

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

Trade Mark No. T1311419E
14 May 2019, 13 August 2019

IN THE MATTER OF A COLLECTIVE MARK APPLICATION BY

BAYERISCHER BRAUERBUND E.V.

AND

OPPOSITION THERETO BY

BAVARIA N.V.

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

Representation:

Ms Catherine Lee / Mr Desmond Chew (Rodyk IP) for the Opponent

Ms Winnie Tham / Mr Marcus Liu (Amica Law LLC) for the Applicant

GROUND OF DECISION

1 This is the first case in Singapore where an application for a collective mark has been opposed.

2 Unlike a “normal” trade mark which serves to *identify* a specific trader as the *source* of goods or services, a “collective” mark can be used by a variety of traders so long as they

are *members of an association*.¹ This raises interesting issues when deciding if the grounds of opposition succeed, as discussed below.

3 In this dispute, the subject mark, T1311419E ("*Application Mark*"):

BAVARIAN BEER

is a collective mark sought to be registered for “beers” in Class 32 by Bayerischer Brauerbund e.V. (the “Applicant”), an umbrella association for the Bavarian brewing industry located in the German Federal State of Bavaria.

4 The *Application Mark* was accepted and published on 19 August 2016 for opposition purposes. The Opponent filed its Notice of Opposition to oppose the registration of the *Application Mark* on 19 October 2016. The matter was set down for a hearing on 14 May 2019. On 12 July 2019, the Registrar requested for further submissions from the parties in relation to specific issues, in particular, with regard to the application of the case law (which relates to trade marks) to collective marks. These further submissions were received on 13 August 2019.

Grounds of Opposition

5 The Opponent relies on sections 8(2)(b), 8(4), 8(7)(a) as well as Paragraph 4 of the First Schedule of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“Act”) in this opposition.²

Evidence and written submissions

6 The Opponent’s evidence comprises the statutory declaration of Peter-Jan Joost Marie Swinkels, Chief Commercial Officer of the Opponent, dated 17 August 2018 (“Opponent’s SD”). The Applicant’s evidence comprises the statutory declaration of Georg Schneider, President of the Applicant, dated 19 December 2018 (“Applicant’s SD”).

7 Parties submitted the following written submissions:

- (i) Opponent’s written submissions (OWS);
- (ii) Opponent’s further written submissions (OFWS);
- (iii) Applicant’s written submissions (AWS);
- (iv) Applicant’s rebuttal written submissions (ARWS);
- (v) Applicant’s further written submissions (AFWS).

Applicable Law and Burden of Proof

¹ A collective mark is defined in section 60(1) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“Act”) as “a sign used, or intended to be used, in relation to goods or services dealt with or provided in the course of trade by members of an association to distinguish those goods or services from goods or services so dealt with or provided by persons who are not members of the association.”

² The Opponent dropped section 7(6) on 15 March 2019.

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

Background

9 The Opponent deposed that the Swinkels family, which owns and operates the Opponent, has been brewing beers in Lieshout, the Netherlands, since 1680. The Opponent was incorporated in 1930 and has used the word “Bavaria” in its company name since then.³ The Opponent’s mark (more below) was created around the year 1930 and has been used in commerce since then.⁴ The Opponent’s mark was initially confined to the Netherlands. However, since 1947, the Opponent expanded its business activities to include the international exportation of products bearing the Opponent’s mark.⁵ The Opponent has registered and/or applied to register the Opponent’s mark in more than 120 countries.

10 The Opponent relies on its following earlier registered marks (collectively, the *Opponent’s Earlier Marks*) ([7] of the Opponent’s SD) in these proceedings:

S/N	<i>Opponent’s Earlier Marks</i>	Class
<i>Opponent’s Earlier Word Mark</i>		
1	BAVARIA HOLLAND BEER	T0913749F <u>Class 32</u> Beer
<i>Opponent’s Earlier Device Mark</i>		
2		T9907397B <u>Class 32</u> Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.
<i>Opponent’s Earlier Blue Label Mark</i>		
3		T1008460J <u>Class 32</u> Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other

³ At [8] of the Opponent’s SD.

⁴ At [5] of the Opponent’s SD.

⁵ At [5] of the Opponent’s SD.

S/N	<i>Opponent's Earlier Marks</i>	Class
		preparations for making beverages.

11 The Applicant deposed that it is an umbrella association for the Bavarian brewing industry located in the German Federal State of Bavaria with its headquarters located in the city of Munich⁶, the capital of Bavaria. The Applicant was formed in 1880 for the purpose of protecting the common interests of the Bavarian beer brewery industry.⁷ In 1880, 462 breweries contributed to the founding charter, which together covered 75% of the Bavarian beer output at the time. Today, member breweries of the Applicant come from all regions of the state of Bavaria and are responsible for the production of approximately 90% of all beer produced in Bavaria.⁸

Summary

12 For convenience, I set out my principal holdings:

- (i) The ground of objection under Paragraph 4 of the First Schedule is both an absolute and relative ground objection. Even at this stage of proceedings, the Registrar has the power under Paragraph 4(2), to require that the Application Mark include some indication that it is a collective mark. Nonetheless, even if this power is exercised, it does not prevent confusion via an economic link being drawn between the *Opponent's Earlier Blue Label Mark* and the *Application Mark* having regard to their shared common elements.
- (ii) The ground of objection under section 8(2)(b) succeeds for the *Opponent's Earlier Blue Label Mark* only.
- (iii) The ground of objection under section 8(4)(b)(i) fails as the *Opponent's Earlier Registered Marks* are not well known in Singapore.
- (iv) The ground of objection under section 8(4)(b)(ii) fails as the *Opponent's Earlier Registered Marks* are not well known to the public at large in Singapore.
- (v) The ground of objection under section 8(7)(a) succeeds.

Preliminary Issue

Interplay with the Geographical Indications Act (Cap 117B) ("GIA")

⁶ At [4] of the Applicant's SD.

⁷ At [5] of the Applicant's SD.

⁸ At [6] of the Applicant's SD.

13 The relevant law pertaining to GIs as at the relevant date, 11 June 2013 (“**Relevant Date**”), is the *GIA*⁹. The Applicant argued that it has obtained the registration of “Bayerisches Bier” as a Protected Geographical Indication (“*PGI*”)¹⁰ in the European Union (“EU”).

14 At the hearing, the Applicant clarified that it is not submitting that “Bavarian Beer is protected as a *GI* in Singapore as at the [R]elevant [D]ate”. In this regard, a *GI* is defined¹¹ as “any indication used in trade to identify goods as originating from a place¹²...and a given quality, reputation or other characteristic of the goods is essentially attributable to that place”.

15 Rather, its submission is that the Registrar should take into account the fact that the Applicant has obtained the registration of “Bayerisches Bier” as a *PGI* in the EU by way of background for the purposes of the objection under paragraph 4(1) of the First Schedule (see below).

16 Further, as only members of the Applicant’s association are allowed to use “Bayerisches Bier”, the public would not be misled as to the character or significance of the mark. In particular, it is unlikely to be taken to be something *other* than a collective mark.

17 The **Application Mark** in this instance consists of the word “Bavarian Beer” and *not* “Bayerisches Bier”. The Applicant’s argument is that “Bavarian Beer” is a translation of “Bayerisches Bier”. However, when probed further at the hearing, the Applicant admitted that it is not aware if this translation is protected as a *PGI* in the EU. Rather, the Applicant’s position is that the translation is protected via other means (for example as a collective mark) in other countries. The Applicant reiterated that it is not its proposition that “Bavarian Beer” is protected as a *GI* in Singapore as at the **Relevant Date**.

18 In light of the above, there is no need to look into this issue since this opposition is based on the Act and none of the objections raised obliges me to take any *GI* into account.

Paragraph 4 of the First Schedule

19 Section 60(2) of the Act provides:

⁹ This has since been superceded by the GI Act 2014 since 1 April 2019.

¹⁰ The Protected Geographical Indication (*PGI*) mark designates a product originating in a specific place, region or country whose given quality, reputation or other characteristic is essentially attributable to its geographical origin and at least one of the production steps of which takes place in the defined geographical area (see <https://uncommoneurope.eu/pdo-and-pgi/>).

¹¹ Section 2 of the *GIA*.

¹² See section 2 of the *GIA* as well; the place must be a “qualifying country” which has been further defined as “any country or territory which is (a) a member of the World Trade Organisation; (b) a party to the Paris Convention; or (c) designated by the Minister as a qualifying country under section 11”.

60(2) The provisions of this Act shall apply to collective marks *subject* to the provisions of the First Schedule.

[Emphasis in italics mine]

The provisions in the First Schedule set out additional requirements which a collective mark must comply with, beyond the requirements applicable to “normal” trade marks.

20 Paragraph 4 of the First Schedule provides:

Mark not to be misleading as to character or significance

4.—(1) A collective mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a collective mark.

(2) The Registrar may accordingly require that a mark in respect of which application is made for registration include some indication that it is a collective mark.

(3) Notwithstanding section 14(3),¹³ an application may be amended so as to comply with any such requirement.

The purpose of Paragraph 4 is to prevent any misconception as to the *type* of mark being applied for since a collective mark¹⁴ has a different function from a trade mark.¹⁵ As mentioned above, a collective mark identifies goods or services dealt with or provided in the course of trade by *any* member of the Applicant association, as opposed to *one specific* trader.

21 It is apposite to refer to the IPOS work manual (*IPOS Manual*) in relation to Collective Marks at Part 5:

5. MARK NOT TO BE MISLEADING AS TO CHARACTER OR SIGNIFICANCE

...an objection will be raised if the mark is likely to be taken as something *other* than the true designation of the mark, i.e. that it is more likely to be taken as an "ordinary" trade mark as opposed to a collective mark.

¹³ Section 14(3) provides:

14(3) In other respects, an application may be amended, at the request of the applicant, only by correcting —

(a) the name or address of the applicant;
(b) errors of wording or of copying; or
(c) obvious mistakes,

and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.

¹⁴ See section 60 of the Act, above.

¹⁵ Section 2 of the Act.

To overcome this objection the Registrar may require that the mark include some indication that it is a collective mark... This may be made in one of the following ways...

- *Amend* the representation of the mark to include the words "collective mark" within the representation of the mark. This form of amendment is permissible *notwithstanding* section 14(3) of the Act.

[Emphasis in italics mine]

22 At the hearing, when queried as to the nature of the objection under Paragraph 4,¹⁶ the Opponent argued that Paragraph 4 can be seen *both* in an absolute sense (where a mark is considered objectionable in and of itself) as well as a relative sense (where a mark is considered objectionable due to an earlier right).¹⁷ Nonetheless, the Opponent submitted that paragraph 4(2) only applies “when absolute (and not relative) ground objections have been raised against a collective mark application”.¹⁸

23 At first blush, it appears that Paragraph 4 is an absolute objection only. The United Kingdom’s Intellectual Property Office Trade Marks Manual (“*UK IPO Manual*”) for Certification and Collective Mark provides:^{19 20}

2.5 Misleading as to the nature of the mark

2.5.1 When will objection be raised?

...

Premier carpet fitters

(Collective mark for carpet fitting services)

There is little in this mark to indicate to the public that it is collective mark. It is therefore likely it will be taken as an ordinary trade mark as opposed to its true designation. An objection will therefore be raised.

24 In response to the Registrar’s request for further submissions,²¹ the Opponent maintained its stance that Paragraph 4 is to be seen *both* in an absolute sense as well as a

¹⁶ In particular, whether Paragraph 4 is an absolute or relative ground of objection, or whether it is a totally novel category of its own.

¹⁷ In this regard, the Opponent’s submissions are worded in both an absolute and relative sense ([146] – [153] OWS) although the Opponent seems to suggest that Paragraph 4 should be a relative ground of objection in its Notice of Opposition ([20] of the Amended Notice of Opposition).

¹⁸ See OFWS at [5].

¹⁹ See [149] OWS.

²⁰ See also *IPOS Manual* at Part 5 (above).

²¹ See above.

relative sense.²² In particular, the Opponent sought to support its stance that Paragraph 4 is also to be seen in a relative sense via [4.6.1] of the *IPOS Manual*:

In the event that the search reveals the existence of an earlier *identical* certification or “ordinary” trade mark for the same goods or services, this would be taken as prima facie evidence that the mark cannot serve the function of distinguishing goods / services or members of an association from those of non-members²³...**and is liable to mislead the public as regard the character or significance of the mark...**

[Emphasis the Applicant’s]

25 Although the above provision refers to an “identical” earlier mark²⁴ while in this instance the marks are merely “similar”, I accept that the above suggests that Paragraph 4 can be seen in a relative sense as well.

26 The next step is to ascertain if Paragraph 4 is applicable in the current case,²⁵ and if so, whether the Registrar can exercise his discretion under Paragraph 4(2) to “[a]mend the representation of the mark to include the words “collective mark” within the representation of the mark”.²⁶ In this regard, I am of the view that there is *nothing* in paragraph 4(2) to restrict its application only when paragraph 4(1) is raised in an absolute sense.²⁷

27 Having considered parties’ arguments,²⁸ I am of the view that Paragraph 4 is applicable to the current instance both in an absolute and a relative sense. In this regard, for the purposes of my remaining grounds of decision below, the word “collective mark” will be added to the *Application Mark* as follows:



28 Further, I agree with the Opponent that “the inclusion of the words “*Collective Mark*” does nothing to reduce the risk of confusion as between the *Application Mark* and [the *Opponent’s Earlier Marks*].” This is because the addition will not prevent an economic

²² See [3] OFWS.

²³ See *IPOS Manual*. For the record, I am of the view that section 7(1)(b) of the Act is not the appropriate objection to be raised; having regard to the context of this paragraph, the appropriate objection which should be raised is section 8 of the Act.

²⁴ See above *IPOS Manual* at [4.6.1].

²⁵ Whether in an absolute sense as well as a relative sense.

²⁶ See above. I accept that there is more than one way of exercising the discretion. Nonetheless I am of the view that this is the most direct way of putting the matter beyond doubt.

²⁷ See OFWS at [5]; the Opponent relied on paragraph 2.5 of the *UK IPO Manual* which is useful as a guide but nonetheless cannot be conclusive on the issue.

²⁸ [2] – [18] AFWS and [2] – [6] OFWS.

link²⁹ from being drawn between an earlier trade mark and a later collective mark having regard to their shared common elements (more below).

MAIN DECISION

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

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

8(2) A trade mark shall not be registered if because...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public.

Decision on Section 8(2)(b)

Step-by-step approach

30 In *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 (“*Staywell*”), the Court of Appeal re-affirmed the 3-step test approach in relation to an objection under section 8(2)(b) (see [15] and [55]):

- (i) The first two elements - namely similarity or identity of the marks and similarity or identity of the goods / services - are assessed individually before the final element which is assessed in the round.
- (ii) Once the two threshold requirements have been met, the issue of the likelihood of confusion arises and the tribunal / court is directed to look at (a) *how* similar the marks are, (b) *how* similar the goods / services are, and (c) given this, how likely the relevant segment of the public will be confused.

Similarity of Marks

31 The law in relation to this issue is as follows (*Staywell* at [15] to [30]):

- (i) The three aspects of similarity (i.e. visual, aural and conceptual similarities) are meant to guide the court’s inquiry. Trade-offs can occur among the three aspects of similarity.

²⁹ It is observed that there is no equivalent akin to paragraph 4 of the Second Schedule of the Act applicable for a collective mark. Thus, there is no prohibition against the proprietor of a collective mark to carry on a business involving the supply of goods or services of the kind sought to be registered for the collective mark.

- (ii) Technical distinctiveness is an integral factor in the marks-similarity inquiry. A mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it.
- (iii) While the components of a mark may be inherently technically distinctive, ultimately the ability of the mark to function as a strong badge of origin must be assessed by looking at the mark as a whole. Conversely, the components of a mark may not be inherently distinctive, but the sum of its parts may have sufficient technical distinctiveness.
- (iv) When speaking of the assessment of a mark as a whole, the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.
- (v) The similarity of marks is ultimately and inevitably a matter of impression rather than one that can be resolved as a quantitative or mechanistic exercise. The court must ultimately conclude whether the marks, when observed in their totality, are similar or dissimilar.
- (vi) The assessment of marks similarity is mark-for-mark without consideration of any external matter.

32 Further, the Court of Appeal provided in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941 at [40(c)] and [40(d)] ("**Hai Tong**"):

[40(c)] The relevant viewpoint is that of the average consumer who would exercise some care and a measure of good sense in making his or her purchases, not that of an unthinking person in a hurry.

[40(d)] It is assumed that the average consumer has "imperfect recollection" such that the two contesting marks are not to be compared or assessed side by side (and examined in detail). Instead, the court will consider the general impression that will likely be left by the essential or dominant features of the marks on the average consumer.

Opponent's Earlier Registered Marks

33 For ease of reference, the marks are:

S/N	<i>Opponent's Earlier Marks</i>	Class
<i>Opponent's Earlier Word Mark</i>		
1	BAVARIA HOLLAND BEER	T0913749F Class 32 Beer

S/N	Opponent's Earlier Marks	Class
Opponent's Earlier Device Mark		
2		T9907397B <u>Class 32</u> Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.
Opponent's Earlier Blue Label Mark		
3		T1008460J <u>Class 32</u> Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

The Opponent had informed the Registrar at the Pre-Hearing Review on 13 March 2019 that the main focus is on the **Opponent's Earlier Word Mark**, although it will also rely on the other two marks.

Distinctiveness

34 I am mindful of the Court of Appeal's guidance in *Staywell* that distinctiveness is a factor integrated into the visual, aural and conceptual analysis as to whether the competing marks are similar; it is not a separate step within the marks-similarity inquiry. However, for ease of analysis, I will summarise my findings on distinctiveness first, before applying them within the context of the mark-similarity analysis (this was also the approach taken by the Court of Appeal in *Hai Tong* at [26]).

Opponent's Earlier Word Mark

35 The Opponent submitted that "it is clear that on the face of all [the **Opponent's Earlier Marks**], the dominant, distinctive component is "Bavaria".³⁰

36 On the other hand, the Applicant argued that "[t]he words "Bavaria" and "Holland" are directly descriptive of geographical origin"³¹ and "[t]he word "Beer" is directly descriptive of the goods protected under [the **Opponent's Earlier Word Mark**]"³². Relying on *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 ("*Caesarstone*

³⁰ [37] OWS.

³¹ [22] AWS.

³² [23] AWS.

CA”) “[w]ords which are merely descriptive of the relevant goods will not be viewed as a distinctive element in a trade mark”.³³

37 It is obvious that “beer” is descriptive of the good at issue (above). However, I do not think that the same holds true for the words “Bavaria Holland”. For a start, it is trite that descriptive words *could* be distinctive for certain goods / services. The key is the *correlation* between the word and the good / service. In this regard, Justice Wei (as he then was) provided as follows in *Han’s (F & B) Pte Ltd v Gusttino World Pte Ltd* [2015] SGHC 39 (“*Hans*”) at [62]:

[62] Another example is a manufacturer who decides to use the mark “Slow Coach” for a range of running shoes that he is about to launch. Even though the words and phrase are not newly coined, *the meaning has little bearing on the product to which it is to be applied.*

[Emphasis in italics mine]

38 The Opponent’s position is “[i]t is entirely presumptuous to assume that the average Singaporean consumer would recognise that the word “Bavaria” is the English name of a state in Germany”.³⁴ The Opponent argued that while the ordinary dictionary meaning of “Bavaria” is “a state of southern Germany...”,³⁵ “[s]imilar to Swatch at [32], while this may be the ordinary dictionary meaning of “Bavaria”, the Registry has to adopt the viewpoint of the average consumer of Class 32 goods...[t]he English dictionary meaning of “Bavaria” is not the typical word that the average member of the Singapore public will use on a regular basis”.³⁶

39 I am of the view that the facts of *Swatch AG (Swatch SA) (Swatch Ltd)* [2019] SGIPOS 1 (“*Swatch*”) are rather unique and that a parallel cannot be drawn here. Rather, I am of the view that judicial notice can be taken into account that “Bavaria” is a German State and the average Singaporean, who has been described to be well travelled and not easily hoodwinked,³⁷ is unlikely to be ignorant of the same.

40 The Opponent further countered that “[t]o date, no evidence has been led by the Applicant that the average Singaporean consumer would link the word “Bavaria” with a German State in respect of the goods concerned”.³⁸

41 I think the reality is somewhere in the middle and an *indirect* connection could be made since German beer is a common item in establishments which serve alcohol. For the

³³ [23] AWS.

³⁴ [43(i)] OWS.

³⁵ [43(i)] OWS.

³⁶ [43(i)] OWS.

³⁷ *McDonald’s Corp v Future Enterprises Pte Ltd* [2005] 1 SLR(R) 177 at [64]:

[64] With widespread education and a public which is constantly exposed to the world, either through travel or the media, one should be slow to think that the average individual is easily deceived or hoodwinked...

³⁸ [43(i)] OWS.

avoidance of doubt, I come to this conclusion *sans* the Applicant’s evidence³⁹ that “Bavaria has strong...ties with Singapore”.^{40 41} In this regard, most of the evidence pertaining to this issue in the Applicant’s SD⁴² cannot be taken into account as the publications are dated after the **Relevant Date**.⁴³

42 Interestingly, the Applicant pointed out at the oral hearing that the Opponent had concocted the name as it describes a brewing method *originating from Bavaria*.⁴⁴ In any event, the Opponent argued that even if the word “Bavaria” is not as distinctive⁴⁵ as “swatch” (above), the word “Holland” is insufficient to distinguish the marks. I do not agree. Having regard to the low level of distinctiveness of “Bavaria”⁴⁶ I am of the view that “Holland” is sufficient to distinguish the marks.

43 Having regard to all of the above, “Bavaria” and “Holland” are respectively distinctive of the beer, albeit to a low extent.⁴⁷ The “juxtaposition and arrangement”⁴⁸ of “Bavaria Holland” also cannot be ignored such that overall, the **Opponent’s Earlier Word Mark** exudes a low level of inherent distinctiveness.

44 The Opponent also sought to rely on acquired distinctiveness.⁴⁹ The Opponent’s stance is that in practice, the Opponent is known as “Bavaria”. The Opponent pointed to “[t]he popularity and extensive use of [the **Opponent’s Earlier Marks**] which are fully detailed at...[83] to [91], and [102] [OWS]”.⁵⁰ The relevant information is extracted below.

45 The Opponent submitted that the volume of the Opponent’s products sold in Singapore are as follows:⁵¹

S/N	Year	Litres
1	2003	104,362
2	2004	168,062
3	2005	137,586

³⁹ [39] – [40] of the Applicant’s SD. See also below.

⁴⁰ [39(b)] Applicant’s SD.

⁴¹ As well as instances of the same listed in [39] of the Applicant’s SD.

⁴² See Exhibit N of the Applicant’s SD.

⁴³ Those which are dated on or before the **Relevant Date** do not link Oktoberfest / Bavaria / beer (see pages 215 and 217).

⁴⁴ See Exhibit PJMS-5 at page 197 of the Opponent’s SD, which contains a print out of the Opponent’s webpage about its history “The name Bavaria refers to the Bavarian brewing method which is the basis for brewing pilsner...”. The Applicant countered that although the Opponent was *inspired by* the Bavarian method, it has now been used in many countries. But that does not detract from the fact that the reason why “Bavaria” was first (and now) adopted is to describe a brewing method *originating from Bavaria*.

⁴⁵ See above.

⁴⁶ See above.

⁴⁷ It is trite that words describing places / locations can be distinctive for certain goods / services. For example, clearly “North Pole” would be distinctive of bananas.

⁴⁸ Using the Applicant’s terminology see [27] AWS.

⁴⁹ [41] OWS.

⁵⁰ As above.

⁵¹ [85] OWS and [18] of the Opponent’s SD.

4	2006	114,650
5	2007	116,631
6	2008	389,686
7	2009	511,175
8	2010	762,658
9	2011	1,195,271
10	2012	711,562
11	2013 ⁵²	909,915

46 The Opponent also deposed that in Singapore the sales figures⁵³ are as follows:

S/N	Year	Amount €	Amount SGD ⁵⁴
1	2008	218,072 ⁵⁵	452,870
2	2009	293,800 ⁵⁶	594,827
3	2010	416,458 ⁵⁷	753,373
4	2011	688,791 ⁵⁸	1,205,109
5	2012	438,898 ⁵⁹	705,002
6	2013 ⁶⁰	625,581 ⁶¹	1,039,778

47 In terms of local promotional expenditure,⁶² the figures are as follows:

S/N	Year	Amount €	Amount SGD ⁶³
1	2013 ⁶⁴	272,244	452,497

48 The modes of promotion in the local market include “...print, radio and television media, billboard advertising at prime public locations and on public buses. [The *Opponent’s Earlier Marks*] have also been featured at several high-profile public events, including the Singapore FHM model events and Singapore Night Festival”.⁶⁵

⁵² The *Relevant Date* is 11 June 2013. Nonetheless, the figure for this year is taken into account for reasons which will become apparent later.

⁵³ [86] OWS and [19] of the Opponent’s SD.

⁵⁴ All yearly exchange rates are obtained via ofx.com.

⁵⁵ Exchange rate of 2.0767.

⁵⁶ Exchange rate of 2.0246.

⁵⁷ Exchange rate of 1.8090.

⁵⁸ Exchange rate of 1.7496.

⁵⁹ Exchange rate of 1.6063.

⁶⁰ The *Relevant Date* is 11 June 2013. Nonetheless the figure for this year is taken into account for reasons provided below.

⁶¹ Exchange rate of 1.6621.

⁶² [88] OWS and [21] of the Opponent’s SD.

⁶³ All yearly exchange rates are obtained via ofx.com.

⁶⁴ The *Relevant Date* is 11 June 2013. Nonetheless, the figure for 2013 is taken into account, otherwise, there is no figure for this item. For parity, the 2013 figures for other items, such local sales figures, are also taken into account.

⁶⁵ See [88] OWS.

49 Those excerpts in the Opponent's SD relating to promotional material⁶⁶ which are too blur to decipher the date,⁶⁷ undated⁶⁸ or dated after the **Relevant Date**⁶⁹ are disregarded. It is observed that the mark which appeared on the material is mainly the **Opponent's Earlier Blue Label Mark**⁷⁰ and variants including:



⁷¹ as well as



⁷².

50 In relation to the public events, with the exception of the *Shin Min Arm-Wrestling Challenge* ("**Shin Min Challenge**") which occurred in 2012, the other events occurred after the **Relevant Date** and cannot be taken into account.⁷³ In this regard, it can be seen⁷⁴ that in addition to the **Opponent's Earlier Blue Label Mark**, variants of the Opponent's mark



include ⁷⁵.

51 The Opponent also submitted that its products are sold at numerous locations in Singapore since 1981, from large supermarkets such as NTUC and Cold Storage, to coffee shops in heavily populated residential areas.⁷⁶ The other avenues of sale include food and beverage establishments such as pubs⁷⁷ as well as via the internet.⁷⁸ Again, however, the Opponent's evidence pertaining to marketing collaterals used at the different locations⁷⁹ are either undated⁸⁰ or dated after the **Relevant Date**.⁸¹

⁶⁶ Exhibit PJMS-14 of the Opponent's SD.

⁶⁷ Page 428 of Opponent's SD.

⁶⁸ Pages 446 -448 of Opponent's SD.

⁶⁹ Page 442 of Opponent's SD.

⁷⁰ Page 416, 419 and 430 of Opponent's SD.

⁷¹ As above.

⁷² Page 460 of Opponent's SD.

⁷³ See [23] of the Opponent's SD.

⁷⁴ Exhibit PJMS-15 of the Opponent's SD at pages 476 – 480.

⁷⁵ Page 476 of the Opponent's SD.

⁷⁶ [89] OWS and [16] Opponent's SD.

⁷⁷ [16(a)] Opponent's SD

⁷⁸ [17] Opponent's SD.

⁷⁹ Exhibit PJMS-10 of the Opponent's SD.

⁸⁰ Page 341 of the Opponent's SD.

⁸¹ Page 354 of the Opponent's SD.

52 The Opponent also made several other contentions, and my comments are as follows:

- (i) The Opponent has not shown how the year in which the Opponent was first established, or the extent to which it has exported to and has made various applications / registrations around the world, help in establishing acquired distinctiveness in Singapore;⁸²
- (ii) In the same vein, it is unclear how the extent of worldwide sales⁸³ or worldwide advertising⁸⁴ affects the local market. Ditto for the engagement of international celebrities⁸⁵ and the use of international publications⁸⁶.
- (iii) With regard to the Opponent's marketing awards, only those which were dated before the **Relevant Date** can be taken into account. Further, it is unclear if the awards pertain to the Singapore market. In this regard, most of the certificates are not in English (although the explanations in the exhibits are in English).⁸⁷

53 In light of the above, the Opponent's reliance on acquired distinctiveness is not made out. In any event, it is unclear if acquired distinctiveness can be relied upon at this mark similarity stage.⁸⁸

Opponent's Earlier Device Mark

54 The Applicant argued that "[the **Opponent's Earlier Device Mark**]...includes the [device] which is complicated and outstanding...[such that]...the distinctiveness of [the **Opponent's Earlier Device Mark**] would thus lie in the [device] and...the specific arrangement and juxtaposition of [the **Opponent's Earlier Device Mark**] as a whole".⁸⁹

55 Even if, as alluded to above, "Bavaria Holland Beer" when considered as a whole is of low inherent distinctiveness, they cannot be ignored in the **Opponent's Earlier Device Mark** for they are of a specific architecture in the same. It is also observed that the words, that is, "Bavarian Holland Beer", are approximately of the same size as the device.

Opponent's Earlier Blue Label Mark

⁸² See [84] OWS and the Opponent's SD at [6], [8] and [9].

⁸³ See [86] OWS and Opponent's SD at [10].

⁸⁴ See [87] OWS and Opponent's SD at [11].

⁸⁵ See [87] OWS and Opponent's SD at [13].

⁸⁶ See [87] OWS.

⁸⁷ See page 328 of the Opponent's SD.

⁸⁸ The latest case in relation to this issue is *Monster Energy Company v Glamco Co, Ltd* [2018] SGHC 238 at [50] and [51]. Justice Chan seems to suggest that acquired distinctiveness *can* be taken into account at this stage although it was not made out there. See also *Monster Energy Company v NBA Properties Inc* [2018] SGIPOS 16 at [41] – [48].

⁸⁹ [29] AWS.

56 Similarly, the Applicant submitted that “[the **Opponent’s Earlier Blue Label Mark**] ...includes the blue and gold shield and label device...which is complicated and outstanding...[such that]...the distinctiveness of [the **Opponent’s Earlier Blue Label Mark**] would thus lie in [the blue and gold shield and label device] component and...the specific arrangement and juxtaposition and arrangement of [the **Opponent’s Earlier Blue Label Mark**] as a whole”.⁹⁰ I *disagree* with the Applicant in this regard.

57 In essence, the devices in the **Opponent’s Earlier Blue Label Mark** comprise of two “shields”, one of which forms the background of the mark (“Background Shield”) and the other, much smaller shield which contains a star device (“Star Shield”), positioned at the top centre. The word “Bavaria” is *conspicuously large* and positioned *right in the centre* of the Background Shield in bold font and in a contrasting colour. The word “Holland” is placed below “Bavaria” in a much smaller and cursive font. Relative to “Bavaria”, the word “Holland” is so inconspicuous that at times one can hardly decipher it at all as it blends into the Background Shield.

58 While the arrangement and juxtaposition of the various elements of the **Opponent’s Earlier Blue Label Mark** contributes to the overall distinctiveness of the mark, it is clear that the word “Bavaria” (taking the design of the word in totality) takes centre stage when the **Opponent’s Earlier Blue Label Mark** is assessed as a whole. Therefore, when assessed as a whole, I am of the view that the distinctiveness of the **Opponent’s Earlier Blue Label Mark** lies in the specific arrangement and juxtaposition of the various elements of the **Opponent’s Earlier Blue Label Mark**, with particular emphasis on the word “Bavaria”.

59 For the avoidance of doubt, I come to the above conclusion without any reliance on *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 (for the proposition that “it would be extremely rare for a consumer to describe the product by its pictorial element”)⁹¹ and *Hu Kim Ai T/A Geneve Timepiece of Registered Trade Mark T99/08070G In The Name of Liew Yew Thoong T/A Crystal Hour* [2007] SGIPOS 11 (that “there is a tendency for the consumers to refer to the marks by that word, for words speak in marks”).⁹²

60 In conclusion, I am of the view that:

<i>S/N</i>	<i>Opponent’s Earlier Marks</i>	<i>Assessment of Distinctiveness?</i>
<i>Opponent’s Earlier Word Mark</i>		
1	BAVARIA HOLLAND BEER	The distinctiveness of the Opponent’s Earlier Word Mark lies in the respective words “Bavaria” and “Holland” as well as the “specific juxtaposition and arrangement of the same” in the Opponent’s Earlier Word Mark .
<i>Opponent’s Earlier Device Mark</i>		

⁹⁰ [31] AWS.

⁹¹ [38] OWS.

⁹² [39] OWS.

S/N	<i>Opponent's Earlier Marks</i>	<i>Assessment of Distinctiveness?</i>
2		Similarly, the distinctiveness of the <i>Opponent's Earlier Device Mark</i> lies in the device and the words “Bavaria Holland Beer” and the specific arrangement and juxtaposition of the different elements in the <i>Opponent's Earlier Device Mark</i> as a whole.
<i>Opponent's Earlier Blue Label Mark</i>		
3		The distinctiveness of the <i>Opponent's Earlier Blue Label Mark</i> lies in the specific arrangement and juxtaposition of the various elements in the <i>Opponent's Earlier Blue Label Mark</i> , with particular emphasis on the word “Bavaria”, when the mark is assessed as a whole.

Application Mark

61 On the other hand, as alluded to above, the Applicant conceded⁹³ that “[t]he *Application Mark* consists of the *directly descriptive* phrase “Bavarian Beer” which designates beer as originating from Bavaria...the *Application Mark* would ordinarily be devoid of distinctive character and unregistrable as a trademark but for the fact that the *Application Mark* is a collective mark...” (emphasis as underlined by the Applicant).

62 In this regard, Paragraph 3(1) of the First Schedule provides:

3.—(1) *Notwithstanding* section 7(1)(c), a collective mark *may* be registered which consists of signs or indications which may serve, in trade, to designate the *geographical origin* of the goods or services.⁹⁴

[Emphasis in italics mine]

Section 7(1)(c) provides:

7.—(1) The following *shall* not be registered:

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services...

⁹³ [18] AWS.

⁹⁴ See also Paragraph 3(2):

However, the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters (in particular, by a person who is entitled to use a geographical name).

63 The Applicant’s arguments, taken to its logical conclusion, would mean that a GI applied for as a collective mark would be impervious to relative ground objections, which cannot be correct. In particular, by seeking to protect a geographical indication (“GI”)⁹⁵ as a collective mark under the Act, the collective mark must necessarily exude some modicum of distinctiveness so as to distinguish the relevant goods from goods which are not provided by members of that association.⁹⁶

64 The issue of distinctiveness of the *Application Mark* is intertwined with the issue of “Economic Connection versus Geographical Connection” (below). The Applicant made extensive submissions in relation to the latter in its further written submissions and they are relevant here as well.

65 In essence, the Applicant submitted that:⁹⁷

- (i) as the primary function of an ordinary trade mark is to indicate commercial origin, protection of the same must consider whether there is confusion as to *commercial origin*;
- (ii) as the primary function of a *GI (protected under the collective mark regime)* is to indicate geographical origin, protection of the same must consider whether there is confusion as to *geographical origin*;
- (iii) the above is so taking into account the nature of the respective marks and their essential *function*.

[Emphasis in italics mine].

66 As alluded to above, the registration of collective marks is governed by Section 60 and the First Schedule of the Act:

60.—(1) A collective mark is a sign used, or intended to be used, in relation to goods or services dealt with or provided in the course of trade *by members of an association to distinguish* those goods or services from goods or services so dealt with or provided by persons who are *not members of the association*.

(2) The provisions of this Act shall apply to collective marks *subject* to the provisions of the First Schedule.

First Schedule:

[2] In relation to a collective mark, the reference in the definition of “trade mark” in section 2(1) to distinguishing goods or services dealt with or provided in the course of trade by a person from those so dealt with or provided by any other person *shall be construed* as a reference to *distinguishing* goods or services dealt with or provided in the course of trade *by members of an*

⁹⁵ See section 2 of the GIA.

⁹⁶ This flows logically from the definition for a collective mark in section 60 of the Act.

⁹⁷ [62] AFWS.

association which is the proprietor of the mark from those so dealt with or provided by persons who are *not members of the association*.

[Emphasis in italics mine]

67 The above provisions suggest a collective mark possesses *an origin function* in relation to goods or services dealt with or provided in the course of trade *by members of an association*, as such *distinguishing* these from those so dealt with or provided by persons who are *not members of the association*. If so, a collective mark *must* be capable of functioning as a trade source or economic source. This would *include* any *GI*, which is sought to be *protected as a collective mark*.

68 The above necessarily implies that there is a *difference* between seeking to protect a *GI* as a collective mark under the Act versus as a *GI* under the *GIA*. In its further submissions, the Applicant relied on texts as to the differences between a trade mark and a geographical indication.⁹⁸ However, I think there is a need to tread with care as the texts are expounding on the concept of a *GI per se*, and not *GI* as a collective mark.

69 In this regard, *Kerly's Law of Trade Marks and Trade Names (Sweet & Maxwell, 16th Ed)* by James Mellor QC, *et al.* the learned authors state:⁹⁹

It is *not clear* why an indication which could be registered as a PGI should also be proper subject matter for a collective mark as the two systems, that for the protection of PDOs¹⁰⁰ and PGIs¹⁰¹ and that for registered trade marks, have *different* and potentially conflicting scopes of protection.

[Emphasis in italics mine]

70 The crux of the matter is the reconciliation of Paragraph 2 of the First Schedule with Paragraph 3. In my view, Paragraph 3 of the First Schedule must be read *in tandem* with Paragraph 2 of the same to explain their *co-existence* within the same schedule regulating collective marks. Seen in that light, the extent of the descriptiveness of a collective mark must not be such that it completely obliterates the origin function of a mark.

71 In *Law of Trade Marks and Passing off in Singapore (3rd Ed, Sweet & Maxwell)* by *Tan Tee Jim*, the learned author states as follows in relation to Paragraph 3 of the First Schedule:¹⁰²

⁹⁸ See and [59] and [60] AFWS.

⁹⁹ See footnote 17 to [14-009]; in the context of the equivalent of Paragraph 3 of the First Schedule, above.

¹⁰⁰ The Protected Designations of Origin (“PDO”) mark identifies a product originating in a specific place, region or country, whose quality or characteristics are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors the production, processing and preparation steps of which all take place in the defined geographical area and in line with the strict production regulations established (see <https://uncommoneurope.eu/pdo-and-pgi/>).

¹⁰¹ See above.

¹⁰² See footnote 175 to [3.121].

In general, the Registrar will accept geographical names as collective mark *only if* they are capable of *distinguishing* goods and services of members of an association from those of non-members...

[Emphasis in italics mine]

72 I also find support in the *UK IPO Manual*:

2.1.4 Section 3(1) - Geographical names and protected geographical indications (“GIs”)

Geographical names in general

A geographical name will normally fall foul of Section 3(1)(c)¹⁰³ of the Act if it is likely to be required by other traders to designate the geographical origin of the goods or services sought for registration. However, Schedule 1 (collective marks)...of the Act provides the Registrar with discretion to accept geographical indications as...collective marks...

The Registrar’s practice is that *a geographical name will only be accepted as a...collective mark if it has the capacity to perform its distinguishing function*. Certain names will be unable to perform the distinguishing function...

In practical terms, the Registrar will accept geographical names that would otherwise be debarred under Section 3(1)(c) *if the applicant can establish that the geographical name is capable of distinguishing the goods and services of members of the applicant association (collective marks)...*and distinguishing them from other goods/services which are not....

[Emphasis in italics mine]

73 All of the above suggest that a collective mark *must be distinctive* (albeit perhaps on the lower side of the scale).

74 Having concluded that the ***Application Mark*** must possess some distinctive element, the next step would be to determine the aspect of the ***Application Mark*** which exudes distinctiveness. In this regard, as alluded to above, ***Caesarstone CA*** clarified¹⁰⁴ that words which are simply descriptive of goods would not be viewed as distinctive component of a mark.

75 Here, the ***Application Mark*** is applied for “beers”¹⁰⁵. Relatively speaking, the word “Bavarian” is clearly more important than the word “beer” in terms of any origin function.

¹⁰³ This is *in pari materia* to section 7(1)(c) of the Act.

¹⁰⁴ See above at [41] of ***Caesarstone CA***.

¹⁰⁵ See above.

Visual Similarity

76 For ease of reference only, the marks are as follows:

S/N	<i>Opponent's Earlier Marks</i>	<i>Application Mark</i>
	<i>Opponent's Earlier Word Mark</i>	BAVARIAN BEER <i>Collective Mark</i> ¹⁰⁶
1	BAVARIA HOLLAND BEER	
	<i>Opponent's Earlier Device Mark</i>	
2		
	<i>Opponent's Earlier Blue Label Mark</i>	
3		

Opponent's Earlier Word Mark

77 I have earlier concluded above that the respective words “Bavaria” and “Holland” as well as the “specific juxtaposition and arrangement” of the same confers on the **Opponent's Earlier Word Mark** a low level of inherent distinctiveness. When compared to the Application Mark (which is also distinctive to a low extent)¹⁰⁷ it is obvious that the *Opponent's Earlier Word Mark* has an *additional* element “Holland”.

78 In light of the above, the marks are visually more dissimilar than similar. In coming to this conclusion, I am of the view that the words “Collective Mark” does not add much to the comparison process (see above). If anything, the words simply further differentiate the marks.

Opponent's Earlier Device Mark and Opponent's Earlier Blue Label Mark

79 Similarly, I have concluded above that the distinctiveness of the **Opponent's Earlier Device Mark** lies in the specific arrangement and juxtaposition of the device and the words “Bavaria Holland Beer” (as per the design) as a whole.

80 For the purposes of comparing composite marks, the guidance in *Hai Tong* at [62] is helpful:¹⁰⁸

¹⁰⁶ See above.

¹⁰⁷ See above.

¹⁰⁸ See also [50] OWS.

(b) The visual similarity of two contesting marks or signs must normally be assessed by reference to the overall impressions created by the marks or signs, bearing in mind their distinctive and dominant components. When the other components of a complex mark or sign are of negligible significance, it is permissible to make the comparison solely on the basis of any dominant element(s).

(c) The overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components...

(d) The textual component of a composite mark or sign *could* (but will not necessarily or always) be the dominant component of the mark or sign. Some instances where this might be the case include where:

- (i) The two marks or signs in question each contain a similar device. The overall resemblance between them may then be diminished if they bear words which are entirely different from each other...
- (ii) **The textual component is large, and is in a prominent location** in relation to the other components or stands out from the background of the mark or sign...
- (iii) The textual component is *in itself* already widely known...
- (iv) The composite mark or sign is applied to goods or services marketed or sold primarily through *online* trade channels...

(e) The device component has been found to be an equally significant, if not the dominant, component of a composite mark or sign where:

- (i) the device is significant and large...
- (ii) the accompanying word(s) are devoid of any distinctive character, or are purely descriptive of the device component... or
- (iii) the device component is of a **complicated** nature...

But usually not where:

- (iv) the device is simple and will not evoke any particular concept for the average consumer...
- (v) the device component does not attract the attention of the average consumer of the goods in question because such a consumer is regularly confronted with similar images in relation to those goods...
- (vi) the device component is more likely to be perceived as a decorative element rather than as an element indicating commercial origin...

[Emphasis in bold mine]

81 Applying the above, it is apparent that the significance of the devices in the *Opponent's Earlier Blue Label Mark* is different from that in the *Opponent's Earlier Device Mark*. For one, the highly complex device in the *Opponent's Earlier Device Mark* takes up about half of the mark and is placed above the words "Bavaria Holland Beer".

82 Accordingly, the *Application Mark* is also visually more dissimilar than similar in comparison to the *Opponent's Earlier Device Mark*. Similarly, as alluded to above, in coming to this conclusion, I am of the view that the words "Collective Mark" do not add much to the comparison process (see above) and that, if anything, the words simply further differentiate the marks.

83 The *inverse* is true for the *Opponent's Earlier Blue Label Mark*. As alluded to above, the Background Shield merely forms the background as a contrast to the word "Bavaria". The Background Shield assists in drawing the customer's attention to the word "Bavaria", especially given its size, positioning and contrast. As alluded to above, the word "Holland" is inconspicuous in the whole scheme of the mark. The Star Shield also clearly pales in terms of size in comparison to the word "Bavaria", despite its position and design.

84 At the oral hearing, the Applicant argued that the word "Bavaria" is so descriptive that despite its size, it would not be taken as the distinctive component. That could be true in some cases, but I am of the view that this is not so for the *Opponent's Earlier Blue Label Mark*.

85 Having regard to the above, the *Application Mark* is *visually more similar than dissimilar* when compared to the *Opponent's Earlier Blue Label Mark*. As indicated above, in coming to this conclusion, I am of the view that the words "Collective Mark" do not add much to the comparison process (see above); specifically, any additional differentiation is not sufficient to distinguish the marks.

Conclusion

86 In conclusion, taken as wholes, both the *Opponent's Earlier Word Mark* and the *Opponent's Earlier Device Mark* are visually more dissimilar than similar while the *opposite* is so for the *Opponent's Earlier Blue Label Mark*.

Aural Similarity

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

88 Before I proceed any further, as submitted by the Applicant,¹⁰⁹ “the device in the mark is to be disregarded as it is irrelevant in the aural analysis”.¹¹⁰ Thus, the analysis below only applies to the text, “Bavarian Holland Beer”.

89 For parity of analysis, I am of the view that the Dominant Component Approach is not appropriate in this instance as the *Opponent’s Earlier Device Mark* does not have any dominant distinctive components.

90 However, I disagree with the Applicant that “a strict quantitative analysis considering the number of similar and dissimilar syllables is also unrealistic...[such that] [u]ltimately, the degree of aural similarity should be assessed based on first principles from the perspective of the average consumer”.¹¹¹ In this regard, I am of the view that *Apple Inc v Swatch AG* [2018] SGIPOS 15 (relied on by the Applicant) can be distinguished from the current case in that the marks in contention there are highly similar¹¹² in contrast to the current case.

91 Returning to the Quantitative Assessment Approach in this case, here the words in contention are “Ba-va-ria Hol-land Beer” versus “Ba-va-rian Beer”. Firstly, I am of the view that the omission of the suffix letter “-N” in the *Opponent’s Earlier Marks* does not assist in differentiating the marks, having regard to the propensity for slurring at the end of a word. Accordingly, as all four syllables of the *Opponent’s Earlier Marks* can be found in the *Application Mark*, I am of the view that the marks are aurally more similar than dissimilar.

Conclusion

92 In light of the above, the *Application Mark* are *aurally more similar than dissimilar* in comparison to the *Opponent’s Earlier Marks*. In coming to this conclusion, I am of the view that the words “Collective Mark” do not add much to the comparison process (see above). Specifically, any difference added is not sufficient to distinguish the marks.¹¹³

Conceptual Similarity

93 The Court of Appeal in *Staywell* expounded at [35] as follows:

[35] ...Unlike the aural analysis, which involves the utterance of the syllables without exploring the composite meaning embodied by the words, the conceptual analysis seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole...*Greater care* is therefore needed in considering what the conceptually dominant component of a composite mark is, because the idea connoted by each component might be very different from the sum of its parts...

¹⁰⁹ [48] AWS.

¹¹⁰ Citing *Caesarstone CA* at [47].

¹¹¹ [46] AWS.

¹¹² THINK DIFFERENT versus TICK DIFFERENT.

¹¹³ See *Hans* at [137].

[Emphasis in italics mine]

94 Having regard to my earlier conclusion on the issue of distinctiveness:

<i>S/N</i>	<i>Opponent's Earlier Marks</i>	<i>Conceptually similar?</i>
<i>Opponent's Earlier Word Mark</i>		
1	BAVARIA HOLLAND BEER	<ul style="list-style-type: none"> • Both marks are pure word marks. • The distinctiveness of the <i>Opponent's Earlier Word Mark</i> lies in the respective words “Bavaria” and “Holland” as well as the specific juxtaposition and arrangement of the same. • On the other hand, the <i>Application Mark</i> is distinctive at the lower end of the spectrum (mainly on the word “Bavarian”). • The word “Bavarian” in the <i>Application Mark</i> also connotes the idea of possessiveness which is absent from the <i>Opponent's Earlier Word Mark</i>. • Thus, the marks are conceptually more dissimilar than similar.
<i>Opponent's Earlier Device Mark</i>		
2		<ul style="list-style-type: none"> • The <i>Application Mark</i> is a pure word mark while the <i>Opponent's Earlier Device Mark</i> is a composite mark. • The <i>Opponent's Earlier Device Mark</i> has no dominant components and any distinctiveness lies in the specific juxtaposition and arrangement of the different elements. • On the other hand, the <i>Application Mark</i> is distinctive at the lower end of the spectrum. • The word “Bavarian” in the <i>Application Mark</i> also connotes the idea of possessiveness which is absent from the <i>Opponent's Earlier Word Mark</i>. • Overall, the marks are conceptually more dissimilar than similar.
<i>Opponent's Earlier Blue Label Mark</i>		

S/N	<i>Opponent's Earlier Marks</i>	<i>Conceptually similar?</i>
3		<ul style="list-style-type: none"> • The <i>Application Mark</i> is a pure word mark while the <i>Opponent's Earlier Blue Label Mark</i> is a composite mark. • The distinctiveness of the <i>Opponent's Earlier Blue Label Mark</i> lies in the specific arrangement and juxtaposition of the different elements, with particular <i>emphasis</i> on the word "Bavaria". • On the other hand, the <i>Application Mark</i> is distinctive at the lower end of the spectrum (mainly on the word "Bavarian"). • The word "Bavarian" in the <i>Application Mark</i> also connotes the idea of possessiveness which is absent from the <i>Opponent's Earlier Word Mark</i>. • On balance, the marks are conceptually slightly more similar than dissimilar.

95 Taking all of the above into consideration, I am of the view that the *Opponent's Earlier Word Mark* and the *Opponent's Earlier Device Mark* are conceptually more dissimilar than similar to the *Application Mark*, while the *Opponent's Earlier Blue Label Mark* is *conceptually slightly more similar than dissimilar* compared to the *Application Mark*.

Conclusion on the similarity of marks

96 It is to be recalled that:

- (i) The court must ultimately conclude whether the marks, when observed in their totality, are similar rather than dissimilar. In this regard, trade-offs can occur among the three aspects of similarity.
- (ii) The average consumer:
 - (a) has an "imperfect recollection" and there is a need to consider the general impression that will likely be left by the dominant features of the marks.
 - (b) is one who would exercise some care and a measure of good sense in making his or her purchases, not that of an unthinking person in a hurry.

97 I have concluded above that:

<i>S/N</i>	<i>Opponent's Earlier Marks</i>	<i>More similar or dissimilar?</i>
<i>Opponent's Earlier Word Mark</i>		
1	BAVARIA HOLLAND BEER	<ul style="list-style-type: none"> • Visually more dissimilar than similar • Aurally more similar than dissimilar • Conceptually more dissimilar than similar
<i>Opponent's Earlier Device Mark</i>		
2		<ul style="list-style-type: none"> • Visually more dissimilar than similar • Aurally more similar than dissimilar • Conceptually more dissimilar than similar
<i>Opponent's Earlier Blue Label Mark</i>		
3		<ul style="list-style-type: none"> • Visually more similar than dissimilar. • Aurally more similar than dissimilar • Conceptually slightly more similar than similar

98 In light of all the above, in my view, the ***Application Mark*** is, overall:

- (i) More *dissimilar than similar* in comparison to the ***Opponent's Earlier Word Mark***;
- (ii) More *dissimilar than similar* in comparison to the ***Opponent's Earlier Device Mark***
- (iii) More *similar than dissimilar* in comparison to the ***Opponent's Earlier Blue Label Mark***.

99 Having regard to the 3-step test, my conclusion above ends the inquiry with regard to the ***Opponent's Earlier Device Mark*** and the ***Opponent's Earlier Word Mark*** in relation to the objection under Section 8(2)(b). The discussion below therefore pertains only to the ***Opponent's Earlier Blue Label Mark***.

Similarity of Goods / Services

100 For ease of reference, the relevant goods and services are as follows:

<i>Opponent's Earlier Blue Label Mark</i>	<i>Application Mark</i>
<u>Class 32</u> Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.	<u>Class 32</u> Beers.

101 It is apparent that this element has been satisfied as the item “beers” appears for both marks.

Likelihood of Confusion

102 The relevant principles for assessing likelihood of confusion have been expounded by the Court of Appeal in *Staywell*:

- (i) In opposition proceedings, the inquiry must take into account the full range of the competing monopoly rights that are already enjoyed on the one hand, namely the *actual and notional fair uses* to which the incumbent proprietor has or might fairly put his registered trade mark, and compare this against the *full range of such rights* sought by the applicant *by reference to any actual use by the applicant (assuming there has been prior use) as well as notional fair uses* to which the applicant may put his mark should registration be granted. This issue is not in contention in this case (*Staywell* at [60]).
- (ii) Once similarity between the competing marks and goods or services has been established, the *impact* of these similarities on the relevant consumers' ability to understand where those goods and services originate from falls to be considered. The only relevant confusion is that which results from the similarity between marks and goods or services. However, the plain words of section 8(2) do *not* have the effect of making a finding of confusion automatic upon the establishment of similarity of marks and goods or services (*Staywell* at [64]).
- (iii) On the effect of the foregoing (i.e. similarity of marks and goods or services) on the relevant segment of the public – *extraneous* factors may be considered to the extent that they inform the court as to how the *similarity of marks and goods* will likely *affect* the consumer's perception as to the source of the goods (*Staywell* at [83]).
- (iv) The following represents a non-exhaustive list of factors which are regarded as admissible in the confusion inquiry (*Staywell* at [96]):
 - (a) Factors relating to the impact of *marks-similarity* on consumer perception:
 - (1) the *degree of similarity* of the marks themselves;
 - (2) the *reputation* of the marks (a strong reputation does *not* necessarily equate to a higher likelihood of confusion, and could in fact have the contrary effect);
 - (3) the *impression* given by the marks; and
 - (4) the *possibility of imperfect recollection* of the marks.
 - (b) Factors relating to the impact of *goods-similarity* on consumer perception (factors concerning the very nature of the goods without implicating any steps that are taken by the trader to differentiate the goods).

- (1) The *normal way in, or the circumstances under, which consumers would purchase goods of that type*;
- (2) Whether the products are *expensive or inexpensive items*;
- (3) Whether they would tend to *command a greater or lesser degree of fastidiousness and attention* on the part of prospective purchasers; and
- (4) The *likely characteristics of the relevant consumers* and whether the relevant consumers would or would not tend to apply care or have *specialist knowledge* in making the purchase.

[Emphasis as underlined mine]

Factors relating to the impact of marks-similarity

103 I have concluded above that the ***Application Mark*** is overall more similar than dissimilar in comparison to the ***Opponent's Earlier Blue Label Mark***. As beers are usually displayed on shelves for sale, it is the visual component which is crucial. In this regard, I have earlier concluded that the marks are visually more similar than dissimilar.

104 In relation to the *reputation* of the ***Opponent's Earlier Blue Label Mark***, I have already indicated above (in relation to the issue of acquired distinctiveness) that most of the evidence cannot be taken into account such that there cannot be any reputation to speak of.

105 On the other hand, the Applicant sought to tender evidence as to its sales in Singapore:¹¹⁴

S/N	Year ¹¹⁵	Singapore (converted into litres) ¹¹⁶
1	2003	238,800
2	2004	300,600
3	2005	356,900
4	2006	436,800
5	2007	537,400
6	2008	6631,800
7	2009	795,600
8	2010	1,123,500
9	2011	1,438,700
10	2012	1,666,900
11	2013 ¹¹⁷	2,069,200

¹¹⁴ See Exhibit K at pages 145 – 149 of the Applicant's SD.

¹¹⁵ The figures for the period after the ***Relevant Date*** are excluded; however, for parity of comparison (above), the figure for 2013 is included below.

¹¹⁶ See Exhibit K at page 148 of the Applicant's SD.

¹¹⁷ Note above.

106 Crucially, it is unclear as to the form in which the ***Application Mark*** appears on the relevant goods. In this regard, the Applicant tendered evidence¹¹⁸ to show how the ***Application Mark*** has been used in Singapore. However, the evidence cannot be taken into account as they are undated.

107 In light of the above, little weight, if any, can be accorded to the evidence of use of the ***Application Mark*** in Singapore.

Typical use of a Collective Mark as a Secondary Mark

108 Given that the ***Application Mark*** here is a collective mark, one issue which arises is the types of *notional* use for the same. The Applicant submitted:¹¹⁹

[32] ...the nature of the ***Application Mark*** (being a collective mark) will also lessen the likelihood of confusion as collective marks are *normally used as a secondary mark* in the course of trade in addition to a primary trade source identified (a normal trademark)...

[Emphasis in italics mine]

109 In response to the Registrar's request for further submissions, the Applicant submitted.¹²⁰

[29] The notional fair use of the ***Application Mark*** in this case must be informed by the *inherent nature of collective marks* and *mandatory compliance with the Regulations* governing the use of collective marks...

110 The Applicant continued:

[33] The intrinsic nature of the ***Application Mark*** as a collective mark is thus relevant to the likelihood of confusion analysis and it is submitted that a collective mark is, by nature, typically used as a secondary mark. This is further supported by the *IPOS Work Manual* at page 9 where it was stated:

A collective mark is ***typically*** used by companies alongside their own trade marks to indicate their membership in a certain association

[Emphasis in bold the Applicant's; emphasis in italics mine]

111 The relevant regulation relating to the use of marks provides:¹²¹

7 Terms of Use

¹¹⁸ At Exhibit L at pages 150 – 168 of the Applicant's SD.

¹¹⁹ [32] ARWS.

¹²⁰ [27] – [34] AFWS.

¹²¹ See Exhibit A at Page 36 of the Applicant's SD at [7(2)] of the Regulations.

(2) The collective trademarks *may* be used in combination with the company's own name or company logo or own trademarks used to identify printed materials, business documents, stationery, invoices, packaging, in particular for bottled beers, or in advertising, in any other manner...

[Emphasis in italics mine]

112 Having regard to the above, my comments are as follows:

- (i) notional uses would include *more* than just typical use. The fact that “[a] collective mark is *typically* used by companies alongside their own trade marks to indicate their membership in a certain association” is merely *one* instance of notional use.
- (ii) This is consistent with the regulation (above), where it stated that it is *not* mandatory that the ***Application Mark*** be used in combination with the mark of a member of the Applicant.

113 In summary, notional uses of the Application Mark (which is a collective mark) would include *more* than the Application Mark used as a secondary mark. For clarity, I agree with the Applicant¹²² that the regulations *can* be considered at this stage of the process having regard to *Staywell*.¹²³

114 A corollary of the above is whether there is a need to take into account the primary mark since the ***Application Mark***, as a collective mark, would typically be used as a secondary mark. In this regard, both parties (in my view rightly) agree that it would be too speculative and out of the scope of the current application to do so.¹²⁴

Economic Connection versus Geographical Connection

115 The Applicant submitted that another issue which arises at this stage is whether there can ever be an economic connection (and thus confusion) in this instance, where the ***Application Mark*** is a *GI* sought to be protected as a collective mark under the Act:¹²⁵

[43(a)] [H]aving regard to the fact that the ***Application Mark*** consists exclusively of descriptive words, there can only be, at most, a link as to geographical origin between the marks but *there cannot be any link as to economic origin* and thus no likelihood of confusion...

[Emphasis in italics mine]

¹²² See above.

¹²³ The Opponent disputed the applicability of the regulations, see [13] - [22] of the OFWS.

¹²⁴ [29] OFWS and [37] - [38] AFWS.

¹²⁵ [43] AFWS.

116 I have already dealt with this issue above in relation to the distinctiveness of the *Application Mark* and will not repeat my analysis here. As the *Application Mark* is sought to be registered as a collective mark under the Act, it *must* be capable of functioning as a trade source or economic source. At most, it can be said that the mark is not as strong a mark, but *not* to the extent that no economic link can be drawn.

Factors relating to the impact of goods-similarity

117 In relation to goods-similarity, I agree with the Opponent that it is not open to the Applicant to argue that¹²⁶ the channels through which the Applicant has made its beer available are “niche”, while those offered by the Opponent are “mass market” in light of *Staywell*. The general mode of purchase for beer is via food and beverage establishments, stores, and online shopping channels.

118 I also agree with the Opponent that beers are generally not too expensive. While I agree that they will not be as cheap as “everyday consumables”,¹²⁷ due to the tax imposed on alcoholic drinks,¹²⁸ I do not think that they are so expensive as to warrant a high degree of attention. In coming to this conclusion, beer in itself must be assessed as a *type* of good, having regard to *Staywell*.

119 This naturally flows into the issue of the *likely characteristics* of the relevant consumers and whether they would or would not apply care or have *specialist knowledge* in making the purchase. The Applicant argued that the consumers would be brand conscious¹²⁹ / aware of the significance of the geographical origin of beers. In particular, the Applicant relied on the case of *Barnsley Brewery Co Ltd v RBNB* [1997] FSR 462 for the proposition that “general beer drinkers [would be]...conscious that beer from certain regions was particularly good”.¹³⁰

120 The above would be true for one end of the spectrum of consumers of beer. However, a typical consumer of beer would be somewhere between a consumer of craft beers at one end and a consumer of beers available from your neighbourhood coffee shops at the other end. I think the typical beer drinker would not be as *fastidious* as the Applicant would like to portray.

121 Thus, having regard to the usual factors relating to the impact of marks-similarity and good-similarity, and having regard to my finding that the *Application Mark* is overall *more similar than dissimilar* in comparison to the *Opponent’s Earlier Blue Label Mark*, there is a *likelihood of confusion* that they are one and the same or are at least economically linked.

¹²⁶ [69] OWS.

¹²⁷ [33] ARWS.

¹²⁸ [33(a)] ARWS.

¹²⁹ See [35] ARWS.

¹³⁰ See ARWS at [36(a)] and *Mobil Petroleum Co, Inc v Hyundai Mobis* [2010] 1 SLR 512 at [50].

Conclusion on Section 8(2)(b)

122 The ground of opposition under Section 8(2)(b) therefore succeeds on the basis of the ***Opponent's Earlier Blue Label Mark***.

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

123 Section 8(4) of the Act reads:

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

- (a) the earlier trade mark is well known in Singapore; and
- (b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —
 - (i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark...

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

Similarity of marks

124 In relation to this ground, it is clear that the first element that must be satisfied is that "the whole or essential part of the trade mark must be identical or similar to an earlier mark". This element is essentially the same as the similar element under section 8(2)(b) (see *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA (Sarika CA)* [2013] 1 SLR 531 at [70] and [71]).

125 In relation to this element, my conclusion is the same in relation to the objection under section 8(2)(b). Thus, the analysis below will simply focus on the ***Opponent's Earlier Blue Label Mark***.

Well-known in Singapore

126 The critical question is whether the ***Opponent's Earlier Blue Label Mark***:



is well known in Singapore at the ***Relevant Date***.

127 The definition of a well known trade mark is provided in section 2 of the Act:

2.—(1) In this Act, unless the context otherwise requires —

“well known trade mark” means —

- (a) any registered trade mark that is well known in Singapore; or
- (b) any unregistered trade mark that is well known in Singapore and that belongs to a person who —

- (i) is a national of a Convention country; or
- (ii) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country, whether or not that person carries on business, or has any goodwill, in Singapore;

128 Further, section 2(7), (8) and (9) of the Act is relevant for the concept of “well known in Singapore”. Section 2(7) of the Act states:

Subject to subsection (8), in deciding, for the purposes of this Act, whether a trade mark is well known in Singapore, it shall be relevant to take into account any matter from which it may be inferred that the trade mark is well known, including such of the following matters as may be relevant:

- (a) the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;
- (b) the duration, extent and geographical area of —
 - (i) any use of the trade mark; or
 - (ii) any promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied;
- (c) any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application;
- (d) any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory;
- (e) any value associated with the trade mark.

Section 2(8) of the Act reads:

Where it is determined that a trade mark is well known to any relevant sector of the public in Singapore, the trade mark shall be deemed to be well known in Singapore.

Section 2(9) states:

In subsections (7) and (8), “relevant sector of the public in Singapore” includes any of the following:

- (a) all actual consumers and potential consumers in Singapore of the goods or services to which the trade mark is applied;
- (b) all persons in Singapore involved in the distribution of the goods or services to which the trade mark is applied;
- (c) all businesses and companies in Singapore dealing in the goods or services to which the trade mark is applied.

129 These provisions have been the subject of further exposition by the Courts:

- (i) Section 2(7)(a) is arguably the most crucial factor when determining whether a trade mark is well known in Singapore. This is because section 2(8) of the Act *deems* a trade mark to be well known in Singapore where it is determined to be well known to *any* relevant sector of the public in Singapore (see [139] of *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] SGCA 13 (“*Amanresorts*”)).
- (ii) Aside from section 2(7)(a) of the Act, the court is ordinarily free to disregard any or all of the factors listed in section 2(7) as the case requires and to take additional factors into consideration (*Amanresorts* at [137]).
- (iii) In relation to section 2(8) of the Act, the Court of Appeal in *Caesarstone CA* clarified that:

[101] ...we said in *Amanresorts* that it is “not too difficult” for a trade mark to be regarded as well known in Singapore¹³¹...

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

¹³¹ The Court of Appeal in *Amanresorts* commented that it is *not too difficult* for a trade mark to be regarded as “well known in Singapore” since the trade mark in question need only be recognised or known by “*any* relevant sector of the public in Singapore” which could in certain cases be *miniscule* ([229] *Amanresorts*).

[Emphasis in italics mine]

- (iv) Last but not least, with regard to the ambit of section 2(9)(a), the inquiry is into the specific goods or services to which the Opponent’s trade mark has been applied ([152] *Amanresorts*).

130 The Opponent made extensive submissions¹³² as to how the *Opponent’s Earlier Marks* are well known to the relevant public in Singapore. I have dealt with the same above with regard to the issue of “acquired distinctiveness” and I will not repeat my analysis here. In short, most of the evidence cannot be taken into account as they are undated or dated after the *Relevant Date* and it is unclear how the evidence relate to the local market.

131 Accordingly, this element has not been made out based on the evidence adduced before me. Thus, there is no need for me to address the other elements of “confusing connection” and “likelihood of damage”.

Conclusion on Section 8(4)(b)(i)

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

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

133 The relevant provisions of the Act read:

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

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

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

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

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

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

134 Having regard to my decision in relation to Section 8(4)(b)(i), this objection has *not* been made out as well. Nonetheless, I will briefly address the element of “well-known to

¹³² [84] – [90] OWS.

the public at large” in light of the evidence tendered by the Opponent with regard to this factor.

Well-known to the public at large

135 The critical question is whether the ***Opponent’s Earlier Blue Label Mark*** is well known to the public at large (in Singapore) as at the ***Relevant Date***. It is clear that the relevant provisions and case law which relate to the limb “well known in Singapore” (above) apply. Further, the following are pertinent:

- (i) The test “well known to the public at large in Singapore” has to mean *more* than just “well known in Singapore”. The mark has to necessarily enjoy a much *higher* degree of recognition. It has to be recognised by *most* sectors of the public though not so far as to all sectors of the public (*City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 at [13]).
- (ii) A much more *extensive* level of protection is granted to trade marks which have attained the *coveted* status of being “well known to the public at large in Singapore”. These form *a rare and exclusive class*, and are entitled to protection from use of a trade mark¹³³ on dissimilar goods or services even in the absence of a likelihood of confusion (*Amanresorts* at [233]).

[Emphasis in italics mine]

136 The Opponent submitted that the current case is analogous to *Clinique Laboratories, LLC v Clinique Suisse Pte Ltd and another* [2010] 4 SLR 510 (“***Clinique***”) and *Seiko Holdings Kabushiki Kaisha (trading as Seiko Holdings Corporation) v Choice Fortune Holdings Limited* [2014] SGIPOS 8 (“***Seiko***”):¹³⁴

- (i) The Opponent first used [the ***Opponent’s Earlier Marks***] in Singapore in 1981;¹³⁵
- (ii) The Opponent has gained widespread and intensive worldwide media coverage, via publications, the engagement of celebrities, the numerous accolades won, and the exposure of [the ***Opponent’s Earlier Marks***] in high human traffic areas;¹³⁶
- (iii) The Opponent has made substantial sales of [the Opponent’s beer] which are in excess of €125 million globally per year;¹³⁷
- (iv) [The Opponent’s beer] has been sold at numerous establishments, including food and beverage establishments and brick-and-mortar / online convenience stores.¹³⁸

¹³³ Similar.

¹³⁴ [102] OWS.

¹³⁵ [102(a)] OWS.

¹³⁶ [102(b) and (c)] OWS.

¹³⁷ [102(d)] OWS.

¹³⁸ [102(e)] OWS.

137 The issues pertaining to the Opponent’s evidence in Singapore have been highlighted above. In any event, to complete the analysis, a comparison of the Opponent’s figures with cases where the element of “well-known to the public at large” was made out is as follows (for the avoidance of doubt, the table is a guide only):

All figures pertain to activities in Singapore					
S/N		Expenditure on marketing	Exposure via physical sales outlets	Sales figures	Survey, if any
1	"Nutella¹³⁹"	NA	94-98% of stores in Singapore that sell food items	2 million units of "Nutella" bread spread sold <i>every year</i>	70% of consumer awareness
2	Intel¹⁴⁰	US\$600 million per annum for 4 years		US\$1 billion per annum for 7 years	85% of consumer awareness
3	Gucci¹⁴¹	<p>- “[I]n the region of hundreds of thousands of euros”... “for many years, including in Singapore”¹⁴²</p> <p>- Exposure via approximately 30 publications.</p> <p>- Exposure via social media (Facebook with 15.9 million likes; Instagram – 17.8 followers; Twitter – 4.97 followers;</p>	<p>- Changi Airport, the Paragon shopping mall in Orchard Road, the Takashimaya department store in Orchard Road and at The Shoppes retail complex in Marina Bay Sands</p>	“[M]ore than tens of millions SGD” for 5 years ¹⁴³	

¹³⁹ *Ferrero SPA v Sarika Connoisseur Cafe Pte Ltd* [2011] SGHC 176

¹⁴⁰ *Intel Corporation v Intelsteer Pte Ltd* [2015] SGIPOS 2

¹⁴¹ *Guccio Gucci S.P.A v Guccitech Industries (Private Ltd)* [2018] SGIPOS 1 (“*Guccitech*”).

¹⁴² See [14] of *Guccitech*.

¹⁴³ See [13] of *Guccitech*.

All figures pertain to activities in Singapore					
S/N		Expenditure on marketing	Exposure via physical sales outlets	Sales figures	Survey, if any
		Youtube – 136,000 subscribers)			
4	"Clinique"	\$3 million each year for 4 years	13 stores and counters	\$10 million per annum for 4 years	
5	"Seiko"	More than \$4 million each year for 5 years	100 optical shops	\$14 million per annum for 5 years	70% of consumer awareness
6	 144	[SGD 452,497] ¹⁴⁵ promotional expenditure for the year 2013 ¹⁴⁶	Exposure ¹⁴⁷ via food and beverage establishments; convenience stores; online stores; various forms of media and billboards as well as events	An average of [SGD 791, 827] ¹⁴⁸ per annum for 6 years. ¹⁴⁹	NA

138 It is apparent from the above table that the Opponent's exposure in Singapore is lacking in comparison to the other cases where this element has been made out, including *Clinique* and *Seiko*.

139 As this element has not been made out, there is no need for me to look at the other elements of the objection.

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

140 The ground of objection under section 8(4)(b)(ii) therefore fails.

¹⁴⁴ As indicated above.

¹⁴⁵ See above.

¹⁴⁶ The actual amount may be lower as the *Relevant Date* is 11 June 2013.

¹⁴⁷ The evidence pertaining to the Opponent in Singapore has been commented above and most of these cannot be taken into account.

¹⁴⁸ This is an average of the above figures.

¹⁴⁹ The actual amount may be lower as the *Relevant Date* is 11 June 2013.

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

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

8(7) A trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented —

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

Decision on Section 8(7)(a)

142 In relation to this ground, it is trite that there are three elements to be established (i) goodwill; (ii) misrepresentation; and (iii) damage.

143 Some further elaboration on the law of passing off:

- (i) The Opponent must establish that it has acquired goodwill as at the *relevant date*, that is, the date on which the defendant's conduct complained of started. Applying this principle, it is the **Relevant Date** in this instance (*Law of Intellectual Property of Singapore* (Sweet & Maxwell, 2nd Edition, 2014) (“**Law of Intellectual Property of Singapore**”) at [17.2.5]).
- (ii) Goodwill, in the context of passing off, is concerned with goodwill in the *business as a whole*, and not specifically in its constituent elements. The issue of *whether a mark or get-up is distinctive* of a plaintiff's products or services is a question best dealt with in the context of the inquiry as to whether the defendant has made a misrepresentation (*Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading* [2016] 4 SLR 86 (“**Singsung**”)). Evidence of sales and income of the business are a “proxy for the attractive force of the business” (**Singsung** at [58]). The “get up” can include various aspects of the business, *including* a mark (**Law of Intellectual Property of Singapore** at [17.2.10] – [17.2.11]).
- (iii) Section 8(7)(a) of the Act at the very least requires an opponent to adduce sufficient evidence to establish a *prima facie* case on goodwill, misrepresentation and damage (*Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] SGHC 216 at [164]).

144 It is not in dispute that the Opponent has the relevant goodwill.

Misrepresentation

145 As alluded to above, in an action in passing off, it is permissible for the Opponent to rely on their *get-up* (which includes the **Opponent's Earlier Marks**).

146 I have already commented on the Opponent’s evidence above:¹⁵⁰

(a) the bulk of the evidence tendered by the Opponent¹⁵¹ pertains to the



Opponent’s Earlier Blue Label Mark ;

(b) Most of the evidence cannot be taken into account as they are unclear, undated or dated after the *Relevant Date*.

147 It is important to recall that for the purposes of this objection, the Opponent’s get up is compared to the *Application Mark* as sought to be registered. In this regard, section 8(7)(a) provides:

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

[Emphasis in italics mine]

This is in contrast to an action under the common law of passing off.

148 In light of the above, similar to my conclusion for the element of “likelihood of confusion” under section 8(2)(b), I am of the view that, on a balance of probabilities, there is a likelihood of misrepresentation that the Applicant and the Opponent are one and the same or that they are economically linked.

Damage

149 With regard to this element, the Opponent argued:¹⁵²

[139] The third element to be proven is, whether there is damage to the Opponent’s goodwill. Goodwill can be damaged through “blurring” or “tarnishing” (see *Amanresorts* at [97]). However, there is no need to prove actual damage; real or probable damage would suffice (see *Amanresorts* at [94]).

I agree that the main avenue of damage is through “blurring”.¹⁵³

¹⁵⁰ See above.

¹⁵¹ Those parts which can be taken into account having regard the *Relevant Date*.

¹⁵² At [139] OWS.

¹⁵³ At [140] OWS, the Opponent referred to its submissions at [107] – [116] which pertain to the concept of “dilution” under section 8(4)(b)(ii)(A). As cautioned in *Amanresorts* at [131], “to avoid unnecessary confusion, it is better to avoid using the word “dilution” in a passing off action when what is meant is simply tarnishment or blurring of the goodwill in the plaintiff’s get-up”.

Conclusion

150 The ground of opposition under section 8(7)(a) therefore succeeds.

Conclusion

151 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition *succeeds on section 8(2)(b) and section 8(7)(a)*. Accordingly, the ***Application Mark*** shall not proceed to registration. The Opponent is to have 50% of its costs having regard to the fact that it failed in relation to the other grounds, including its withdrawal of section 7(6) on 15 March 2019. These are to be taxed, if not agreed.

Date of Issue: 10 December 2019