecessary to (and did not) decide the issue (see [23] – [24]).
- b. In *The Polo/Lauren Company, L.P. v Royal County of Berkshire Polo Club Ltd* [2017] SGIPOS 19, the learned PAR took the view that the issue of whether acquired distinctiveness can be taken into account at the mark-similarity stage “*does not appear to be settled law*” but proceeded in any event to assess the evidence of alleged acquired distinctiveness (which she found to be insufficient to show that any of the marks relied upon had acquired an enhanced level of distinctiveness in relation to the relevant goods: see [47]).

24 The above discussion is not an academic one. Since it bolsters their case, trade mark opponents (or applicants seeking invalidity) invariably run the argument that the trade mark upon which they rely have “greater technical distinctiveness” and therefore enjoys “a high threshold before a competing sign will be considered dissimilar to it” (*Staywell* at [25]). It is now, more than ever, that guidance from our courts as to the correct approach would be welcome so that the issue can be settled once and for all.

25 In case my view is of assistance, it is this. In both *Staywell* and *Caesarstone*, the Court of Appeal did not consider evidence of alleged acquired distinctiveness at the marks-similarity stage. Instead, the focus in each case was on which, if any, were the distinctive and dominant elements of the competing marks. Whether intentional or not, the advantage of such an approach is that it preserves the conceptual clarity of the step-by-step test. It allows the first stage to be focussed on the crucial question of whether the competing marks are similar, instead of being side tracked by the additional question of whether the earlier mark enjoys sufficient acquired distinctiveness so as to have an impact on the marks-similarity enquiry. This is not to say that evidence of acquired distinctiveness through use is irrelevant. It is not. Rather, as with reputation, it can be considered at the likelihood of confusion stage.

26 Nevertheless, since the legal position appears to be unclear, I will analyse the Opponent's evidence relating to acquired distinctiveness at the appropriate juncture below.

Inherent distinctiveness

27 I begin with the Opponent's Mark, "ANGEL".

28 In its written submissions, the Opponent initially argued that "ANGEL" has a strong level of distinctiveness in that it has no direct meaning in relation to the goods for which it is registered. During the hearing, however, it shifted its position. Counsel for the Opponent, Mr Chua, reframed the Opponent's case as follows: "ANGEL" has a medium level of inherent distinctiveness. But (so the argument goes), once evidence of acquired distinctiveness through use is taken into account, the mark enjoys a high degree of distinctiveness.

29 The Applicant's case is that "ANGEL" has a low to medium level of distinctiveness. It makes two points in this connection. First, the Applicant argues that "ANGEL" is a common English word which refers to a heavenly or spiritual being that can be said to have some nexus to the relevant goods inasmuch as it promotes a "heavenly" image. In this connection, I was referred to *Han's (F&B) Pte Ltd v Gusttimo World Pte Ltd* [2015] 2 SLR 825 ("*Han's*") at [74] wherein Wei J observed that apart from descriptive words and words used arbitrarily in relation to the goods concerned, leaving aside inventive words, there is a third category: "*commonly-used words that have some nexus to the goods concerned, yet are neither descriptive of the goods nor arbitrary in relation to them*". (The example given was: "*words which promote the image of a product, however imprecisely, such as 'The Perfectionists' for women's underwear*".) Second, the Applicant argues that the existence of 24 other registered trade marks on the register in Class 3 that contain the element "ANGEL" suggests that the word "ANGEL" itself is common and has a low degree of technical distinctiveness in relation to Class 3 goods.

30 In my judgment, the inherent technical distinctiveness of the Opponent's Mark, "ANGEL", is normal or medium in nature. Obviously, "ANGEL" is an ordinary English word. It is not an invented word or name and therefore does not possess a great degree of inherent technical distinctiveness. But, "ANGEL" is not descriptive of the goods either. It is arbitrary. One does not describe a perfume as an "ANGEL" perfume. It is meaningless, and says nothing about what the perfume smells like. (What does an angel smell like? I have no idea.) Neither does perfume come from angels. Nor does "ANGEL" allude to any qualities of perfume or its attributes. As regards the passage from *Han's* above, I do not think that it carries the matter further in either direction. It is not disputed in these proceedings that "ANGEL" refers to a heavenly, supernatural or celestial being. Naturally, this has religious or at least superstitious

connotations and I cannot see how such an image can be said to have a nexus to perfumes. To be fair, one might describe perfume as smelling “heavenly” or “divine” in the superlative sense, but the point is that one would not say that it smells like “an angel”.

31 As concerns the Applicant’s invitation to consider the state of the register, it was observed by Jacob J in *British Sugar plc v James Robertsons & Sons Ltd* [1996] RPC 281 at 305 that the fact that there are other marks on the register that consist of or incorporate a certain word (in that case, the word “treat”) does not assist the factual inquiry one way or the other, “*save perhaps to confirm that this is the sort of word in which traders would like a monopoly*” and that “*the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register*”. So too, here. The fact that a number of traders have obtained registrations containing the word “ANGEL” in Class 3 is not surprising, given that it is a common English word. But it does not necessarily follow that “ANGEL” is less distinctive.

Acquired distinctiveness

32 What about acquired distinctiveness? Does the Opponent’s Mark, “ANGEL”, enjoy high technical distinctiveness as a result of the use made of it?

Sales figures and invoices

33 I start with the Opponent’s sales figures and supporting invoices. Evidence was led that from 2010 to 2015, the Opponent’s net invoicing figures in Singapore for each year (in SGD) were as follows:¹

	2010	2011	2012	2013	2014	2015
Singapore	576 141	511 758	584 442	375 314	129 291	99 506

In this connection, the Opponent adduced more than 300 pages of invoice printouts annexed to Exhibit C of Madec’s SD. From these invoice printouts, I can see that the Opponent has sold a sizeable quantity of its products over the years to distributors/retailers in France, Germany, Hong Kong, Macau, Italy, and the United Kingdom.²

34 However, none of the Exhibit C invoices evidenced sales in Singapore. It was not stated whether the sales figures in Madec’s SD were for “ANGEL” perfumes only, or whether other products were included as well. (After all, the invoices showed that outside of Singapore, the Opponent was selling other lines of perfumes such as “ALIEN”, “AMEN” and “WOMANITY” alongside “ANGEL”.) Could it be that the reported sales figures for Singapore were for other perfumes? I cannot tell one way or another. In the circumstances, I accord little weight to the Opponent’s net invoicing figures for Singapore.

Evidence relating to Singapore

35 The Opponent tendered two categories of documents with a view to proving that products bearing the “ANGEL” mark have: (a) been sold to consumers in Singapore through retailers

¹ Madec’s SD at [14].

² Madec’s SD at Exhibit C, generally.

(both brick-and-mortar as well as online); and (b) been extensively reviewed, discussed and mentioned in news articles and blogs originating in Singapore.

36 Under the first category, there is evidence that goods bearing “ANGEL” have been sold in various places in Singapore such as Raffles City, Takashimaya, Isetan, Tangs, Sephora, Changi Duty Free, Sasa, Robinsons and Metro, as well as on the internet via Lazada and Perfumestore.sg.³ Although there is no direct evidence from representatives of these various stores, the Opponent has produced website printouts in Exhibit G of Madec’s SD which, at face value, show that various products bearing “ANGEL” have been offered for sale to the public in Singapore. Some examples of these websites (with the corresponding products) are below.⁴

- a. Sephora Singapore: THIERRY MUGLER Angel Eau de Parfum Spray Shooting Star.
- b. Tangs Singapore: Thierry Mugler Angel EDT, Thiery Mugler Angel (EDP Spray – Shooting Star), Thierry Mugler Angel EDP, Thierry Mugler Angel Perfume (Body Lotion, Body Cream, and Deodorant Spray), and Thierry Mugler Angel Perfuming Hair Mist.
- c. KRISSHOP Air: THIERRY MUGLER ANGEL STARS IN THE SKY.
- d. Lazada: Thierry Mugler Angel Eau De Toilette and Thierry Mugler Angel Eau Sucree Eau De Toilette.

37 The website printouts above were all accessed in 2016. This was after the relevant date of 5 May 2015. The Applicant argues that little weight should be accorded to them. If there had been no other evidence relating to Singapore, I might have been more inclined to agree with the argument. But, there are also printouts from internet forums and other websites relating to Singapore in Exhibit H of Madec’s SD, many of which were published before the relevant date. I provide some examples below.

- a. COZYCOT forums⁵: This is a printout of an online forum thread titled “*Thierry Mugler*”. The posts in this thread are dated between December 2008 and March 2009. The original thread starter asked whether this is “*available anywhere in Singapore*”. There were affirmative replies. One replied to say that “*U can get it at Taka*” (i.e. Takashimaya Singapore) which has a “*Thierry Mugler counter*”. Another chimed in to say that there is a “*counter at Tangs too*” and that he or she has seen it in other shops such as those in Lucky Plaza. Pertinently, a person with the forum handle of “birki” posted on 28 January 2009, saying: “*I usually get mine refilled at Taka counter but I recall Tangs having Thierry Mugler too... Angel & Alien are my absolute faves!*” Yet another person chipped in to say that “*I like ‘Angel’! Very very feminine scent!*” Later on, there is also someone who mentioned having seen the brand at “*isetan scotts last year*”.
- b. SINGAPORE BRIDES forums⁶: This is a printout of an online forum thread titled “*Perfume – Which one will you recommend?*”. The posts in this thread are dated

³ Madec’s SD at [20].

⁴ Madec’s SD at Exhibit G, p1197, 1212, 1213, 1216, 1223.

⁵ Madec’s SD at Exhibit H, pp 1260 to 1263.

⁶ Madec’s SD at Exhibit H, pp 1271 to 1278.

between December 2005 and April 2006. Many different perfumes are discussed, until one person known as “hippie” writes that she is currently alternating between “*Angel by Thierry Mugler*” and 5 other perfumes. Others pick up on the discussion. Another replies to say “*Angel is kinda strong and can really lasts the whole day*”. Yet another comments that “*i find Angel very musky*”. There are a few other references to “*Angel*” in the thread as well.

- c. HUNGRY BIRD blog⁷: This is a printout of a blogpost dated 31 October 2011, from someone who appears to be a food blogger based in Singapore. This post is about a sales event, “The Beauty Bazaar” by Luxasia scheduled for 11 November 2011. The blogger explains that Luxasia is “*a leading distributor of fine fragrances and beauty products in Singapore*” and that they carry “*a wide range of popular fragrances*”, including “*Thierry Mugler*”. She goes on to say that “*I love Thierry Mugler Angel*” and she hopes to be able to find it there.
- d. AMANDA LEONG blog⁸: This is a printout of an advertorial post by Amanda Leong, in relation to perfumes sold in Singapore. It is dated 8 October 2013. Although the post, titled “*Smells Like Roses*”, does not directly feature the Opponent’s products, she does discuss perfume preferences and mentions that “*Some popular scents include... the sweet and spicy Angel by Thierry Mugler*”.
- e. herworldplus.com⁹: This is a printout from the HER WORLD website, a Singapore publication. The article in question is dated 14 January 2013 and is titled “*Thierry Mugler unveils perfume refill station*”. It informs readers that users “*of the brand’s four main women’s fragrances – the Angel eau de toilette and Womanity as well as the already-refillable Alien and Angel eau de parfum – will soon be able to bring their used-up bottles to refilling stations*” in France.
- f. blog.omy.sg¹⁰: This is a printout from a syndicated blogpost dated 3 July 2014 titled “*Georgia May Jagger in Thierry Mugler “Angel” Fragrance Ad*”. (A syndicated post essentially reproduces, with consent, content that was first published elsewhere, so as to reach a wider audience.) Although not entirely clear, it seems that this blog is directed at the public in Singapore although the original advertisement was not.

38 Having considered the evidence relating to Singapore as a whole, and in particular the documents mentioned above, I have no trouble finding that perfumes bearing “ANGEL” have been offered for sale to, and purchased by, at least some consumers in Singapore before the relevant date. However, the inherent difficulty with forum posts and articles on the internet is that they provide only a small part of the picture. Without direct testimony from retailers or precise sales figures (for “ANGEL”) supported by documentary evidence, it is hard to draw any meaningful conclusions on the size of the market and the extent of sales.

39 As regards advertising, as will be seen shortly, the Opponent does not appear to have advertised its perfume bearing “ANGEL” directly in Singapore. But, with the internet and the

⁷ Madec’s SD at Exhibit H, p 1269.

⁸ Madec’s SD at Exhibit H, p 1288.

⁹ Madec’s SD at Exhibit H, p 1293 to 1294.

¹⁰ Madec’s SD at Exhibit H, p 1263.

various methods of content syndication, at least some consumers in Singapore would have been exposed to the Opponent's advertising outside of Singapore.

Evidence relating to matters outside of Singapore

40 According to Ms Madec, the Opponent has engaged in extensive marketing worldwide, through means such as television commercials, brochures and displays, celebrity endorsements, and events and sponsorships for events.¹¹ Advertising expenditure figures for the “*selected jurisdictions*” of France, the UK, Germany, Italy, the USA, Brazil, Hong Kong, and Australia were provided. No figures for Singapore were given.

41 The Opponent produced documents in Exhibits D, E, and F of Madec's SD as evidence of its marketing and promotion activities. These documents form the bulk of Madec's SD, and span more than 800 pages. I examine each in turn.

42 Exhibit D contains two sets of documents.

43 The first is marked “*THIERRY MUGLER International Communication*” and bears the title “*Les Anges D'Angel – Retrospective Des Campagnes 1992 – 2012*”. It was explained in the main body of Madec's SD that this document details “*the history of the ANGEL ICON phenomenon*”.¹² The document is entirely in French. Since no translation was provided,¹³ I am unable to make any findings on the substantive content.

44 Nevertheless, I am able to make observations on the names, dates and pictures that appear. It seems that from 1992 to 2011, the Opponent secured celebrity endorsements from the following: Estelle Lefebure (1992), Jerry Hall (1995), Amy Wesson (1998), Anna Maria Cseh (2003), Bianca Balti (2006), Naomi Watts (2008), and Eva Mendes (2011). These celebrities would appear in advertisements that would invariably feature the sign “ANGEL”



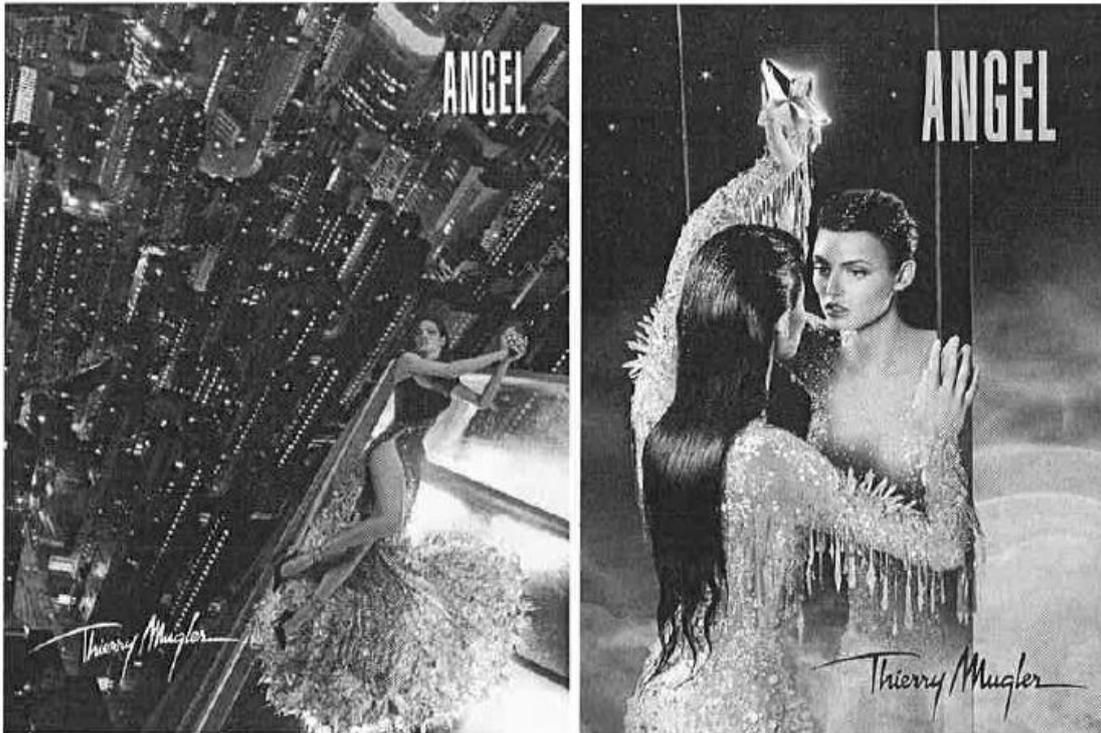
and the

signature. I give two examples below:

¹¹ Madec's SD at [16].

¹² *Ibid.*

¹³ Documents which are in a foreign language should be translated into the English language (see HMD Circular No. 3/2015 at Part B).



The key takeaway from this document is that over the years, the Opponent has consistently advertised its perfume bearing “ANGEL” in connection with a female celebrity (who personifies the “ANGEL”) and the “THIERRY MUGLER” signature trade mark.

45 The second set of documents in Exhibit D is described in the main body of the SD as a “press book detailing the international media coverage of Eva Mendes as the ANGEL ICON of 2012”. It is more than 130 pages thick. The following is a list of just some of the publications which Eva Mendes was featured in: (a) ELLE in Russia; (b) MARIE CLAIRE in the USA, Greece, India, Spain, the United Kingdom, France; and (c) GLAMOUR in France, Russia, Germany, Italy and Spain. There were various other publications which were circulated in other areas, and I need not name them all. It suffices to say that international media coverage was extensive. While I might be over-generalising, it would not be incorrect to say, I think, that while the content of the press coverage might differ, the underlying message is the same: Eva Mendes endorses “THIERRY MUGLER ANGEL” perfume.

46 Be that as it may, it appears reasonably clear from the evidence that the Eva Mendes documents in Exhibit D were never directly aimed at the public in Singapore. A great many of them were not even in the English language. And, as the Applicant rightly points out, in terms of geographical proximity, the closest thing to Singapore is a June 2012 HARPERS BAZAAR magazine extract which was circulated in Malaysia.¹⁴ For the avoidance of doubt, I am not suggesting that consumers in Singapore were completely oblivious to Eva Mendes’ endorsement of “THIERRY MUGLER ANGEL”. As discussed above, there is some evidence that through the internet, at least some consumers in Singapore would have been exposed to the Opponent’s advertising and other business activities outside of Singapore. Instead, all I am saying is this: extensive as it may be, the effect of the advertising abroad on consumers in Singapore is likely to have been limited.

¹⁴ Madec’s SD at Exhibit D, p 493.

47 Next, Exhibit E. The documents in this exhibit are described in Madec’s SD as “*advertising and promotional material, including posters and short films featuring products bearing the Opponent’s mark*”.¹⁵ These posters and other material were in the same style as those in [44] above (see examples below) and my observations apply equally here as well. The extent to which the public in Singapore were exposed to these (if at all) is also unclear.



48 Exhibit F weighs in at 670 or so pages. Ms Madec described this exhibit as a compilation of “*the comprehensive wealth of material bearing the Opponent’s mark*”.¹⁶ As I run through them, I see that this exhibit comprises a series of 4 separate compilations, each corresponding to a specific year: (a) the “GRAVITY Press Book 2015 MUGLER”¹⁷; (b) the “INTERNATIONAL PRESS REVIEW GEORGIA MAY JAGGER (MAY TO OCTOBER 2014)”¹⁸; (c) the “BEST OF INTERNATIONAL PRESS COVERAGE 2013”¹⁹; and (d) the “BEST OF INTERNATIONAL PRESS COVERAGE 2012”²⁰. Unlike the documents in Exhibits D and E, those in Exhibit F are not confined to specific celebrity endorsements although there is evidence of that as well.

49 As a whole, the abovementioned documents show that the Opponent has widely advertised its perfume bearing “ANGEL” outside of Singapore²¹ through various avenues. As with the Eva Mendes documents in Exhibit D, there is no evidence that any of this advertising in Exhibit F was ever directed towards the public in Singapore. There is, of course, some limited connection to Singapore in the form of the syndicated blogpost concerning Georgia May Jagger (see [37(f)] above), but reaching viewers through syndicated content is not the same as direct advertising.

¹⁵ Madec’s SD at [18].

¹⁶ Madec’s SD at [19].

¹⁷ Madec’s SD at Exhibit F, p 519 to 767.

¹⁸ Madec’s SD at Exhibit F, p 768 to 857.

¹⁹ Madec’s SD at Exhibit F, p 858 to 1000.

²⁰ Madec’s SD at Exhibit F, p 1001 to 1195.

²¹ The following is a listing of the countries or territories to which the advertising material in Exhibit F relates: Argentina, Australia, Belgium, Brazil, Canada, Chile, France, Germany, Greece, Hong Kong, Italy, India, Japan, Malaysia, Mexico, Middle East (various, including Saudi Arabia and Kuwait), Netherlands, Paraguay, Peru, Philippines, Poland, Romania, Russia, South Africa, Spain, Switzerland, Slovak Republic, UK, and USA.

50 To conclude, I find that the Opponent has engaged in extensive advertising in many parts of the world, including neighbouring Malaysia, Hong Kong and the Philippines. But, there is no evidence that the Opponent’s advertising ammunition has ever been directly brought to bear in this country. While I do accept that some members of the public in Singapore may have been exposed to the Opponent’s advertising abroad, especially through the internet, its impact is likely to have been limited.

Effect of the evidence

51 Perhaps the most striking aspect of the Opponent’s evidence is this. As far as I can ascertain, “ANGEL” never appears without “THIERRY MUGLER” (sometimes in signature form) at least somewhere in the same document. Instead, the consumer or potential consumer is constantly educated that “ANGEL” perfume is from or by “THIERRY MUGLER”. As a result, when individuals refer to it in forums or blogposts or articles, they do so in conjunction with “THIERRY MUGLER”. Although this should already be apparent from the discussion on the evidence above, I give further examples below.

- a. In a June 2012 HARPER’S BAZAAR article (Malaysia),²² Eva Mendes is quoted as having said that she can’t live without “*My fragrance, Angel*”, and that she loves “*Angel because... It is a perfume for modern women – independent yet vulnerable and sexy at the same time*”. Although “ANGEL” is used to refer to the fragrance, there is no doubt that it comes from “THIERRY MUGLER” because of the heading: “*Eva MENDES The drop-dead gorgeous actress and face of Thierry Mugler’s Angel reveals her eternal beauty secrets*”.
- b. In the March 2012 edition of Marie Claire (USA), where Eva Mendes appears on the front cover, readers are introduced to her perfume, “*Angel Eau de Toilette by Thierry Mugler*”. At the bottom of one of the pages, one can see the line: “*For a chance to win a bottle of Angel Eau de Toilette by Thierry Mugler, go to... [website]*”.²³ The message here to the readers is that “ANGEL” is by “THIERRY MUGLER”. In the main feature article in that same magazine, there is also mention of the fact that Eva Mendes is a spokeswoman for “*Thierry Mugler’s Angel fragrance*”.²⁴
- c. In the posters and advertising material reproduced at [44] and [47] above, one can clearly see “ANGEL” being advertised in conjunction with the signature “”. It is worth noting that at times, the signature appears immediately above “ANGEL”, to be read as “THIERRY MUGLER ANGEL”.²⁵ At other times, the signature is given prominence and “ANGEL” appears only later.²⁶
- d. At other times, “ANGEL” has been advertised and used in conjunction with other words or signs. Examples of this include: “THIERRY MUGLER ANGEL HAIR MIST”,²⁷ and “ANGEL STAR GRAVITY” / “THIERRY MUGLER ANGEL

²² Madec’s SD at Exhibit D, p 493.

²³ Madec’s SD at Exhibit D, p 385.

²⁴ Madec’s SD at Exhibit D, p 393.

²⁵ Madec’s SD at Exhibit F, p 547.

²⁶ Madec’s SD at Exhibit F, p 604. Notably, in this document “ALIEN” is also advertised.

²⁷ Madec’s SD at Exhibit F, p 989, 990, 991.

GRAVITY” / “THIERRY MUGLER ANGEL GRAVITY STAR”.²⁸ I have also given the examples (at [36] above) of “THIERRY MUGLER Angel Eau de Parfum Spray Shooting Star” and “THIERRY MUGLER ANGEL STARS IN THE SKY”.

- e. In the sample images of the products and corresponding packaging bearing “ANGEL” in Exhibit A of Madec’s SD, one can see the signature “

The image shows a handwritten signature in black ink that reads "Thierry Mugler". The signature is written in a cursive, flowing style with a long horizontal line extending to the right from the end of the name.

” on the packaging. Depending on the colours used, at times the signature appears more prominently on the packaging whereas at other times it is less so, but it seems that it is in each case always present. To be fair, based on the images provided, the product bottles (be they perfume, deodorant or cream) themselves do not appear to bear the “THIERRY MUGLER” signature. And, sometimes the word “ANGEL” appears on the product bottles, whereas at other times it does not. But the point is that by the time that one removes the product from the packaging, one would already have been educated and informed that what is inside is an “ANGEL” by “THIERRY MUGLER” product.

52 I consider that “ANGEL” falls into the category of what trade mark practitioners and jurists sometimes refer to as “secondary” or “limping” trade marks. (Limping because they rely on another mark as a “crutch”.) In *Societe des Produits Nestle SA and anor v Petra Foods Ltd and anor* [2017] 1 SLR 35 (“*Nestle*”) at [59], the Court of Appeal had this to say about acquired distinctiveness for such marks (references omitted):

“... In our judgment, there is no absolute rule that a mark that has only been used with other trade marks cannot also on its own distinguish the relevant goods or services. Ultimately, the question is whether the mark can stand up on its own *as an indicator of trade origin*, and in each case, this will depend on the evidence. Nonetheless, where a mark has never been used as a sole badge of origin, we agree with the observations of the Judge, that this might lend weight to the inference that the trader does not depend on the mark standing alone to serve as a trade mark. This is a factor that the trader would have to overcome in proving that the mark has indeed acquired distinctiveness.”
(emphasis added)

Although the Court of Appeal in *Nestle* was considering acquired distinctiveness in a different context, I see no reason why the underlined segment above cannot apply here. For the avoidance of doubt, I am not suggesting that “ANGEL” is not distinctive. (Above, I have found “ANGEL” to be of ordinary, or medium, inherent distinctiveness.) Nor am I making a finding that “ANGEL” has not been used as a trade mark. (That issue is not even before me.) All I am saying is that care must be taken in approaching the Opponent’s evidence with a view to assessing whether “ANGEL” truly has attained that greater level of acquired distinctiveness (which the Opponent says it has) by reason of the use that has been made of it.

53 After sieving through the Opponent’s evidence, I do not think that it supports the conclusion that “ANGEL” has acquired greater distinctiveness through use. “ANGEL” does not appear to have been marketed and used without “THIERRY MUGLER”, and it is not clear that consumers necessarily regard “ANGEL” *alone* as a trade mark (i.e. a guarantee of origin), for the purposes of proving greater distinctiveness through use. (This is the test for acquired

²⁸ Madec’s SD at Exhibit F, p 722 to 759, generally.

distinctiveness: see *Nestle* at [51].) Consequently, even if evidence of acquired distinctiveness can be taken into account at the marks-similarity stage, “ANGEL” does not enjoy a high threshold before the Application Mark can be considered dissimilar to it.

Visual similarity

54 The Applicant argues that “*derma*
Angel” is not visually similar to the Opponent’s Mark for two main reasons. First, it contains an additional word (“derma”). Second, the Application Mark is stylised and can thus be distinguished from the Opponent’s Mark. The Applicant also stresses that the distinctive component of the Application Mark should be its entire composition and that it would be incorrect to isolate the stylised “*Angel*” element and place focus on it.

55 As far as “derma” is concerned, the Opponent’s case is that this element is descriptive of skin or skin related products and therefore ought to play a lesser role in the assessment. As for stylisation, its case is that the stylisation in the Application Mark is insignificant and/or decorative, and does not imbue the mark with distinctive character. In this connection, the Opponent also argues that “ANGEL” is registered in block letters and this confers protection against “*any offending use in any font or stylisation*”.

56 It is convenient to begin the discussion with “derma”. There was some evidence tendered by the Opponent in Madec’s Reply SD as to what it means.²⁹ In brief, “derma” has Greek and Latin roots, and is closely connected to the word “skin”, or “dermis”. There is also a lesser known meaning of “derma” which is beef or fowl intestine used as a casing for certain dishes, such as kishke. (Which, I am given to understand, is essentially a sausage. In this context, “derma” would then be something like the skin of a sausage.)

57 Delving into the dictionaries is one thing. At the end of the day, the assessment must be from the perspective of the relevant consumer in Singapore of the goods. I can accept that some segment of the public in Singapore might be aware of the etymological connection between “derma” and skin. Others might connect it to words like “epidermis” and “dermatologist”. In any case, no one in Singapore uses “derma” itself to refer to or describe skin. At best, it falls into the category of words which may have some nexus to the goods, but is neither arbitrary nor descriptive.

58 Even if I am wrong in taking the view that “derma” is not descriptive of the goods, as the Applicant rightly points out, the marks must be compared as wholes. The Application Mark contains not only “derma” but also “*Angel*”. Even if the two elements can be said to separately possess some level of descriptiveness, when combined together, “DERMA ANGEL” is not a familiar expression that alludes to or designates the essential characteristics of the type of goods in question. I thus agree with the Applicant’s submission that one would not speak of a “DERMA ANGEL”, just as one “*does not speak of a ‘lady’ rose*” (see *Hai Tong* at [35]). For these reasons, I am not persuaded by the argument that “derma” should play a lesser role in the overall assessment.

59 On the contrary, I consider that the “derma” element serves as a key visual difference between the two marks. While each case must turn on its own facts, it is useful to look for

²⁹ Madec’s Reply SD at Exhibit A, p 9 to 12.

guidance in decided cases with similar fact patterns. One such case was *Ozone Community Corp v Advance Magazine Publishers Inc* [2010] 2 SLR 459 (“*Ozone*”), where the competing marks were “HYSTERIC GLAMOUR” and “GLAMOUR”. There, it was stated that:

“... given that the word “hysteric”, which appears at the beginning of Ozone’s word mark, is almost of equal length to the word “glamour”, I could not see how it would be entirely overlooked or overshadowed by the word “glamour”. That Ozone’s word mark has two words was to my mind a visual difference. Thus, even if “glamour” is the more common word of the two (ie, “hysteric” and “glamour”) and may come to mind more quickly than “hysteric”, the consumer with an imperfect recollection would still remember that Ozone’s word mark has an additional word to “glamour”.”

(emphasis added, internal references omitted)

The High Court ultimately arrived at the conclusion that the marks were visually dissimilar.

60 In the present case, I find that “derma”, which appears at the beginning of the Application Mark, occupies almost the same amount of visual space as “*Angel*”. This can be attributed to the fact that their font sizes are similar, and also that each is 5 letters long. Just like “HYSTERIC GLAMOUR” in *Ozone*, the fact that the Application Mark contains two words is a visual difference. Even if one were to leave aside the stylisation (a point which I will come to shortly) and focus on the common element “ANGEL”, the consumer with an imperfect recollection would still remember that the Application Mark has an additional first word. This points to the conclusion that the marks are visually dissimilar.

61 Next, stylisation. I first address the Opponent’s argument that its registration in block letters for “ANGEL” means that it should be protected against “*offending use in any font or stylisation*”. The Opponent relies on *Ferrero SpA v Sarika Connoisseur Café Pte Ltd* [2011] SGHC 176 (“*Sarika HC*”) at [56]. In that paragraph, it was stated that:

“... It is trite law that word-only registered trade marks render infringing any offending use in any font or stylisation. As stated by the learned authors of *Kerly’s Law of Trade Marks and Trade Names* (Sweet & Maxwell, 14th Ed, 2005) at para 2-036:

Consider a word-only registration. The graphical representation of the word in capitals is in plain type. Such a registration covers the word in a very wide range of typefaces. The variation in presentation is permissible because the distinctive character of the mark resides in the word itself and that does not change.”

62 I do not think that the above holding in *Sarika HC* or the passage from the 14th Edition of *Kerly’s* cited therein assists the Opponent’s case. In *Sarika HC*, the plaintiff’s registered mark was “NUTELLA” in block letters, and the defendant was using (among other things) the sign “*Nutello*”. Although italicised, the stylisation in the defendant’s sign clearly did not change the distinctive character of the sign: it is obvious that the distinctive character of the mark resides in the word itself: “*Nutello*”.

63 The present case is set in a very different context. The “*A*” in the Application Mark is heavily stylised and appears marginally larger in comparison with the other letters. Alone, one would more likely than not consider it to be a meaningless sign. It is only because it appears together with the letters “N-G-E-L” that a reader is able to fill in the gaps to reach the

conclusion that “*Angel*” is to be read as “ANGEL”. (This is clever, because no other letter in the alphabet would form an ordinary English word in that context apart from “A”.) It is for this reason that the distinctive character of the Application Mark as a whole cannot be said to reside solely in the words “DERMA ANGEL”. Rather, its distinctive character is drawn, at least in part, from the combination of all the elements together, *including* the “*A*”.

64 In the same vein, and for the same reasons, I must partially reject the Opponent’s argument that the stylisation in the Application Mark is insignificant and/or decorative. As far as the “*A*” element is concerned, I find that this is something that would leave an impact on the mind’s eye of the average consumer. Given imperfect recollection, the consumer would not remember all the details. But at the very least, the impression of a cleverly stylised “A” would likely remain. That said, I agree that average consumers would not pay too much attention to what the Applicant describes as the italicised font with rounded edges. The stylisation inherent in “D-E-R-M-A” and “N-G-E-L” is minimal, at best.

65 A useful case to consider in this connection is *Qingdao Sentury Tire Co., Ltd v PT Industri Karet Deli* [2016] SGIPOS 5, where the competing marks were “*Deli Tire*” and “DELINTE”. It was held that the stylised “D” in front of the opponent’s “DELI TIRE” mark is a “*significant feature that cannot be disregarded, adding to the different visual impressions of the marks*” (at [28]). The marks were found to be visually dissimilar.

66 There were also some oral and written submissions presented in relation to the effect of the stacking of the element “derma” which appears above “*Angel*”. I think that this feature does not make much of a difference in the analysis. Perhaps the most that can be said about it is that it draws the eye to “*A*”, which stands out visually in “*derma Angel*”.

67 While it is true in certain cases that the overall impression conveyed by a composite trade mark may be dominated by one or more of its components (see *Hai Tong* at [62(c)]), it is important to bear in mind that this need not always be the case. There are many cases where no feature of the mark dominates the mark’s landscape, and to micro-analyse a mark for particular distinctive features in such cases is unhelpful. (*Caesarstone Sdot-Yam Ltd v Ceramiche Caesar SpA* [2016] 2 SLR 1129 (HC) at [30].³⁰) Here, even though “*A*” can be said to stand out visually, it does not dominate the Application Mark as a whole. The same can also be said for the elements “derma” and “*Angel*” as well. Each element occupies weight in the whole and I cannot simply focus on any one element to the exclusion of the others.

68 To conclude, when the marks are compared visually, “derma” and “*A*” would be critical points of distinction that would distinguish the Application Mark visually from the Opponent’s Mark. I thus find the marks to be visually dissimilar.

Aural similarity

69 It is clear from *Staywell* that there are two possible approaches that can be taken in the comparison for aural similarity (see [23] – [33]). The first is to have special regard to the

³⁰ Although this decision was reversed on appeal by the Court of Appeal, this passage was not commented on and I see no reason to doubt its correctness.

distinctive or dominant components of the marks (“Dominant Component Approach”). The second is to undertake an assessment as to whether the competing marks have more syllables in common than not (“Syllables Approach”).

70 First, the Dominant Component Approach. Here, the Opponent’s case is that the marks are aurally similar in that the dominant component in both marks is “ANGEL”. As for the Applicant, its case is that this approach is not relevant because the dominant component of the Application Mark is the entire phrase “DERMA ANGEL”.

71 I am unable to agree with the Opponent’s submission that the dominant component in “DERMA ANGEL” is “ANGEL”. One cannot simply isolate “ANGEL” and disregard “DERMA”. After all, “DERMA” comes first and would surely be pronounced in full, just as “ANGEL” would be pronounced in full. Importantly, consumers in Singapore would not have problems enunciating the words, and by nature the words would typically not be slurred. In my judgment, neither “DERMA” nor “ANGEL” can be said to be dominant or more dominant than the other. Each component has about the same aural weight in the sense that neither would stand out more to the ear. Because there is no aural dominant component in the Application Mark, the comparison would thus be between “DERMA ANGEL” as a whole, and “ANGEL”. The irresistible conclusion is that the marks are aurally dissimilar.

72 The same result can be reached via the Syllables Approach. Here, the Application Mark would be read as two two-syllable words - “DER-MA AN-GEL” - which is one more word (and two more syllables) than the Opponent’s Mark “AN-GEL”. And just like *Ozone*, where “HYSTERIC GLAMOUR” was found to be aurally dissimilar to “GLAMOUR”, and *Taylor, Fladgate & Yeatman Limited v Taylors Wines Pty Ltd* [2014] SGIPOS 14 where “TAYLORS WAKEFIELD” was found to be aurally dissimilar to “TAYLOR’S”, the conclusion here must be that “DERMA ANGEL” is aurally dissimilar to “ANGEL”.

73 In summary, although both contain the aural component “ANGEL”, the additional first word “DERMA” in the Application Mark sets it apart aurally from the Opponent’s Mark, such that on balance, the marks are aurally dissimilar.

Conceptual similarity

74 The conceptual analysis “*seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole*”. (Staywell at [35].)

75 It is not in dispute that the Opponent’s Mark can be said to connote an angel in the sense of a heavenly or spiritual or celestial being. In arguing that the marks are conceptually similar, the Opponent focuses on the common word “ANGEL” in both marks, and seeks to downplay the significance of “DERMA” which in its submission is descriptive and inconsequential. In response, the Applicant submits that one must not lose sight of the fact that “DERMA ANGEL” is a coined term that is meaningless and does not connote anything. To restate the Applicant’s submission, even if “DERMA” and “ANGEL” might each separately have some form of meaning, the juxtaposition engenders distinctiveness in that the phrase “DERMA ANGEL” does not convey a sensible meaning (just like “LADY” and “ROSE” in *Hai Tong*, when combined together as “LADY ROSE”).

76 It is true that if one were to simply focus on the “ANGEL” element to the exclusion of “DERMA”, one would naturally reach the conclusion that the marks are conceptually similar.

However, in *Staywell* at [35], the Court of Appeal emphasised that greater care is needed in considering what the conceptually dominant component of a composite mark is, because the sum connoted by each component might be very different from the sum of its parts. I take the

view that there is no one conceptually dominant component in “^{derma}Angel”, and agree with the Applicant’s submission that the combination of the two elements results in a phrase that is meaningless in relation to the goods (which are cosmetics and various other goods in Class 3). After all, in *Hai Tong*, the Court of Appeal considered “LADY ROSE” to have no sensible meaning in relation to cosmetics in Class 3. Following that line of reasoning, I cannot see how “DERMA ANGEL” can be said to have any sensible meaning in relation to the goods either. Even if one were to disregard the goods and look at “DERMA ANGEL” in abstract, one would also say that it is meaningless.

77 To summarise, it was undisputed that the Opponent’s Mark has an ordinary meaning which refers to a heavenly or spiritual, supernatural, being. The Application Mark, on the other hand, has no sensible meaning. I therefore find that the competing marks are conceptually dissimilar.

Conclusion on marks-similarity

78 I have found that the Application Mark and the Opponent’s Mark are, on balance, visually, aurally, and conceptually dissimilar. In totality, the marks are dissimilar.

Outcome of opposition under Section 8(2)(b) TMA

79 In light of my finding that the competing marks are more dissimilar than similar, the opposition under Section 8(2)(b) TMA fails at this first step.

Opposition under Sections 8(4)(b)(i) and 8(4)(b)(ii) TMA

80 The Opponent is relying on Section 8(4)(b)(i) as well as 8(4)(b)(ii) TMA. The former relates to marks that are well known in Singapore, whereas the latter relates to marks that are well known to the public at large in Singapore.

81 Section 8(4) TMA provides that:

“(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.”

82 As can be seen from the above, two elements are common to the sub-grounds of opposition within Section 8(4) TMA.

- a. First, the whole or essential part of the later trade mark must be shown to be identical with or similar to the earlier trade mark.
- b. Second, the earlier trade mark must be shown to be well known in Singapore. (Although Section 8(4)(b)(ii) TMA concerns marks that are well known to the public at large in Singapore, it goes without saying that a mark that is not well known in Singapore cannot be well known to the public at large in Singapore.)

If either (or both) of these elements cannot be established, the opposition under all the sub-grounds of Section 8(4) TMA will fail.

Similarity of marks?

83 The earlier trade mark that the Opponent is relying on for the purposes of the sub-grounds of opposition under Section 8(4) TMA is the Opponent’s Mark, “ANGEL”. This is the same mark I have found to be dissimilar to the Application Mark under the Section 8(2)(b) TMA ground of opposition.

84 It is undisputed that there is no material difference between the similarity of marks enquiry under Section 8(2)(b) TMA as compared to Section 8(4) TMA. Accordingly, for the same reasons, I find that the whole or essential part of the Application Mark is not identical with or similar to the Opponent’s Mark.

Outcome of the opposition under Section 8(4)(b)(i) and 8(4)(b)(ii) TMA

85 My finding that the whole or essential part of the Application Mark is not identical with or similar to the Opponent’s Mark is sufficient to dispose of the ground of opposition under all sub-grounds of Section 8(4) TMA. In other words, the opposition under Section 8(4)(b)(i) and 8(4)(b)(ii) TMA fails. It is not necessary for me to go on to examine the remaining elements of the provision, and I will not do so.

Opposition under Section 8(7)(a) TMA

86 Section 8(7)(a) TMA provides that a trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented “*by 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*”.

87 The basic elements of passing off are trite. Three must be established in turn: (a) goodwill, (b) misrepresentation, and (c) damage. The fundamental principles relating to each element are set out in the Court of Appeal’s decision in *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 (“*Singsung*”). (I also recently restated some of the salient points in *Mixi* at [180], and will not repeat them here.)

88 Under the first element, the key question is whether the Opponent enjoys goodwill in Singapore in its business as a whole. The Applicant contends that the Opponent's evidence does little to show that products bearing "ANGEL" are being sold in Singapore or that the Opponent has an actual business presence here. I disagree. Above, I considered the Opponent's evidence relating to Singapore in some detail, and arrived at the conclusion that perfumes bearing "ANGEL" have been offered for sale to, and purchased by, at least some consumers in Singapore before the relevant date. In particular, the various forum posts show that consumers in Singapore were actively seeking out and purchasing the Opponent's products bearing "ANGEL" from various department stores and other locations. Clearly, the Opponent was in the business of selling its goods here. I have no trouble finding that the goodwill element has been made out.

89 Next, misrepresentation. The key question here is whether there is such a similarity between the Application Mark and the Opponent's Mark such that in all the circumstances, it is sufficiently likely to result in the relevant segment of the public being deceived into thinking that the Applicant's goods are, or emanate from a source that is linked to, the Opponent's. Above, I have found the marks to be dissimilar. Consequently, this question must be answered in the negative. I thus find that the element of misrepresentation has not been made out, and it is not necessary for me to comment further on the final element of damage.

Outcome of opposition under Section 8(7)(a) TMA

90 For the reasons above, this ground of opposition fails.

Conclusion

91 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 Applicant is entitled to costs to be taxed, if not agreed.

92 For completeness and although nothing turns on it, a final word on *Clarins Fragrance Group v BenQ Materials Corporation* (Opposition No. B 2 507 609), which the Opponent relied on. That case involved the same two parties before me, and the outcome was that the Opponent succeeded in its opposition to the Applicant's European Union Trade Mark application for "DermaAngel". I do not consider the reasoning and outcome of the decision (which is of course not binding on me) to be of any assistance to this case for the following reasons. First and most importantly, it relates to a different mark altogether: the mark opposed

in those proceedings was "DermaAngel" whereas the Application Mark here is "^{derma}Angel". Second, the lens through which I must view this dispute is that of relevant consumers in Singapore, not in Europe. (This impacts upon, among other things, the critical issue of whether or not "DERMA" is distinctive.) Third, as observed by the learned IP Adjudicator, Prof. David Llewelyn in *LG Electronics Inc. v Beats Electronics, LLC* [2016] SGIPOS 8 at [27], there are "*now significant differences in certain respects between trade mark law in the EU and in Singapore*". While this does not mean that decisions from the EU are irrelevant, it does mean that I have to be cautious and calibrated in my approach to them.

Date of Issue: 1 February 2018