

Intellectual Property Office of Singapore Case Summary: Starwood Hotels & Resorts Worldwide, Inc and Sheraton International IP, LLC v Staywell Hospitality Pty Limited [2018] SGIPOS 11

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Starwood Hotels & Resorts Worldwide, Inc and Sheraton International IP, LLC (the Applicants), sought to invalidate the trade mark T1005795F registered for Class 35 and 43 services ("**Subject Mark**"):



on the basis of, amongst others:

Applicants' Earlier St Regis Mark		
1	ST. REGIS T9512253G	Class 42 Hotel, motel, resort, restaurant, bar, cocktail lounge, food and beverage services.

The Applicants relied on Section 23 read with Sections 7(6), 8(2)(b), 8(4)(b)(i), 8(4)(b)(ii)(A) and Section 8(7)(a) of the Trade Marks Act (Cap 332, 2005 Rev Ed).

This case is intertwined with the seminal case of *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide Inc & anor* [2014] 1 SLR 911 ("**Staywell Court of Appeal**") where the Court of Appeal elucidated the 3-step test approach in relation to an objection under Section 8(2)(b).¹

The findings and observations of **Staywell Court of Appeal** are highly persuasive since the marks are highly similar in both cases:

Current Invalidation Proceeding	
Subject Mark	Applicants' Earlier St Regis Mark
	ST. REGIS
Previous Opposition Proceeding	
Application Mark	Opponent's Earlier Mark
 	ST. REGIS

Here, the Applicants are relying on the *exact* same mark as their earlier mark. As for Staywell Hospitality Pty Limited (the Proprietor), the only difference between the **Subject Mark** and the **Application Mark** are the Chinese characters, “柏·伟诗酒店” which is transliterated and translated as follows:

S/N	Chinese character	Transliteration	Translation
1	柏	bai	Cypress
2	伟	wei	Great
5	诗	shi	Poetry, poem
4	酒店	Jiu dian	Hotel

The key then is whether the inclusion of the Chinese characters in the **Subject Mark** will result in a different outcome to that in **Staywell Court of Appeal**.

¹The previous chain of dispute (without regard to the forum) will be referred to as **Previous Opposition Decision**.

In *Staywell Court of Appeal*, the court was of the view that “Regis” was the distinctive component of the mark



Having regard to the local demographics, Chinese will be understood such that it is unlikely that the Chinese characters 柏·伟诗酒店 will be viewed simply as a decorative element. Nonetheless, as English is the working language in Singapore, the Chinese characters 柏·伟诗酒店 are of *secondary* significance in comparison to the English words. As the characters 柏·伟诗酒店 do not possess any fixed meaning as a phrase while sounding similar to “PARK REGIS” at the same time, 柏·伟诗酒店 would be understood, *first and foremost*, as a phonetic transliteration of “Park Regis”.

Together with the *fleur-de-lis* device manifesting a connotation of royalty and “Park” being descriptive of the service, 柏·伟诗酒店 being subsidiary would not significantly erode any distinctiveness exuded by “Regis” in the mark



Overall, the **Subject Mark** and the **Applicants’ Earlier St Regis Mark** are more similar than dissimilar in view of the common distinctive element REGIS.

There is also a likelihood of confusion in that consumers would believe that the users of the competing marks are economically linked. In this regard, the Court of Appeal’s finding as to the state of the hotel industry in *Staywell Court of Appeal* (that it is *common* for large hotel chains to operate differently branded hotels carrying different logos, united only by use of a common denominator in their names, pitching to different segments of the market) remains applicable as at the **Relevant Date**³, such that there is a likelihood of confusion as to the existence of an *economic link* between the two hotels in question.

In addition to Section 8(2)(b), the case also succeeded on the basis of Sections 8(4)(b)(i), and 8(7), but failed on Sections 7(6) and 8(4)(b)(ii)(A).

Disclaimer: The above is provided to assist in the understanding of the Registrar’s grounds of decision. It is not intended to be a substitute for the reasons of the Registrar. The full grounds of decision can be found at <https://www.ipos.gov.sg/docs/default-source/resources-library/hearings-and-mediation/legal-decisions/2018/starwood-hotels-resorts-worldwide-and-sheraton-international-ip-v-staywell-hospitality-2018-sgipos-11.pdf?sfvrsn=0>.

² See [31] of *Staywell Court of Appeal*, in the context of the issue of aural similarity.

³ Date of application of the **Subject Mark**.