

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

Trade Mark No. 40201719339S
14 July 2020

IN THE MATTER OF A TRADE MARK APPLICATION BY

DHAMANI JEWELS DMCC

AND

OPPOSITION THERETO BY

DAMIANI INTERNATIONAL BV

Hearing Officer: Jason Chan
IP Adjudicator

Representation:

Ms Ang Su Lin and Ms Loi Choi Sieng (KL Tan & Associates) for the Applicant

Mr Chua Shang Li (Donaldson & Burkinshaw LLP) for the Opponent

GROUND OF DECISION

1 This case involves two parties which use their family names as trade marks in the jewellery and precious stones business. There is no allegation by either party of misappropriation or lack of bona fides in the use of the names.

2 Dhamani Jewels DMCC (“**the Applicant**”), applied to register the trade mark

D H A M A N I

1969

(“**the Application Mark**”) in Singapore on 4 October

2017 under Trade Mark No. 40201719339S in Classes 14 and 35. The specifications of goods and services relevant to this opposition are set out below:

Class 14

Badges of precious metal; Beads for making jewelry; Bracelets [jewellery]; Brooches [jewellery]; Jewellery charms; Cloisonné jewellery; Diamonds; Earrings; Gold thread [jewellery]; Jewellery; Ornaments [jewellery]; Pearls [jewellery]; Platinum [metal]; Precious metals, unwrought or semi-wrought; Precious stones; Rings [jewellery]; Semi-precious stones; Spinel [precious stones]; Watches.

Class 35

Advertising by mail order; Commercial information and advice for consumers [consumer advice shop]; Business management assistance; Professional business consultancy; Business inquiries; Commercial administration of the licensing of the goods and services of others; Commercial or industrial management assistance; Demonstration of goods; Direct mail advertising; Invoicing; Marketing; On-line advertising on a computer network; Presentation of goods on communication media, for retail purposes; Rental of advertising space; Rental of advertising time on communication media.

3 The application was accepted and published on 5 January 2018 for opposition. Damiani International BV (“**the Opponent**”), filed its Notice of Opposition to oppose the registration of the Application Mark on 5 March 2018. The Applicant filed its Counter-Statement on 4 May 2018.

4 The Opponent filed its evidence in support of the opposition on 18 October 2018. The Applicant filed its evidence in support of the application on 16 April 2019. The Opponent filed its evidence in reply on 13 September 2019. Following the close of evidence, the Pre-Hearing Review was held on 18 October 2019. The opposition was heard on 14 July 2020. At the hearing, both parties referred to case authorities which were not in their respective bundles of authorities. Hence, they were directed to file and serve these authorities, and make any rebuttal submissions, as soon as possible after the hearing. The Opponent did so on 15 July 2020 and the Applicant did so on 16 July 2020.

Grounds of Opposition

5 The Opponent relies on Section 8(2)(b), Section 8(4)(b)(i) and Section 8(7)(a) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“**the Act**”) in this opposition.

Opponent’s Evidence

6 The Opponent’s evidence comprises the following:

- (a) a Statutory Declaration made by Guido Grassi Damiani, Director of the Opponent (“**Opponent’s Deponent**”), on 12 October 2018 in Lugano, Switzerland (“**Opponent’s SD**”);

- (b) a Statutory Declaration in Reply made by the same Guido Grassi Damiani on 30 August 2019 in Lugano, Switzerland.

Applicant's Evidence

7 The Applicant's evidence comprises a Statutory Declaration made by Amit Dhamani, CEO/Managing Director of the Applicant ("**Applicant's Deponent**"), on 7 April 2019 in Dubai, United Arab Emirates ("**Applicant's SD**").

Applicable Law and Burden of Proof

8 As the applicable law is the Act, there is no overall burden of proof on the Applicant whether during examination or in the present opposition proceedings. It is accepted that the burden of proof falls on the Opponent.

Background

9 The Opponent is a subsidiary of Damiani S.p.A ("**Damiani Group**"), an Italian luxury jewellery corporate group that designs, manufactures, distributes and sells jewellery and luxury watches. The Damiani Group was founded in Valenza, Italy in 1924 by one Enrico Grassi Damiani, the grandfather of the Opponent's Deponent. The Damiani Group has expanded to sell its goods worldwide.

10 In Singapore, the Damiani Group operates through its local subsidiary, Damiani Singapore Pte. Ltd., and has opened one boutique in Singapore.¹ The Opponent operates an e-commerce platform which operates across 21 countries. Whilst customers in Singapore may access the Damiani Group's online website, www.damiani.com, currently, it is not possible for customers in Singapore to make a purchase of the Opponent's goods online, but they can make an online request for an appointment to visit the boutique in Singapore.

11 The Applicant is a company incorporated and headquartered in Dubai that manufactures and retails jewellery. The Applicant's jewellery business was started in 1969 in Jaipur, India, by the parents of the Applicant's Deponent. "Dhamani" was the family's surname and the Dhamani family started off as an emerald business in Jaipur and later expanded globally to include wholesale and retail of diamonds, precious stones and jewellery.² The Applicant does not operate a physical retail store in Singapore, though they have made private sales to individual customers and jewellers in Singapore.³ The Applicant does not sell its jewellery online⁴ and operates wholesale offices.⁵

12 In this opposition, the Opponent relies on the following earlier trade mark of which it is the registered proprietor:


¹ Opponent's SD at [4]

² Applicant's SD at [4] and Tab AD-4

³ Applicant's Written Submissions at [75]; Applicant's SD at [30] – [32]

⁴ Applicant's Written Submissions at [75]

⁵ Applicant's Written Submissions at [75]; Applicant's SD at [5]

Trade Mark No.	Mark	Class & Goods
T8101413C		Class 14 Jewellery and precious stones.

(hereinafter referred to as the “**Opponent’s Mark**”)

MAIN DECISION

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

13 Section 8(2)(b) of the Act provides as follows:

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

...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public.

Decision on Section 8(2)(b)

The Three-Step Approach

14 There is no dispute between the parties’ counsel that the applicable law is that set out in the seminal case of *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc.* [2014] 1 SLR 911 (“*Staywell*”). In that case, the Court of Appeal held at [15] that a three-step test should be applied for Section 8(2)(b):

- (a) Firstly, are the competing marks similar?
- (b) Secondly, are the goods (or services) identical or similar?
- (c) Thirdly, is there a likelihood of confusion arising from (or to use the words of the section: *because of*) the foregoing?

All three steps must be established for the opposition under this ground to succeed. If any one step cannot be established, this ground of opposition will fail.

Similarity of Marks

Guiding Principles

15 Under the first step of the three-step test, I proceed to decide whether the competing marks are similar. In assessing the similarity of marks, I have taken into account the following principles established by the Court of Appeal in the cases of *Staywell*, *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 (“*Caesarstone*”), *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR

941 (“*Hai Tong*”) and *Sarika Connoisseur Café Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 (“*Sarika (CA)*”):

- (a) The marks are to be compared mark-for-mark, without consideration of any external matter. (*Hai Tong* at [40(b)], *Staywell* at [20])
- (b) The marks are to be compared on three aspects of similarity: visual, aural and conceptual. It is not a pre-requisite that all three aspects of similarity must be made out before there can be a finding of similarity. Each aspect serves as a signpost towards answering the question of whether the marks are similar. (*Sarika (CA)* at [16]; *Staywell* at [18])
- (c) The relevant viewpoint is that of the average consumer who would exercise some care and a measure of good sense in making his or her purchases, not that of an unthinking person in a hurry. (*Hai Tong* at [40(c)], *Caesarstone* at [27])
- (d) However, the average consumer is assumed to possess “imperfect recollection”. The contesting marks are not to be compared side by side. Instead, what will be considered is the general impression that will likely be left by the essential or dominant features of the marks on the average consumer. (*Hai Tong* at [40(d)]; *Staywell* at [26]; *Caesarstone* at [27])
- (e) The distinctiveness of a mark is a factor that is integrated into the visual, aural and conceptual analysis as to whether the competing marks are similar, and is not a separate step within the mark-similarity inquiry (*Staywell* at [30]).
- (f) A mark can be distinctive in two senses: (i) ordinary and non-technical; or (ii) technical.
 - (i) Distinctiveness in the ordinary and non-technical sense refers to what is outstanding and memorable about the mark that stands out in the consumer’s imperfect recollection. The court is entitled to have special regard to the distinctive or dominant components of a mark even while it assesses the similarity of the two marks as composite wholes. (*Staywell* at [23])
 - (ii) Distinctiveness in the technical sense stands in contrast to descriptiveness, which means to describe the goods or services in question, or some quality or aspect thereof. Technical distinctiveness can be inherent (where the words comprising the mark are meaningless), or acquired (where words having a meaning acquire the capacity to act as a badge of origin through long-standing or widespread use). 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. (*Staywell* at [24] - [25])
 - (iii) While the components of a mark may be inherently technically distinctive, ultimately the ability of the mark to function as a strong badge of origin must be assessed by looking at the mark as a whole. Conversely, the components of a mark may not be technically distinctive, but the sum of its parts may have sufficient technical distinctiveness. (*Staywell* at [25])

Distinctiveness of Marks

16 While I am mindful that distinctiveness is integrated into the visual, aural and conceptual analysis of mark similarity and not a separate step in the mark similarity inquiry, I shall address the distinctiveness of the Opponent's Mark at this juncture as this would affect my subsequent analysis on visual, aural and conceptual similarity.

Ordinary/Non-Technical Distinctiveness of Marks

17 The Opponent argues that because the font or stylization of the Opponent's Mark is relatively insignificant, the word element "DAMIANI" is the dominant component of the Opponent's Mark.⁶ The Applicant presents the opposite and argues that the most memorable aspect of the Opponent's Mark is the impact of the stylization as a design⁷.

18 As for the Application Mark, the Opponent argues that the word element "DHAMANI" is the dominant element and the numerical "1969" element occupies a secondary position and is portrayed in a much smaller font and would have a limited impact on the overall impression of the Application Mark and little impact in differentiating the marks.⁸ The Applicant argued that the most memorable aspect was that it is a recognizable and readable surname as a substantial number of Singaporeans, expatriates and tourists are from the Indian sub-continent and would likely identify "DHAMANI" as an Indian/Asian surname⁹.

19 With regard to the Opponent's Mark, I disagree with both parties. I am of the view that no single dominant element stands out in the Opponent's Mark, as the cursive font is unique and the textual element, "DAMIANI", is also a unique and unfamiliar word or name. In this regard, it cannot and must not be assumed that there will always be a feature of the mark which dominates the mark's landscape; in some cases, no particular feature will stand out (*Caesarstone* at [30]). In this case, I find that it would be artificial to find a dominant element in the Opponent's Mark where there is none.

20 As for the Application Mark, I agree with the Opponent that the dominant component in the Application Mark is the plain word element "DHAMANI". The "1969" element is displayed in much smaller font¹⁰. Since "DHAMANI" is set out in much larger font and this is a name or word unfamiliar to the average consumer in Singapore, the textual element "DHAMANI" is the dominant and distinctive component in the Application Mark. I am entitled to have special regard to this dominant component when assessing the similarity of the competing marks (*Staywell* at [23]).

21 In summary, under non-technical distinctiveness, I find that there is no dominant feature that stands out in the Opponent's Mark. I also find that the dominant feature in the Application Mark is "DHAMANI".

Technical Distinctiveness of Marks

⁶ Opponent's Written Submissions as [11]

⁷ Applicant's Written Submissions at [24]

⁸ Opponent's Written Submissions at [11]

⁹ Applicant's Written Submissions at [23] - [24]

¹⁰ Opponent's Written Submissions as [11]

22 The Opponent briefly addressed the issue of technical distinctiveness by arguing that the Opponent’s Mark is *inherently distinctive* as it has a greater technical distinctive nature because it has no direct meaning or significance in relation to the goods for which it is registered¹¹. The Opponent also argued that the Opponent’s Mark has *acquired distinctiveness* due to long-standing and extensive use in Singapore.¹² On the basis of both inherent distinctiveness and acquired distinctiveness, the Opponent argues that the Opponent’s Mark enjoys a high threshold before a competing sign can be considered to be dissimilar to it.

23 In response, the Applicant argued that the Opponent’s Mark does not possess “*a substantial degree of technical distinctiveness*” (*Staywell* at [31]) in relation to the goods and services in issue in the same way that “Regis” was technically distinctive in *Staywell*.¹³ The Applicant argues that while the average Singapore consumer may identify the word “Damiani” as being European in origin, he or she is unlikely to identify “Damiani” as a surname.

24 At this juncture, it is important to clarify that whether the Opponent’s Mark has acquired distinctiveness is not a relevant factor when assessing mark similarity. The Court of Appeal reiterated in *Staywell* at [20] that “...*the assessment of marks similarity is mark-for-mark without consideration of any external matter*”.¹⁴ This principle was followed recently in *Valentino S.P.A v Matsuda & Co* [2020] SGIPOS 8. As such, whether or not the Opponent has adduced sufficient evidence to establish acquired distinctiveness is only relevant at the likelihood of confusion stage. Nevertheless, since the Opponent has raised the issue of acquired distinctiveness to support its arguments on mark similarity, I shall consider whether the Opponent’s Mark has acquired distinctiveness at this juncture.

25 To assess whether the Opponent’s Mark has acquired distinctiveness, I have reviewed the Opponent’s SD for evidence pertaining to the use of the Opponent’s Mark in Singapore. The Opponent opened its first boutique store in Singapore in 2012¹⁵ and has submitted extensive revenue figures and advertising and promotion figures from 2012 to 2018 both globally and in Singapore.¹⁶

26 However, I note that the Opponent’s Mark does not appear in the evidence of use at all and the most commonly used marks in the Opponent’s SD are the following variations of the “DAMIANI” mark:



¹¹ Opponent’s Written Submissions at [8]

¹² Opponent’s Written Submissions at [9]

¹³ Applicant’s Written Submissions at [28]

¹⁴ See also *BenQ Materials Corp v Clarins Fragrance Group* [2018] SGIPOS 2.

¹⁵ Opponent’s SD at [4]

¹⁶ Opponent’s SD at [7] – [8]

¹⁷ The phrase “HANDMADE IN ITALY SINCE 1924” appears below the word “DAMIANI”.



(collectively referred to as the “**Damiani SD Marks**”)

DAMIANI


27 Amongst the Damiani SD Marks, the “**DAMIANI** HANDMADE IN ITALY SINCE 1924” mark²⁰ is the mark which is most often used by the Opponent in its catalogues²¹, advertisements²², the Opponent’s online retail website and social media homepages²³, testimonial marketing campaigns from celebrities and press articles²⁴ and awards on the Opponent’s website²⁵.

28 In the absence of any evidence of use of the Opponent’s Mark, I would have to conclude that the Opponent’s Mark has not acquired distinctiveness.

29 In summary, I am of the view that the Opponent’s Mark possesses a substantial degree of technical distinctiveness as it is inherently distinctive – the word “DAMIANI” is unique or unusual, and does not have any meaning, with the cursive representation adding to the distinctiveness of the mark as a whole.

Visual Similarity

30 In terms of visual similarity, the two marks are set out below for ease of comparison:

Opponent’s Mark	Application Mark
	<p>D H A M I A N I 1969</p>

The Applicant argues that the competing marks are more dissimilar than similar visually, as the Application Mark is a readable surname with the additional feature of the year “1969” while the Opponent’s Mark is depicted in a “stylized and highly fanciful cursive font that is not easily readable”.²⁶ In the Applicant’s oral submissions, the Applicant argued that since the Opponent’s Mark is registered as a stylised mark in

¹⁸ The phrase “HANDMADE IN ITALY SINCE 1924” appears below the word “DAMIANI”.

¹⁹ The phrase “HANDMADE IN ITALY SINCE 1924” appears below the word “DAMIANI”.

²⁰ The phrase “HANDMADE IN ITALY SINCE 1924” appears below the word “DAMIANI”.

²¹ Opponent’s SD at [5] and Exhibit A

²² Opponent’s SD at [9] and Exhibit E

²³ Opponent’s SD at [10] and Exhibit F

²⁴ Opponent’s SD at [11] and Exhibit G

²⁵ Opponent’s SD at [12] and Exhibit E

²⁶ Applicant’s Written Submissions at [20]

cursive font and not as a plain word mark, it should be confined to the style that it is registered in. In this regard, the Applicant distinguished the present case from *Ferrero SPA v Sarika Connoisseur Café Pte Ltd* [2011] SGHC 176 (“*Sarika (HC)*”) which compared the opponent’s earlier plain word mark, “**NUTELLA**” with the

applicant’s stylised mark, “*Nutello*” (see *Sarika (HC)* at [52] to [60]). In *Sarika (HC)*, at [52] to [53], the High Court referred to *Hyundai Mobis v Mobil Petroleum Company Inc* [2007] SGIPOS 12 (“*Mobis*”) which was an opposition comparing the

opponent’s earlier word mark “**Mobil**” with the applicant’s stylised mark, “**MOBIS**”.

The High Court held that the applicant’s “Nutello” sign was visually similar to the opponent’s registered “Nutella” mark when viewed holistically (*Sarika (HC)* at [54]) because a plain word mark registration would cover use of the word in any other form of lettering (*Sarika (HC)* at [57]). The High Court rejected the argument that the cursive font of the “nutello” sign renders it visually dissimilar from the block capital registration of the “Nutella” word mark and found that the “Nutello” sign was similar to the “Nutella” mark (see *Sarika (HC)* at [59] and [60]).


31 In applying the above principles found in *Sarika (HC)*, the Applicant argued that the Opponent’s Mark, unlike the “NUTELLA” mark and the “Mobil” mark, is not in plain-word font but in a stylised font. As such, the Opponent’s Mark does not enjoy the far-reaching protection of a plain word mark and that the stylisation of the Opponent’s Mark must be considered in assessing whether the competing marks are visually similar.

32 I invited the Applicant’s counsel to draw my attention to any precedent to support the Applicant’s argument regarding visual dissimilarity between an earlier stylised mark and later-filed plain word mark. At the end of the hearing, the Applicant referred to *Swatch AG (Swatch SA) (Swatch Ltd) v Apple Inc.* [2019] SGIPOS 1 (“*Swatch*”) at [43] and [44] where the Hearing Officer found that the pending mark “ISWATCH” was not visually similar to the earlier registered mark for “*iswatch*”.

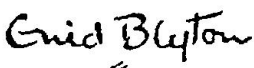
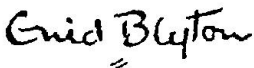
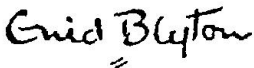


43 The *Opponent’s Earlier Registered ISWATCH Mark* is even more dissimilar to the Application Mark. This is because the *Opponent’s Earlier Registered ISWATCH Mark* consists of 7 letters while the Application Mark consists of 6. The *Opponent’s Earlier Registered ISWATCH Mark* has an additional letter “S”. Crucially, the “I” in the *Opponent’s Earlier Registered ISWATCH Mark* is highly stylised such that the visual impact foisted on the eye at the beginning of the *Opponent’s Earlier Registered ISWATCH Mark* is undeniable.

Conclusion

44 Having regard to the above, my conclusion is as follows:

<i>Application Mark</i>	<i>Opponent's Earlier Marks</i>	<i>Visually Similar?</i>
"IWATCH"	<i>Opponent's Earlier Unregistered SWATCH Mark</i>	More dissimilar than similar
	SWATCH	
	<i>Opponent's Earlier Registered ISWATCH Mark</i>	Dissimilar
		

33 In response, the Opponent submitted orally that IPOS does recognise that a plain word mark and a cursive mark can be similar, since IPOS accepts registrations for series marks comprising of a plain word mark and a cursive mark. The Opponent cited the following series marks as an example:

Mark	Registration Number	Class	Registration Date	Proprietor
ENID BLYTON 	T9804905I	41	12/05/1998	Hodder & Stoughton Limited
ENID BLYTON 	T9804904J	28	12/05/1998	Hodder & Stoughton Limited
ENID BLYTON 	T9804903B	25	12/05/1998	Hodder & Stoughton Limited
ENID BLYTON 	T9804901F	9	12/05/1998	Hodder & Stoughton Limited
ENID BLYTON 	T9804902D	16	12/05/1998	Hodder & Stoughton Limited

(collectively referred to as the “**Enid Blyton Series Marks**”)

34 In response, the Applicant submitted that the Enid Blyton Series Marks were registered under the earlier Trade Marks Act (Cap. 332, 1992 Rev. Ed), at Sections 26 and 28(2) which mandated association of series trade marks. However, the current Trade Marks Act (Cap. 332, 2005 Rev. Ed.) does not permit association of trade marks and is stricter in application when it comes to assessing the registrability of series marks (citing the Trade Marks Work Manual, Chapter 8 Series of Marks at pages 12-13 (Version 4 April 2017)).

35 In my view, while the Applicant has gone to great lengths to argue that the Opponent's Mark is not similar to the Application Mark because the Opponent's Mark is a stylised mark, I remain unpersuaded by the Applicant's argument. The marks at issue in *Swatch* were of a different nature from the marks presently in contention. While the Opponent's Mark is also a stylised mark not unlike the opponent's stylised "iswatch" mark in *Swatch*, in my view, the similarity ends there. The Application Mark is not a plain word mark (unlike the applicant's "IWATCH" mark in *Swatch*) as there is some form of stylisation in the font and addition of the numerals "1969". As such, I do not find the Applicant's reliance on *Swatch* persuasive.

36 I also do not consider the Opponent's reference to the Enid Blyton Series Marks helpful in advancing the argument that a stylised mark and a plain word mark can be visually similar. As the Applicant has correctly pointed out, the Enid Blyton Series Marks were registered under the earlier Trade Marks Act (Cap 332, 1992 Rev Ed) and there is no equivalent provision under the current Act.

37 Going back to the issue of visual similarity, this typically involves looking at the following:

- (a) Length of the marks;
- (b) Structure of the marks (i.e. whether there are the same number of words);
and
- (c) Whether the same letters are used in the marks

(*Sarika (HC)* at [51], *Ozone Community Corp v Advance Magazine Publishers Inc* [2010] 2 SLR 459 at [49]).

38 The Opponent's Mark and the dominant element of the Application Mark, "DHAMANI", both have the same number of letters as they comprise of seven letters each. The first letter in both marks is the same letter ("D") and the last three letters ("ANI") are also the same. The Application Mark comprises of two components, the word component "DHAMANI" and the numerical component "1969" which spans across two lines, while the Opponent's Mark comprises of one single word, "DAMIANI". However, I do not agree that the addition of "1969" in the Application Mark renders the marks visually dissimilar, as I had concluded earlier at [20] above that the dominant element that stands out to the average consumer in the Application Mark is "DHAMANI".

39 For the reasons above, I find that on the balance, the Application Mark is visually more similar than dissimilar to the Opponent's Mark.

Aural Similarity

40 Preliminarily, neither party presented evidence of how the marks are pronounced by the parties themselves, nor how the public would pronounce the marks. Absent evidence, this Tribunal assessed the similarity of the marks based on the approach set out in *Staywell*.

41 There are two approaches that can be taken in the comparison for aural similarity (*Staywell* at [31] – [32]):

- (a) The first approach is to have special regard to the distinctive or dominant components of the marks (“**Dominant Component Approach**”).
- (b) The second approach is to undertake an assessment as to whether the competing marks have more syllables in common than not (“**Syllables Approach**”).

42 In applying the Syllables Approach, the Opponent submits that “DAMIANI” in the Opponent’s Mark is pronounced as “DAM-YAR-NEE” but could also be pronounced as “DA-MEE-A-NI”. As for the Application Mark, the Opponent argued that it would be pronounced as “DA-MA-NEE”. The first syllable would be pronounced as “DA” in the same manner as the first syllable in the Opponent’s Mark (or “DAA” for the Application Mark due to “H” which might result in a slightly longer initial “DAA” sound), the second syllable, “MA”, would be pronounced in a similar way as the second syllable of the Opponent’s Mark and the last syllable, “NEE”, would be identical. In applying the Dominant Component Approach, the Opponent submits that it is unlikely that the “1969” element of the Application Mark would be articulated by consumers.

43 The Applicant submits that the Opponent’s Mark has four syllables and is pronounced as “DA-MI-AN-I”, while the Application Mark has three syllables and pronounced as “DAR-MAH-NEE”. To rebut the Opponent’s arguments on the Syllables Approach, the Applicant denies the Opponent’s technical distinctiveness argument and argues that the average Singapore consumer may identify the word “Damiani” as being European in origin but is unlikely to identify it as a surname. The Applicant argues however, that when the Application Mark is spoken, it would be recognised by the Singapore consumer as an Indian/Asian surname because Singapore has a significant proportion from the Indian sub-continent and would be familiar with Indian surnames. On this basis, the Applicant argues that the competing marks would not be aurally confused.

44 In this regard, I observe that the Applicant did not provide evidence to support its arguments about the European and Indian origins that the Opponent’s Mark and Application Mark would evoke specifically amongst Singapore consumers.

45 I am of the view that when the average consumer hears the word “DAMIANI” being pronounced, he may think that it is an invented name or a word or name with a foreign origin. However, it is unlikely that he would associate this word to be of European origin specifically. When the average consumer hears the word “DHAMANI” being pronounced, he may also think it is an invented name or word, or a word or name with a foreign origin. However, it is unlikely that he would associate the mark with Indian origin specifically.

46 Applying the Dominant Component Approach, I agree with the Opponent that it is likely that the average consumer would not pronounce “1969” in the Application Mark as this is a subsidiary component appearing in a smaller font. This is consistent with my earlier conclusion at [19] above that the dominant element in the Application Mark is “DHAMANI”. It is likely that the average consumer would pronounce the word element of the Application Mark “DHAMANI” when referring to the Application

Mark. Hence, for the purpose of aural comparison, I shall compare the pronunciation of “DHAMANI” in the Application Mark with “DAMIANI” in the Opponent’s Mark.

47 As mentioned earlier at [45] above, average consumers hearing the words “DAMIANI” and “DHAMANI” would likely conclude that these words are invented words or names, or possibly words or names with foreign origins, or at least intended to invoke a foreign association. Both “DAMIANI” and “DHAMANI” would appear unfamiliar to the average consumer. An earlier IPOS case, *Appitude Pte Ltd v MGG Software Pte Ltd* [2016] SGIPOS 15 (“*Appitude*”) is helpful on this point. In *Appitude* at [41], the Hearing Officer took the view that when pronouncing invented or unfamiliar words, there is a tendency for a person to reach within their own vocabulary and mentally look for similar words with the same structure. Having done so, he would apply the way in which those words are pronounced to the invented or unfamiliar word.

48 Applying this approach to the present case, the average consumer, being unfamiliar with the word “DAMIANI”, is likely to pronounce the Opponent’s Mark as “DA-MYAR-NEE”. Familiar words or names in the English language which they may draw reference from include “DAMIAN” (pronounced as “DA-MYAN”). The average consumer, being unfamiliar with the word “DHAMANI”, is likely to pronounce the Application Mark as “DA-MA-NEE”. Familiar words or names in the English language which they may draw reference from include “DHAL” (pronounced as “DAAL”) and “DHARMA” (pronounced as “DAAR-MA”).

49 Notably, the first syllable of both marks is identical and would likely be pronounced as “DA”. I am also guided by the principle that the first syllable of a word is aurally the most important, given that English speakers tend to slur subsequent syllables (“**First Syllables Principle**”) (*Doctor’s Associates Inc v Lim Eng Wah* [2012] 3 SLR 193 (“*Doctor’s Associates*”) at [35]). The High Court noted in *Doctor’s Associates* that the First Syllables Principle “seems reserved for cases where the marks comprise only one word”. I also note that the last syllable of both marks is identical and would likely be pronounced as “NEE”. The only difference would be the second syllable, “MYAR” (Opponent’s Mark) vs. “MA” (Application Mark), which would aurally still be very similar. Based on the Dominant Syllables Approach, the Application Mark is aurally similar to the Opponent’s Mark.

50 For the above reasons, I find that the Application Mark is aurally more similar than dissimilar to the Opponent’s Mark.

Conceptual Similarity

51 In terms of conceptual similarity, this requires consideration of the ideas that lie behind and inform the understanding of the mark as a whole (*Staywell* at [35] and *Hai Tong* at [70]).

52 The Opponent argued that from a conceptual perspective, both marks would be perceived by the average consumer as being family names of foreign origin.

53 The Applicant argued that the average consumer would identify the Opponent’s Mark as European in origin and the Application Mark as being a surname of Indian origin. The Applicant further argues that the difference in the styles of the competing

marks renders them conceptually different – the Opponent’s Mark is elaborate and cursive which creates the impression of tradition and history, while the Application Mark is in plain block letter form which gives the impression of simplicity and modernity. The Applicant also argues that the inclusion of “1969” in plain script in the Application Mark is a distinguishing feature as it evokes some curiosity and a sense of mystery.²⁷

54 Overall, I am inclined to agree with the Applicant that the Application Mark is conceptually dissimilar when compared with the Opponent’s Mark as the cursive font in the Opponent’s Mark gives it a more traditional look, while the stylisation in the Application Mark imparts a more modern look to the mark.

55 For the above reasons, I find that on the balance, the Application Mark is conceptually more dissimilar than similar to the Opponent’s Mark.

Conclusion on Overall Similarity / Dissimilarity of Marks

56 Overall, taking into account the substantial visual and aural similarity of the competing marks, I find that the Application Mark is more similar than dissimilar to the Opponent’s Mark.

Similarity of Goods and Services

57 Under the second step of the three-step *Staywell* test, I must now assess whether the goods and services for which the competing marks are registered are similar.

58 The factors to be taken into account in determining whether or not goods-similarity is satisfied are set out in the English case of *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 ("*British Sugar*"), where the following factors were held to be relevant considerations in determining the question of similarity of goods and services:

- (a) the respective uses of the respective goods or services;
- (b) the respective end users of the respective goods or services;
- (c) the physical nature of the goods or services;
- (d) the respective trade channels through which the goods or services reach the market;
- (e) in the case of self-serve consumer items, whether in practice they are respectively found or likely to be found on the same or different shelves; and
- (f) whether the respective goods or services are competitive or complementary. This inquiry may take into account how those in the trade classify goods, for instance whether market research companies who act for the industry put the goods or services in the same or different sectors.

59 For ease of comparison, the goods and services claimed under the Opponent’s Mark and the Application Mark are set out below:

²⁷ Applicant’s Written Submissions at [32]

Opponent's Mark	Application Mark
<p>Class 14 Jewellery and precious stones.</p>	<p>Class 14 Badges of precious metal; Beads for making jewelry; Bracelets [jewellery]; Brooches [jewellery]; Jewellery charms; Cloisonné jewellery; Diamonds; Earrings; Gold thread [jewellery]; Jewellery; Ornaments [jewellery]; Pearls [jewellery]; Platinum [metal]; Precious metals, unwrought or semi-wrought; Precious stones; Rings [jewellery]; Semi-precious stones; Spinel [precious stones]; Watches.</p> <p>Class 35 Advertising by mail order; Commercial information and advice for consumers [consumer advice shop]; Business management assistance; Professional business consultancy; Business inquiries; Commercial administration of the licensing of the goods and services of others; Commercial or industrial management assistance; Demonstration of goods; Direct mail advertising; Invoicing; Marketing; On-line advertising on a computer network; Presentation of goods on communication media, for retail purposes; Rental of advertising space; Rental of advertising time on communication media.</p>

Partial Opposition Issue: Parties' Arguments

60 In addressing the similarity of goods issue in Class 14, the Applicant concedes that some items for which registration is sought are identical to or similar with goods claimed under Class 14 of the Opponent's Mark ("**Category A**") while the remaining items for which registration is sought in Class 14 are not identical to or similar with the goods claimed under Class 14 of the Opponent's Mark and should be allowed to be registered ("**Category B**"). Category A and Category B are set out below:

Category A	Category B
Bracelets [jewellery]; Brooches [jewellery]; Jewellery charms; Cloisonné jewellery; Diamonds; Earrings; Gold thread [jewellery]; Jewellery; Ornaments [jewellery]; Pearls [jewellery]; Precious stones; Rings [jewellery]; Spinel [precious stones].	Badges of precious metal; Beads for making jewelry; Platinum [metal]; Precious metals, unwrought or semi-wrought; Semi-precious stones; Watches.

61 The Applicant's argument essentially is that the Hearing Officer has the power (or is even obligated) to grant a partial opposition to allow the Application Mark to

proceed to registration for the items in Category B and all items in Class 35 and that such power must be exercised by the Hearing Officer in the present case. The Applicant's counsel has submitted extensive arguments in written and oral submissions.

62 I set out the relevant provisions in the Act and the Interpretation Act (Cap. 1, 2002 Rev Ed) ("*the IA*") that the Applicant relies on to support its partial opposition argument in its written submissions:

Section 12(3) of the Act

12(3) If it appears to the Registrar that **the requirements for registration are not met** or that additional information or evidence is required to meet those requirements, the Registrar shall inform the applicant **and give him an opportunity**, within such period as may be prescribed, to make representations, **to amend the application** or to furnish the additional or any other information or evidence.

Section 15(1) of the Act

15(1) Where an application has been accepted and —

(a) no notice of opposition is given within the period referred to in section 13(2); or

(b) all opposition proceedings are withdrawn or **decided in favour of the applicant**,

the Registrar shall register the trade mark.

Section 6 of the IA

6. When an Act is divided into Parts, Chapters, titles or other subdivisions, the fact and particulars of such division shall, with or without express mention thereof in the Act, be taken notice of in all courts and for all purposes whatsoever.

Section 9A(1) of the IA

9A (1) In the interpretation of a provision of a written law, an interpretation that would promote the purpose or object underlying the written law (whether that purpose or object is expressly stated in the written law or not) shall be preferred to an interpretation that would not promote that purpose or object.

Section 29(1) of the IA

29(1) Where a written law confers powers on any person to do or enforce the doing of any act or thing, such powers shall be understood to be also conferred as are reasonably necessary to enable the person to do or enforce the doing of the act or thing.

63 The Applicant's partial opposition arguments are somewhat complicated and have been summarised below:

(a) Section 12(3) of the Act gives the Registrar the power to grant the applicant an opportunity to amend the specification during opposition proceedings. While the Registrar does not have an express power to order a partial opposition, it is argued that Section 12(3) of the Act is worded such that the Registrar is obligated to "*give him an opportunity...to amend the*

application". In other words, it is mandatory for the Registrar to give an applicant the opportunity to delete the offending goods or services after opposition proceedings.²⁸

(b) When Section 15(1) of the Act is read together with Section 12(3), the effect is that it gives the Registrar the power to provide an applicant with the opportunity to amend the specification where the requirements for registration are not met.

- i. It would be unreasonable to limit the power of the Registrar to allow for an amendment of its trade mark application to meet the requirements only during the examination period, but not during the remainder of the registration procedure.²⁹
- ii. Section 12(3) and Section 15(1) of the Act are located within the same Part II, hence there is no justification to limit the power of the Registrar and refuse an applicant the right to amend its application following opposition proceedings in order to enable the registration of goods or services which do not conflict with those registered under the earlier conflicting registered mark ("**Earlier Mark**") whilst the application is still within the registration procedure.³⁰
- iii. As the purpose of the Act is to provide for the registration of trade marks, the Registrar is only empowered to refuse registration where the requirements of the Act are not met. Where the Registrar refuses registration of all the goods and services applied for under any or all of the relative grounds of registration, including the goods or services that are not identical with or similar to the goods or services of the Earlier Mark, this would not promote the purpose or object of the Act (per Section 9A(1) of the IA) and indeed, the Registrar would be acting *ultra vires* of his powers as provided by the Act as he has no power to refuse registration if the goods or services are not identical with or similar to the goods or services of the Earlier Mark.³¹

(c) From a policy standpoint, if an applicant is only allowed to divide the application or delete the offending goods at the examination stage when a citation objection is raised but not at the opposition stage, this could be unfair to an applicant as there could be situations where an opposition would succeed even though only a few goods overlap. This was the point raised by the Hearing Officer in *Christie Manson & Woods Limited v Chritrs Auction Pte. Ltd.* [2016] SGIPOS 1 ("*Christie*") at [113]. The Applicant also referred to *Monster Energy Company v Tencent Holdings Limited* [2018] SGIPOS 9 ("*Tencent*") at [94], where 5 out of 650 items claimed under the pending application mark was found to overlap with the opponent's registered mark and therefore goods-similarity was established. The Applicant's argument is that if the marks were

²⁸ Applicant's Written Submissions at [55]

²⁹ Applicant's Written Submissions at [49]

³⁰ Applicant's Written Submissions at [54]

³¹ Applicant's Written Submissions at [51]

found to be similar (which they were not), the opposition would have succeeded and the pending application mark would be rejected for all 650 items because of an overlap of 6 items.

(d) Partial oppositions should be allowed as proprietors of international registrations do not have an opportunity to divide out an application (*New Yorker S.H.K. Jeans GmbH & Co. KG v Daidoh Limited* [2017] SGIPOS 16 (“*New Yorker*”) at [13b]).

(e) If the opposition succeeds for all goods, the Applicant would be in a worse off situation than if it had deleted its goods.

(f) The Hearing Officer in *Tencent* at [79] recognised that it is possible to grant a partial opposition in a multi-class application to refuse an opposition in one class and allow it in another.

64 In response to the Applicant’s arguments in support of partial oppositions, the Opponent argued in its oral submissions that there are cogent policy reasons for not allowing partial oppositions:

(a) An applicant is given the opportunity prior to an opposition hearing to amend or divide out the application to avoid opposition proceedings. This was recognised in *New Yorker* at [59]:

...It gives me no pleasure to observe, at the end of the proverbial day, that *New Yorker* (No. 1) was indeed a Pyrrhic war which had no genuine impact on the material issues arising in this opposition. And if *New Yorker* (No. 1) was straightforward, the issues in this dispute were — if anything — simpler still. **If only the Applicant had been willing to delete the Contested Services from the specification of services, the dispute might have been resolved without the need for adjudication by this tribunal.** (emphasis added)

(b) Previous cases before IPOS have recognized that it is not possible to grant a partial opposition. Most recently, *Rolux S.A. v FMTM Distribution Ltd* (“*Rolux*”) [2020] SGIPOS 6 at [66]:

66 At the hearing, the Applicant clarified that it was not proposing the possibility of finding goods-similarity for the overlapping goods, but allowing its mark to proceed to registration in respect of the remaining goods. **I note that in any case, such a partial registration (or partial opposition) would not have been possible** (see *Monster Energy Company v Tencent Holdings Ltd* [2018] SGIPOS 9 at [78]–[91]). (emphasis added)

(c) Partial opposition in the context of a multi-class application has not been granted by IPOS, and on this basis a partial opposition that succeeds in Class 14 but fails in Class 35 should not be granted in the present case.

Analysis on Partial Opposition Issue

65 I note that to date, under the current Act, neither IPOS, the High Court or the Court of Appeal have had to decide on the issue of partial oppositions within the same class (i.e. opposition allowed for some goods/services within the class but rejected for the remaining goods/services within the same class) and in multi-class applications (i.e. opposition allowed in one class but rejected in another class in the same application). Whilst a number of cases before IPOS have discussed the issue (see *Christie* at [102]-[114], *Tencent* at [74]-[92], *Abbott Laboratories v Société des Produits Nestlé S.A.* (“*Abbott Laboratories*”) at [71]-[75] and *Rolux* at [66]), the observations made by the Hearing Officers were *obiter*. Whilst there has been one IPOS case, *Nike International Ltd v Camponar SL* [2001] SGIPOS 4 (“*Nike*”), where the Hearing Officer ordered the applicant to amend their specification after an opposition hearing, I accept the Hearing Officer’s reasoning in *Tencent* that *Nike* should be confined to the specific context of the earlier 1992 Act that it was decided under as explained in *Tencent* at [91b]:

Second, the Opponent pointed out that Nike was based on the pre-1999 version of the Trade Marks Act (Cap. 332, Rev. Ed. 1992) (“TMA 1992”), which was materially different from the present version of the TMA. In my assessment, this submission is correct. It seems that the Hearing Officer in Nike did not, strictly speaking, allow a partial opposition but instead ordered the applicant in that case to amend “*the subject specification in the manner set out above within 4 weeks from the date hereof, failing which the application shall be refused*” (see Nike at [41]). Such an order was made pursuant to Section 12(2) of the TMA 1992 which conferred upon the Registrar the power to “*refuse the application or... accept it absolutely or subject to such conditions, amendments, modification, or limitations, as he may think right to impose*”. It seems that there is no direct equivalent of this power in the present day incarnation of the TMA. As such, Nike should be viewed in that specific context.

66 Having considered the Applicant and the Opponent’s arguments, I am not convinced that the Hearing Officer is mandated nor has the authority to grant partial oppositions within the same class and in multi-class applications, for the reasons set out below.

Opportunity to Amend an Application in Section 12(3) Is Strictly Confined to the Examination Stage Before Publication.

67 I accept the Applicant’s counsel’s point that Section 12(3) and Section 15(1) of the Act fall under the same heading, “*Registration procedure*”. However, it should be noted that Section 12(3) falls under the sub-heading “*Examination of application*” whilst Section 15(1) comes under the sub-heading “*Registration*”. The relevant sub-headings and the corresponding section numbers that fall under the heading “*Registration procedure*” are reproduced below:

Heading	Sub-Heading	Section Number
Registration Procedure	Examination of application	12
	Publication and opposition proceedings	13
	Withdrawal, restriction or amendment of application	14
	Registration	15

	Revocation of acceptance	16
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68 The sub-headings have been put in place to delineate each stage of the registration procedure in chronological order. Section 12 of the Act therefore clearly falls under the examination stage while Section 15 falls under the registration stage.

69 I note that Section 12(5) provides further clarification on the scope of Section 12 being limited to the examination of the application before acceptance, as it provides that the Registrar “*shall accept the application*” if the requirements for registration are met:

(5) If it appears to the Registrar that the requirements for registration are met, the Registrar shall accept the application.

70 Section 12(5) is immediately followed by Section 13, which comes under the heading “*Publication and opposition proceedings*”. The substantive content of Section 13 relates specifically to publication and opposition proceedings:

Publication and opposition proceedings

13.—(1) When an application for registration has been accepted, the Registrar shall cause the application to be published in the prescribed manner.

(2) Any person may, within the prescribed time from the date of the publication of the application, give notice to the Registrar of opposition to the registration.

(3) The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition and such other matter as may be prescribed.

(4) The Minister may make rules to provide for opposition proceedings and for matters relating thereto.

71 I am of the view that because the Act clearly demarcates each stage in the registration procedure, the opportunity to amend an application under Section 12(3) of the Act is strictly confined to the examination stage. The Applicant’s counsel had referred to Section 6 of the IA in its submissions, which I note provides that chapters, titles as well as sub-divisions “*...be taken notice of in all courts and for all purposes whatsoever.*”

72 I do not agree that it is unreasonable not to extend the opportunity to amend the application under Section 12(3) to Section 15(1)(b) of the Act. If the legislative intent was to allow for the amendment of the application pursuant to an opposition, this would have been more appropriately provided for under Section 13 of the Act, which deals with opposition proceedings. I do not agree with the Applicant’s broad proposition that because the purpose of the Act is to register trade marks, the Registrar is only empowered to refuse registration where the requirements of the Act are not met or else will be acting *ultra vires*. The provision of specific rules and procedures that govern an application for the registration of a trade mark is not inconsistent with an overarching legislative intent to provide for a trade mark registration regime under the Act.

73 Accordingly, in the absence of such an express provision, I do not think it is permissible to rely on Section 12(3) of the Act to argue that the Applicant should be given an opportunity to amend the specification of the application at or after the opposition stage.

The Act Expressly Provides for Partial Revocations and Partial Invalidations, But Does Not Expressly Provide for Partial Oppositions.

74 I am further fortified by the fact that while the Act does not have a provision which explicitly permits partial oppositions, in contrast, partial revocations and partial invalidations are explicitly permitted under Sections 22(6) and 23(9) of the Act respectively:

Section 22(6) of the Act

(6) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

Section 23(9) of the Act

(9) Where the ground of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

75 Accordingly, if it was the legislative intent for partial oppositions within the same class and in multi-class applications to be allowed under the Act, this would have been expressly provided for under the Act. Even if there may be practical reasons in favour of partial oppositions being granted, this does not alter the fact that a Hearing Officer does not have the power to grant partial oppositions since such powers are not expressly provided for under the Act.

76 Although the Hearing Officer in two previous cases before IPOS has commented that partial opposition in multi-class applications is uncontroversial (see *Tencent* at [79] and *Abbott Laboratories* at [73c]), the statements were made in *obiter*. Sections 22(6) and 23(3) of the Act are worded such that they could cater for partial revocation and partial invalidation within the same class and in multi-class applications. However, as there is no express provision that provides for the granting of a partial opposition in either scenario under the Act, I can only conclude that partial oppositions within the same class and in multi-class applications are not provided for under the Act.

Policy Reasons For and Against Partial Oppositions

77 It would be opportune to comment briefly on the policy reasons for and against partial oppositions raised by the Opponent and the Applicant.

Applicant Has Opportunity to Amend Its Specification or Divide Its Application Prior to the Opposition Hearing

78 The Applicant argued in its oral submissions that partial oppositions should be allowed as a failure to allow partial oppositions would mean that the Applicant is in a worse-off position if the opposition succeeds against the entire specification claimed.

However, I am of the view that this serves as an impetus for parties to attempt to resolve their dispute before the need for a contested hearing. Where an applicant decides not to amend its specification or divide its application prior to the opposition hearing, it should be taken to have accepted the risk that its entire application will be rejected. This was the position taken by the Hearing Officer in *Tencent* at [91d]:

Fourth, the Opponent argued that it would not be unfair to refuse an application on the basis of a single point of overlap/similarity of goods/services because the incumbent mark is registered on the register which is public, and the trade applicant cannot say that there was no notice of the earlier mark. **Following this line of argument, it is always open for the applicant of the later mark to take steps to ensure that his trade mark application does not encroach on the rights of the proprietor of the earlier mark; indeed, if the application gets through, the applicant only stands to gain, and if it does not — well, the applicant must be treated as having willingly adopted that risk. I agree with this submission as well.** (emphasis added)

Opportunity to Amend and Divide the Specification Also Extends to International Registrations

79 The Applicant expressed a concern that it would be unfair to disallow partial oppositions as that unduly prejudices the proprietors of international registrations, who do not have this same opportunity to divide their international registrations. However, that position appears incorrect. At the date of issuance of the decision for *New Yorker* (24 October 2018) which the Applicant had placed reliance on, the division of international registrations was not permitted under the Trade Marks (International Registration) Rules (the “**TM (IR) Rules**”). However, 5 months later, IPOS introduced the division of international registrations designating Singapore under Rule 5A of the TM (IR) Rules. The relevant provisions from Circular No. 2/2019 dated 4 March 2019 and the TM (IR) Rules are set out below:

Circular No. 2/2019 dated 4 March 2019

Division of International Registrations Designating Singapore

Pursuant to the amendment of the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (the “Common Regulations”), where new rule 27bis is introduced to cater for the division of international registrations, rule 5A of the Trade Marks (International Registration) Rules (the “**TM (IR) Rules**”) is amended to cater for the division of international registrations designating Singapore (“**IRs**”). With effect from 1 April 2019, IPOS will be accepting requests to divide IRs. An IR holder can request to divide the goods and/or services in an IR (“principal registration”) into two separate IRs (“divisional registrations”). This new procedure may be useful to a holder whose IR faces a partial refusal from IPOS. The acceptable goods and/or services could proceed to publication and/or registration without delay, while the objectionable goods and/or services in the IR could be divided out and dealt with separately.

Rule 5A(1) and (2) of TM (IR) Rules

Request for division of international registration designating Singapore

5A.—(1) Subject to the provisions of this rule, the holder of an international registration designating Singapore (called in this rule a principal registration) for 2 or more goods or services (called in this rule the subject goods or services) may make a request to the International Bureau through the Registrar, to divide the principal registration into 2 international registrations designating Singapore (called in this rule a divisional registration), each for —

- (a) one or more classes of goods or services to which the subject goods or services belong; or
- (b) one or more of the subject goods or services.

80 In particular, Rule 5A(5) of TM (IR) Rules addresses the scenario where a notice of opposition has been filed against the principal registration and this registration is later divided by the proprietor and how the division would affect the opposition proceedings:

Rule 5A(5) of TM (IR) Rules

(5) Upon the division of the principal registration into 2 divisional registrations by the International Bureau —

- (a) any notice of opposition to the conferring of protection on the principal registration filed with the Registrar must —
 - (i) if the notice relates only to some (but not all) of the goods or services to which the principal registration relates, be treated as having been given in relation only to the divisional registration for the goods or services to which the notice relates; or
 - (ii) if the notice relates to all of the goods or services to which the principal registration relates, be treated as having been given in relation to both of the divisional registrations,

and the opposition proceedings are to continue as if the notice had been so given; and

81 This reaffirms the principle that an applicant should be regarded as having assumed the risk that its application would be rejected if an opposition against its mark succeeds. If it is not prepared to take this risk, it should take steps to amend its specification to delete overlapping goods/services or divide its application.

82 Whilst Applicant’s counsel had presented reasons for allowing a partial opposition, unfortunately, absent express legislative power, this Tribunal is unable to do so.

Analysis on Similarity of Goods

Class 14

83 With regard to similarity of goods in Class 14, the Opponent argued that if the marks fell within the same class of products, the requirement of similarity of goods would be *prima facie* established and it would be unnecessary for the court to engage

in the *British Sugar* test. The Opponent relied on *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2005] 4 SLR(R) (“*Polo*”) at [33]:

33 Accordingly, I have very little doubt that the goods carried by the plaintiff and the defendant are similar, if not identical, for the purposes of s 27(2)(b) of the TMA. The plaintiff’s trade marks were registered under Class 25 of the ICGS and the defendant’s products which are being complained of (mainly T-shirts) would qualify to be registered in the same class, as evidenced by their attempted registration. This being the case, it is not necessary for the court to engage in the test set down in *British Sugar* ([11] supra). The test in that case was employed because the defendant’s product would not have been registered in the same class as the plaintiff’s and thus there was a need to decide if it was similar enough to the plaintiff’s product. It would be a very rare case, if ever, that a defendant could claim that its products, if listed in the same classification as the plaintiff’s, were not similar. The defendant here attempted to make some argument about this issue though very briefly and somewhat half-heartedly. The considerations it listed – price, design and quality of the goods – are relevant in considering the likelihood of confusion but not whether the goods are identical or similar. Even if I were to apply the *British Sugar* test, I am persuaded that the goods to which the marks and the sign are applied are similar, if not identical – all being articles of casual clothing.

84 Applying the above principle, the Opponent argued that because the Application Mark is filed in Class 14 and the Opponent’s Mark is registered in Class 14, the requirement of similarity of goods is *prima facie* established and hence it is unnecessary to engage in the *British Sugar* test.

85 The Applicant’s contention, as stated at [60] above, is that there is similarity of goods for Category A but not for Category B. However, since I have decided that partial oppositions are not permissible, I will only consider the similarity of goods based on the Applicant’s specification in Class 14 as a whole and will not consider Category A and Category B separately.

86 I do not agree with the Opponent’s argument that similarity of goods has been *prima facie* established in Class 14 because the specification claimed under the Application Mark is also filed in Class 14. In particular, the position in *Polo* at [33] has been clarified in *Staywell* at [40] to [41]:

40 The comparison before us was between the services falling under Staywell’s intended Class 35 and 43 registrations, and the Opponents’ existing Class 43 registration. In relation to the Class 43 registration, we agree with the Judge’s observation that the fact that the parties’ hotel services were branded for different market segments did not render the services dissimilar. **Following the dictum of Lai Kew Chai J in *Polo* (HC) at [33], the Judge stated that registration in the same category establishes a prima facie case for similarity. This invites some clarification. We think that what Lai J was referring to was registration in the same specification. We would go further to say that registration in the same specification within a class establishes a prima facie case for identity.** This is because it is not within the scheme of

the classification system to make distinctions within a specification based on whether the particular product is targeted at one or another market segment.

41 Hotel services are hotel services, whether these concern a luxury hotel or a more modest one. We adopt the view that while “trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise... [w]here words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, **there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.**” (per Floyd J in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) (“YouView”) at [12]; see also *Omega Engineering Inc v Omega SA* [2013] FSR 25 at [33]). **Where a good or service in relation to which registration is sought falls within the ambit of the specification in which the incumbent mark is registered, the competing goods or services would be regarded as identical** (see *Gerard Meric v OHIM*, Case T-133/05 at [29]). [emphasis added]

87 It is clear that it is not sufficient to simply show that goods are filed in the same class to establish similarity of goods. *The same specification of goods must be sought in the same class* for the goods to be identical. Bearing in mind that *Staywell* at [41] refers to “...a good or service in relation to which registration is sought” in the singular sense and how this renders “...the competing goods or services...as identical”, it is sufficient to show at least one of the goods is similar and there is no requirement to show that all goods are similar in order to establish similarity of goods.

88 The goods claimed in Class 14 under the Opponent’s Mark are “jewellery and precious stones”, while the goods claimed in Class 14 of the Application Mark include “jewellery” and “precious stones”. On this basis, I find that identity of goods has been established in Class 14.

Class 35

89 When an application is filed in other related classes which do not correspond with the registered class of the earlier registered mark, the *British Sugar* test would apply. This has been established in *Staywell* at [43]:

43 In relation to its Class 35 registration, the Judge accepted the PAR’s finding that Staywell’s advertising, marketing and business management services were adjunct to and inseparable from its primary services under Class 43, and therefore similar to the Opponent’s Class 43 services (GD ([8] supra) at [32]–[33]). We agree with the Judge’s reasoning to the extent that Staywell’s Class 35 services are closely related and indeed inseparable from its Class 43 hotel and restaurant services. This is not to say that Staywell’s application for registration under the two classes was to be considered and compared collectively as against the Opponents’ Class 43 services. **Rather, the real question is whether Staywell’s services that were sought to be registered under Class 35 are similar to the Opponents’ services under Class 43, having regard to all relevant factors relating to the services themselves. Some of the factors set out in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 (“British Sugar”) at 296 would be relevant at the goods-**

similarity stage of the inquiry, in particular the consideration of the uses and the end-users of the services. The question is how the services are regarded, as a practical matter, for the purposes of trade. Applying this approach, we agree with the PAR’s findings at [63] of the PAR’s GD. There is an overlap between the uses and users of Staywell’s Class 35 business management and administration services, and its Class 43 service of providing hotel venues for business conferences and receptions. As for the advertising and marketing services under Class 35, these relate to the promotion of the hotel and restaurant services under Class 43. Therefore we agree that there is similarity between Staywell’s services in Class 35 and the Opponents’ services in Class 43. (emphasis added)

90 In *Staywell*, the Court of Appeal noted that there is an overlap between uses and users of the Applicant’s Class 35 advertising and marketing services under Class 35 which relate to the promotion of the hotel and restaurant services under Class 43. I have reproduced the specification claimed by the Opponent in Class 43 and the specifications claimed in Classes 35 and 43 by the Applicant in *Staywell* below:

Opponent’s Class 43 Services (T9512253G)	Applicant’s Class 35 & Class 43 services (T0802642I)
<p>Class 43 Hotel, motel, resort, restaurant, bar, cocktail lounge, food and beverage services.</p>	<p>Class 35 Advertising, marketing, promotion and publicity services; business management; business administration; office functions; provision of office facilities; administration of the business affairs of retail stores; advisory, information and consultancy services relating to all the aforesaid; all the aforesaid services also provided on-line from a computer database or via the global communications network; all included in Class 35</p> <p>Class 43 Services for providing food and drink; temporary accommodation; hotel services; resort hotel services; hotel accommodation services; hotel catering services; hotel reservation services; hotel restaurant services; provision of hotel venues for business exhibitions, business fairs, conferences, congresses, lectures and meetings; providing facilities [accommodation] for conducting conferences, conventions, exhibitions, fairs and holidays; rental of meeting rooms; hospitality services [accommodation]; hospitality suites [provision of accommodation, food or drink]; holiday information and planning relating to</p>

	accommodation; inn keeping [bar, restaurant and accommodation]; restaurants; cafes; bar and catering services; advisory, information and consultancy services relating to all the aforesaid; all the aforesaid services also provided online from a computer database or via the global communications network; all included in Class 43
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91 In the present case, advertising and marketing related services are also claimed in Class 35 of the Application Mark, namely “*Advertising by mail order; ... Demonstration of goods; Direct mail advertising; ... Marketing; On-line advertising on a computer network; Presentation of goods on communication media, for retail purposes*”. The full specification claimed under the Opponent’s Mark and the Application Mark are compared below:

Opponent’s Mark in Class 14	Application Mark in Classes 14 and 35
<p>Class 14 Jewellery and precious stones.</p>	<p>Class 14 Badges of precious metal; Beads for making jewelry; Bracelets [jewellery]; Brooches [jewellery]; Jewellery charms; Cloisonné jewellery; Diamonds; Earrings; Gold thread [jewellery]; Jewellery; Ornaments [jewellery]; Pearls [jewellery]; Platinum [metal]; Precious metals, unwrought or semi-wrought; Precious stones; Rings [jewellery]; Semi-precious stones; Spinel [precious stones]; Watches.</p> <p>Class 35 Advertising by mail order; Commercial information and advice for consumers [consumer advice shop]; Business management assistance; Professional business consultancy; Business inquiries; Commercial administration of the licensing of the goods and services of others; Commercial or industrial management assistance; Demonstration of goods; Direct mail advertising; Invoicing; Marketing; On-line advertising on a computer network; Presentation of goods on communication media, for retail purposes; Rental of advertising space; Rental of advertising time on communication media.</p>

92 Applying the reasoning in *Staywell* at [43], advertising and marketing services claimed by the Applicant in Class 35 would, for usual reasonable or practical purposes, be used for the promotion of jewellery and precious stones which are claimed in Class 14 of the Application Mark.

93 Accordingly, the services claimed in Class 35 of the Application Mark are adjunct to and inseparable from the goods claimed in Class 14 of the Opponent's Mark. On this basis, I find that the services claimed in Class 35 of the Application Mark are similar to the goods claimed in Class 14 of the Opponent's Mark.

Conclusion on Similarity of Goods and Services

94 I conclude that there is similarity between the goods claimed in Class 14 of the Opponent's Mark and the goods and services claimed in Classes 14 and 35 of the Application Mark.

Likelihood of Confusion

95 The third element that has to be established under Section 8(2)(b) of the Act is that there exists a likelihood of confusion on the part of the public. The public is taken to refer to the average consumer of the type of goods or services in question, which includes members of the trade as well as the general public (see IPOS Trade Mark Work Manual, Chapter 7 Relative Grounds of Refusal at page 37 (Version 7 June 2020)). In this case, the average consumer would be the general public and jewellers purchasing jewellery and precious stones.

96 Confusion for the purposes of Section 8(2)(b) can be of two kinds: where the consumer thinks that the goods bearing the opposed mark are those of the registered proprietor of the earlier trade mark, or where the consumer thinks that the parties using these two marks are economically-linked (*Staywell* at [99] and *Hai Tong* at [74]).

97 The relevant principles for assessing likelihood of confusion were authoritatively set out by the Court of Appeal in *Staywell*:

- (a) In opposition proceedings the inquiry must take into account the full range of the competing monopoly rights that are already enjoyed on the one hand, namely the actual and notional fair uses to which the incumbent proprietor has or might fairly put his registered trade mark, and compare this against the full range of such rights sought by the applicant by reference to any actual use by the applicant (assuming there has been prior use) as well as notional fair uses to which the applicant may put his mark should registration be granted. The likelihood of confusion inquiry in opposition proceedings therefore sets a higher threshold for the applicant than the similar inquiry in infringement proceedings (*Staywell* at [60] and [62]).
- (b) Once similarity between the competing marks and goods or services has been established, the *impact* of these similarities on the relevant consumers' ability to understand where those goods and services

originate from falls to be considered. The only relevant confusion is that which results from the similarity between marks and goods or services. However, the plain words of Section 8(2) do not have the effect of making a finding of confusion automatic upon the establishment of similarity of marks and goods or services (*Staywell* at [64]).

- (c) On the effect of the foregoing 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]).
- (d) The following is a non-exhaustive list of factors which are regarded as admissible in the confusion inquiry (*Staywell* at [96]):
 - (i) 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.
 - (ii) 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) The nature of goods and 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.

Factors Relating to the Impact of Marks-Similarity

Degree of Similarity of the Marks

98 I had concluded earlier that the marks are more similar than dissimilar, as they are visually and aurally similar. Overall, I am of the view that the level of similarity is substantial and this factor contributes to likelihood of confusion.

Reputation of the Marks

99 On the evidence before me, I find that the Opponent has not succeeded in establishing a strong reputation in the Opponent’s Mark. As the Applicant correctly pointed out, none of the evidence of use submitted by the Opponent in the Opponent’s

SD showed use of the Opponent's Mark.³² The Applicant highlighted, in its written submissions, that the following unregistered marks are the marks used by the Opponent as submitted in the Opponent's SD:

S/No.	Trade Marks in Opponent's SD
1	 33
2	 34
3	 35
4	
5	
6	
7	
8	 36
9	
10	
11	

(collectively referred to as the “Opponent’s Unregistered Marks”)

³² Applicant's Written Submissions at [75]

³³ The phrase “HANDMADE IN ITALY SINCE 1924” appears below the word “DAMIANI”.

³⁴ The phrase “HANDMADE IN ITALY SINCE 1924” appears below the word “DAMIANI”.

³⁵ The phrase “HANDMADE IN ITALY SINCE 1924” appears below the word “DAMIANI”.

³⁶ The letters “MAR”, “GHE” and “RITA” appear above the word “DAMIANI”.

100 As stated at [246] above, based on my review of the Opponent's SD, I agree with the Applicant that the Opponent's Mark does not appear in the Opponent's SD and the most commonly used marks found in the Opponent's SD are the Damiani SD Marks (defined in [26] above).

101 Since the Opponent did not establish a strong reputation in the Opponent's Mark, I find that this factor is neutral but notwithstanding, this does not preclude a likelihood of confusion from arising.

Impression Given by the Marks

102 The Opponent argued that both marks convey the same impression to a consumer as they each consist of a family name. The Applicant argues otherwise, that the impression given by the Opponent's Mark is traditional and elaborate but the impression given by the Application Mark is contemporary and simple.

103 Under this factor, I will have to consider the general impression that will be left by the essential or dominant features of the mark on the average consumer (*Hai Tong* at [40(d)]). Taking into account my earlier finding that the dominant component in the Application Mark is "DHAMANI" (see [20] above) and there is no dominant component in the Opponent's Mark (see [19] above), I am of the view that the impression given by the marks would be similar in light of the of the substantial visual and aural similarity between the Application Mark and the Opponent's Mark. As such, this factor contributes to the likelihood of confusion inquiry.

Possibility of Imperfect Recollection of the Marks

104 The Applicant argues that the strongly stylised form of the Opponent's Mark makes it distinct from the Application Mark. However, due to the substantial visual and aural similarity between the marks, I believe that there is a possibility, by reason of imperfect recollection of the marks, that the average consumer would be confused into believing that the Application Mark originates from the Opponent. Overall, I believe that this factor points towards a likelihood of confusion.

Factors Relating to the Impact of Goods-Similarity

Normal Way or Circumstances in which Consumers Purchase Goods of that Type

105 The Opponent relies on evidence submitted to show that its goods may be purchased at boutiques and on e-commerce platforms. The Applicant does not dispute that both parties sell jewellery through brick-and-mortar stores, but they have highlighted that there is a difference in the mode of sales since the Applicant also runs a substantial wholesale business while the Opponent runs an e-commerce business.

106 The evidence submitted by the Opponent and Applicant to establish how customers would purchase their jewellery is not conclusive, as the inquiry of a likelihood of confusion takes into account the actual and notional fair use of the mark that the Opponent is entitled to (*Staywell* at [60]). As such, it is necessary to consider the normal way and circumstances in which consumers would purchase jewellery and precious stones.

107 At this juncture, it would be helpful to clarify what precious stones are. The Applicant has referred to the Precious Stones and Precious Metals (Prevention of Money Laundering and Terrorism Financing) Act 2019 (Act 7 of 2019) which refers to “precious stones” as diamond, sapphire, ruby, emerald, jade (including nephrite and jadeite) and pearl³⁷ and submitted that “semi-precious stones” claimed by the Applicant are not identical or similar.

108 I note that whilst the Precious Stones and Precious Metals (Prevention of Money Laundering and Terrorism Financing) Act 2019 (Act 7 of 2019) had defined precious stones as being limited only to diamond, sapphire, ruby, emerald, jade (including nephrite and jadeite) and pearl, that legislation is not relevant as it is targeted against the offences of money laundering and terrorism financing; it cannot be intended to address or be conclusive of the issue of similarity of goods to the average member of the public. As a general reference, I note that the official Wikipedia page on Gemstones³⁸ refers to “precious stones” as diamonds, rubies, sapphires and emerald, and adds as follows:

The traditional classification in the West, which goes back to the ancient Greeks, begins with a distinction between precious and semi-precious; similar distinctions are made in other cultures. In modern use the precious stones are diamond, ruby, sapphire and emerald, with all other gemstones being semi-precious. This distinction reflects the rarity of the respective stones in ancient times, as well as their quality: all are translucent with fine color in their purest forms, except for the colorless diamond, and very hard, with hardnesses of 8 to 10 on the Mohs scale. Other stones are classified by their color, translucency and hardness. **The traditional distinction does not necessarily reflect modern values**, for example, while garnets are relatively inexpensive, a green garnet called tsavorite can be far more valuable than a mid-quality emerald.^[5] Another unscientific term for semi-precious gemstones used in art history and archaeology is hardstone. **Use of the terms 'precious' and 'semi-precious' in a commercial context is, arguably, misleading in that it deceptively implies certain stones are intrinsically more valuable than others, which is not necessarily the case.**

109 I accept that with the growing ubiquity of online retail platforms, the normal way that the average consumer would purchase jewellery now includes online, in addition to physical retail stores. As for precious stones, they can be purchased on both physical retail stores and online retail platforms. I accept that jewellery can be of both an expensive and inexpensive nature (see further comments below) and whether they are expensive or inexpensive would affect a consumer’s mode of purchase. If the jewellery is more expensive, it is more likely that the consumer would purchase it at a physical retail store in order to have the opportunity of trying the jewellery on and examining the jewellery physically. In contrast, if jewellery is inexpensive, the consumer is less disinclined to purchase it online without having to physically examine and try on the jewellery.

³⁷ Appellant’s Written Submissions at [42]; Appellant’s BOA, Tab 3, Part 2 of the Schedule

³⁸ Whilst there may be limitations to the accuracy of this definition since Wikipedia entries can be made and modified by anyone, the official Wikipedia page on Gemstones remains helpful as a general reference on what could potentially fall within the scope of the term.

110 Similarly, as precious stones tend to be relatively expensive and consumers would be desirous of examining the characteristics of precious stones, it is more likely that the consumer would purchase them from a physical retail store. When purchasing jewellery and precious stones from a physical retail store, consumers would examine the goods closely and also have the opportunity to assess the marks directly when looking at the marks affixed to the goods. When jewellery and precious stones are purchased on an online retail platform, consumer would also be able to view the marks displayed on the website alongside the goods. They would also be able to type in the name of the marks when doing online searches or looking for reviews. As such, I am of the view that the normal way in which jewellery and precious stones are purchased does not contribute to a likelihood of confusion.

Whether the Products are Expensive or Inexpensive

111 The Opponent argues that jewellery could comprise of lower-end costume jewellery to luxury jewellery, while the Applicant takes the opposite view and argues that the jewellery sold by both parties is expensive and as a result, the average consumer would take great care and deliberation in purchasing these items.

112 The actual and notional fair uses to which a registered proprietor has or might fairly put his registered trade mark must be taken into account (*Staywell* at [60] and [63]). As such, the fact that the Opponent and the Applicant both sell expensive jewellery is not immediately relevant. What should be considered is the normal or average prices of jewellery and precious stones as a type or category of goods, as illustrated in *The Polo/Lauren Company, L.P. v United States Polo Association* [2015] IPOS 10 at [108]:

108 Thus, when determining the degree of care that the average consumer will pay when purchasing eyewear, it is inappropriate to consider if *the Opponents' and/or the Applicants' eyewear* are expensive or inexpensive items. The reference point should be the normal or average price of eyewear *as a type or category of goods*. For example, cars are expensive goods whereas erasers are inexpensive goods, and hence the degree of attention and care that goes into buying a car would be greater than that which goes into buying an eraser. This is what the Court of Appeal meant when it said, "*The price of the type of goods being sold* is distinct from the issue of *price disparity between the parties' products.*" (*Staywell* at [96(b)], emphasis added).

(Emphasis in italics in the original)

113 I agree with the Opponent that jewellery could comprise of lower-end costume jewellery to luxury jewellery. As a result, the price range of jewellery could span from low to high. As for precious stones, I note that the price range is generally quite high. As the price range of jewellery and precious stones collectively spans from low to high, such goods can be both inexpensive and expensive. As such, I find this factor is neutral in the likelihood of confusion inquiry and does not preclude a likelihood of confusion.

Nature of the Goods and Whether They Tend to Command a Greater or Lesser Degree of Fastidiousness and Attention on the Part of Prospective Purchasers

114 The Opponent argues that jewellery is ubiquitous in daily life and is frequently purchased by consumers as fashion accessories. The Opponent seems to be suggesting that the average consumer would apply a lesser degree of care and circumspection in purchasing jewellery because of the frequency of such purchases.

115 Conversely, the Applicant argues that such goods command a great degree of fastidiousness and attention as the style, design and artistry of the jewellery are unique to the Opponent and the Applicant. Consumers are likely to apply great care and have some knowledge in making their purchase especially where the items are expensive.

116 It is not in dispute that the nature of goods would affect the level of care and attention taken by prospective purchasers. In *Caesarstone*, the Court of Appeal held at [79] that consumer indifference towards a mark would normally point towards a likelihood of confusion and conversely, consumer sensitivity toward the mark used would point away from a likelihood of confusion:

79 For these reasons, we are satisfied that consumer indifference towards the mark used in relation to the relevant goods or services does not preclude the question of a likelihood of confusion from arising. **Consumer indifference would, in the normal course of events, point towards a likelihood of confusion in so far as consumers would pay less attention to the differences between the marks. Conversely, where consumers are especially sensitive towards the mark used in relation to the relevant goods or services (for example, in the case of luxury goods), this would likely point away from a likelihood of confusion as consumers would pay more attention to the differences between the marks.** Accordingly, the finding that consumers of Class 19 goods are likely to be indifferent towards the mark used in relation to the goods (see [64] above) points towards, rather than away from, a likelihood of confusion in the present case.(Emphasis added)

117 Jewellery is a type of product that is highly personal and individualised. Even if jewellery is purchased as a gift, the purchaser is likely to take into account matters of taste, preference and style of the recipient before making the purchase. Jewellery could be purchased because a consumer likes the jewellery designs that originate from a specific company and in such circumstances, the average consumer would apply a commensurate degree of fastidiousness when purchasing jewellery. Jewellery could also be luxury goods and in applying the principle in *Caesarstone* at [79], consumers purchasing such jewellery would be more sensitive towards the mark used for/on the goods. As such, when purchasing jewellery, consumers would be more brand-conscious and more sensitive towards the marks.

118 However, I am of the view that precious stones are of a different nature from jewellery. Consumers purchasing precious stones are more likely to focus on the characteristics, specifications and certifications of authenticity of the precious stone (e.g. whether it is GIA certified) and the price, rather than the mark used on or for such goods. As such, this type of consumer may be indifferent towards the mark used in relation to the goods and pays less attention to the differences between the marks, which points towards a higher likelihood of confusion.

119 Given the different nature of jewellery and precious stones, overall, it would appear that this factor is neutral in the likelihood of confusion inquiry and does not preclude a likelihood of confusion.

Likely Characteristics of the Relevant Consumers and Whether They Tend to Apply Care or Have Specialist Knowledge in Making the Purchase.

120 The Opponent argues that the relevant consumer may not have specialist knowledge and cites an example of a husband purchasing jewellery as a gift for his wife. On the other hand, the Applicant argues that the average consumer is likely to apply great care and have some knowledge in making the purchase since jewellery is expensive.

121 I agree that the average consumer would apply some degree of care when purchasing jewellery, given that jewellery is purchased based on personal preference and style as mentioned earlier at [117] above.

122 In *Caesarstone*, the Court of Appeal held at [86] that a likelihood of confusion may persist, despite specialist knowledge:

85 We deal first with the Judge’s first finding, which is that it “would not at all be surprising” if a large proportion of consumers would consult specialists when purchasing Class 19 goods. In our judgment, the relevant public in the present context is a composite comprising both specialists and lay end-consumers. Before us, Mr Pang accepted (rightly, in our view) that specialists would not likely be confused. As for the lay end-consumers, Mr Pang accepted (again rightly, in our view) that the predominant mode of their purchase would tend to be with the assistance of specialists (notwithstanding his written submissions otherwise). However, his point is that the likelihood of confusion on the part of these consumers would not be dispelled even with the assistance of specialists. As Mr Pang explained, this is because their discussions with the specialists would revolve around the price and attributes of the goods, rather than trade origin. Put another way, the submission, as we understand it, is that **the likelihood of confusion on the part of these consumers is not dispelled because any discussions they might have with the specialists would not be about trade origin in the first place. As a result, the likelihood of confusion is not addressed even with the advice of specialists and, therefore, persists. We agree with this submission, as it is simply a corollary of our earlier finding that consumers of Class 19 goods tend to focus more on the price and attributes of the goods rather than the mark used in relation to the goods** (see [64] above).
(Emphasis added)

123 The average consumer purchasing precious stones and jewellery could include members of the trade (e.g. jewellers purchasing precious stones and jewellery) who may have specialist knowledge in making the purchase. Such jewellers may not place an emphasis on the mark used on the goods and the trade origin, as their focus would be on the price and specifications etc, of the precious stones and jewellery. On the other hand, average consumers also include members of the public who may not have specialist knowledge but would place some care when purchasing jewellery as it is a

personal item (as explained earlier at [117] above) but may be indifferent towards the mark used on precious stones (as explained earlier at [118] above).

124 Overall, I believe this factor is neutral in the likelihood of confusion inquiry and does not preclude a likelihood of confusion.

Conclusion on Likelihood of Confusion

125 In summary, most of the above factors are neutral but there are two factors that contribute to likelihood of confusion, namely, the degree of similarity of the marks and possibility of imperfect recollection thereof. On the other hand, the normal way and circumstances in which customers purchase jewellery and precious stones do not support a claim of confusion. On the balance, I find that there is a likelihood of confusion between the Application Mark and the Opponents' Mark both over the origin of the goods and the existence of an economic link between the sources of the Applicant's goods and services and the Opponent's goods.

Conclusion on Section 8(2)(b)

126 The ground of opposition under Section 8(2)(b) therefore succeeds.

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

127 Section 8(4) of the Act reads:

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




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

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

Well Known Mark

128 The mark that the Opponent is relying on under the well known marks ground is the Opponent's Mark. However, as mentioned earlier at [26] above, the Opponent's SD did not show any use of the Opponent's Mark but only showed use of the Opponent's Unregistered Marks and this was emphasized by the Applicant in its written submissions.³⁹ The Opponent clarified during the hearing that under the Section

³⁹ Applicant's Written Submissions at [80]

8(4)(b)(i) ground, it is arguing that use of the marks, “**DAMIANI**”, “”, “” and “” (“**Damiani Word Marks**”) in the Opponent’s SD constitutes use of the Opponent’s Mark and on this basis, the Opponent’s Mark is well known in Singapore.

129 In response, the Applicant referred to *The Patisserie LLP v Aalst Chocolate Pte Ltd* [2019] SGIPOS 6 (“*Patisserie*”) which was an action for revocation. In *Patisserie*, the key issue before the IP Adjudicator was whether the registered proprietor’s use of a mark could be regarded as genuine use, where the form in which it was actually used differs from the form in which it was registered. The IP Adjudicator held that “*there should be some correspondence between the breadth of Section 22(2) of the TMA and the scope of the test for when non-identical trade marks qualify as a ‘series of trade marks’*” (*Patisserie* at [26]). The relevant provisions under Sections 17(2) and 22(2) of the Act are reproduced below:

Section 17(2) of the Act

17(2) For the purposes of this Act, “series of trade marks” means **a number of trade marks which resemble each other as to their material particulars and which differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.**

(Emphasis added)

Section 22(2) of the Act

22(2) For the purposes of subsection (1) [revocation provisions], **use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered**, and use in Singapore includes applying the trade mark to goods or to materials for the labelling or packaging of goods in Singapore solely for export purposes.

(Emphasis added)

In particular, the Applicant referred to *Patisserie* at [25] to [26]:

25 Even though the TMA does not provide explicit statutory guidance on how to determine when the “distinctive character of the mark” has been altered, the issue of when non-identical trade marks should be regarded as possessing sufficient legal proximity to each other is relevant in another statutory provision of the TMA. Arising in the context of when non-identical trade marks are eligible to be registered together under a single trade mark application, Section 17 of the TMA permits a “series of trade marks” to be the subject of a single trade mark application, with Section 17(2) providing that: ... ‘series of trade marks’ means a number of trade marks which resemble each other as to their material particulars and which differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.

26 While the wording of Section 22(2) of the TMA requires the actually used form of the trade mark to possess the “distinctive character” of the registered form of the trade mark so as to avoid the latter’s revocation on grounds of non-use, the language of Section 17(2) states that the members of a “series of trade marks” can differ “only as to matters of a non-distinctive character” that do not “substantially” affect “the identity of the trade mark”. Adopting an approach towards statutory interpretation that promotes internal consistency between Sections 17 and 22 of the TMA would suggest a substantial overlap between the breadth of Section 17(2) and Section 22(2). Non-identical trade marks that qualify as part of a “series of trade marks” because they “resemble each other as to their material particulars and which differ only as to matters of a non-distinctive character not substantially affecting the identity of the mark” could also be regarded as trade marks which share the same “distinctive character”. In other words, each trade mark belonging to a single “series of trade marks” should be regarded as possessing a form “differing in elements which do not alter the distinctive character of” the other members of that series. So when a registered trade mark proprietor makes use of one member of his “series of trade marks”, his use of that trade mark should also be regarded as a use falling within Section 22(2) of the TMA in relation to the other trade marks belonging to the same series. If I am correct in drawing this parallel between these provisions of the TMA, then there should be some correspondence between the breadth of Section 22(2) of the TMA and the scope of the test for when non-identical trade marks qualify as a “series of trade marks”.

130 The Applicant argued that the issue of whether the Damiani Word Marks constitutes use of the Opponent’s Mark would have to be decided by applying the “series of marks” test. In applying the “series of marks” test, the Applicant argues that the Opponent’s Mark does not resemble the Damiani Word Marks as to their material particulars and does not differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark. In particular, the Applicant argues that the distinct stylisation of the Opponent’s Marks is very different from the Damiani Word Marks.

131 I agree with the Applicant that use of the Damiani Word Marks does not constitute use of the Opponent’s Mark. While the Opponent’s Mark does resemble the Damiani Word Marks as “DAMIANI” is used, I am of the view that the difference in stylisation in the Opponent’s Mark does substantially alter the identity of the trade mark when comparing it with the Damiani Word Marks. Further, as I had concluded earlier at [19] above, there is no distinctive or dominant component that stands out in the Opponent’s Mark. Because the word “DAMIANI” is not the dominant and distinctive element and the stylisation adds to the distinctiveness of the Opponent’s Mark as a whole, the difference in stylisation between the Opponent’s Mark and the Damiani Word Marks does affect the identity of the mark as a whole.

132 I therefore conclude that use of the Damiani Word Marks does not constitute use of the Opponent’s Mark and the Opponent has failed to establish that the Opponent’s Mark is well known. It would not be necessary for me to consider the other elements under this ground of opposition under Section 8(4)(b)(i).

133 The Applicant raised a further point and argued that if the Opponent wishes to rely on the Damiani Word Marks specifically to argue that the Damiani Word Marks are well known marks under Section 8(4)(b)(i), the Opponent would have to file a request to amend their pleadings. In any case, the Applicant argued that the Opponent should not be allowed to amend their pleadings at such a late stage in the proceedings. The Applicant relied on *Monster Energy Company v Chun-Hua Lo* [2017] SGIPOS 1 at [6] where the Hearing Officer rejected the request from the opponent to amend its pleadings one day before the deadline to file written submissions and bundle of authorities to add a ground of opposition based on Section 8(4) of the Act.

134 At the hearing, the Opponent did not make a request to amend its pleadings and maintained that it was relying on the use of the Damiani Word Marks in the Opponent's SD to establish that the Opponent's Mark is well known in Singapore. As the Opponent has not specifically pleaded that the Damiani Word Marks or the Opponent's Unregistered Marks are well known under Section 8(4)(b) of the Act, I do not need to consider this line of argument.

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

135 The ground of opposition under Section 8(4)(b)(i) therefore fails.

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

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

(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)

137 To succeed on the ground of opposition under Section 8(7)(a), the 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

138 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], explained what goodwill related to:

“In our judgment, 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.”

139 The Opponent’s arguments on passing off were somewhat unclear and failed to recognize the correct legal position established in *Singsung* above, namely, that goodwill attaches to a business as a whole and not to a mark *per se*. Its Grounds of Opposition pleaded passing off based on goodwill and reputation in the Opponent’s Mark and its written submissions also argued that there is goodwill in the Opponent’s Mark.⁴⁰ At the hearing, I sought clarification from the Opponent as to whether it was arguing that the Opponent has goodwill in the business as a whole or goodwill in the Opponent’s Unregistered Marks. The Opponent confirmed that it was asserting goodwill in the Opponent’s Mark, which is a wrong principle in law as per *Singsung*.

140 However, in the Opponent’s Written Submissions, I note that the Opponent seems to also argue that there is goodwill in its business, being established through its “substantial volume of sales in Singapore for many years”⁴¹ and “huge amount of advertising expenditure....which includes Singapore”⁴². Furthermore, in the Opponent’s SD, I note that the Opponent has submitted evidence to support goodwill in the Opponent’s business as a whole, claiming that it has used its DAMIANI brand since 1924, and that it is one of the leading jewellery companies in the world, with 63 stores including one store in Singapore, its goods also being made available online in 21 countries.⁴³ The Opponent has also provided a breakdown of its international and local sales revenue and advertising-and-promotion expenses and relied on such figures to support its argument that the Opponent has substantial goodwill in Singapore.⁴⁴ Hence, on the assumption that the Opponent was in fact asserting goodwill in the business operating under its DAMIANI brand and for completeness, I will consider whether there is relevant goodwill in Singapore for the purposes of Section 8(7)(a).

141 Having reviewed the Opponent’s SD, I am satisfied that the Opponent has demonstrated sufficient goodwill under Section 8(7)(a). The Court of Appeal held in *Staywell* at [130] that goodwill must exist in Singapore at the date of the application for the registration of the Application Mark. I am satisfied that the Opponent has demonstrated sufficient goodwill in its business prior to the date of application of the Application Mark, i.e. 4 October 2017. In particular, the Opponent has proved goodwill in its business prior to 4 October 2017 as the Opponent has provided evidence of annual revenue figures in Singapore from 2012 to 2017 and also spent considerable amounts in advertising and promoting the DAMIANI brand in Singapore from 2012 to 2017.⁴⁵ I am satisfied that the Opponent has established goodwill in its DAMIANI business for jewellery.

Misrepresentation

142 In *Singsung* at [70], the Court of Appeal elaborated on the test for misrepresentation:

⁴⁰ Opponent’s Written Submissions at [59] and [62]

⁴¹ Opponent’s Written Submissions at [50]

⁴² Opponent’s Written Submissions at [52]

⁴³ Opponent’s SD at [4]

⁴⁴ Opponent’s SD at [7] to [8]; Opponent’s Written Submissions at [40] to [52]

⁴⁵ Opponent’s SD at [7] to [8] and Exhibits C and D

70 **The preliminary issue to be considered in the context of misrepresentation is whether the appellant’s goodwill is sufficiently associated with the Singsung Get-Up, or, put another way, whether the Singsung Get-Up is distinctive of the appellant’s goods. If so, the appellant will have to satisfy two further requirements: first, that there was a misrepresentation made by the respondent in adopting get-ups for its products which are strikingly similar or identical to the Singsung Get-Up, and second, that actual confusion or a sufficient likelihood of confusion arose from this.** The quintessential misrepresentation in this variety of the tort of passing off is a misrepresentation as to trade source or the trade origin of goods, the classic form being a false representation by the defendant that his goods or services emanate from the plaintiff or an entity connected to or associated with the plaintiff (see *Ng-Loy Wee Loon, Law of Intellectual Property of Singapore*, (Sweet & Maxwell, 2nd Ed, 2014) (“Law of IP in Singapore”) at para 18.1.2). If these elements are established, they would also serve to show that the respondent’s goods are “inherently deceptive” for the purposes of the doctrine of instruments of deception.
(Emphasis added)

143 Applying the above test from *Singsung* at [70], a preliminary issue that I have to consider in the context of misrepresentation is whether the Opponent’s goodwill is sufficiently associated with the Opponent’s DAMIANI brand. If this threshold is met, I will then consider two further questions, i.e. firstly, whether there was a misrepresentation made by the Applicant in using marks on its goods and services which are strikingly similar or identical; and secondly, that actual confusion or likelihood of confusion arose as a result of the misrepresentation is met.

144 I am satisfied that the threshold query requirement has been met and the goodwill in the Opponent’s business is sufficiently associated with the Opponent’s DAMIANI brand as the Opponent has provided evidence of use of the DAMIANI brand in

DAMIANI

Singapore. In particular, I note that the “**DAMIANI**” is displayed at the store front of the Opponent’s boutiques in Singapore⁴⁶ and in-store jewellery displays⁴⁷,

DAMIANI

while “HANDMADE IN ITALY SINCE 1924” is used in the backdrop at the Opponent’s promotional events in Singapore.⁴⁸ I also note that the official launch of the Opponent’s first DAMIANI boutique in Singapore in 2014 was published in local publications such as Herworld and Asiaone and also announced through an official press release from Marina Bay Sands.⁴⁹ The DAMIANI brand has also been promoted in high fashion and luxury magazines in Singapore. For instance, the unveiling of the Opponent’s Masterpiece collection was covered by Prestige Online⁵⁰, a styling collaboration

⁴⁶ Opponent’s SD, Exhibit E at page 740

⁴⁷ Opponent’s SD, Exhibit E at page 727

⁴⁸ Opponent’s SD, Exhibit E at pages 731, 735, 744, 754, 755, 756, 759






⁴⁹ Opponent’s SD at [11] and Exhibit G

⁵⁰ Opponent’s SD, Exhibit E at pages 742 to 747

between the Opponent and Singapore Tatler was covered in Asia Tatler⁵¹ and the Opponent’s first exhibition in Asia which was held in Singapore was covered by Wardrobe Trends Fashion.⁵² In light of the evidence of use of the DAMIANI brand that the Opponent has submitted, I am satisfied that the goodwill in the Opponent’s business is sufficiently associated with the Opponent’s DAMIANI brand.

145 I now proceed to consider the two further requirements: first, whether there is misrepresentation made by the Applicant in using a mark on its products (i.e. the Application Mark) which is similar or identical to the marks used by the Opponent on its products; and secondly, whether the actual confusion or a sufficient likelihood of confusion will arise as a consequence.

146 A side by side comparison of the marks that are most frequently used by the Opponent to promote the DAMIANI brand in Singapore (“**Damiani Singapore Marks**”) and the Application Mark is set out in the table below:

Damiani Singapore Marks	Application Mark
(a) 	
(b) 	
(c) 	
(d) 	

147 Overall, I am satisfied that there is misrepresentation as the Application Mark is similar to the Damiani Singapore Marks, for the following reasons:

- (a) Visually, the Damiani Singapore Marks and the Application Mark are similar as the brand names, “DAMIANI” and “DHAMANI”, which are featured in the Damiani Singapore Marks and the Application Mark respectively have the same number of letters. “DAMIANI” and “DHAMANI” both comprise of seven letters each. The first letter in both words is the same letter (“D”) and the last three letters (“ANI”) are also the same.
- (b) Aurally, the average consumer is likely to pronounce “DAMIANI” in the Damiani Singapore Marks and “DHAMANI” in the Application Mark. The pronunciation of both words is similar for the reasons set out earlier in my aural similarity analysis at [46] to [50] above.

⁵¹ Opponent’s SD, Exhibit E at pages 748 to 749

⁵² Opponent’s SD, Exhibit E at pages 718 to 737

⁵³ The phrase “HANDMADE IN ITALY SINCE 1924” appears below the word “DAMIANI”.

⁵⁴ The phrase “HANDMADE IN ITALY SINCE 1924” appears below the word “DAMIANI”.

- (c) Conceptually, the Damiani Singapore Marks and the Application Mark are also similar as “DAMIANI” and “DHAMANI” are depicted in upper case letters. Furthermore, the Application Mark has a reference to a year (i.e. 1969) which is conceptually similar to Marks (b) and (d) above which also have a reference to a year (i.e. 1924).

148 In *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] SGHC 216 (“*Rovio*”), the High Court held that how close or far apart the fields of activity of the parties are is a relevant factor in deciding whether any misrepresentation is likely to cause confusion:

199 Whilst the law of passing off no longer requires that the parties are competing in the same or common field of activity, **a relevant factor in deciding whether any misrepresentation is likely to cause confusion is how close or far apart the fields of activity are.** Much will depend on the actual facts and circumstances. As was said in *Ng-Loy Wee Loon* at para 18.3.28:

The closer the defendant’s field of business activity is to that of the plaintiff, the greater is the risk of confusion. However, it does not automatically follow from this, that confusion cannot arise if the parties are in completely different fields of activity.

200 In general, the fact that the defendant used a similar mark in a wholly unrelated field will lessen the likelihood of confusion, and, indeed, damage. But, equally, **where the plaintiff’s mark is well established and the fields of activity (whilst not identical) are close or related, a likelihood of confusion and damage may still be found.** Other relevant factors in determining misrepresentation and confusion include whether the plaintiff has already started using the mark in that different field of activity. (Emphasis added)

149 Applying *Rovio* at [199] to [200], the fact that the Applicant operates in a similar field of business activity as the Opponent (i.e. retail of jewellery and precious stones) contributes to a greater risk of a likelihood of confusion. Overall, I am satisfied that a sufficient likelihood of confusion will arise from the misrepresentation and therefore the element of misrepresentation has been established.

Damage

150 To establish damage, it is not necessary for the Opponent to show actual damage as long as a real tangible risk of substantial damage is present. A real tangible risk of substantial damage could occur by way of blurring or tarnishment (*Singsung* at [41] and *Amanresorts* at [100] and [105]).

151 In *Amanresorts* at [97], the Court of Appeal recognised that damage by blurring occurs when the business, goods or services of the plaintiff and those of the defendant are in competition with or are at least substitutes for each other. The sales are being diverted from the plaintiff to the defendant as a result of the plaintiff’s goodwill attaching to the defendant’s goods, services or business which manifests itself in sales being diverted from the plaintiff to the defendant:

97 There are two primary and very well-established means by which goodwill can be damaged, namely, by “blurring” and by “tarnishment”. **Blurring occurs when the plaintiff’s get-up, instead of being indicative of only the plaintiff’s goods, services or business, also becomes indicative of the defendant’s goods, services or business. While customers may still be drawn by the attractive force of the plaintiff’s get-up, they may be drawn to the business, goods or services of the defendant instead of those of the plaintiff.** In other words, the goodwill attached to the plaintiff’s business, goods or services becomes spread out over business, goods or services which are not the plaintiff’s. **This phenomenon occurs only when the business, goods or services of the plaintiff and those of the defendant are in competition with or are at least substitutes for each other.** The damage manifests itself in sales being diverted from the plaintiff to the defendant. (Emphasis added)

152 The Applicant’s business and the Opponent’s business are in direct competition with each other as both parties sell jewellery and precious stones. As such, there is a real tangible risk of the Opponent’s goodwill being adversely affected by way of blurring. As such, the element of damage has been established.

Conclusion on Section 8(7)(a)

153 The ground of opposition under Section 8(7)(a) therefore succeeds.

Overall Conclusion

154 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition succeeds on the grounds under Sections 8(2) and 8(7)(a) of the Act. The ground of opposition under Section 8(4)(b)(i) of the Act was not established. The application to register the Application Mark is refused.

155 As the Opponent has succeeded on two out of three grounds of opposition, the Opponent is entitled to 70% of the costs, which are to be taxed, if not agreed.

156 I am grateful to the parties’ counsel for their written and oral submissions.

Date of Issue: 14 October 2020