

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

Trade Mark No. 40201714407Q
Hearing Date: 14 November 2019

IN THE MATTER OF A TRADE MARK APPLICATION BY

A-STAR-EDUCATION DISCOVERY CAMPS PTE. LTD.

AND

OPPOSITION THERETO BY

DISCOVERY COMMUNICATIONS, LLC

Hearing Officer: Anne Loo
Principal Assistant Registrar of Trade Marks

Representation:

Mr Max Ng and Mr Justin Lee (Gateway Law Corporation) for the Applicant

Mr Jon Chan Wenqiang and Ms Dimple Banghar (Ravindran Associates LLP) for the
Opponent

GROUND OF DECISION

Introduction

1 David and Goliath. Counsel for A-Star-Education Discovery Camps Pte. Ltd. (“the Applicant”) likened this opposition between Discovery Communications, LLC (“the Opponent”) and the Applicant as a David and Goliath clash, presumably alluding to the face-off between a corporate giant in the media world and a much smaller Singapore incorporated company. The biblical story of David and Goliath in 1 Samuel 17 however is

more than just about size. It is an account of how an underdog can overcome overwhelming odds when faced with a more formidable adversary, and the phrase is often used as a metaphor for the victory of the underdog. Does the reference to the phrase here allude to an underlying hint of confidence, that in the face of seemingly insurmountable challenges, victory is but a stone's throw away?

Chronology of Proceedings



2 Changededu Holdings Pte. Ltd¹. applied to register the trade mark (“the Application Mark”) in Singapore on 26 July 2017 under Singapore Trade Mark No. 40201714407Q in Classes 9, 16 and 43. The goods and services covered by the application are indicated below:

Class 09:

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].

Class 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

¹ Ownership in the mark was transferred from Changededu Holdings Pte. Ltd to Cedu Discovery Camps Pte. Ltd. on 2 November 2017. Cedu Discovery Camps Pte. Ltd. then filed notices to change its name to A-Star-Education Holdings Pte. Ltd. and A-Star-Education Discovery Camps Pte. Ltd. respectively on 22 February 2019 and 13 May 2019.

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]

Class 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 goods and services of the Application Mark relate mainly to educational resources.

3 The application was accepted and published on 18 September 2017 for opposition purposes. The Opponent filed its Notice of Opposition to oppose the registration of the Application Mark on 30 November 2004. The Applicant filed its Counter-Statement on 17 January 2018.

4 The Opponent filed evidence in support of the opposition on 28 February 2019. The Applicant filed its evidence in support of the application on 23 May 2019. Following the close of evidence, the Pre-Hearing Review was held on 19 August 2019. The Opponent and the Applicant both filed their written submissions (“Opponent’s WS” and “Applicant’s WS” respectively) on 14 October 2019.



5 The opposition was heard on 14 November 2019.

Grounds of Opposition

6 The Opponent relies on Sections 8(2)(b), Section 8(4)(a) read with 8(4)(b)(i), Section 8(4)(a) read with 8(4)(b)(ii)(A) and (B), Section 8(7)(a) and Section 7(6) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”) in this opposition.

The Opponent’s Earlier Trade Marks

7 The Opponent has registrations of many “DISCOVERY” and “DISCOVERY”-formative trade marks in many classes in Singapore (Schedule A, Opponent’s Notice of Opposition). For the purposes of this opposition, however, the Opponent relies on the following registered trade marks (collectively referred to as the “Opponent’s Earlier Trade Marks”):

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

Evidence filed

8 The Opponent's evidence comprises a Statutory Declaration made by David Modzeleski, the Senior Vice President, Intellectual Property and Litigation of the Opponent on 24 February 2019 ("OSD").

9 The Applicant's evidence comprises a Statutory Declaration made by Brian Geoffrey Rogove, Director of the Applicant on 21 May 2019 ("ASD").

The Relevant Date

10 The relevant date in this opposition is 26 July 2017 ("Relevant Date"), being the date of the application of the Applicant's mark.

Applicable Law and Burden of Proof

11 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

The Opponent

12 The Opponent deposes that it is one of the world's largest mass media companies. It commenced its business in 1985 through a single television channel, The Discovery Channel, which started broadcasting in the United States of America on 17 July 1985. Since then, the Opponent has broadened its international network and become one of the world's leading non-fiction media companies with over 3 billion subscribers in over 220 countries and territories, including Singapore. The Opponent deposes that it owns 130-plus worldwide television networks, led by Discovery Channel. It is also a leading provider of educational products and services to schools and owns and operates a diversified portfolio of digital media services. In Asia Pacific, Singapore is the regional headquarters of Discovery Networks Asia Pacific, which was set up to target the Asia-Pacific region.² The Opponent is the proprietor of DISCOVERY and DISCOVERY-formative marks worldwide in various classes and also in Singapore³.

The Applicant

13 The Applicant is a private limited company incorporated under the laws of Singapore. It deposes that it is an education company focusing on educational development, improvement, innovation and growth for its students. It has operations in Asia Pacific, Europe, the United States of America and the United Kingdom serving more than 15,000 students worldwide. The Applicant deposes that it has acquired substantial goodwill and reputation as an educational operator in Singapore and in the region and the countries stated above. "Discovery Camps" is one of the Applicant's brands that offers a wide range of enrichment camps for kids of all ages in Singapore only. The Applicant's revenue is earned mainly during the Singapore school holiday periods between the months of October to December, and during the month of March. The Applicant has also advertised and promoted its mark via digital advertising and social media marketing of its goods and services.

MAIN DECISION

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

14 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.

² See [7] –[20] of the OSD


³ See Schedule A of the Opponent's Notice of Opposition


Decision on Section 8(2)(b)

15 The law in relation to Section 8(2)(b) is well-established. The Court of Appeal’s decision in *Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide* [2014] 1 SLR 911 (“*Staywell*”) at [15] reaffirmed that it is the “*step-by-step*” approach that is to be applied. Three elements will have to be assessed systematically under the step-by-step approach and these may be summarised as follows:

- (i) the first element is to assess whether there is identity or similarity of the respective marks;
- (ii) the second element is to assess whether there is identity or similarity between the goods and services for which registration is sought as against the goods and services for which the earlier trade mark is protected; and
- (iii) the third element is to consider whether there exists a likelihood of confusion arising from the two similarities.

16 The Court of Appeal in *Staywell* at [15], made it clear that “[t]he first two elements are assessed individually before the final element which is assessed in the round”. If, for any one step, the answer is in the negative, the inquiry will end, and the opposition will fail. However, if the first two threshold elements have been met, the issue of the likelihood of confusion arises and the inquiry must be made into: (a) how similar the marks are; (b) how similar the services are; and (c) given this, how likely the relevant segment of the public will be confused (*Staywell* at [55]).

17 The earlier trade marks relied on under this ground of opposition are the marks listed in [7] above. For ease of reference, I will refer to the “ **Discovery**” mark as the Primary Earlier Trade Mark and have categorised the Opponent’s other earlier trade marks into the following categories:

- (i) Category I: “DISCOVERY” + Suffix (serial numbers 2 to 7 on the list at [7] above)
These include the marks DISCOVERY EDUCATION, DISCOVERY GO, DISCOVERY KIDS, DISCOVERY CHANNEL, DISCOVERY ADVENTURE.
- (ii) Category II: “**THE DISCOVERY CHANNEL**” mark (serial number 8 on the list at [7] above)
- (iii) Category III:  (serial number 9 on the list at [7] above)

Assessment of Marks Similarity

18 In assessing the marks for similarity, the following principles from *Staywell* at [15] to [30] and *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941 at [40] (“*Hai Tong*”) apply:

(i) Comparison between two competing marks is mark-for-mark - between the mark applied for and the earlier mark - and as a whole, without consideration of any external matter. The Court of Appeal in *Staywell*, states at [20] that “this even extends to not considering the relative weight and importance of each aspect of similarity having regard to the goods”.

(ii) The marks are to be compared with regard to three aspects of similarity – visual, aural and conceptual. The law does not prescribe that all three aspects of similarity must be made out before the marks can be found to be similar. The three aspects of similarity do not invite a formulaic consideration but are signposts meant to guide in the marks-similarity inquiry. Trade-offs can occur among the three aspects of similarity in the marks-similarity inquiry. Ultimately, the conclusion will have to be made as to whether the marks, when observed in their totality, are similar rather than dissimilar. *Staywell* at [17] states that the “reality [is] that the similarity of marks is ultimately and inevitably a matter of impression than one that can be resolved as a quantitative or mechanistic exercise.”

(iii) 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.

(iv) 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.

(v) The comparison is made from the perspective 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.

(vi) The average consumer, however, is assumed to possess “imperfect recollection” and cannot be expected to compare the contesting marks side by side and examine them in detail for the sake of isolating particular points of difference. Instead, it is the general impression that will likely be left by the essential or dominant features of the marks on the average consumer.

Distinctiveness

19 I am mindful of the Court of Appeal’s reiteration in *Staywell* at [30] that distinctiveness is a factor integrated into the visual, aural and conceptual analysis as to whether the competing marks are similar and is not a separate step within the marks-similarity inquiry. However, for convenience, I will follow the approach of the Court of Appeal in *Hai Tong* at [26] and consider distinctiveness of the Opponent’s mark as a

separate step and then apply these considerations within the context of the mark-similarity analysis.

20 The Court in *Staywell* at [22]-[24] distinguished between two aspects of distinctiveness: (a) distinctiveness in the ordinary and non-technical sense and (b) distinctiveness in the technical sense. Distinctiveness in the ordinary and non-technical sense refers to what is outstanding and memorable about the mark, the components of the mark that draw the consumer’s attention and tend to stand out in the consumer’s imperfect recollection. Distinctiveness in the technical sense on the other hand refers to the capacity of the mark to function as a badge of origin. Technical distinctiveness may be inherent where the word is meaningless, or acquired through long and widespread use. A mark which has greater technical distinctiveness however enjoys a high threshold before a competing sign will be considered dissimilar to it (see *Staywell* at [25]).

21 The Opponent submits that the “DISCOVERY” word is the “*outstanding and memorable*” component in the competing marks and is therefore distinctive in the non-technical sense. The word “DISCOVERY” resides in the dominant part of the marks and will attract the attention of the consumer. On technical distinctiveness, the Opponent submits that the mark is of a medium level of inherent distinctiveness but this is enhanced by the use of the mark.



22 The Applicant argues that the word “DISCOVERY” is an extremely common noun and does not possess much inherent distinctiveness. The Applicant disagrees that the word “DISCOVERY” is distinctive given the multiple number of other marks on the register that comprise the word “DISCOVERY” which do not belong to the Opponent.

23 The Opponent acknowledges that the word “DISCOVERY” is an ordinary English word but disputes that it has any obvious or immediate descriptive nexus to the Opponent’s good and services. If there is any association, the Opponent says that it is allusive. As to the number of other marks bearing the word “discovery” found on the register, the Opponent says that this does not assist this inquiry and refers to *Clarins Fragrance Group f.k.a. Thierry Mugler Parfums S.A.S. v BenQ Materials Corp.* [2018] SGIPOS 2 (“*Clarins*”) at [31].

24 I agree that it would be a speculative exercise to try to figure out the reason for other traders’ choices of their marks. Save for published disclaimers and other relevant published information relating to the mark on the register, the circumstances of acceptance of a mark are not privy to others. However, I am of the view that the word “DISCOVERY” which bears the meaning of making a finding that no one else has known about before, a breakthrough of sorts, is likely “the sort of word in which traders would like a monopoly” (“*Clarins*”) at [31]. The meaning it carries has a certain appeal, for which trader would not want to describe their goods or services as being imbued with exciting possibilities of a *Eureka* moment, of finding out something good or new or exciting about the goods or services? And certainly, this is clearly borne out in Annex A of the Applicant’s Counter-Statement, where there is a list of marks showing that many traders favour the use of the word “DISCOVERY” in their marks. Some examples include “Lash Discovery” (class 3),

“Channel to Discovery” (class 36), “i-Discovery” (class 9), “Wine Discovery” (class 35), and 4 marks bearing the word “DISCOVERY” in plain block letters belonging to 4 different proprietors in classes 11, 12, 14 and 16 respectively. There are also other marks which comprise only the word “DISCOVERY” with a device, as well as marks with only the word “DISCOVERY” written in coloured stylised font. The number of such marks where the word “DISCOVERY” is chosen as part of the mark, and in particular the many marks comprised solely of the word “DISCOVERY”, indicate that the word “DISCOVERY” is not an uncommon choice for marks across the classes.

25 It bears noting that the Opponent does not have any registration for the plain word “DISCOVERY” on its own.

26 With the exception of “THE DISCOVERY CHANNEL” mark, all of the Opponent’s Earlier Trade Marks begin with the word “DISCOVERY”. The Opponent submits that this component will therefore be accorded central prominence as it is what first catches the consumer’s attention. The Opponent’s Primary Earlier Trade Mark.  and the Category III  mark both contain the device of a globe, but the Opponent says that the textual component is large and the significantly smaller device is placed in a subsidiary position. Hence the “DISCOVERY” component is still more prominent. As for the Opponent’s Earlier Trade Marks in Category I which comprise the word “DISCOVERY” with a suffix, for example “Discovery Go” and “Discovery Kids”, the Opponent submits that the word “DISCOVERY” still takes up more visual space and occupies greater aural and conceptual significance. The Opponent admits that these suffixes are “generally descriptive of the kind, quality, intended purpose, or other characteristics of goods and services claimed”. The Opponent has submitted at [17] OWS that in relation to its earlier trade marks, the component “DISCOVERY” is “the central prominent component which inherently enjoys a medium level of technical distinctiveness.”

27 The fact that the component “DISCOVERY” is a common English noun defined as “the act or an instance of finding something previously unknown” does not automatically mean that it is not inherently distinctive. *Han’s (F&B) Pte Ltd v Gusttino World Pte Ltd* [2015] 2 SLR 825 (“*Hans*”) at [61]-[62] has held that although a word or phrase is not newly coined, if the meaning of the word or phrase has little bearing on the product to which it is to be applied, then it can have a high level of inherent distinctiveness. In this matter however, I am of the view that the word “DISCOVERY” has some nexus to the Opponent’s goods and services. In *Han’s* at [74], Wei J mentions a category of words which are “commonly used words that have some nexus to the goods concerned, yet are neither descriptive of the goods nor arbitrary in relation to them.” The word “DISCOVERY” is one of such words that has some nexus to the Opponent’s goods and services which are related to the exploration and unearthing of new information or the acquisition of new knowledge. The Opponent’s marks in class 9 for example include goods such as “electronic learning games”, “pre-recorded audio-visual recordings, audiotapes, video discs, compact discs, DVDs and multimedia software recorded on CD-ROM, all featuring subjects of general human interest” and class 41 “television programs in the field of general human interest”. These are but some examples of the Opponent’s goods and

services that veer towards the acquisition of new knowledge, the discovery of things not yet known. The Opponent’s marks therefore do not have a high level of inherent distinctiveness, and I note the Opponent’s own submission that the “DISCOVERY” component only enjoys a medium level of inherent distinctiveness. Indeed, I am of the view that the “DISCOVERY” component leans towards having only a low level of inherent distinctiveness.


Is the “DISCOVERY” component the distinctive and dominant of the Opponent’s marks?


28 The Opponent’s submissions are premised on the point that the “DISCOVERY” component is the distinctive and dominant part of its marks which will tend to stand out in the consumer’s imperfect recollection and used as the primary basis of comparison.

29 I am guided by the High Court in *The Polo/Lauren Company LP v United States Polo Association* [2016] SGHC 32 at [11] (“*Polo*”) and will use the following relevant factors in assessing whether the “DISCOVERY” component is the distinctive and dominant component of the Opponent’s marks:

- (a) The technical distinctiveness of the component
- (b) The “size” of the component
- (c) The position of the component within the composite mark


30 I have already decided that the “DISCOVERY” component has a low level of technical distinctiveness. Applying the other relevant factors in *Polo* to assess the dominance of the “DISCOVERY” component, I find:

Primary Earlier Trade Mark		The Opponent’s Primary Earlier Trade Mark features the word “Discovery” and the device of a globe. The device of the globe on its own is smaller than the entire word, but being approximately the size of the letter “o” in the word “Discovery”, it is not <i>de minimis</i> . However, the position of the device of the globe shows that it is not a device separate from the word “Discovery”. The device is elided with and clearly forms part of the capital letter D in the word “Discovery”. Hence, this D-plus-globe device cannot be ignored because it is a distinctive feature of the whole word “Discovery”.
	DISCOVERY EDUCATION	
	DISCOVERY ADVENTURES	

Category I “DISCOVERY” + suffix	DISCOVERY CHANNEL	The “DISCOVERY” component has equal prominence in terms of the length of the words in the mark.
	DISCOVERY GO	The “DISCOVERY” component is more prominent, given the length of the suffixes “GO” and “KIDS”
	DISCOVERY KIDS	
Category II	THE DISCOVERY CHANNEL	(see [32] below)
Category III		The same considerations made in respect of the Primary earlier trade Mark apply here. The added word “EDUCATION” is written in a font which is almost a quarter the font size of the “Discovery with D-plus-globe device” component and do not distract the eye from its focus on the “Discovery with D-plus-globe device” component.

31 With respect to the Category I marks, the “DISCOVERY” component and the suffixes are generally of equal size and length, and neither can be said to enjoy a more prominent position over the other.

32 The Opponent’s “**THE DISCOVERY CHANNEL**” mark does not have a distinctive or dominant component. The words “The”, “Discovery” and “Channel” read collectively will be seen as a reference to a specific unique item. The article “The” references the proper noun “Discovery Channel” which is the uniquely specified item. As such, I find that there is no distinctive or dominant component in “The Discovery Channel” mark.

33 I find that the word “DISCOVERY” is not the distinctive and dominant component in the Opponent’s Earlier Trade Marks. The prominent component in the Opponent’s Earlier Trade Marks and the Category III mark  is not the plain word “DISCOVERY” but “DISCOVERY” with the distinctive D-plus-globe device feature. There is no dominant or distinctive component in the Opponent’s Category I and II marks.

34 I note that the Application Mark also has the word “DISCOVERY” featuring as the more prominent component in terms of its overall size and position in the mark. However, the same considerations on the distinctiveness of the word “DISCOVERY” in relation to the Opponent’s Earlier Trade Marks would apply to the Application Mark. Distinctiveness is an important consideration in this assessment especially where the competing marks both have the same “DISCOVERY” component and where this common word is a descriptive word. Professor Ng-Loy Wee Loon in *Law of Intellectual Property of Singapore* (Sweet & Maxwell, 2nd Edition, 2014) (“Ng-Loy Wee Loon”) at [21.5.18] has said:

“If there is a common component in the two marks, and this component is inherently non-distinctive (because, for example, it describes the quality of the goods or services in question) there would be some reluctance to find similarity

between the marks. This is because the tribunal would be wary of granting a monopoly over components which other traders may legitimately wish to use as part of their own trade marks.”

35 In any event, even if I am not correct in this assessment of whether the Opponent’s Earlier Trade Marks have a dominant and distinctive component, I have found the word “DISCOVERY” is of low technical distinctiveness by virtue of its descriptive connotation to the goods and services of the earlier trade marks. I would add that the Category I marks all bear suffixes that make reference to the nature or a characteristic of the goods or services which will not be considered as distinctive and dominant component of the marks. The Court of Appeal in *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] SGCA 30 (“*Caesarstone*”), has said at [41] that “the public will not generally consider a descriptive element ... as the distinctive and dominant element of the overall impression conveyed by that mark”. The residual in the Category I marks sans the suffixes is the word “DISCOVERY” which I have found to be of low technical distinctiveness.

Distinctiveness of the Opponent’s Earlier Trade Marks as a whole

36 Having found that the competing marks are essentially dominated by the word “DISCOVERY” , it is important to relate this back to the impression of the marks as wholes. *Staywell* at [29] states:

The finding of distinctiveness of the separate components of the mark must ultimately be related back to the impression given by the mark as a whole. The distinctiveness of a particular component of a mark is but one factor feeding into the ultimate question of whether the mark, in the form it is registered and/or used, has strength as an indicator of origin to the exclusion of other trade sources. This latter question clearly must be considered by looking at the mark as a whole, ***because it is the entire mark, and not only a component of it, that must function as the badge of origin.***

37 The Opponent’s submissions are that the Opponent’s Earlier Trade Marks have come to acquire a high degree of distinctiveness by reason of the long history of use and promotion of the “DISCOVERY” marks worldwide and in Singapore, its numerous registrations of the “DISCOVERY” marks in Singapore and worldwide (see pages 50 to 237 of the OSD) and the recognition of the well-known status and value of the “DISCOVERY” marks. In making these submissions, the examination of the evidence and reference to the figures, exhibits, etc are inevitable.

38 The Courts have held that at this stage of inquiry extraneous factors should not be taken into account. There has been some deliberation as to whether evidence of use may be considered at this stage. In the decision of *Monster Energy Company v NBA Properties, Inc* [2018] SGIPOS 16 (“*NBA Properties*”) the IP Adjudicator discussed whether such evidence may be considered at the marks-similarity stage at [41] to [48] and stated at [46]:

In my view, how the average consumer understands what he sees (which is the essence of the mark-similarity analysis) must necessarily depend on what he knows. As such, the knowledge of the average consumer, and how he is likely to understand or interpret the word device element of a composite mark, must be relevant to mark-similarity assessment. *What words (or images, for that matter) mean to the average consumer must be evaluated contextually. It follows that the parties should be permitted to adduce evidence of those surrounding circumstances that are relevant towards establishing the general knowledge possessed by the average consumer.* To consciously ignore this context would entail the adoption of a highly contrived, and artificially blinkered, approach towards mark-similarity assessment that is incompatible with the commercial realities within which the trade mark regime operates. (emphasis mine)

39 At the outset, where distinctiveness is concerned, I note that the Opponent's Primary Earlier Trade Mark and all the Opponent's other earlier trade marks have secured registration. This is an indication that the Opponent's marks meet the threshold of being signs capable of distinguishing the origin of goods or services. This threshold has been described as "an initial, albeit low, threshold that all aspiring trade marks must clear". (*Hai Tong* at [28], *Nation Fittings (M) Sdn Bhd v Oystertec plc* [2006] 1 SLR(R) 712 ("*Nation Fittings*") at [136])

40 Beyond crossing the initial low threshold of distinctiveness and securing registration, how an average consumer attains his "general knowledge" of the *who-what-when-how* of a mark must surely be through his exposure to the mark via means such as advertisements, promotional activities, media reports, publications. In my view, assessment of the technical distinctiveness of marks at marks-similarity stage would be difficult without information on how the marks are used. However, I do not propose to delve into the evidence of use at this juncture save to point to an article published in the Straits Times on 31 May 2018 (OSD at page 279) that will assist "*towards establishing the general knowledge possessed by the average consumer.*" Although the date of the article post-dates the Relevant Date of 26 July 2017, the article makes a reference to the viewership of the Opponent's channels in 2017:

"In Singapore, Discovery's portfolio of channels reached a total of 1.3 million viewers in the last year."




41 The statement is indicative of the breadth of exposure an average consumer of cable television would have had to the Opponent's Discovery marks over time, culminating in the 1.3 million viewers in 2017. The Opponent is a big player in the mass media industry, and producing programmes for television is but one of its major portfolios. Television has been a popular means of entertainment particularly before the advent of the internet, and the average consumer in Singapore would be sufficiently exposed to the Opponent's Discovery marks. This exposure would contribute towards the shaping of the average consumer's "general knowledge" vis-à-vis the Opponent's Discovery marks. I therefore conclude that due to this exposure, the Opponent's Earlier Trade Marks as wholes can be said to have acquired distinctiveness that gives it greater technical distinctiveness.

The First Element: Marks Similarity

42 I now move on to the step-by-step approach for the assessment of mark-similarity. I will consider whether there is visual, aural and conceptual similarity between the marks, bearing in mind the reiteration of the Court of Appeal in *Staywell* at [26] which states that 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.”

Visual Similarity

43 For ease of reference, the Opponent’s Earlier Trade Marks and the Application Mark are reproduced below, following the earlier categorisation at [17]. I am however mindful that an average consumer who has but an average recollection, will not have this luxury of comparing the marks visually side-by-side.

Opponent’s Mark	Application Mark
Primary Earlier Trade Mark 	
Category I DISCOVERY EDUCATION DISCOVERY GO DISCOVERY KIDS DISCOVERY CHANNEL DISCOVERY KIDS DISCOVERY ADVENTURES	
Category II THE DISCOVERY CHANNEL	
Category III 	

44 The Court of Appeal in *Caesarstone* at [32] cited with approval the principle laid down in *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2005] 4 SLR(R) 816. Lai Kew Chai J held (at [26]) that “[i]n cases where there is a common denominator, it is important to look at the differences between the mark and the sign in order to decide whether the challenged sign has been able to distinguish itself sufficiently and substantially”.


45 I am further guided by the Court of Appeal in *Hai Tong* at [62(b)] where the Court said that when assessing composite marks “...[t]he 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).”

46 The Opponent submits that the “DISCOVERY” component will tend to stand out in the consumer’s imperfect recollection and be used as the primary basis of comparison. The Application Mark has the word “DISCOVERY” placed in a prominent central position and is of a larger size compared to the word “Camps”. The Opponent’s Earlier Trade Marks all begin with the “DISCOVERY” component as the first word (with the exception of the “**THE DISCOVERY CHANNEL**” mark) and this component will be accorded central prominence by the average consumer. In relation to the DISCOVERY plus device marks, the textual component “DISCOVERY” is larger than the globe device and it occupies a more prominent location in relation to the device. Similarly, for the DISCOVERY plus suffix marks, the word “DISCOVERY” takes up more visual space and occupies greater aural and conceptual significance.

47 The Applicant submits that it is clear that none of the Opponent’s Earlier Trade Marks are similar to the Application Mark. The Application Mark features the word “Camp” prominently and visually, the Opponent’s Earlier Trade Marks do not contain the word “Camp” nor do they make any reference to camps, camping or camp related activities. The Applicant also reiterates that the font used in the Application Mark is not similar to any fonts used in the Opponent’s Earlier Trade Marks.

48 I have held above that the overall distinctiveness of the word “DISCOVERY” is low but the distinctive feature of the Opponent’s Primary Earlier Trade Mark is its D-plus-globe device. Bearing this in mind, I will assess the visual similarity of the marks according to the categorisation in [17].

Comparison between the Opponent’s Primary Earlier Trade Mark. :  Discovery and the Application Mark

49 I am mindful that in assessing marks for visual similarity the average consumer will perceive the competing marks as wholes. However, in the overall visual impression of marks, the average consumer will not pay too much heed to a descriptive word in the mark. Hence the presence of the word “CAMPS” below the word “DISCOVERY” in the Application Mark will not be perceived as significant as it is descriptive of the goods and services.

50 The competing marks are similar only insofar that they both incorporate the word “DISCOVERY”. Visually however the marks differ because of the distinctive feature in the Opponent’s Primary Earlier Trade Mark and the stylised manner in which the Application mark is presented. The device in the Opponent’s Primary Earlier Trade Mark is an elided globe on the capital letter D in the word “DISCOVERY” and which forms the vertical stem of the capital “D” is a special feature in the whole word “DISCOVERY”. Even though the size of the device is not significant in relation to the whole mark, visually the elided device constitutes a material part of the whole word “DISCOVERY”. The visual

impact of the Application Mark is different from the Opponent's Primary Earlier Trade Mark. The word "DISCOVERY" in the Application Mark is in a different presentation; it is angled and written in cursive with a stylised flourish to underscore the word "DISCOVERY". I find that 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".

51 I find therefore that Opponent's Primary Earlier Trade Mark and the Application Mark are visually more dissimilar than similar.

Comparison between Opponent's Category I marks ("DISCOVERY + suffix" marks) and the Application Mark

52 When comparing the visual similarity of word marks, the following is to be considered:

- (a) The length of the marks
- (b) The structure of the marks, i.e. whether there are the same number of words
- (c) Whether the same letters are used in the marks

See *Ozone Community Corp v Advance Magazine Publishers Inc* [2010] SGHC 16 at [49] ("*Ozone*").

53 Using the guide in *Ozone*, I find the marks to be structurally similar in that the competing marks are two-word marks which begin with the word "DISCOVERY". Although lengthwise the marks may differ as different suffixes are used, what strikes the eye first when looking at the competing marks is the dominance of the word "DISCOVERY" as the first word in the marks. Furthermore, the suffixes used are words which are descriptive of the services offered and which are in the words of the Opponent at [19b] OWS "generally descriptive of the kind, quality, intended purpose, or other characteristics of goods and services claimed", and this equally applies to the suffix "CAMPS" in the Application Mark. In *Caesarstone* at [41] the Court of Appeal said:


We agree with the Appellant that the word "stone" is merely descriptive of the goods in Class 19. In this regard, the public will not generally consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark (*Honda Motor Europe Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (Case T-363/06) [2009] ETMR 34 at [39]) and, for this reason, we do not think that the presence of such a descriptive element can fairly be regarded as being effective to displace similarity.

54 The Category I marks are presented in plain block letters without any embellishment and do not sport any distinctive feature. Although the Application Mark is stylised, I find here that the stylisation in the Application Mark here is not sufficient to visually detract from the fact that the overall impression conveyed by both marks is dominated by the word "DISCOVERY". At the same time, I would reiterate that the overall distinctiveness of the word "DISCOVERY" is low.

55 Having regard to the above therefore, I am of the view that these marks are visually slightly more similar than dissimilar.

Comparison between Opponent's Category II mark (" THE DISCOVERY CHANNEL ") and the Application Mark

56 I find that the competing marks here visually more dissimilar than similar. The presence of the word "The" before "Discovery Channel" gives the mark a different visual presentation compared to the Application Mark. The word "The" gives the mark a referencing emphasis and calls the eye to pay particular attention to the following words "Discovery Channel".

Comparison between Opponent's Category III mark ( mark) and the Application Mark

57 The additional word "EDUCATION" that appears is in much smaller font and is descriptive. However, the same considerations in [49]-[50] relating to the device in the mark apply. I find that the competing marks are visually more dissimilar than similar.

Conclusion on Visual Similarity

58 Overall, with the exception of the Category I marks, I find that that the Opponent's Earlier Trade Marks are visually more dissimilar than similar to the Application Mark.

Aural Similarity

59 The Court of Appeal in *Staywell* at [31]-[32] set out the following two approaches to the inquiry into aural similarity:


- (i) Consider the dominant component of the marks to assess whether the competing marks are aurally similar as wholes ("Dominant Component Approach")
- (ii) Undertake a quantitative assessment as to whether the competing marks have more syllables in common than not ("Quantitative Assessment Approach").

60 The D-plus-globe device appearing in the Opponent's Primary Earlier Trade Mark. and the Category III mark is not relevant in the aural similarity inquiry.

61 The Applicant argues that the Application Mark should be considered as a whole and that the words "Discovery" and "Camp" are both dominant components. When referred to aurally, both "Discovery" and "Camp" are pronounced equally loudly. Further, at least half the pronunciation of the Application Mark will differ entirely from any of the Opponent's Earlier Trade Marks. The Applicant says that quantitatively, there is also significant difference between the competing marks. There is a 33% difference in syllables between the Primary Earlier Trade Mark and the Application Mark (2 syllable difference (out of 6)), and the difference vis-à-vis the Opponent's other earlier marks is even more stark.

62 The Opponent submits that there is a high degree of aural similarity between the competing marks due to the presence of the dominant component “DISCOVERY” in both the competing marks; and the other elements are negligible. As for the quantitative aspect, the Opponent submits that there is strong aural similarity between the competing marks; particularly with respect to the Primary Earlier Trade Mark, the “Discovery Go” and “Discovery Kids” marks in Class 9, “Discovery Kids” in Class 16, and “Discovery Adventure” in Class 39. There are more syllables in common than not between these marks and the Application Mark.

63 Using the approach in *Staywell* at [31]-[32] in the inquiry into aural similarity and applying the Dominant Component Approach:

Comparison between the Opponent’s Primary Earlier Trade Mark. :  Discovery and the Application Mark


64 As the word “CAMPS” in the Application Mark is a descriptive suffix it has been held in *Caesarstone* at [41] that the presence of such a descriptive element cannot fairly be regarded as being effective to displace similarity. As such the aural significance of the competing marks is greater and I find that the marks are aurally more similar than dissimilar.

Comparison between Opponent’s Category I marks (“Discovery + suffix” marks) and the Application Mark

65 The marks all have the same structure and sequence – each begins with the component “DISCOVERY” followed by a suffix. The suffix is a word that tends towards the description of the kind, quality, intended purpose, or other characteristics of goods and services claimed (such as “Kids”, “Education” and “Adventure”) and what has been decided at [53] in relation to these descriptive suffixes applies equally in the aural analysis. I find that the marks are aurally more similar than dissimilar.

Comparison between Opponent’s Category II mark (“ THE DISCOVERY CHANNEL”) and the Application Mark

66 I find that the competing marks are aurally similar. The referencing word “the” is often used in the spoken word when one makes a reference to nouns or proper names: for example, “the girl”, “the Smartphone”, “the Cricket Club” and indeed “the Discovery Channel” or “the Discovery Camp”. It would be unlikely and unusual if the manner of referring to “**THE DISCOVERY CHANNEL**” were “the **THE DISCOVERY CHANNEL**”.

Comparison between Opponent’s Category III mark ( mark) and the Application Mark




67 The same considerations in [64] apply to these competing marks. Visually the word “DISCOVERY” in the competing marks dominates and the tendency will be to read the

more dominant component This makes the competing marks aurally more similar than dissimilar.

Quantitative Assessment Approach

68 Most of the Opponent’s Earlier Trade Marks and the Application Mark both appear in the same sequence, the word “DISCOVERY” preceding the suffix (if any). The sequence is important in the Quantitative Assessment Approach as shown in the hypothetical situation in *Monster Energy Company v Glamco* [2018] SGHC 238 (“*Glamco*”) at [61] where a dissimilar sequence might result in a different conclusion on aural similarity.

69 Applying the Quantitative Assessment Approach to the competing marks to assess whether they are aurally similar, the analysis is as shown:

Opponent’s Earlier Trade Marks	Application Mark	
		4 out of 5 syllables are identical
DISCOVERY EDUCATION		4 out of 8 syllables are identical
DISCOVERY GO		4 out of 5 syllables are identical
DISCOVERY KIDS		4 out of 5 syllables are identical
DISCOVERY CHANNEL		4 out of 6 syllables are identical
DISCOVERY ADVENTURES		4 out of 7 syllables are identical
THE DISCOVERY CHANNEL		4 out of 7 syllables are identical
		4 out of 8 syllables are identical

70 In light of the above, applying both the Dominant Component Approach and the Quantitative Assessment Approach, I find that the Opponent’s Earlier Trade Marks aurally more similar than dissimilar to the Application Mark. However, in all the above comparisons, the similarity in each case resides in the word “DISCOVERY”. As I have already mentioned, the overall distinctiveness of the word “DISCOVERY” is low.

Conceptual Similarity

71 The inquiry into the conceptual similarity of marks “seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole” (*Staywell* at [35], affirmed in *Caesarstone Sdot-Yam Ltd v Ceramiche Caesar SpA* [2017] 2 SLR 308 (“*Caesarstone HC*”) at [48]).

72 The Opponent submits that the overall impression conveyed by the competing marks will be conveyed by the “DISCOVERY” word since this word is the dominant and distinctive component of the marks. The Opponent also states that its earlier marks have enhanced technical distinctiveness and having regard to the descriptive nature of the suffixes in the

competing marks, the average consumer will come to associate any “DISCOVERY”-formative sign to be a subsidiary, branch or extension of the main “DISCOVERY” brand. (OWS at [66])

73 The Applicant on the other hand submits that conceptually, the Application Mark is clearly focused on and references camps. This, it argues is a separate and distinct concept from the Opponent’s Earlier Trade Marks for the Opponent’s marks are focused towards media and cable television. The Applicant reiterates that “DISCOVERY” is not a distinctive concept and is a common noun.

74 I am not able to agree with the Applicant’s submission that the Application Mark is focused on camps. It would follow from this line of submission that the Opponent’s Category I marks would similarly be focused on “Education”, “Kids”, “Adventure”, etc. In any event, I have found that where the competing marks are prefixed with the component “DISCOVERY” and followed by a suffix that is descriptive of the goods or services of that mark, the overall impression remaining in the marks is that which is conveyed by the word “DISCOVERY”. For this reason, I therefore find that conceptually, the competing marks are more similar than dissimilar. But again, I note that the similarity resides in the word “DISCOVERY”, which is of low distinctiveness, and is a word which many other traders might legitimately wish to use to describe their goods and services.

Conclusion on Marks-Similarity

75 Having considered the three aspects of similarity above, I find: (i) the Primary Earlier Trade Mark, the Category II and III marks visually more dissimilar than similar; (ii) the competing marks aurally more similar than dissimilar; and (iii) the competing marks conceptually similar. The similarity resides in the word “DISCOVERY”, which is of low distinctiveness.


The Second Element: Similarity between the goods or services

76 The second step in the assessment of likelihood of confusion is to assess whether there is similarity between the goods and services of the Application Mark and the Opponent’s earlier trade marks.

77 The relevant factors for consideration under this limb are those set out in ***British Sugar Plc v James Robertson & Sons Ltd*** [1996] RPC 281 (“***British Sugar***”) (and endorsed in ***Staywell*** at [43]):

- (i) the respective uses of the respective goods or services;
- (ii) the respective users of the respective goods or services;
- (iii) the physical nature of the goods or acts of service;
- (iv) the respective trade channels through which the goods or services reach the market;
- (v) the extent to which the respective goods or services are competitive.

78 The goods and services of the competing marks are set out below:


S/N	Opponent's Trade Marks	Applicant's Mark
1	<p style="text-align: center;"> Discovery</p> <p style="text-align: center;">TM No. T1414024F</p> <p>Class 9 Prerecorded audiovisual recordings, audiotapes, videotapes, video discs, compact discs, DVDs and multimedia software recorded on CD-ROM, all featuring subjects of general human interest; electronic learning games in the nature of electronic game software for educational purposes; video game discs; computer game discs; electronic game programs; downloadable ring tones, graphics, ring backs, animated ringers, video ringers and animated screensavers via the Internet and wireless devices; digital media, namely, downloadable prerecorded video clips, prerecorded audio clips, text and graphics held in electronic personal computers and handheld wireless devices, all featuring subjects of general human interest; sunglasses.</p>	<p>Class 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 pre-recorded 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;</p>
2	<p style="text-align: center;">DISCOVERY EDUCATION TM No. T0908248I</p> <p>Class 9 Prerecorded audiovisual recordings, audiotapes, videotapes, video discs, compact discs, DVDs, VCDs, CD-ROMS; electronic learning games, video game cartridges, video game discs, computer game discs, electronic game programs, computer game programs; downloadable ring tones, graphics, ring backs, animated ringers, video ringers and animated screensavers; downloadable prerecorded video clips, prerecorded audio clips, text and graphics held in electronic personal computers and handheld wireless devices; magnets; stereoscopic viewers and slide reels; calculators; telescopes, binoculars, sunglasses; motorcycle goggles; helmets (motorcycle, bicycle).</p>	<p>Education software; Films bearing recorded educational material; Language translating apparatus; Magnetic data carriers recorded with programmes for instruction in foreign languages; Mathematical instruments;</p>
3	<p style="text-align: center;">DISCOVERY GO TM No. T1210936H</p>	<p>Mathematical instruments;</p>

	<p>Class 9 Computer software for use in processing, transmitting, receiving, organizing, manipulating, playing, reviewing, reproducing and streaming audio, video and multimedia content including text, data, image, audio, video and audiovisual files; computer software for controlling the operation of audio and video devices and for viewing, searching and/or playing audio, video, television, movies, other digital images, and other multimedia content; computer software for interactive entertainment, which allows users to customize the viewing, listening, and playing experience by selecting and arranging the display and performance of audio, video and audiovisual elements; downloadable audio, visual, and audiovisual files and recordings, featuring multimedia entertainment programs and content.</p>	<p>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].</p>
4	<p style="text-align: center;">DISCOVERY KIDS TM No. T1217103I</p> <p>Class 9 Motion picture films (recorded); pre-recorded video discs and audio-visual recordings; pre-recorded videotapes; pre-recorded compact discs; DVDs; CD-ROMs; sunglasses; cell phone faceplates; computer accessories, namely, CD-ROM cases and mouse pads; magnets; electronic media, namely, books on tape and CD-ROM; electric switch plates; radios incorporating clocks; telescopes; microscopes; calculators; telephones; binoculars; directional compasses; stereoscope slide reels and viewers; computer game software and video game disks and cartridges.</p>	
S/N	Opponent's Trade Marks	Applicant's Mark
5	<p style="text-align: center;">DISCOVERY EDUCATION TM No. T0908248I</p> <p>Class 16 Books, magazines, newsletters, instructional manuals and printed instructional teaching materials; photographs; stationery; adhesives for stationery or household uses; artists' materials, namely, artists' brushes and artists' pastels; paint brushes, paint applicators, paint application rollers,</p>	<p>Class 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</p>

	<p>paint roller covers, instruction books and manuals regarding home repair and home and garden design; plastic material for packaging, namely, plastic bags; printers' type; printing blocks; posters; postcards; note cards; desk top organizers; desk sets; desk pads; blotters; personal organizers; bulletin boards; diaries; agendas; pens; pencils; pencil cases; pen cases; drawing rulers; bookmarks; book plates; book covers; paper stationery portfolios; binders; notebooks; coloring books; note pads; non-electric erasers; non-electric pencil sharpeners; stencils; stencil kits comprised of instruction manual, stencils, film, brushes and paint; stationery letter and writing paper folders; envelopes; file folders; rubber stamps; blackboards; paper bags; plastic bags for general use; wrapping paper; trading cards (printed matter) ; children's activity books; educational activity books; composition books; stickers; decals; paper napkins and plates; paper tablecloths; place mats of paper; calendars, desk calendars, wall calendars, daily calendars; paper, including writing paper, art paper, construction paper; art and crafts paint kits; painting kits comprised of instruction manual, drawings or pictures, paint embossing tools, paintbrushes and mats for framing; boxes and containers made of paper, cardboard and plastic; art prints; color prints; lithographic prints; photographic prints; comic strips; decorations of paper (other than Christmas decorations), party streamers; paper bags (wrapping materials); maps; temporary tattoos.</p>	<p>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].</p>
6	<p style="text-align: center;">DISCOVERY CHANNEL</p> <p style="text-align: center;">TM No. T0105038C</p> <p>Class 16 Posters; postcards; desk top organizers; desk sets; desk pads; blotters; personal organizers; diaries; pens; pencils; pencil cases; pen cases; drawing rulers; bookmarks; book plates; book covers; notebooks; coloring books; note pads; non-electric erasers; non-electric pencil sharpeners; stencils; stationery folders; file folders; rubber stamps; bulletin boards; paper bags; wrapping paper; trading cards; children's activity books; educational</p>	<p>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].</p>

	<p>activity kits comprising mainly books and including, flashcards and other instructional printed material; composition books; stickers; decals; paper napkins, paper plates, place mats; calendars, namely, desk calendars, wall calendars, daily calendars; paper, namely, writing paper, art paper, construction paper; arts and crafts paint kits; art prints; color prints; lithographic prints; photographic prints; comic strips; books; magazines; party favors; paper party decorations; paper party hats; paper party bags; playing cards; maps</p>	
7	<p style="text-align: center;">DISCOVERY KIDS TM No. T1302177D</p> <p>Class 16 Posters; postcards; desk top organizers; desk sets; desk pads; blotters; personal organizers; diaries; pens; pencils; pencil cases; pen cases; drawing rulers; bookmarks; book plates; book covers; notebooks; binders; coloring books; note pads; non-electric erasers; non-electric pencil sharpeners; stencils; stationery folders; file folders; rubber stamps; marker boards (stationery), memo boards (printed matter), mount boards being articles of cardboard or paper for mounting pictures and/or printed matter, notice boards (signboards) of cardboard, paper boards (stationery), signboards of paper or cardboard and writing boards; paper bags; wrapping paper; trading cards (printed matter); children`s activity books; educational activity kits comprising books, flashcards, printed publications containing puzzles, word games and other instructional materials; composition books; stickers; sticker albums; decals; paper napkins, paper place mats; calendars, desk calendars, wall calendars, daily calendars; paper, including writing paper, art paper, construction paper; arts and crafts paint kits; art prints; color prints; lithographic prints; photographic prints; photo albums; comic strips; books; magazines; party game books, party invitation pads, party stationery; paper party decorations; paper party bags; maps.</p>	


79 And in Classes 39, 41 and 43:

S/N	Opponent's Trade Marks	Applicant's Mark
8	<p>DISCOVERY ADVENTURES TM No. T1114528Z Class 39 Organization of trips; organization, booking and arrangement of excursions, day trips and sightseeing tours; coordinating travel arrangements for individuals and for groups; arranging travel tours; providing online information relating to travel and travel services; organization of excursions, sightseeing tours, holidays, tours and travel; travel agency services, namely, making reservations and bookings for transportation; travel information services; travel guide services.</p>	<p>Class 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.</p>
9	<p>THE DISCOVERY CHANNEL TM No. T9206666J Class 41: Education and entertainment services; television and audio visual production services, all being services included in this Class.</p>	
10	 <p>TM No. T1010851H Class 41 Educational services, namely, dissemination of educational materials via broadband distribution, online web sites and television programming.</p>	

80 A comparison of the goods of both the Opponent and the Applicant shows that the goods are quite similar in respect of their uses, users and physical nature. The class 9 specification of both parties cover primarily audio-visual devices for educational purposes. I will not go into the details of each item but generally the overlapping items include audio-visual recordings such as tapes and film, and educational electronic apparatus. Similarly, there is a clear and fairly substantial overlap in class 16, where the bulk of the items covers books, publications, stationery items, art and craft material which are primarily for

educational purposes. The uses are the same and there may be some overlap in the users of the goods. The physical nature of the goods is similar.

Class 43 services

81 The Opponent submits that there is close similarity between the Applicant's Class 43 services and its services in class 39 (in relation to the "**DISCOVERY ADVENTURES**" mark) and class 41 services under the "**THE DISCOVERY CHANNEL**" mark. The Opponent states that the Applicant's class 43 services broadly cover 2 distinct segments, that is, accommodation services and childcare services. The Opponent's class 39 services for the "**DISCOVERY ADVENTURES**" mark include "[o]rganization of trips; ... coordinating travel arrangements for individuals and for groups; ... travel agency services" which is complementary and ancillary to the services provided by the Applicant with respect to the provision of lodging services and accommodation at holiday camps. As for the Applicant's childcare services", the Opponent's argue that its services "[e]ducation and entertainment services" ("**THE DISCOVERY CHANNEL**" mark) and "[e]ducational services, namely, dissemination of educational materials via broadband distribution, online web sites and television programming" ("  " mark) are inextricably linked and complementary to child care services which are primarily intended to educate and entertain children. The Opponent cites the case of *Guccio Gucci S.P.A v Guccitech Industries (Private Ltd)* [2018] SGIPOS 1 ("*Guccitech*") at [41] to support its argument. As further support for this proposition, the Opponent referred to the published guideline of the Early Childhood Development Agency ("ECDA"), the regulatory and developmental agency for the early childhood sector in Singapore. The guideline is titled the "Guide to Setting Up An Early Childhood Development Centre" (29 April 2019) ("the Guide") (OBOA at page 790). According to the Guide, the Opponent argues that any premises which provide early childhood development services must have a programme plan that supports the learning and developmental needs of all the children, and this may include the usage of different types of teaching aids. In this regard, the Opponent says that the use of the internet and online television broadcasting as modes of educational instruction are common and hence the Opponent's educational services in class 41 have an inextricable link to the Applicant's class 43 services.

82 The Applicant points out that the Applicant's Mark does not cover goods and services which are similar to the Opponent's Mark in classes 9 and 16. It also states that its relevant segment of the public, regardless of the classes in dispute, is different. The Applicant runs enrichment classes and camps for children and the consumers of its services are not the same as the Opponent's. The Opponent's consumers are those who watch TV cable programmes, hence there is no overlap in the services.

83 I am not able to agree with the Applicant on this. I would venture to say that the Applicant's relevant segment of the public is a subset of the Opponent's much larger segment. Aided by television viewership, the Opponent's consumers far outnumber the Applicant's smaller pool of consumers.

Childcare service

84 As a starting point, it is not disputed that the Opponent does not have any registrations in class 43. The Opponent's reference to the Guide is to buttress its argument that there is an inextricable link between the Applicant's childcare services in class 43 and the Opponent's "[e]ducation and entertainment services" and "[e]ducational services, namely, dissemination of educational materials via broadband distribution, online web sites and television programming in *class 39*". What the Opponent seems to say is that since the Applicant runs child care services, it should heed the ECDA's requirements which set out that child care centres must provide a proper plan for the learning and developmental needs of the children. This plan should include use of the internet and online television broadcasts, hence the inextricable link between the Applicant and the Opponent services is established.

85 I find the Opponent's argument a stretch. The Guide does not explicitly state the modality of the "various types of teaching and learning aids and manipulatives" required in the programme plan. Furthermore, the text from page 29 of the Guide [Tab 26 OBOA] which reads "[t]he centre uses various types of teaching and learning aids and manipulatives for every learning area/domain. The variety of materials is able to sustain the children's interest, promote the children's development and provide different experiences. Play equipment and materials are accessible to all children" must be read in context. These sentences are extracted from content in the Guide which relates to the spatial requirements of the learning environment. (Tab 26 OBOA, page 29 of the Guide). I therefore do not find the extrapolation of a generic requirement in the Guide useful to conclude that there is an "inextricable link" between the Opponent's and Applicant's services.

86 In any event, I do not find an inextricable link between the Opponent's services "[e]ducation and entertainment services" and "[e]ducational services, namely, dissemination of educational materials via broadband distribution, online web sites and television programming" and the Applicant's "child care services".

Accommodation services

87 With respect to "accommodation services", the Opponent's submission at [74] OWS states this:

Vis-a-vis **accommodation services**, the Class 39 services in the "**DISCOVERY ADVENTURES**" (S/N 7) mark relates to the "[o]rganization of trips; ... coordinating travel arrangements for individuals and for groups; ... travel agency services" etc. The nature of these claimed services is complementary and ancillary to the provision of lodging services and accommodation at holiday camps as claimed by the Applicant's Mark. It is common for travel agencies to offer one-stop travel solutions which covers every aspect of the travel experience from the organization of the itinerary to the transportation and accommodation arrangements. Thus, the average consumer of such services would be the general public who can preview and choose both travel and lodging services at a travel agency in relation to a holiday camp experience on the same occasion and in the same place.

88 The Applicant’s “accommodation services” under class 43 are not services akin to that of holiday makers seeking out a travel agent to make arrangements for their travel accommodation. The Applicant’s class 43 services cover “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”. [emphasis mine] Hence it can be seen that the Applicant’s accommodation services are specific to “holiday camps” – “holiday camp services [**lodging**]; holiday camp services [**temporary accommodation**] and providing **temporary lodging** at holiday camps”. This is consistent with the Applicant’s evidence that its programmes are camps which are specifically tailored for pre-schoolers, school-going children and teenagers. This “accommodation” would entail “staying over at camp”, usually a day or a few in a structured and controlled environment, with activities planned for the camp. This sort of “accommodation” arrangement does not require services of a travel agent.

89 The Opponent’s class 39 services (this specification relates to the Opponent’s “DISCOVERY ADVENTURE” mark) refer to “Organization of trips; organization, booking and arrangement of excursions, day trips and sightseeing tours; coordinating travel arrangements for individuals and for groups; arranging travel tours; providing online information relating to travel and travel services; organization of excursions, sightseeing tours, holidays, tours and travel; travel agency services, namely, making reservations and bookings for transportation; travel information services; travel guide services.” The list of services of the Opponent’s class 39 suggests full-fledged travel agency services which handle the organisation of trips or bookings from inception until the end of the trip.

90 Be that as it may, at this stage the comparison is between the specification of services in respect of which the Application Mark is applied for in Class 43 and the specification of services in the Opponent’s Earlier Trade Marks in Classes 39 and 41. I will not consider actual use of either or both marks in respect of those services.

91 I find that there is an overlap in “[o]rganization of trips; organization, booking and arrangement of excursions, day trips and sightseeing tours; coordinating travel arrangements for individuals and for groups” with the Applicant’s holiday camp services. This subset of services within the Opponent’s class 39 specification are wide enough to overlap with the Applicant’s Class 43 services. Although the services described are not identical, their overlap is meaningful and complementary: for example, the Opponent’s “organisation, booking and arrangement of excursions, day trips” are complementary to arranging for lodging, temporary lodging of the Applicant’s “holiday camp”.

Conclusion on similarity of goods and services

92 I find therefore that there is similarity of the Class 9 and class 16 goods. With respect to the services in classes 39 and 41, and class 43, there is some similarity of services in the identified subset of services “holiday camp services [**lodging**]; holiday camp services [**temporary accommodation**] and providing **temporary lodging** at holiday camps” to

“Organization of trips; organization, booking and arrangement of excursions, day trips and sightseeing tours; coordinating travel arrangements for individuals and for groups”.

The Third Element: Is there a likelihood of confusion arising from the two similarities?

93 Having assessed the similarity or identity of the marks and similarity and identity of the goods and services, the issue of whether there is a likelihood of confusion arises. In the inquiry into the likelihood of confusion, the Court of Appeal in *Staywell* at [55] states that the following have to be considered: (a) how similar the marks are; (b) how similar the goods or services are; and (c) given this, how likely it is that the relevant segment of the public will be confused. The relevant segment of the public in this opposition would be the purchasers of the Opponent’s goods and services. In this inquiry, I would also have to take into account the actual and notional fair uses of both the existing and the application mark (*Staywell* at [60]).

94 I bear in mind that confusion may take two forms and Courts in *Caesarstone* at [57] and *Hai Tong* at [74] have emphasised this:

“The first is mistaking one mark for another. The second is where the relevant segment of the public may well perceive that the contesting marks are different, but may yet remain confused as to the origin which each mark signifies and may perceive that goods bearing the two marks emanate from the same source or from sources that are economically linked or associated (*Hai Tong* at [74])”.

95 I am guided by the further relevant principles which are set out in *Staywell*:

(i) 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. 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])

(ii) On the effect of the 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])

(iii) In the confusion inquiry, the non-exhaustive list of factors which are regarded as admissible are as follows:

(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 (*Staywell* at [96(a)]) .

(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 (*Staywell* at [96(b)]).

96 The Opponent reiterates that there is a high degree of similarity between the competing marks, such as to lead to a likelihood of confusion, and this likelihood is further increased as the average consumer is likely to confuse the Application Mark as belonging to the Opponent's family of "DISCOVERY" marks. The Opponent submits that it has a family of marks and adduced evidence to show the use of 13 marks which have the "DISCOVERY" prefix followed by the more descriptive component. As the Application Mark incorporates the Distinctive Features of the Opponent's family of "DISCOVERY" marks, the relevant public will be confused into thinking that it is part of the same family such that they will perceive goods and services under the Application Mark to originate from the Opponent or from sources that are economically linked.

97 With respect to the impact of goods-similarity on consumer perception, the Opponent argues that Class 9 goods are not expensive and the average consumer is unlikely to apply care or fastidiousness in their selection. Similarly, class 16 goods are inexpensive, run-of-the-mill daily essentials and the average consumer is unlikely to pay extra care and attention on the trade marks used on the goods. This will point towards a greater likelihood of confusion. As for class 43 services, although the Opponent does not have a Class 43 registration or application, the Opponent's submission is that the services are similar to its Class 39 and 41 services. The emphasis that an average consumer places on the selection of these services is principally on price and content as opposed to the trade mark. This "consumer indifference" towards the trade marks point to a greater likelihood of confusion.

98 The Applicant argues that the issue of likelihood of confusion directs the court to look at how similar the marks and the goods/services are; and given this, how likely the relevant segment of the public will be confused. The Applicant submits that the relevant consumers for the goods and services for the Applicant's Marks and the Opponent's Marks, are an entirely different segment and there can therefore be no likelihood of confusion. The Applicant's target audience are children and the parents of such children, who are interested in holiday camps. The Applicant is focussed on education development, improvement, innovation and growth for its students, which is different from the Opponent's main target audience in relation to its marks, that is cable television viewers. Further, the Applicant's services would have to be purchased directly through its own website. The Applicant's and the Opponent's websites are very different and it is evident to

any consumer that the two are not linked. The Applicant also submits that as its services are for children, this would command a greater degree of fastidiousness, attention and due diligence on the part of prospective consumers when choosing such services.

Is there a Family of Marks?

99 The Opponent has submitted that it has a family of trade marks, where the “DISCOVERY” word is a commonly used prefix. The Opponent states that its marks follow a naming convention which uses the “DISCOVERY” prefix followed by a more descriptive component which describes the nature or characteristics of the relevant content. The Opponent highlighted the IPOS Trade Mark Registry's Trade Mark Work Manual, Version 6 (February 2018), under Chapter 7 for "Relative Grounds for Refusal of Registration" which reads (at page 39):

“Where a number of similar marks in the same ownership incorporate an identical element as a family of marks and another party also applies for registration of a mark incorporating that element, the public may assume that the new mark originates from the same undertaking as an addition to the family of marks and be confused or deceived if that is not the case.”

100 The Applicant disputes that the Opponent’s marks form a family of marks. It states that the Opponent has not adduced sufficient evidence, to support its claim that its earlier marks form a family of “Discovery” marks. The Applicant cites *Glamco* at [79] where it is stated that “*sufficient evidence must first be adduced to show the use of a sufficient number of “members” of this family. Indeed, in the absence of such evidence, it cannot be said that a consumer would detect the common element present in these marks and associate them with being part of the same family.*” The Applicant points out that marks with the word “DISCOVERY” have been used by other traders for a substantial amount of time, and there is no evidence that the relevant consumers associate the word “DISCOVERY” with the Opponent’s goods and services. Further, registration of the marks containing a common element does not automatically give rise to a presumption that the public perceives the marks as belonging to a family. *Carolina Herrera, Ltd v. Lacoste* [2014] SGIPOS 3 (“*Carolina Herrera*”) at [38].

101 I agree with the Applicant’s submissions that in order to determine whether a mark falls within a larger “family of marks”, there must be sufficient evidence adduced to show the *use* of a sufficient number of “members” of this family. The Opponent has reiterated that its established “family” follows a naming convention where the “DISCOVERY” prefix is followed by a more descriptive component which describes the nature or characteristics of the relevant content. I will therefore assess the evidence to ascertain whether there is sufficient use of marks bearing this characteristic structure and sequence, and whether a consumer is able to easily detect this and associate them as being part of the same family.

The Opponent’s evidence

102 I have at [24] dealt with the Applicant’s submissions concerning the state of the Trade Marks Register showing that numerous other proprietors have registered various “DISCOVERY” marks.

103 The 13 registered trade marks which were highlighted by the Opponent in its submissions have the “DISCOVERY” prefix followed by the more descriptive component, are as follows:

Discovery Channel	Discovery HD
Discovery Asia	Discovery HD World
Discovery Science	Discovery Health
Discovery Kids	Discovery Home & Health
Discovery Turbo	Discovery H & L
Discovery Travel & Adventure Channel	Discovery Real Time
Discovery Travel & Living	

104 The OSD contains evidence of registration of its marks overseas and in Singapore, write ups in periodicals on the Opponent and its word marks and composite marks, subscription plans for cable television packages from Starhub and Singtel, publicity on the fallout between Starhub and Discovery, Discovery’s social media presence using Facebook, Instagram and Twitter. I will focus on the evidence of use of the marks that pre-dates the Relevant Date of the opposition. A number of the exhibits lodged are dated 2018 and 2019 and I will not refer to these post-application date evidence.

105 The marks Discovery Channel, Discovery Asia, Discovery Science, Discovery Kids, Discovery Turbo, Discovery Travel & Adventure Channel, Discovery Travel & Living, Discovery HD, Discovery HD World, Discovery Health, Discovery Home & Health, Discovery H & L and Discovery Real Time are mentioned primarily in the evidence relating to the subscription plans for Starhub. These are found in the OSD at pages 249 to 266. I find this evidence relevant as they pre-date the Relevant Date of 26 July 2017⁴.

106 The marks are mentioned in Starhub’s price plans or subscription plans, where consumers of Cable-TV programmes can pick and choose from different bundles of programmes in order to create a package which suits their viewing needs. For example, on page 261 of the OSD, a consumer who wants to add educational programmes may choose from the list provided under “Education” the channels “Discovery Channel” or “Discovery Travel & Living”. Similarly, at page 258 of the OSD, another example is where the consumer chooses an add-on to his plan and chooses the “Family Plus” group to add “Discovery Home & Health, Discovery Real Time and Discovery Science”. At page 266, a screen grab of Starhub’s website describes the mark “Discovery Science” as the “only network dedicated to making science programming accessible, relevant and entertaining.”

107 The evidence in the OSD appears to be limited to the mention of the marks in these subscription plans. It is not certain that from this evidence, consumers in Singapore will recognize the Opponent’s “DISCOVERY” family of marks. The rest of the evidence in the OSD has not been too helpful in showing the use of the marks. The Opponent’s evidence

⁴ Starhub Cable TV Price Plans: Pages 255-256 (10 Oct 2004), pages 257-260 (23 Aug 2006), pages 261-265 (8 Oct 2007), page 266 (2012 excerpt from Starhub Entertainment Channel)

concerning the contract renewal between itself and Starhub at pages 268-311 and at pages 460-487, the publications about the cessation of Discovery programmes on Starhub, all post-date the Relevant Date. In light of the evidence lodged, it cannot be established that consumers will be aware that there is the common element in the marks where the “DISCOVERY” prefix is followed by a more descriptive component which describes the nature or characteristics of the relevant content, and that these marks are owned by a single proprietor. Mere use alone is insufficient to establish that the Opponent has a family of marks; the greater issue relating to use is “not just whether the marks have been in use but whether consumers associate the marks which bear a common element as originating from a single source such that if there is another mark in the marketplace bearing that common element, the consumer is likely to be confused.” ***Bridgestone Corporation and Bridgestone Licensing Services, Inc. v Deestone Limited*** [2018] SGIPOS 5 at [39]. Although the Opponent has shown that the 13 highlighted marks have been registered in its name, the learned Assistant Registrar in ***Carolina Herrera*** at [38] has said that:

“... *prima facie*, registration of a number of marks each bearing the same element in common, does not automatically give rise to the presumption that the consumer would perceive them as being a family or series of marks, such that the registered proprietor of the marks is entitled to have protection of that common element. ... [T]he registered proprietor who claims additional protection of that common element will have to adduce sufficient evidence to show use of a sufficient number of these marks as to be capable of constituting a family or series of trade marks, for the purposes of the assessment of the likelihood of confusion.”

108 I find that the evidence presented does not assist and is insufficient for me to come to a decision that the Opponent’s marks constitute a family of marks. I will therefore move on to consider the consumer perception in relation to marks-similarity and good-similarity, applying ***Staywell*** at [96(a)] and [96(b)].

Factors relating to the impact of marks-similarity on consumer perception:

The degree of similarity of the marks

109 I have found that aurally and conceptually, the competing marks are on the whole more similar than dissimilar. However, in terms of visual similarity, I have found that the Opponent’s Primary Earlier Trade Mark has a distinct feature that clearly differentiates it from the Application Mark. The “D-plus-globe” logo is a material and distinctive feature in word “DISCOVERY” as shown in the Opponent’s evidence where it features prominently in the exhibits in the OSD. For example, the marks at the bottom of the exhibit on page 238 of the OSD at show that the distinctive “D-plus-globe” logo is always used with the word “DISCOVERY”.

110 In all cases, any similarity resides in the word “DISCOVERY”. As I have already noted, this word is of low distinctiveness, and is a word which many other traders might legitimately wish to use to describe their goods and services. I find therefore that this factor is neutral.

The reputation of the marks

111 The Opponent has a strong reputation in its earlier “DISCOVERY” marks. This is evident in its evidence of use where the evidence shows that it has strong brand recognition worldwide being consistently ranked in the top 100 best global brands, being positively mentioned in local publications such as the Straits Times and Business Times, and having a presence on all the major social networks with a strong following. However, the Court in *Staywell* at [96(a)] cited *Mobil Petroleum Co, Inc v Hyundai Mobis* [2010] 1 SLR 512 (“*Mobil*”) at [74] which makes it clear that a strong reputation does not necessarily equate to a higher likelihood of confusion, and could in fact have the contrary effect, as occurred in *McDonald’s Corp v Future Enterprises Pte Ltd* [2005] 1 SLR(R) 177 (“*McDonald’s*”) at [64].

112 The Opponent’s Discovery Channel programme has been aired on television in Singapore since 1995 compared to the Application Mark which has been used since 2017 in Singapore. During the Opponent’s period of long use in Singapore, it has been consistently linked with Starhub cable television and has built up a strong reputation for producing quality content for television. Television was the staple where entertainment was concerned in the years before the internet became readily available. This form of entertainment cuts across all ages and any household with a television would be inevitably exposed to the Opponent’s Discovery mark with its distinctive feature of a D-plus-globe device. In my view, the Opponent’s strong reputation in this area will have an effect contrary to the likelihood of confusion for consumers will be cognisant of its reputation, which reduces the likelihood of confusion between the competing marks.

The impression given by the marks and the possibility of imperfect recollection of the marks

113 Given such widespread and constant exposure to the Opponent’s Primary Earlier Trade Mark via the television, consumers are likely to remember the distinctive feature of a D-plus-globe device attached to the word “DISCOVERY” in the Opponent’s mark. The Application Mark which has the word “Discovery” stylised with a flourish and the descriptive word “CAMPS” below gives a different impression from the Opponent’s Primary Earlier Trade Mark. This impression will lessen the likelihood of confusion between the marks.

Factors relating to the impact of goods-similarity on consumer perception

The normal way in or the circumstances under which consumers purchase goods and services

114 At the outset, I find that the goods in class 16 which are ordinary and inexpensive stationery items are commonly sold in normal stationery stores and not sold under any special circumstances. The goods in class 9 however which include “computer apparatus for educational use” are not inexpensive goods which may be purchased in a store or online. As the goods are more expensive goods, the average consumer in a store will have the

opportunity to assess the marks directly and to look at the marks affixed to the goods. Online purchases will require the consumer to have more regard to the marks as the requisite site is called up when the correct description is keyed into the text field of the address bar. Similarly, services such as holiday camp services or services relating to the organization, booking and arrangement of excursions are likely to be purchased directly from websites and consumers will be expected to key in the correct mark in order to arrive at the site at which they wish to make a purchase from. The way in which the goods in class 9 and services are purchased points to a low likelihood of confusion.

Whether the nature of the goods and services would tend to command a greater or lesser degree of fastidiousness and attention on the part of prospective purchasers

115 The goods in class 16 which are ordinary and commonplace items are often bought without fastidiousness and attention on the part of the purchasers. In contrast, “computer apparatus for educational use” in class 9 are items which are generally expensive and will be bought after some research on the technical specifications, price and suitability of the apparatus for the buyer. There will be a greater degree of fastidiousness and attention in the selection of these goods.

116 With respect to the services, the services offering holiday camps are not inexpensive, and these are often chosen by parents with extreme care with the notion that there should be a good return on investment of paying that high cost. Parents in this day and age are astute consumers especially when they are involved in choosing what is perceived to be the best for their children. It is certain that before purchasing the holiday camp services, they would have weighed all the options by consulting fellow parents with children of similar age, by checking the reviews and the ratings on social media and the internet. The average consumer will pay greater attention to the services offered, its brand name (the trade mark) and its reputation in the field, the cost of such camps. In short, a high degree of fastidiousness and attention is exercised before these services are purchased.

117 The differences in the nature of the goods in class 9 and services, and the degree of attention paid by the competing parties’ respective consumers means that there is less likelihood of confusion as to the origin of the goods or services. Accordingly, these differences would tend towards the Applicant’s favour.

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

118 The Singapore courts have described the average consumer in Singapore as “literate, educated, exposed to the world and unlikely to be easily deceived or hoodwinked”. See *Festina* at [80], citing *McDonald's Corp v Future Enterprises Pte Ltd* [2005] 1 SLR(R) 177 at [64]. The average consumer of the Opponent’s and the Applicant’s goods and services would be reasonably well-informed when making their purchases.

119 The Opponent’s relevant consumers are the general public who watch television and this is a wider and more varied segment of society compared to the Applicant’s relevant public

of “children and their parents” (generally it would only be “parents of children” since the parents are the purchasers). The Applicant’s smaller segment of consumers is clearly a subset of the Opponent’s consumers.

120 The Opponent’s average consumer when choosing to add a programme into his subscription plan for cable television will depend on his interest in the subject matter of the programme: he could be a sports fan, a movie buff, a parent with children, or a food connoisseur. There is no specialist knowledge involved nor would the consumer apply a greater level of care in his selection. The Applicant’s relevant consumer on the other hand would take much greater care in his selection of goods and services which have an important bearing on his offspring. He would be reasonably conscious of the brand name of the services he purchases and not be indifferent to the mark used in relation to the goods and services. This would tend towards a lower likelihood of confusion between the competing marks.

121 The considerations relating to the factors relating to the impact of goods-similarity on consumer perception above do not similarly apply to the Class 16 goods as these goods are ordinary and inexpensive stationery items. The average consumer will not fastidiously pay attention in selection of these goods and do not need specialist knowledge in their purchase of these goods.

Conclusion on likelihood of confusion

122 Overall, having considered all the factors, I find that although the competing marks are more similar than dissimilar (due to the inclusion in the marks of the word “DISCOVERY”, which as noted is of low distinctiveness), and there is similarity in the goods and services, this similarity does not give rise to a likelihood of confusion.

Conclusion on Section 8(2)(b)

123 The ground of opposition under Section 8(2)(b) therefore fails.

Ground of Opposition under 8(4)(a) read with Sections 8(4)(b)(i)

124 The Opponents rely on both Section 8(4)(b)(i) as well as Section 8(4)(b)(ii)(A) and (B) of the Act. The former relates to marks that are well known in Singapore, whereas the latter relates to marks that are well known to the public at large in Singapore.

125 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; or
- (ii) if the earlier trade mark is well known to the public at large in Singapore —
 - (A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or
 - (B) would take unfair advantage of the distinctive character of the earlier trade mark.”

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.

Decision

126 In order to succeed under this ground of opposition, the Opponent has the burden of establishing the following:

- (i) The whole or an essential part of the Application Mark is identical with or similar to the Opponent's earlier mark
- (ii) The Opponent's earlier mark is well known in Singapore
- (iii) The use of the Application Mark in relation to the goods claimed would indicate a connection between the Applicant's goods/service with the Opponent
- (iv) The use of the Application Mark would damage the interests of the Opponent

Is the whole or an essential part of the Application Mark is identical with or similar to the Opponent's earlier mark?

127 Under Section 8(4), the preliminary element to be satisfied is that "the whole or essential part of the trade mark must be identical or similar to an earlier mark". If this element is not made out, the ground of opposition under any limb of Section 8(4) will fail. In ***Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd [2015] 5 SLR 618*** at [146] ("***Rovio***"), it was decided that there is no difference between the similarity of marks comparison in Section 8(2)(b) and Section 8(4) even though the relevant wording of Section 8(4)(b) is different from that found in Section 8(2)(b).

128 I have dealt with the issue of marks-similarity earlier under Section 8(2)(b) and found (at [75] above) that the Opponent's Earlier Trade Marks are more similar rather than dissimilar to the Application Mark. Hence for the same reasons, I find that the preliminary element that the whole or essential part of the Application Mark is identical with or similar to the Opponent's Earlier Trade Marks is satisfied.

Is the Opponent's earlier mark well known in Singapore?

129 The onus is on the Opponent to show that on the Relevant Date, i.e. the date of the application to register the Application Mark, the Opponent's Earlier Trade Marks were well known in Singapore. In order to discharge this burden, the Opponent must go beyond just showing that the public has been exposed to its trade marks. There must be enough evidence to show the extent to which the "relevant sector of the public" has been exposed to the Opponent's marks. The Opponent submits that the relevant public in this matter are the "actual and/or potential consumers of the goods the Opponent offers and not consumers of everything that may fall under the type of goods or services to which the Opponent's mark is applied".

130 The Opponent says that its "DISCOVERY" marks have acquired a high degree of recognition as trade marks exclusively denoting the Opponent's goods and services and which have become well known because of:

- (a) Opponent's long history and use of the "DISCOVERY" name and brand worldwide and in Singapore;
- (b) Opponent's extensive and long-standing worldwide trade mark registrations including Singapore;
- (c) Opponent's huge social media presence and public awareness of the same, local collaborations, and incredible brand recognition, value and ranking awarded to the Opponent through various well-regarded and credible sources;
- (d) enormous sales figures of the Opponent's goods and services which translate to a huge amount of goodwill and reputation in the Opponent's business conducted under the "DISCOVERY" marks; and
- (e) Opponent's extensive promotional and advertising efforts in various media (which are circulated both in Singapore and internationally).

131 Whilst looking through the Opponent's evidence, a few points stand out: firstly, much of the evidence filed post-dates the Relevant Date of 26 July 2017. Secondly, the evidence has an inordinate emphasis on the number of registrations filed and obtained in Singapore and internationally. There are 188 pages showing the registrations of Opponent's DISCOVERY and DISCOVERY-formative marks in Singapore and internationally which forms almost 40% of the total exhibits in the OSD. The Singapore registrations only appear on 4 pages out of the total. Thirdly, there is quite a lot of evidence in the form of screen grabs of the Opponent's websites, publications, etc concerning the negotiations for the renewal of the contract between the Opponent and Starhub and the cessation of Discovery programmes on Starhub (at pages 268-311 and at pages 460-487). Though not overwhelming in number (about 15% of the evidence in total), this evidence is peppered throughout the OSD. Whilst it is understandable that the reason for providing this information is to show the magnitude of public sentiment against the cessation of programmes by Discovery offered by Starhub, the downside of this is that it eventually draws attention away from the "DISCOVERY" marks to the Starhub mark.

132 I propose to look at the Opponent's evidence of about 500 pages of exhibits against the Opponent's submissions (a) to (e) above to assess whether it has discharged the onus of proving that its "DISCOVERY" marks are well known. I am grateful for the schedule⁵ prepared by the Opponent's counsel in the OWS which categorises the evidence filed into helpful headings such as the marks, the source, and date and country of the source (if applicable).

(a) Evidence of the Opponent's long history and use of the "DISCOVERY" name and brand worldwide and in Singapore

133 The Opponent's history is sufficiently provided in exhibit DM-1 of the OSD which is from the Opponent's website. The chronology of the Opponent's history beginning from Discovery Channel's launch in 1985 and the key corporate milestones are shown. I note that the Opponent's entry into Asia is not a milestone mentioned in this chronology. The exhibits following this chronology make mention of Discovery being "[a]vailable in 220 countries and territories and 50 languages" (at page 38) and the first mention of Asia is at

⁵ See Schedule A of the OWS pages 71 to 95

page 40 where it states that “Discovery Networks International comprises three regional operations covering all major cable and satellite markets, including: Asia-Pacific; Europe, Middle East and Africa (EMEA); and Latin America.” The exhibit from www.discoverychannelasia.com at page 48 of the OSD states that “Discovery Channel reaches 174 million subscribers in Asia Pacific” and a Singapore address and phone number is provided for queries. With respect to the provision of the Singapore address and telephone number, this relates to Singapore being the headquarters for the Asia Pacific region as shown in the exhibit at page 349 of the OSD, where it states that “DNAP (Discovery Networks Asia-Pacific) is the Asia-Pacific headquarters (based in Singapore) of Discovery Communications which is the world’s #1 pay-TV programmer reaching 2.5 billion cumulative subscribers in more than 220 countries and territories.”

134 The evidence also states that Discovery has been aired in Singapore since 1995 and that Discovery Kids has been available to viewers since 2012. (see [139] below) The “Discovery Science” mark was first used by the Opponent in Singapore in September 2003.

(b) Evidence of the Opponent’s extensive and long-standing worldwide trade mark registrations including Singapore

135 As mentioned above, the Opponent has exhibited 188 pages showing the registrations of the Opponent’s DISCOVERY and DISCOVERY-formative marks in Singapore and internationally. With respect to this evidence, it will only be relevant to the extent that it leads to the mark being well known in Singapore. In *Caesarstone* the court held at [133] that:

“Indeed, although the overseas registrations of the mark and the successful enforcement of rights are relevant factors under s 2(7)(c) and (d) of the TMA, the language of s 2(7) of the TMA makes it abundantly clear that the ultimate inquiry is whether a trade mark is well known in Singapore. The crucial point, therefore, is that the Appellant has to show how the overseas registrations of the Appellant’s CAESAR Mark and the successful enforcement of its rights has led to its mark being well known in Singapore.”

136 In its submissions or evidence, the Opponent has not indicated how these numerous overseas registrations have led to the marks being well known in Singapore.

(c)(i) Evidence of the Opponent’s huge social media presence and public awareness of the social media

137 The evidence tendered at pages 445 to 459 are 2019 screen grabs of the Opponent’s Facebook, Instagram and Twitter accounts which show that the Opponent has an on-line presence. This information however all post-dates the Relevant Date of 26 July 2017. It would have been more useful if the information as at the Relevant Date was presented. The actual numbers about the community (in terms of the number of “Likes” on Facebook and Instagram, the followers on Instagram and Twitter) following these social media platforms will not be considered but I will take cognisance that the Opponent has a healthy social media presence. I would add that with respect to evidence of this nature, obtaining a

snapshot of a particular period of time is not impossible. That said, I am not able to conclude that the evidence filed shows a “huge social media presence and public awareness” as claimed by the Opponent.

(c)(ii) Evidence of local collaborations

138 At pages 385 to 402, the evidence refers to Discovery Channel’s inaugural documentary film initiative for Singaporean film-makers and production companies called the Jumpcut Asia, a collaboration with the Info-Communications Media Development Authority of Singapore (IMDA). The 2016 collaboration was reported in several publications: on Discovery’s own webpage Discovery Communications (pages 388-390), Today paper (pages 385-387), the Straits Times (pages 391-393), Television Asia Plus (pages 394-396), adobomagazine.com (pages 397-398) and Asia 361 (pages 399-402).

(c)(iii) Evidence of brand recognition, value and ranking awarded to the Opponent through various well-regarded and credible sources

139 At pages 406 to 409 of the OSD, the Opponent exhibits an article from the Starhub Newsroom dated September 2012 which states that [Starhub] was the first to bring Discovery Channel into Singapore when it launched its cable television in 1995. It goes on to mention that 17 years later, [Starhub] customers would be the first in Singapore to catch Discovery Kids, a programme that offered “school-going children in Singapore an entertaining way to satisfy their natural curiosity ... [and which] promises to ignite their imagination through stimulating and transformative programming.” Singtel Mio similarly in October 2012 began offering Discovery Kids on mioTV Channel (pages 404-405).

140 The OSD exhibits pages from Interbrand.com, Fortune and Forbes as evidence of brand recognition. The latter two exhibits show information of the Discovery brand in 2018 (the information was extracted in 2019). As for the exhibits from Interbrand.com, the figures for 2014 to 2017 are relevant to show that it has a strong global brand recognition and was ranked within the top 100 in those years. The brand value presented in the exhibits is shown in [143] below. I find that the evidence is sufficient to decide that the Opponent’s Discovery marks are recognised globally.

(d) Evidence of the enormous sales figures of the Opponent’s goods and services which translates to a huge amount of goodwill and reputation in the Opponent’s business conducted under the “DISCOVERY” marks

141 I note that the Opponent’s indication of its sales figures in its evidence is by way of providing a link to the annual report. The OSD at Part E paragraph 44 merely states:

“As seen from page 73 of the Opponent’s 2017 Annual Report (see <https://bit.ly/2VeULgU>), the Opponent’s total revenues for 2017, 2016 and 2015 were US\$6,873 million, US\$6,497 million and US\$6,394 million, respectively.”

142 Page 73 of the 2017 Annual Report is not exhibited, and there are no invoices relating to the use of the Opponent's Mark exhibited. Although evidence has been declared and affirmed on oath in the form of a statutory declaration, I find that the presentation of the figures in this manner far from satisfactory as it is a bare statement of the sales figures that is not supported by any exhibits. It is not difficult to put into evidence statements relating to use and sales; copies of invoices of sales, profit and loss accounts and indeed annual reports are often available to this end. Providing a link to a website does not give any certainty to the evidence sworn because websites may be corrected and change over time, sometimes without the corrigenda to indicate what corrections have been made. In any event, the total revenue figures shown are global figures; there is no indication as to how much of the global figures relate to Singapore's sales figures.

143 In pursuit of some certainty and some figures to show that the Opponent has used its marks, I find that the Opponent had included in its evidence reports from Interbrand.com showing the Best Global Brands rankings in 2014 to 2017 (pages 494 to 501 of the OSD) and the reports include some figures within. The figures indicated relate to the brand value and not sales figures per se, and do not present a breakdown to show figures for Singapore. However, these global figures give an indication of the Opponent's standing and its value globally and the relevant years can be considered. The relevant figures are extracted below:

Year	Rank	Brand Value
2014	67	USD 6,143m
2015	64	USD 6,509m
2016	71	USD 5,944m
2017	79	USD 5,411m

144 The Interbrand.com reports also show the figures in terms of number of "Likes" or followers for the Opponent's social impact on Facebook and Twitter but as these are figures extracted as at 22 February 2019, they will not be considered.

145 After considering all the evidence, I am not able to reach a conclusion whether the Opponent has what it claims as "enormous sales figures". Although the brand value is impressive, these are global figures pertaining to the overall Discovery brand and not sales figures per se. It is not indicated in the exhibits how the brand value was assessed and I should be cautious in giving it too much weight. Further, none of the figures relate to Singapore or even to Southeast Asia, and hence I do not find it helpful in the determination of whether the Opponent's Earlier Trade Marks were well known in Singapore at the Relevant Date.

(e) Evidence of the Opponent's extensive promotional and advertising efforts in various media (which are circulated both in Singapore and internationally).

146 The Opponent's advertising figures in Part C paragraph 22 of OSD are presented in the same way as its evidence of use, as a statement of the figures and a link to the Opponent's annual report:

“The Opponent’s expenditure on advertising costs to third parties, totalled \$162 million, \$166 million and \$148 million respectively for 2017, 2016, and 2015, respectively (see page 89 of Opponent’s 2017 Annual Report at <https://bit.ly/2VeULgU>).”

147 I have looked at the evidence and exhibits filed in support and do not find the said page 89 of Opponent’s 2017 Annual Report exhibited to support the statement at Part C paragraph 22. Even if I were to consider the expenditure figures mentioned in the statement, it is unclear how much of this expenditure relates to promotional activities in Singapore as there are no invoices or documents exhibited to indicate this.

148 The Opponent has also deposed in its statutory declaration that its “goods and services bearing the Opponent’s DISCOVERY Marks are advertised and featured extensively in many editorials, advertisements, promotions, and advertising visuals in Singapore”. Looking through the evidence lodged, I find that the advertisements, editorials, promotions are few in number and do not fully support the extensiveness of advertisement claimed in the OSD. The range of exhibits in Exhibit DM-3 include a page from the Opponent’s Discovery Communications giving a snapshot of the Opponent’s Asia-Pacific portfolio, screen grabs from Singtel TV showing the Discovery programmes available (all the SingTel TV exhibits however are post-Relevant Date⁶) and subscription plan menus from Starhub.

Conclusion on whether Opponent’s earlier marks are well known in Singapore

149 In conclusion, despite some gaps in the evidence, I find that overall the evidence is sufficient for a finding that the Opponent’s Earlier Trade Marks are well known in Singapore. The Opponent has an advantage in this respect as it is a global media company that provides content such as television programmes. As I have mentioned earlier at [41], television has always been one of the key forms of entertainment and information in Singapore. The public will be aware of and recognise the Opponent’s Discovery marks through watching television.

Would the use of the Application Mark in relation to the goods claimed indicate a connection between the Applicant’s goods/service with the Opponent?

150 The Court in *Staywell* at [120] states that this element is satisfied so long as there is a likelihood of confusion:

“...As for the third element, the detailed analysis in *Amanresorts* ([105] supra) has put it beyond doubt that the connection requirement of s 8(4)(b)(i) and s 55(3)(a) of the Act will be satisfied where there is a likelihood of confusion (see *Amanresorts* at [226] and [233])”

⁶ All the exhibits from SingTel TV post-date the Relevant Date as the fallout between Starhub and Discovery occurred in mid-2018.

151 I have decided at [122] that there is no reasonable likelihood of confusion, and for the same reasons I also find that a confusing connection has not been established by the Opponent.

Would the use of the Application Mark damage the interests of the Opponent?

152 As the Opponent has not established the third element of confusing connection under Section 8(4)(a) read with 8(4)(b)(i), there is no need for me to assess whether use of the Application Mark will damage the interests of the Opponent.

Conclusion on Section 8(4)(a) read with 8(4)(b)(i)

153 The ground of opposition under Section 8(4)(a) read with 8(4)(b)(i) therefore fails.

Ground of Opposition under 8(4)(a) read with Sections 8(4)(b)(ii)(A) and 8(4)(b)(ii)(B)

154 In order to succeed under this ground of opposition, the Opponent has the burden of establishing the following:

- (i) The whole or an essential part of the Application Mark is identical with or similar to the Opponent's earlier mark
- (ii) The Opponent's earlier mark is well known to the public at large in Singapore
- (iii) The use of the Application Mark in relation to the goods claimed would
 - (a) cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or
 - (b) take unfair advantage of the distinctive character of the earlier trade mark.

155 I have found at [127]-[128] that the whole or the essential part of the Application Mark is identical with or similar to the Opponent's earlier mark. As such the initial threshold is satisfied.

Is the Opponent's earlier mark well known to the public at large in Singapore?

156 I am guided by the following in the assessment of whether the Opponent's Earlier Trade Marks satisfy the limb "well known to the public at large":

- (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 the defendant’s trade mark on dissimilar goods or services even in the absence of a likelihood of confusion (*Amanresorts* at [233]).

157 I reiterate a note I made at [141] and [146] in the assessment of the Opponent’s evidence where the sales and advertising figures provided were not supported in the evidence. The status of a mark that is “well known to the public at large in Singapore” is rare and exclusive and its coveted exclusive membership cannot be extended to aspiring members that fall short of showing extensive use and extensive promotion of their marks. I find that the Opponent’s evidence lacked precision in showing the extent to which the Opponent’s Earlier Trade Marks were used, and also was not helpful as quite a lot of post-Relevant Date evidence was filed to support its case. Accordingly, based on the evidence I have before me, I cannot conclude that the Opponent’s Earlier Trade Marks should enter the hallowed halls of this exclusive group.

Conclusion on Section 8(4)(a) read with 8(4)(b)(ii)

158 The ground of opposition under Section 8(4)(a) read with 8(4)(b)(ii) therefore fails.

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

159 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)

160 To succeed on the ground of opposition under Section 8(7)(a), an opponent must establish the classical trinity of goodwill, misrepresentation and damage (*Novelty Pte Ltd v Amanresorts Ltd and anor* [2009] 3 SLR 216 at [36]; *The Audience Motivation Company Asia Pte Ltd v AMC Live Group China (S) Pte Ltd* [2016] 3 SLR 517 at [80]).

Goodwill

161 It is well established that such goodwill must exist in Singapore at the date of the application for the registration of the Application Mark. (*Staywell* at [130])

162 The Court of Appeal in *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 (“*Singsung*”) at [34], said that goodwill “...in the context of passing off, is concerned with goodwill in the business *as a whole*, and not specifically in its constituent elements, such as the mark, logo or get-up that it uses...”

Goodwill does not exist on its own, but attaches to a business in the jurisdiction and is manifested in the custom that the business enjoys. Goodwill may be proved by evidence of sales or of expenses incurred in promoting the goods and services in association with the mark, brand or get-up which they bear.”

163 Having carefully considered the Opponent’s evidence under the different grounds of opposition, it may be shown that the Opponent has goodwill in Singapore. The Opponent’s evidence at pages 494 to 501 of the OSD showing its brand strength and ranking from 2014 to 2017 are testimony of this goodwill. And although the figures from its social media presence could not be used as they post-dated the Relevant Date, the Opponent could still ride on the existence of these accounts to show that they have a presence globally as well as in Southeast Asia.

Misrepresentation

164 The Court of Appeal in *The Singapore Professional Golfers’ Association v Chen Eng Waye and others* [2013] SGCA 18 at [20] provided a summary of misrepresentation as follows:

... It will then be necessary to consider, amongst other factors, whether there is such a similarity between the corresponding element that is being used by the defendant on the one hand and by the claimant on the other such that in all the circumstances, it is sufficiently likely to result in the relevant segment of the public being deceived or confused into thinking that the defendant’s goods or services are, or emanate from a source that is linked to, the claimant’s...

165 I have earlier found, in the context of the claim under Section 8(2)(b) of the Act, that there is no likelihood of confusion between the competing marks. It therefore follows that there cannot be any misrepresentation that is sufficiently likely to deceive the public into thinking that the Applicant’s goods are those of the Opponent’s. As misrepresentation which is an essential component under the ground of passing off has not been established, it is not necessary for me to assess the element of damage.

Conclusion on Section 8(7)(a)

166 The grounds of opposition under Section 8(7) therefore fails.

Ground of Opposition under Section 7(6)

167 Section 7(6) of the Act reads:

A trade mark shall not be registered if or to the extent that the application is made in bad faith.

168 The Opponent’s pleaded claim of bad faith under Section 7(6) found in [14] of the Grounds of Opposition is premised on the argument that the Applicant is intending to unfairly benefit from the association with the Opponent and seeking to take advantage of the Opponent’s goodwill and reputation in the Opponent’s “DISCOVERY” mark(s).

169 The Opponent submits that the Applicant has acted in a manner which is objectively commercially unacceptable because it has deliberately misappropriated the Opponent's well-known and distinctive "DISCOVERY" Mark. The Opponent states that it is inconceivable and unimaginable that the Applicant would not have known of the Opponent's well known "DISCOVERY" Mark and family of "DISCOVERY" marks at the point of filing the Applicant's Mark in 2017. The Applicant would have been well aware of the Opponent's area of trade and therefore by attempting to register the Application Mark for goods and services that are closely related to the Opponent's goods and services, it has acted in bad faith. The Opponent says the Applicant has not pleaded or adduced any evidence that it was unaware of the "DISCOVERY" Mark at the point of filing.

170 The Opponent also states that the filing of the Applicant's Mark is marked by several suspicious transactions, in particular the two changes of its name whereby the "DISCOVERY CAMPS" component was included the Applicant's corporate name. The chronology of the change of name is as follows:

- (a) The original applicant of the Application Mark was CHANGEDEDU HOLDINGS PTE. LTD who applied for registration of the said mark on 26 July 2017.
- (b) On 24 October 2017, the Opponent wrote to the CHANGEDEDU HOLDINGS PTE. LTD's agents to request for a voluntary withdrawal of the Application Mark, but this was not acceded to.
- (c) Shortly thereafter, on 2 November 2017, the ownership of the Applicant's Mark was transferred to CEDU DISCOVERY CAMPS PTE. LTD.
- (d) CEDU DISCOVERY CAMPS PTE. LTD. then filed notices to change its name to A-STAR-EDUCATION HOLDINGS PTE. LTD. and A-STAR-EDUCATION DISCOVERY CAMPS PTE. LTD. respectively on 22 February 2019 and 13 May 2019.

171 The Opponent claims that the name changes were deliberately effected to give the Application Mark a veneer of legitimacy. It is most likely calculated to mask the bad faith involved in the application of the Applicant's Mark and to advance the argument that the Applicant's mark was legitimately derived from the corporate name of the Applicant instead. The Applicant's conduct sought to intentionally mislead the consumer with imperfect recollection to draw an association between the Applicant's goods and services with the Opponent and thereby misappropriate the Opponent's goodwill relating to the DISCOVERY Mark.

172 The Applicant says that the Opponent is making bare allegations. The Applicant states that the Application Mark and the Opponent's Earlier Trade Marks are not similar. The Applicant has taken many steps to build its own reputation and goodwill in relation to the Application Mark. The Applicant submits that a claim that the Application Mark is made in bad faith simply on account of the alleged reputation and goodwill enjoyed by the Opponent cannot be sustained. It cites the case of *Jo's the Boss* (SRIS O/170/99), a decision from the UK Trade Marks Registry at lines 1-4 on page 10 of the decision where it is stated that "[a]n allegation that the applicants were aware of the use and worldwide

reputation of the opponents' trade marks, is not sufficient to sustain an objection to registration under this head."

Decision on Section 7(6)

173 An allegation of bad faith is a serious claim that must be supported by the evidence. The assessment of evidence must then lead to a finding that the application to register the mark was made in bad faith. It cannot be based on inferences, see **The Polo/Lauren Co, LP v United States Polo Association** [2015] SGIPOS 10 at [45] where the IP Adjudicator states "... The Law in this regard is very clear. An allegation of bad faith is a serious claim to make, and it must be distinctly proved and this will rarely be possible by a process of inference...", citing from **Valentino Globe BV v Pacific Rim Industries Inc** [2010] 2 SLR 1203 ("**Valentino**") at [30].

174 I am guided to look at the facts of this case closely in order to ascertain bad faith. The Court of Appeal in **Valentino** at [29] has said that "*[i]n the final analysis, whether bad faith exists or not hinges on the specific factual matrix of each case*".

175 The onus is on the Opponent to show that the Applicant has acted in bad faith and to this end, I note that the Opponent has not filed any evidence to support its claim that the Applicant has acted in a manner that falls short of the standards of acceptable commercial behaviour. There is no evidence to show that the Application Mark was filed with the intention of unfairly benefitting from the association with the Opponent and to take advantage of the Opponent's goodwill and reputation in the Opponent's "DISCOVERY" marks. The evidence lodged in the ASD does not make any claim that it is associated with the Opponent. Further, contrary to the Opponent's claim, the Applicant has not advanced any argument that its mark was legitimately derived from its own corporate name. In any event, I note that the first change of name was made on 2 November 2017, a date which post-dates the Relevant Date. At the oral hearing, the Applicant submitted that the changes to the Applicant's corporate name should not be taken to be made in bad faith. The changes were made to reflect the business that it is in and were done without any ulterior motive.

176 I find that the Opponent has not discharged its burden of showing that there is bad faith on the part of the Applicant and as such the opposition under this ground must fail.

Conclusion on Section 7(6)

177 The ground of opposition under Section 7(6) therefore fails.

Overall Conclusion

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

Date of Issue: 6th March 2020