

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

Trade Mark No. 40201604845Y-02
Hearing Date: 6 December 2018

IN THE MATTER OF A TRADE MARK APPLICATION BY

ISETAN MITSUKOSHI LTD.

AND

OPPOSITION THERETO BY

THE SCOTCH WHISKY ASSOCIATION

Hearing Officer: Tan Mei Lin
Principal Assistant Registrar of Trade Marks

Representation:

Ms Yvonne Tang (Drew & Napier LLC) for the Applicant

Mr Aaron Thng (Amica Law LLC) for the Opponent

GROUND OF DECISION

Introduction

1 Most of us would have heard of Scotch Whisky. Some of us may also know that Scotch Whisky is a geographical indication – a sign that a product has a specific place of origin and that it is made to a certain quality or standard according to factors that are due to that origin, such as ingredients used, manufacturing process, etc. However, is “Tartan” also a geographical indication designating whiskies from Scotland? If so, is it

entitled to protection under the Geographical Indications Act (Cap 117B, 1999 Rev Ed) (the “GIA”)? These are some of the issues to be determined in this case.¹

Chronology of Proceedings

2 Isetan Mitsukoshi Ltd. (the “Applicant”), applied to register the trade mark ISETAN TARTAN (the “Application Mark”) in Singapore on 18 March 2016 under Trade Mark No. 40201604845Y (“the Original Application”) in respect of some 18 classes of goods and services (Classes 3, 4, 9, 14, 16, 18, 20, 21, 24, 25, 26, 27, 28, 29, 30, 32, 33 and 35).

3 The Original Application was accepted and published on 31 October 2016 for opposition. The Scotch Whisky Association (the “Opponent”), filed its Notice of Opposition to oppose the registration of the Application Mark in Class 33, on 3 January 2017. The Applicant filed its Counter-Statement on 3 March 2017.

4 The Opponent filed evidence in support of the opposition on 4 September 2017. On 30 November 2017, the Applicant applied to divide the Original Application into two separate applications, one for the application in Class 33 (“the Subject Application”) and another for the remaining 17 classes of the Original Application (Trade Mark No. 40201604845Y-01). With the division, Trade Mark No. 40201604845Y-01 was allowed to proceed to registration and the opposition filed in respect of Class 33 of the Original Application continued as if the opposition had been filed in respect of the Subject Application.

5 The Applicant filed its evidence in support of the Subject Application on 13 April 2018. The Opponent filed its evidence in reply on 9 July 2018. Following the close of evidence, the Pre-Hearing Review (“PHR”) was held on 1 August 2018. On 6 September 2018, pursuant to directions given by the Registrar, the Opponent clarified its grounds in the opposition. The opposition was heard on 6 December 2018.

Grounds of Opposition

6 The Opponent relies on Sections 7(7), 7(5), 7(4)(b), 7(1)(b) and 7(1)(c) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (the “TMA”) in this opposition.

Opponent’s Evidence

7 The Opponent’s evidence comprises the following:

- (i) First statutory declaration of Lindesay Matheson Low, Senior Legal Counsel of the Opponent, dated 30 August 2017 (“OSD1”); and
- (ii) Second statutory declaration of Lindesay Matheson Low, dated 29 June 2018 (“OSD2”).

¹ This case is also interesting because this is the first time this tribunal is considering a case under the GIA since it came into force in 1999.

Applicant's Evidence

8 The Applicant's evidence comprises the statutory declaration of Toshihiko Sugie, President and CEO of the Applicant, dated 30 March 2018 ("ASD").

Applicable Law and Burden of Proof

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

Background

10 The parties to this dispute need little introduction.

11 The Opponent, the Scotch Whisky Association, is a company incorporated and existing under the laws of the United Kingdom. It is an association of the leading distillers, blenders and exporters of Scotch Whisky. One of its principal objectives is the protection of the Scotch Whisky trade around the world.

12 The Applicant, Isetan Mitsukoshi Ltd., established in 1886, is a leading corporate group in Japan's retail industry and renowned for its high-quality service as a department store, domestically and internationally. The Applicant's Singapore subsidiary, Isetan (Singapore) Limited (formerly known as Isetan Emporium (Singapore) Private Limited), was incorporated in 1970. The Applicant's first department store opened in Singapore in 1972, and the Applicant presently has 6 retail stores in Singapore.

13 The Applicant has registrations for trade mark "ISETAN TARTAN" in Class 33 in Japan and France. In Malaysia and Thailand, the Applicant's Class 33 trade mark applications are pending.

14 In China, the application for "ISETAN TARTAN" in Class 33 was refused by the China Trademark Office in a decision dated 1 August 2018 on the basis that as "the mark fully contains "TARTAN", it is likely to mislead consumers into thinking that the products' origin[ate] from or [are] associated with Scotland"². The Applicant has appealed against the decision and the appeal is pending.

MAIN DECISION

Ground of Opposition under Section 7(7)

15 Section 7(7) of the TMA provides:

7.—(7) ... a trade mark shall not be registered if it contains or consists of a geographical indication in respect of a wine or spirit and the trade mark is used or intended to be used in relation to a wine or spirit not originating from the place indicated in the geographical indication.

² OBOA at Tab 10.

16 The TMA further states in Section 2:

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

“geographical indication” has the same meaning as in section 2 of the Geographical Indications Act (Cap. 117B);

17 Section 2 of the GIA provides:

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

“geographical indication” means any indication used in trade to identify goods as originating from a place, provided that —

(a) the place is a qualifying country or a region or locality in the qualifying country; and

(b) a given quality, reputation or other characteristic of the goods is essentially attributable to that place;

Decision on Section 7(7)

18 Section 7(7) stipulates that “a trade mark shall not be registered if it contains or consists of a geographical indication...”. It is clear from the wording of Section 7(7) that a trade mark does not need to consist entirely of a geographical indication for the provision to kick in. So long as one component of a trade mark is a geographical indication, the entire mark may be barred from registration.

Is “Tartan” a Geographical Indication?

19 “Tartan” is defined in the Collins Concise Dictionary as:

a design of straight lines, crossing at right angles to give a chequered appearance, esp the distinctive design or designs associated with each Scottish clan: *the Buchanan tartan ...*

20 It is the Opponent’s submission under this ground that “*the tartan is an iconic symbol of Scotland and can function as a geographical indication*”³. In support of its submission, the Opponent cites Susanna Leong, *Intellectual Property Law of Singapore* (Academy Publishing, 2013) at [34.003]:

GIs often consist of the actual geographical name of the place of origin of the products but other indicating terms may also suffice as GIs as long as they identify the goods as originating in the territory, region or locality in the territory. Thus, it may be argued that iconic symbols such as the Eiffel Tower, the Great Wall of China or the Taj Mahal may serve as GIs of products from France, China or India.

³ OWS at [11].

21 The Opponent also lodged extensive amounts of evidence showing “*the long association between the tartan and Scotland*”⁴ as well as evidence which the Opponent claims shows that Singapore consumers are likely to associate tartans with Scotland⁵.

22 The Opponent further submits that Scotch Whisky producers frequently incorporate the tartan pattern on their labels or the word “Tartan” in their brand names and gave some 44 examples of them in Exhibit P and Exhibit S of OSD1, including:



Exhibit P, OSD (page 181)

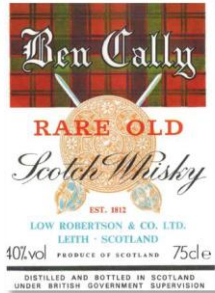


Exhibit P, OSD (page 186)



Exhibit P, OSD (page 217)



Black Tartan Scotch Whisky for sale on spiritscotland.sg

23 The Opponent’s submission is, however, misconceived. The relevant issue is not whether the tartan is or is not iconic of Scotland, whether consumers associate tartans with Scotland or even whether it can or cannot function as a geographical indication but whether the tartan (or more precisely, the word “Tartan”), *is* a geographical indication.

24 Geographical indications by their very definition are indications which identify goods with a given quality, reputation or other characteristic attributable to their origin. There is no evidence to show that “Tartan” is used to identify goods. Neither is there evidence from the Opponent as to what characteristics “Tartan” whiskies possess. In fact, the Opponent focussed on the qualities of a different geographical indication, namely, Scotch Whisky.

25 As for the use of tartan patterns and/or the word “Tartan” on labels and brand names, they are for the purpose of identifying the whisky distillery and not for the purpose of identifying the product. In order to function as a geographical indication, the sign must identify a product.

26 In view that there is no evidence to support a finding that “Tartan” is a geographical indication, the opposition under this ground must necessarily fail.

Conclusion on Section 7(7)

27 The ground of opposition under Section 7(7) fails.

Ground of Opposition under Section 7(5)

28 Section 7(5) of the TMA reads:

⁴ OSD1 at [9]-[15] and OSD2 at [11]-[23].

⁵ OSD2 at [30]-[40].

7.—(5) A trade mark shall not be registered if or to the extent that its use is prohibited in Singapore by any written law or rule of law.

29 The “written law” relied on by the Opponent is Section 3 of the GIA which provides:

3.—(1) Subject to the provisions of this Act, an interested party of goods identified by a geographical indication may bring an action against a person for carrying out an act to which this section applies in relation to the geographical indication.

(2) This section shall apply to the following acts:

(a) the use of a geographical indication in relation to any goods which did not originate in the place indicated by the geographical indication, in a manner which misleads the public as to the geographical origin of the goods;

(b) any use of a geographical indication which constitutes an act of unfair competition within the meaning of Article 10 bis of the Paris Convention;

...

(d) any use of a geographical indication, being a geographical indication which identifies a spirit, in relation to a spirit which did not originate from the place indicated by the geographical indication, whether or not —

(i) the true geographical origin of the second-mentioned spirit is used together with the geographical indication;

(ii) the geographical indication is used in translation; or

(iii) the geographical indication is accompanied by any of the words “kind”, “type”, “style”, “imitation” or any similar word or expression.

(3) Any use of a geographical indication within the meaning of subsection (2) shall be deemed to be an act to which this section applies even if the geographical indication is literally true as to the geographical origin of the goods in question, provided that such use falsely represents to the public that the goods originate in another place.

(4) For the purposes of subsection (2), “use of a geographical indication” includes the use of a trade mark which contains or consists of the geographical indication in question.

Decision on Section 7(5)

Does “Tartan” Qualify for Protection Under the GIA?

30 I have decided that there is no evidence to support a finding that “Tartan” is a geographical indication. This is sufficient to dispose of this ground of opposition.

However, even if “Tartan” is a geographical indication, there is another hurdle which the Opponent would need to cross in order to succeed under the GIA.

31 Section 6 of the GIA provides:

6. Section 3 shall not apply to —

(a) the use of a geographical indication, being a geographical indication which is contrary to public policy or morality;

(b) *the use of a geographical indication, being a geographical indication which is not or has ceased to be protected in its country or territory of origin, or which has fallen into disuse in that country or territory; or*

(c) the use of a geographical indication in relation to any goods or services which has become the common name of the goods or services in Singapore.

32 It is clear from Section 6(b) that Section 3 of the GIA, which the Opponent relies on, does not apply if “Tartan” is not a geographical indication that is protected in the UK. There is no evidence before me to suggest that “Tartan” is protected as such in the UK. In this regard, the Opponent furnished evidence of the registration of “Scotch Whisky” as a geographical indication with the Department for Environment, Food and Rural Affairs, which administers the Protected Food Name scheme, including spirit drinks in the UK. However, the Opponent did not produce any evidence to show that “Tartan” is also accorded protection as a geographical indication in the UK. Accordingly, even if I do find that “Tartan” is a geographical indication, Section 3 of the GIA does not apply to “Tartan” and this ground would fail.

Conclusion on Section 7(5)

33 The ground of opposition under Section 7(5) fails.

Ground of Opposition under Section 7(4)(b)

34 Section 7(4)(b) of the TMA reads:

7.—(4) A trade mark shall not be registered if it is —

(a) ...

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

Decision on Section 7(4)(b)

35 The Opponent’s case under this ground is that by virtue of the incorporation of the word “Tartan” in the Application Mark, the Application Mark is strongly evocative

of Scotland and would deceive the public as to the nature, quality, or geographical origin of the goods when it is used on whiskies which are not of Scottish origin⁶.

36 The Opponent's approach misses the point. The issue is not whether the Application Mark does or does not evoke Scotland. Section 7(4)(b) does not prohibit evocation per se⁷. The issue is whether the Application Mark is of such a nature as to deceive the public.

37 "Deceive" is defined in the English Oxford Dictionary as:

Deliberately cause (someone) to believe something that is not true, especially for personal gain.

38 In order to succeed under Section 7(4)(b), an opponent has to show that there is a real or sufficiently serious risk that the consumer would be deceived, as opposed to a mere theoretical potential that the consumer may be deceived. *Kerly's Law of Trade Marks and Trade Names* (Sweet & Maxwell, 16th Ed, 2018) explains at para 10–215:

... In general, if a mark gives rise to an expectation which will not be fulfilled, then registration will be refused. The expectation (and hence the objection) must be a real one, as opposed to something obscure or fanciful, arising from the mark itself.

39 I will therefore examine the Application Mark to see if it deliberately causes, in a direct, immediate and obvious manner, an expectation that the goods originate from Scotland.

40 The Application Mark is for the plain words "ISETAN TARTAN" with no emphasis, stylisation or device. It does not contain the word "Scotland" and neither does it contain any symbols or designs representative of Scotland.

41 "ISETAN" is the name of the Applicant and is its house mark. For those who have heard of the Applicant, it would probably evoke Japan more than Scotland. But for those who have not heard of the Applicant, "ISETAN" would be a meaningless invented word and would not evoke any geographical area.

42 As for the word "Tartan", it is a design or pattern (see [19]). While each Scottish clan may have its own distinctive tartan pattern, tartan patterns are not used exclusively by the Scots⁸ and the word "Tartan" is in no way synonymous with Scotland.

⁶ Notice of Opposition at [7].

⁷ Evocative or allusive trade marks usually require a subtle leap in thought for the consumer to reach a conclusion as to the exact nature of the goods and would usually not meet the required threshold to constitute deception.

⁸ In fact, the Scottish Register of Tartans itself states on its website that it permits "anyone, from anywhere in the world [to] register a tartan..." on its register.

43 I am unable to see anything in the Application Mark that makes a direct reference to Scotland. Accordingly, the Application Mark is not of such a nature as to deceive the public.

Conclusion on Section 7(4)(b)

44 The ground of opposition under Section 7(4)(b) fails.

Ground of Opposition under Section 7(1)(b) and 7(1)(c)

45 Section 7(1)(b) and (c) of the TMA reads:

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

...

(b) trade marks which are devoid of any distinctive character;

(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;

Interplay Between Section 7(1)(b) and 7(1)(c)

46 The grounds in Sections 7(1)(b) and 7(1)(c) of the TMA overlap in some way. This was explained in *Love & Co Pte Ltd v The Carat Club Pte Ltd* [2009] 1 SLR(R) 561 at [44]:

The test in s 7(1)(b) for being “devoid of any distinctive character” is akin to a sweep up “exclusion from registration clause” for trade marks that lack an inherent distinctive character. For instance, if the attributes of a trade mark taken as a whole are generic or descriptive, then it will not have any inherent distinctive character and will fail s 7(1)(b). If it is descriptive of any of the characteristics of the goods or services, again it has no inherent distinctive character and fails the test in s 7(1)(c) ...

47 Therefore, descriptive signs referred to in Section 7(1)(c) are also devoid of any distinctive character for the purposes of Section 7(1)(b). However, a sign may be devoid of distinctive character for the purposes of Section 7(1)(b) for reasons other than the fact that it may be descriptive. This is because Section 7(1)(b) is distinguished from Section 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one person from those of other.

48 In those circumstances, it is important for the correct application of Section 7(1) to ensure that the ground for refusal set out in Section 7(1)(c) duly continues to be applied only to the situations specifically covered by that ground for refusal.

49 The Opponent’s case based upon Section 7(1)(b) and Section 7(1)(c) of the Act are founded upon the Application Mark designating characteristics of the goods and the

Opponent made no additional submissions in respect of distinctive character⁹. Therefore, the Section 7(1)(b) and Section 7(1)(c) claims stand or fall together. If I find that the Application Mark designates a characteristic of the goods it will be caught by both Section 7(1)(b) and Section 7(1)(c). If I do not, then both the Section 7(1)(b) and Section 7(1)(c) grounds will fail. In light of this, I will begin by considering the Section 7(1)(c) ground.

Decision under Section 7(1)(b) and 7(1)(c)

50 The Opponent's submission under this ground is that the word "Tartan" in the Application Mark evokes or connotes a direct link with Scotland or Scottish provenance. The Application Mark therefore designates the type, nature, quality, value and geographical origin of the goods in question and is devoid of distinctive character¹⁰.

51 The wording of Section 7(1)(c) makes it clear that the provision only excludes 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.

52 I have found at [42] that "Tartan" is not synonymous with Scotland but even if it is, the Application Mark does not consist exclusively of the word "Tartan". It also contains the word "ISETAN" which, being an invented word, cannot be said to describe any characteristics of the goods claimed. The Section 7(1)(c) ground thus fails.

53 As for the Section 7(1)(b) ground, there being no separate claim to the mark being devoid of distinctive character apart from the claim that this is because it designates a characteristic of the goods, the Section 7(1)(b) ground falls with the Section 7(1)(c) ground.

Conclusion on Section 7(1)(b) and Section 7(1)(c)

54 The ground of opposition under Section 7(1)(b) and Section 7(1)(c) fails.

Conclusion

55 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition fails on all grounds. The Subject Application will proceed to registration. The Applicant is also entitled to costs to be taxed, if not agreed.

Date of Issue: 6 March 2019

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

⁹ OWS at [145].

¹⁰ Notice of Opposition at [13].