


Intellectual Property Office of Singapore Case Summary: Discovery Communications, LLC v A-Star-Education Discovery Camps Pte. Ltd. [2020] SGIPOS 4

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This case concerns an opposition against the Application Mark “  ” by the Opponent Discovery Communications, LLC. The Opponent opposed the application on several grounds, one of the main grounds of the opposition being Section 8(2)(b) of the Trade Marks Act (Cap 332, 2005 Rev Ed.) (“TMA”).


The Applicant, A-Star-Education Discovery Camps Pte. Ltd. applied for the Application Mark in the following classes:

Class	Goods/Services
9	Audio cassettes for language teaching; Audio test instruments; Audio testing apparatus; Audiovisual teaching apparatus; Computer apparatus for educational use; Computer assisted language programmes; Computer programs for studying languages; Connectable blocks for instruction in mathematics; Counting apparatus for teaching arithmetic to children; Educational apparatus; Educational materials in the form of computer programmes for teaching languages; Educational materials in the form of pre-recorded discs for teaching languages; Educational materials in the form of prerecorded tapes for teaching languages; Educational science sets; Education apparatus connectable to television receivers; Education software; Films bearing recorded educational material; Language translating apparatus; Magnetic data carriers recorded with programmes for instruction in foreign languages; Mathematical instruments; Pre-recorded video tapes for teaching purposes; Science sets for children being teaching apparatus; Sound compositions for self study; Teaching apparatus; Teaching apparatus for use as study aids; Teaching instruments; Teaching machines; Teaching programmes recorded on data carriers; Training apparatus [teaching apparatus].
16	Art materials [paint boxes for use in school]; Art paints [paint boxes for use in school]; Audiovisual teaching materials [printed matter]; Books pertaining to language comprehension; Colouring materials [paint boxes for use in school]; Educational materials in printed form; Educational materials in written form; Educational publications; Instructional and teaching materials; Mathematical tables [printed matter]; Modelling materials for educational purposes; Paint boxes for use in school; Paint boxes [articles for use in school]; Printed educational materials for the teaching of languages; Printed educational materials for use in teaching; Printed matter for educational purposes; Printed matter relating to school photographs; Printed publications for institutions of higher education; Printed school photographs; Printed teaching materials for education; Printed teaching materials for instruction; Printed timetables; Promotional pamphlets; Promotional publications; School diaries; School supplies [stationery]; School writing books; School yearbooks; Stationery for children's educational activities; Teaching manuals; Test booklets [printed matter]; Teaching materials [except apparatus]; Water colour paint boxes [articles for use in school]; Water colour paints for use in school; Water-colours [paint boxes for use in school]
43	Child care services; Child minding services; Day care services for children; Day nursery services; Day-care centres [day-nurseries]; Holiday camp services [lodging]; Holiday camp services [temporary accommodation]; Preschooler and infant care at daycare centers; Providing temporary lodging at holiday camps; Provision of day nurseries, other than schools; Provision of child care centres.

The Opponent relied on several of its earlier trade marks in the opposition, as shown in the table below.

S/N	Trade Mark Application	Date	Class
1.	 TM No. T1414024F	September 2014	09, 38, 41
2.	DISCOVERY EDUCATION TM No. T0908248I	24 July 2009	09, 16, 28
3.	DISCOVERY GO TM No. T1210936H	27 July 2012	09, 38, 41
4.	DISCOVERY KIDS TM No. T1217103I	14 November 2012	09, 18, 41
5.	DISCOVERY CHANNEL TM No. T0105038C	6 April 2001	16
6.	DISCOVERY KIDS TM No. T1302177D	7 February 2013	16
7.	DISCOVERY ADVENTURES TM No. T1114528Z	17 October 2011	39, 41
8.	THE DISCOVERY CHANNEL TM No. T9206666J	31 August 1992	41
9.	 TM No. T1010851H	23 August 2010	41

It is noted that the Opponent does not have any registration for the plain word “Discovery” on its own.

For the purposes of this opposition, the Opponent’s mark “” is taken to be the “Primary Earlier Trade Mark”.


In order to succeed in an opposition under Section 8(2)(b), the Opponent must show: (a) similarity of marks; (b) similarity of goods; and (c) likelihood of confusion arising from the two similarities. The distinctiveness of a mark is also an important factor in the assessment of similarity.

Similarity of Marks

In the comparison of the similarity of marks, similarity is assessed from three aspects – the visual, the aural and the conceptual aspects – in order to make an assessment as to whether the marks are overall more similar or dissimilar.

The Principal Assistant Registrar (“PAR”) found that the word “DISCOVERY” in the Opponent’s earlier trade marks to be of low distinctiveness as it is a common dictionary word which bears the meaning of making a finding that no one else has known about before, a breakthrough of sorts. This kind of word is likely “the sort of word in which traders would like a monopoly”. Further, it was noted that there are numerous registrations in different classes on the Register bearing the word “Discovery” either as part of the marks or on its own. This shows that other traders might legitimately wish to use the word “Discovery” to describe their goods and services.

The Application Mark also has the word “DISCOVERY” featuring as the more prominent component in the mark. Where there is a common component in the competing marks and this common component is of low distinctiveness, there would be reluctance to find similarity between the marks and to grant a monopoly over components which other traders may legitimately wish to use as part of their own trade marks.

On visual similarity, the PAR considered that the Opponent’s Primary Earlier Trade Mark “” has a distinctive feature which is the globe device that is elided with and clearly forms part of the capital letter D in the word “Discovery”. This device constitutes a material part of the whole word “DISCOVERY” and cannot be ignored. In contrast, the Application Mark is presented in an angled manner and written in cursive with a stylised flourish to underscore the word “DISCOVERY”. The distinctive feature of the device in the Opponent’s Primary Earlier Trade Mark and the presentation and

stylisation of the Application Mark reduces the visual impact of similarity of the word “DISCOVERY” and as such, the PAR found the marks more dissimilar than similar.

With regard to aural similarity and conceptual similarity, the PAR found that the marks were more similar than dissimilar. However, the aural and conceptual similarity of the marks reside in the word “DISCOVERY” which has low distinctiveness.

Similarity of Goods

On goods-similarity, the PAR found identity in the Class 9 and 16 goods. The Opponent did not have a registration in Class 43, only registrations in classes 39 and 41. The PAR however found a subset of services within the Opponent’s class 39 specification which although not identical, overlapped in a meaningful and complementary manner with the Applicant’s Class 43 services. Thus, it was concluded that there is some similarity of services.


Likelihood of Confusion

Overall, the PAR considered that the marks were more similar than dissimilar but concluded that the word “DISCOVERY” is of low technical distinctiveness by virtue of its descriptive connotation to the goods and services of the earlier trade marks. Therefore, when considering all the facts and circumstances, the PAR found that a likelihood of confusion did not exist. The PAR considered these factors which led to the conclusion: the distinct feature of the D-plus-globe device in the Opponent’s Primary Earlier Trade Mark, the nature of the goods and services which required a greater degree of fastidiousness and attention on the part of prospective purchasers when buying the goods, the consumers who would pay more attention and care in their choice of the goods and services, and in particular, the strong reputation of the Opponent arising from the widespread and constant exposure it has on television.

Well Known Mark

Although the Opponents did not succeed on the ground of opposition on Well Known Marks, the PAR found that the Opponent’s earlier marks were well known in Singapore. However, the PAR was not able to make a similar finding that it was “well known to the public at large” based on the Opponent’s evidence.

Conclusion

The Opponent did not succeed on all the grounds of opposition and the Application Mark “” was allowed to proceed to registration.

Disclaimer: The above is provided to assist in the understanding of the Registrar’s grounds of decision. It is not intended to be a substitute for the reasons of the Registrar. The full grounds of decision can be found [here](#).