

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

Trade Mark No. 40201602064R  
15 January 2020

**IN THE MATTER OF A TRADE MARK APPLICATION BY**

**FMTM DISTRIBUTION LTD**

**AND**

**OPPOSITION THERETO BY**

**ROLEX S.A.**

Hearing Officer:      Tony Yeo  
                          IP Adjudicator

Representation:

Ms Francine Tan and Ms Ethel Sng (Francine Tan Law Corporation) for the Applicant  
Ms Gooi Chi Duan (Donaldson & Burkinshaw LLP) for the Opponent

**GROUNDΣ OF DECISION**

1       FMTM Distribution Ltd (“the Applicant”) is a company selling high-end luxury watches.

2       Rolex S.A. (“the Opponent”) is a watchmaker established in 1905, based in Geneva, Switzerland.

3 On 5 February 2016, the Applicant applied to register the trade mark  
“**MARINER**” (“the Application Mark”) in Singapore in Class 14. The specification of goods is indicated below:

Precious metals; precious metal alloys; horological instruments; watches; chronometric instruments; chronographs (watches); chronometers; apparatus for sports timing (stopwatches); clocks; movements for watches and clocks; straps for wristwatches; watch bracelets; components for watches and clocks; buckles for watchstraps; watch crowns; watch cases (components); watch springs; dials (clock- and watchmaking); hands for clocks and watches; watch glasses; parts and fittings for timepieces; cases for watches and clocks; cases for the display of timepieces (presentation); watch boxes; clock boxes; precious stones; semi-precious stones; diamonds; imitation precious stones; jewellery; semi-precious articles of bijouterie; jewellery ornaments; fashion jewellery; jewellery cases [caskets]; jewellery boxes; jewel cases of precious metal; tie pins; cuff links; key fobs; boxes for cufflinks; boxes for tie-pins; boxes for key fobs [caskets]; cases for the display of jewellery, cufflinks and tie pins; presentation boxes and cases adapted to contain and transport timepieces; presentation cases and cases adapted to contain and transport jewellery; presentation cases and cases adapted to contain and transport cufflinks, tie pins and key fobs.

4 The Application Mark was accepted and published on 9 February 2018 for opposition purposes. The Opponent filed its Notice of Opposition to oppose the registration of the Application Mark on 5 April 2018. The Applicant filed its Counter-Statement on 27 July 2018. The Opponent filed evidence in support of the opposition on 1 April 2019. The Applicant filed evidence in support of the application on 31 July 2019, followed by a paginated version of this evidence on 29 October 2019. The matter was heard on 15 January 2020.

### **Grounds of Opposition**

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

### **Opponent’s Evidence and Submissions**

6 The Opponent’s evidence comprises a Statutory Declaration made by Ms Catherine O’Rourke, Assistant Manager of the Opponent, on 28 March 2019 in Switzerland (“Opponent’s SD”).

7 The Opponent further submitted its written submissions on 16 December 2019.

## **Applicant's Evidence and Submissions**

8 The Applicant's evidence comprises a Statutory Declaration made by Ms Gwenaelle Vache, Intellectual Property Director of the Applicant, on 25 July 2019 in Switzerland ("Applicant's SD").

9 The Applicant further submitted its written submissions on 16 December 2019. It also tendered an additional set of basic rebuttal submissions at the hearing on 15 January 2020.

## **Applicable Law and Burden of Proof**

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

## **MAIN DECISION**

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

11 Section 8(2)(b) of the Act reads :

(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)***

12 The law in relation to Section 8(2)(b) is well-settled. As the Court of Appeal in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 ("Staywell") affirmed at [15], the applicable test comprises the "step-by-step" approach:

- (a) The first step is assessing whether the respective marks are similar;
- (b) The second step is assessing whether there is identity or similarity between the goods or services for which registration is sought and the goods or services for which the earlier trade mark is protected; and

- (c) The third step is considering whether, ultimately, there exists a likelihood of confusion as a result of the marks-similarity and goods-similarity.

13 The first and second steps are threshold criteria: they must each be met before the inquiry proceeds to the third step of assessing likelihood of confusion (*Staywell* at [15]). Once they are fulfilled, the likelihood of confusion is “assessed in the round”, with a view to “(a) how similar the marks are; (b) how similar the services are; and (c) given this, how likely the relevant segment of the public will be confused” (*Staywell* at [15], [55]).

#### *Marks-similarity: Principles*

14 In assessing the marks for similarity, I have taken into account the following principles (*Staywell* at [15] to [30]; *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 (“*Hai Tong*”) at [40]):

- (a) The marks are to be compared mark-for-mark, without consideration of any external matter.
- (b) The marks are to be compared on three aspects of similarity: visual, aural and conceptual.
- (c) 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.
- (d) 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.
- (e) 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.
- (f) 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.

#### *Marks-similarity: Analysis*

15 The Opponent owns and relies upon the following trade mark registration (“the Opponent’s Mark”) in Singapore in these proceedings:

| Trade Mark No. | Registration Date | Mark       | Specification   |
|----------------|-------------------|------------|---|
| T5925069E      | 11 June 1959      | SUBMARINER | <p><u>Class 14</u></p> <p>Horological instruments and parts thereof included in Class 14.</p> |

### *Distinctiveness Inquiry*

16 I am mindful of the Court of Appeal's guidance in *Staywell* (at [30]) that distinctiveness is a consideration to be integrated into the visual, aural and conceptual analysis of marks-similarity, and not a separate step. However, for ease of analysis, I will, as the Court of Appeal did in *Hai Tong* at [26], summarise my findings on distinctiveness first, before applying them in the marks-similarity analysis. In so doing, I will first look at whether the Opponent's Mark and Application Mark possess any distinctive or dominant components, before proceeding to consider the distinctiveness of the Opponent's Mark as a whole.

### *Distinctive and Dominant Features of the Marks*

17 The Opponent submits that the marks share a common distinctive and dominant feature of "MARINER".<sup>1</sup> In asking for the prefix "SUB" in the Opponent's Mark to be disregarded for the purposes of comparison, the Opponent sought to draw a parallel between the present case and *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 ("Caesarstone (CA)"), in which the Court of Appeal considered the word "CAESAR" to be the distinctive and dominant component of the "CAESARSTONE" mark in question, "STONE" being merely descriptive of the goods to which the mark related.<sup>2</sup>

18 The Applicant offered a different account, though one that by the conclusion of submissions had become somewhat muddled. In its written submissions, the Applicant argued that the respective dominant and distinctive components were "SUBMARINE" for the Opponent's Mark and "MARINE" instead for the Application Mark.<sup>3</sup> However, by the time of the hearing, the Applicant was submitting instead that the prefix "SUB" was the dominant component of the Opponent's Mark.<sup>4</sup> In support of this latter argument, the Applicant identified in online articles exhibited in the Opponent's SD, 13

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<sup>1</sup> Opponent's written submissions at [20].

<sup>2</sup> Opponent's written submissions at [18].

<sup>3</sup> Applicant's written submissions at [34].

<sup>4</sup> Applicant's basic rebuttal submissions at [8].

instances wherein watches from the Opponent’s “SUBMARINER” line were referred to as a “Sub” or “Subs”.<sup>5</sup>

19 I find myself unable to agree with the submissions of either party regarding the dominant features of each mark. With regard to the Opponent’s submissions, I note that “SUBMARINER” is a single word known in the English language. This distinguishes the Opponent’s Mark from the “CAESARSTONE” mark in *Caesarstone (CA)* cited by the Opponent. Where in that case “CAESARSTONE” was an invented word that was clearly separable into a distinctive component and a descriptive one, the same cannot be said of “SUBMARINER”.

20 Nor did I find either of the Applicant’s positions on the respective dominant components of the marks to be of assistance. With regard to the position set out in the Applicant’s written submissions, it is to my mind artificial and unhelpful to carve away the last letters of “SUBMARINER” and “MARINER” and to label what remains as distinctive and dominant.

21 The Applicant’s later position that “SUB” is the dominant component of the Opponent’s Mark is somewhat more attractive, especially in light of the Applicant’s analysis of the articles exhibited by the Opponent. However, closer examination of the articles reveals that the 13 instances highlighted by the Applicant of “Sub” being used as an abbreviation of “SUBMARINER” are found in seven discrete articles, out of the total of 28 submitted by the Opponent. This is an altogether less impressive array than might have appeared at first blush, and in my view is not strong evidence of the dominance of the prefix “SUB”. Beyond the numbers, I further observe that a number of the articles that used the abbreviation “Sub” appeared to strive for a certain casual style in their writing. In particular, three of these seven articles were written by the same person.<sup>6</sup> I would therefore attribute the use of the abbreviation “Sub” to the affectations of a few particular writers, rather than to any conclusion that “SUB” is generally observed to be the dominant and distinctive component of the Opponent’s Mark. I am as such unpersuaded by the Applicant’s arguments here as well.

22 In my view, the proper position with regard to the marks in question is captured in the words of George Wei J in *Caesarstone Sdot-Yam Ltd v Ceramiche Caesar SpA* [2016] 2 SLR 1129 at [30]:

[I]t cannot and must not be assumed that there will always be a feature of the mark which dominates the mark’s landscape. In many cases, no particular feature will stand out. Micro-analysing a mark for particular distinctive features in such cases is unhelpful.<sup>7</sup>

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<sup>5</sup> Applicant’s basic rebuttal submissions at [8].

<sup>6</sup> The articles exhibited at pages 100–103; 104–107; and 108–112 of the Opponent’s SD were all written by one Alvin Wong, editor-in-chief of a website called Crown Watch Blog.

<sup>7</sup> While this decision was reversed on appeal in *Caesarstone (CA)*, the Court of Appeal did not challenge this comment by George Wei J. I see no reason to doubt its correctness.

23 Ultimately, I do not find that there are any particular features of either the Opponent's Mark or the Application Mark which stand out. Both marks are word marks in block capital letters and have no additional stylisations to draw one's eye to any particular subset of letters. In addition, both marks comprise single known words in the English language, each of which I would consider to be compact enough, such that it would be contrived to poke and prod for some distinctive or dominant core. As such, I do not think there exists for either mark, any distinctive and dominant components which I ought to bear in mind.

24 I turn now to an assessment of the distinctiveness of the Opponent's Mark as a whole.

#### *Inherent Distinctiveness of the Opponent's Mark*

25 The Opponent argued in its written submissions that the Opponent's Mark, as a pure word mark in block letters composed of an unusual word that may be considered to have a strong level of inherent distinctiveness, by virtue of the fact that it has no meaning or relationship in relation to any of the goods it is registered for.<sup>8</sup>

26 I was not persuaded by the Opponent's arguments in this regard. As the Applicant pointed out,<sup>9</sup> the Opponent's Mark is composed merely of the word "submariner", which is a known English word. Moreover, contrary to its own submissions, the Opponent's SD states that the "SUBMARINER" line of watches "was designed and engineered for diving".<sup>10</sup> An article cited within the Opponent's SD elaborates that the "SUBMARINER" line of watches "was designed specifically for divers and professionals who worked underwater".<sup>11</sup> While the Applicant – rightfully, in my view – did not go so far as to suggest that "submariner" was descriptive and therefore devoid of all distinctiveness, the connection between the Opponent's Mark and its goods is clear.

27 Taking all the factors above into account, I find that the Opponent's Mark possesses only a medium degree of inherent distinctiveness, not a strong one.

#### *Acquired Distinctiveness of the Opponent's Mark*

28 Although not fully explored in the Opponent's written submissions, at the hearing, the Opponent further sought to argue that the Opponent's Mark had acquired distinctiveness. In making this oral submission, the Opponent alluded to a substantial amount of evidence from its SD:

- (a) A brochure for the Opponent's watches under the Opponent's Mark;<sup>12</sup>

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<sup>8</sup> Opponent's written submissions at [14].

<sup>9</sup> Applicant's written submissions at [22].

<sup>10</sup> Opponent's SD at [12]

<sup>11</sup> Opponent's SD at page 43

<sup>12</sup> Opponent's SD at pages 9–14.

- (b) An article mentioning that the Opponent is the market leader in Swiss high-end watchmaking<sup>13</sup> and stating that the Opponent accounts for 11.8% of the global watch market;<sup>14</sup>
- (c) A list of official retailers selling the Opponent's ROLEX watches;<sup>15</sup>
- (d) An article regarding "The Rolex Submariner Exhibition" held in Singapore, which took place in August 2017;<sup>16</sup>
- (e) Four online articles relating to the James Bond film series, purportedly demonstrating the distinctiveness of the Opponent's Mark by virtue of the fact that the Opponent's watches under the Opponent's Mark have had a long history of association with the series and the character, and the fact that the series is popular in Singapore;<sup>17</sup>
- (f) The selection of 28 online articles mentioned at [21] above, all of which mention the Opponent's Mark;<sup>18</sup> and
- (g) Three advertisements published in three local magazines.<sup>19</sup>

29 I agree, however, with the Applicant that none of this evidence supports the Opponent's case on acquired distinctiveness.

30 One important factor weighing against the Opponent's evidence is that every piece of evidence features the "ROLEX" mark prominently alongside the Opponent's Mark. The acquired distinctiveness spoken of here is technical: it is "the capacity of a mark to function as a badge of origin" (*Staywell* at [24]). If the Opponent's Mark is constantly accompanied by the "ROLEX" mark in every piece of evidence, then I cannot see how it can be said that the Opponent's Mark is a mark that has acquired distinctiveness.

31 When faced with a similar situation, the Court of Appeal held in *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 415 ("*City Chain*") at [98] that:

The trial judge's finding that the Flower Quatrefoil mark is in itself distinctive is really unsustainable for the simple reason, as stated in [95] above, that there is no evidence that the Flower Quatrefoil mark has ever been promoted or used on its own.

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<sup>13</sup> Opponent's SD at page 18.

<sup>14</sup> Opponent's SD at page 19.

<sup>15</sup> Opponent's SD at pages 25–32.

<sup>16</sup> Opponent's SD at pages 33–36.

<sup>17</sup> Opponent's SD at pages 38–72.

<sup>18</sup> Opponent's SD at pages 74–301.

<sup>19</sup> Opponent's SD at pages 303–310.

32 The Applicant made a number of further, cogent critiques of the Opponent's evidence with which I agree:

- (a) The Rolex Submariner Exhibition is not relevant, having taken place after the Application Mark's filing date of 5 February 2016;<sup>20</sup>
- (b) The argument made alongside the exhibition of the James Bond articles is tenuous at best, especially since the popularity of the film series in Singapore is presumed and not demonstrated by any of the four articles,<sup>21</sup> and since two of the articles – “Iconic Bond girls through the years” and “London – James Bond Style” – evince no connection to the Opponent’s Mark either;<sup>22</sup> and
- (c) The evidence is sparse at certain points, most notably of the fact that no figures or invoices for sales or promotions were adduced, and of the fact that in terms of examples of promotional materials, the Opponent produced only three advertisements, despite the Opponent’s Mark having had at least a 50-odd year history in Singapore dating back to its registration date.<sup>23</sup>

33 When I asked counsel for the Opponent at the hearing why no sales or advertising figures were adduced, she answered that the figures were sensitive, and that it did not want to run the risk of leaking confidential information. In any case, she submitted that the absence of such figures did not rule out a finding that a mark was well known in Singapore, or that it possessed goodwill.

34 I accept that such figures are strictly speaking not necessary (see *Pontiac Marina Pte Ltd v CDL Hotels International Ltd* [1997] 1 SLR(R) 422 at [50]). However, they are undoubtedly highly useful. If confidentiality was the concern, the Opponent could have applied for a confidentiality club to be formed. It is not unusual for such clubs to be formed, even in opposition actions before IPOS (see *TWG Tea Company Pte Ltd v T2 Singapore Pte Ltd & Tee Too Pty Ltd* [2019] SGIPOS 9). Alternatively, the Opponent could have submitted redacted figures, or figures with ranges.

35 Seeing as the Opponent decided to take the risk of not adducing such evidence, it must bear the consequences as well.

36 I find the Opponent has not sufficiently made out its case of acquired distinctiveness.

#### *Conclusion on Distinctiveness*

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<sup>20</sup> Applicant’s written submissions at [24(i)].

<sup>21</sup> Applicant’s written submissions at [24(d)].

<sup>22</sup> Applicant’s written submissions at [24(k)].

<sup>23</sup> Applicant’s written submissions at [24(c)].

37 As such, I find that the Opponent's Mark possesses a medium degree of distinctiveness, no higher or lower than the norm. Consequently, it does not enjoy a high threshold before a competing sign will be considered dissimilar to it.

#### *Visual Similarity*

38 I move on to an assessment of the visual, aural and conceptual similarity of the Opponent's Mark and the Application Mark, bearing in mind the Court of Appeal's guidance in *Staywell* that this assessment "must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components" (at [26]).

39 For ease of reference, I set out the Opponent's Mark and the Application Mark:

| Opponent's Mark   | Application Mark |
|-------------------|------------------|
| <b>SUBMARINER</b> | <b>MARINER</b>   |

40 I have concluded (see [19] to [23] above) that there is no feature or element that is dominant in either the Opponent's Mark or the Application Mark. Hence, I will compare the marks as wholes.

41 *Ozone Community Corp v Advance Magazine Publishers Inc* [2010] 2 SLR 459 states (at [49]) that in the case of word marks, a determination of visual similarity typically involves looking at the:

- (a) length of the marks;
- (b) structure of the marks (ie, whether there are the same number of words); and
- (c) whether the same letters are used in the marks.

42 The Application Mark and the Opponent's Mark are of relatively similar lengths: the former is seven letters long, while the latter is ten letters long. Both are single words. As the Opponent rightfully pointed out, the entirety of the Application Mark is encompassed in the Opponent's Mark.<sup>24</sup>

43 In such cases where there is a common denominator, it is nonetheless "important to look at the differences between the mark and the sign in order to decide whether the challenged sign has been able to distinguish itself sufficiently and substantially" (*The Polo/Lauren Co, LP v Shop in Department Store Pte Ltd* [2005] 4 SLR(R) 816 ("Polo") at [26]).

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<sup>24</sup> Opponent's written submissions at [16].

44 I am unable to agree with the Applicant’s submissions<sup>25</sup> that this has been achieved by the additional three-letter prefix “SUB” in the Opponent’s Mark. It is clear that this prefix is relatively small compared to the seven-letter common denominator “MARINER”. I do not think that this difference suffices to displace the visual similarity made clear by the application of the test set out in *Ozone*, and which is likely to be enhanced in the imperfect recollection of the average consumer.

45 For the avoidance of doubt, the apparent difference in the fonts of the marks is of no consequence. The registration of a mark in block capital letters covers the use of the mark in every font or style possible (*Ferrero SPA v Sarika Connoisseur Cafe Pte Ltd* [2011] SGHC 176 (“*Sarika (HC)*”) at [56]). In any case, the Applicant did not rely on this as a distinguishing factor.

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

#### *Aural Similarity*

47 In *Staywell*, the Court of Appeal established (at [31] to [32]) that there are two approaches to assessing aural similarity. The first is to consider the dominant component of the marks, and the second is to undertake a quantitative assessment of whether the marks have more syllables in common than not.

48 My finding that neither mark has a distinctive or dominant component holds equally true here. Therefore, I will proceed with the second approach.

49 An issue that arises here is how the average Singaporean would pronounce the marks. According to the Oxford Advanced Learner’s Dictionary (as cited by the Opponent<sup>26</sup>), the word “mariner” is pronounced “/’mærɪnər/” (or, roughly, “MARE-ee-ner”), while the word “submariner” is pronounced “/sʌb’mærɪnər/” or “/sʌbmə’ri:nər/” (“sub-MARE-ee-ner” or “SUB-muh-REE-ner”). Apart from the dictionary pronunciations, however, the Applicant acknowledged that the Application Mark might be pronounced similarly to the word “marina” by the average Singaporean (“muh-REE-ner”).<sup>27</sup> The Opponent, meanwhile, submitted merely that the Application Mark would be pronounced in identity with the latter part of the Opponent’s Mark, without specifying which pronunciations it had in mind.<sup>28</sup>

50 For my part, I consider that the average Singaporean is indeed likely to adopt the pronunciation “muh-REE-ner” for the Application Mark. I think that in the Singaporean context, the word “mariner” is more likely to be encountered visually (in news articles or literature, for example) rather than aurally (in conversation, television or radio). It is not difficult to imagine that the average Singaporean, if asked to pronounce the word,

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<sup>25</sup> Applicant’s written submissions at [36].

<sup>26</sup> Opponent’s written submissions at [23].

<sup>27</sup> Applicant’s written submissions at [38].

<sup>28</sup> Opponent’s written submissions at [22].

would extrapolate from the much more commonly aurally encountered words “marine” (Marine Parade) or “marina” (Marina Bay). In the same manner, I consider that the average Singaporean would more likely pronounce the Opponent’s Mark as “SUB-muh-REE-ner”, drawing from “marine” and “submarine”.

51 On this basis, the application of the quantitative assessment approach shows that the Application Mark and the Opponent’s Mark share three identical syllables, or at the very least three very similar-sounding syllables. The aural difference between the marks therefore lies primarily in the monosyllabic prefix “SUB”.

52 This difference, argued the Applicant, is material. In support of this, the Applicant cited the case of *Doctor’s Associates Inc v Lim Eng Wah* [2012] 3 SLR 193 (“*Doctor’s Associates*”) at [35] for the principle that the first syllable of a word is aurally the most important, given that English speakers tend to slur subsequent syllables.<sup>29</sup>

53 As *Doctor’s Associates* went on to emphasise, however, “it is clear that the ‘first syllable principle’ should not be applied in a ‘blanket fashion’” (at [35]). While I accept that a speaker is likely to place emphasis on the first syllable of “SUBMARINER”, this does not displace – though it may temper – the fact that the remaining syllables shared in common with the “MARINER” mark form a substantial part of the Opponent’s Mark and the entirety of the Application Mark.

54 For the reasons above, I find that the Application Mark is aurally more similar than dissimilar to the Opponent’s Mark, though to a lesser degree compared to the visual similarity between the two.

#### *Conceptual Similarity*

55 As stated in *Staywell* at [35], “the conceptual analysis seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole”.

56 In this regard, I am prepared to accept the Opponent’s submissions that both the Opponent’s Mark and the Application Mark convey the ideas of the sea and a sailor, thereby establishing conceptual similarity.<sup>30</sup>

57 I was not persuaded by the Applicant’s attempts to avert this conclusion. The Applicant’s distinction between the visual image of a submarine or a submarine crew member evoked by the Opponent’s Mark and the notion of sailors prompted by the Application Mark<sup>31</sup> draws too fine a line. The Oxford Advanced Learner’s Dictionary<sup>32</sup> is once again illuminative: a “submariner” is “a **sailor** who works on a submarine” and a “mariner” is “a **sailor**” [emphases added].

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<sup>29</sup> Applicant’s written submissions at [33].

<sup>30</sup> Opponent’s written submissions at [23].

<sup>31</sup> Applicant’s written submissions at [37]–[38].

<sup>32</sup> Opponent’s written submissions at [23] and Opponent’s Bundle of Authorities at Tab 9.

58 The Applicant's alternative submission that the average Singaporean would be unlikely to know the meaning of the word "mariner"<sup>33</sup> did not bring it very far either. Even if I accept this gap in the average Singaporean's knowledge, by virtue of the supposed fact that "mariner" is an archaic word (a contention not borne out by the dictionaries), I find that he would nonetheless likely infer, from the word "marine" that begins the Application Mark, the idea of the sea.

59 Closely connected to this argument was the Applicant's suggestion that "MARINER" could be misapprehended by the average Singaporean to mean "marina".<sup>34</sup> However, even if I accepted that the recollection of the average Singaporean were so imperfect as to permit such a mistake (which I rather doubt), "marina" and "SUBMARINER" still share in common an evocation of the sea.

60 Consequently, I find that the Application Mark is conceptually more similar than dissimilar to the Opponent's Mark.

#### *Conclusion on Marks-similarity*

61 In light of the above, I find that the Application Mark is more similar than dissimilar to the Opponent's Mark.

#### *Goods-similarity*

62 For ease of reference, I set out the goods in respect of which the Opponent's Mark has been registered and those in respect of which the Applicant seeks registration of its mark:

| <b>Opponent's Mark</b>   | <b>Application Mark</b>   |
|--|---|
| <u>Class 14</u><br>Horological instruments and parts thereof included in Class 14. | <u>Class 14</u><br>Precious metals; precious metal alloys; horological instruments; watches; chronometric instruments; chronographs (watches); chronometers; apparatus for sports timing (stopwatches); clocks; movements for watches and clocks; straps for wristwatches; watch bracelets; components for watches and clocks; buckles for watchstraps; watch crowns; watch cases (components); watch springs; dials (clock- and watchmaking); hands for clocks and watches; watch glasses; parts and |

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<sup>33</sup> Made orally at the hearing.

<sup>34</sup> Applicant's written submissions at [38].

|  |  |
|--|--|
|  | fittings for timepieces; cases for watches and clocks; cases for the display of timepieces (presentation); watch boxes; clock boxes; precious stones; semi-precious stones; diamonds; imitation precious stones; jewellery; semi-precious articles of bijouterie; jewellery ornaments; fashion jewellery; jewellery cases [caskets]; jewellery boxes; jewel cases of precious metal; tie pins; cuff links; key fobs; boxes for cufflinks; boxes for tie-pins; boxes for key fobs [caskets]; cases for the display of jewellery, cufflinks and tie pins; presentation boxes and cases adapted to contain and transport timepieces; presentation cases and cases adapted to contain and transport jewellery; presentation cases and cases adapted to contain and transport cufflinks, tie pins and key fobs. |
|--|--|

63 Both parties cited the factors set out in *The British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 (“**British Sugar**”) at 296–297 which are taken into account in determining whether or not goods-similarity is satisfied:

- (1) the respective uses of the respective goods or services;
- (2) the respective users of the respective goods or services;
- (3) the physical nature of the goods or acts of service;
- (4) the respective trade channels through which the goods reach the market;
- (5) in the case of self-serve consumer items, whether in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves; and
- (6) the extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same and different sectors.

64 However, the Opponent further submitted 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”.<sup>35</sup> In support of this proposition, it cited the case of *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.

65 In response, the Applicant initially submitted that notwithstanding the clear overlap in goods (“horological instruments”), the fact that a large proportion of goods were not identical or substantially similar was a relevant consideration.<sup>36</sup>

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]).

67 In my view, neither the Opponent’s contentions nor those of the Applicant were quite on the mark. The following passage from *Staywell* – providing substantial clarification on the passage from *Polo* cited by the Opponent – is dispositive (at [40]–[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**

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<sup>35</sup> Opponent’s written submissions at [26].

<sup>36</sup> Applicant’s written submissions at [45].

**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]

68 In the present case, therefore, the overlap of “horological instruments” is determinative of the matter, and when this was put to the Applicant at the hearing, it rightfully accepted that in the premises, the element of goods-similarity is satisfied.

#### *Likelihood of Confusion*

69 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) 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*

70 I have concluded already that the marks are more similar than dissimilar. As a matter of degree, taking into account the considerations set out above at [14] to [61], I would say that this similarity is substantial.

71 In relation to the reputation of the Opponent's Mark, I have already indicated that the Opponent's evidence does not establish that the Opponent's Mark had acquired any distinctiveness (see [28] to [36] above). Similarly, I do not think the Opponent's evidence establishes any reputation on the part of the Opponent's Mark.

72 As for the reputation of the Application Mark, the Applicant has submitted two items of evidence:

- (a) A large number of customer sales invoices dating back to 31 July 2009 issued by a Franck Muller Pte Ltd;<sup>37</sup> and
- (b) Two sets of website printouts from the Applicant's websites, one listing ten Franck Muller retailers in Singapore and the other apparently depicting the line of watches to which the Application Mark is applied.<sup>38</sup>

73 At the outset, I observe that the efficacy of the evidence is limited by the fact that of the large number of invoices provided by the Applicant, only a fraction relates to sales through retailers in Singapore. The remainder are invoices relating to retailers in the region surrounding Singapore. Though these regional invoices share the "Franck Muller Pte Ltd" footer, I do not think that the sales represented therein are in any way strong evidence of the Application Mark's reputation in Singapore.

74 From this narrowed list of Singaporean invoices, I set out below a table of the yearly sales of watches bearing the Application Mark in Singapore:

| Year  | Sales (\$) |
|-------|------------|
| 2009  | 309,780    |
| 2010  | 107,360    |
| 2011  | 124,140    |
| 2012  | 156,700    |
| 2013  | 92,860     |
| 2014  | N/A        |
| 2015  | 36,862.53  |
| 2016  | 45,659.21  |
| 2017  | 34,580     |
| 2018  | 63,800     |
| Total | 971,741.74 |

<sup>37</sup> Applicant's SD at pages 4–131.

<sup>38</sup> Applicant's SD at pages 133–141.

75 The Opponent raises three issues about the Applicant's evidence:<sup>39</sup>

- (a) That the Applicant has not explained its relationship, if any, with Franck Muller Pte Ltd, and therefore that there is no evidence that any purported use of the "MARINER" mark by Franck Muller Pte Ltd is attributable as use by the Applicants of the mark;
- (b) That there is no evidence to show that the entries in the invoices labelled "MARINER" and highlighted represent goods that fall within the specification of goods under the Application Mark; and
- (c) That the Application Mark does not in fact appear on the images of watches in the website printouts, and therefore that there is no evidence that "MARINER" is affixed onto or used as indicia of origin for the watches.

76 With regard to the first issue, I agree that there is some ambiguity surrounding the Applicant's relationship with Franck Muller Pte Ltd. There are some hints scattered in the evidence as to what exactly this relationship might be. Ms Vache, deponent of the Applicant's SD and Intellectual Property Director in the Applicant has access to the records of Franck Muller Pte Ltd.<sup>40</sup> Ms Vache also apparently holds the position of Intellectual Property Director in the Franck Muller Group,<sup>41</sup> and it is not hard to infer a connection. However, the Opponent is right that in the absence of an explicit explanation in the evidence, it would not be right to jump to such inferences.<sup>42</sup>

77 Nonetheless, this issue does not prevent the invoices issued by Franck Muller Pte Ltd from functioning as evidence of the reputation of the Application Mark. Tan Tee Jim SC notes in *Law of Trade Marks and Passing Off in Singapore (Sweet & Maxwell, 3rd edition, 2014)* at [19.057] that in contrast to goodwill, which "does not exist on its own but instead attaches to a business", "reputation can, and often does, exist without any supporting business". It stands to reason, then, that in spite of the ambiguity over which entity exactly is using the Application Mark, the reputation gained from such use can still attach to the Application Mark itself.

78 The second issue raised by the Opponent is answered by [4] of the Applicant's SD, in which Ms Vache confirmed that "the references to 'Mariner' wherever they appear in the said invoices correspond to watches bearing the MARINER trade mark".

79 Of the third issue raised by the Opponent, the Application Mark does not indeed appear on the images of watches in the website printouts. When I asked counsel for the Applicant at the hearing on this issue, she agreed that this was the case, though she also stated that the Application Mark was applied to the back of the watch, which was not

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<sup>39</sup> Opponent's written submissions at [64].

<sup>40</sup> Applicant's SD at [2].

<sup>41</sup> Applicant's SD at [1].

<sup>42</sup> Submission made orally at the hearing.

captured in the website's images. As she rightfully and immediately acknowledged, however, this latter statement was evidence from the bar, unsupported by the materials adduced by the Applicant. I therefore could not take it into consideration. However, to suggest that there is no evidence that "MARINER" is affixed onto or used as indicia of origin for the watches is to bring the argument too far, in light of Ms Vache's declaration at [4] of the Applicant's SD that "[w]atches bearing the MARINER mark has been sold in boutiques and official retailers in Singapore for many years".

80 To my mind, however, the true problem revealed by the Applicant's evidence is in a way the inverse of the Opponent's third issue. It is not that the Applicant's watches lack the Application Mark, but that they are invariably *burdened* with the "FRANCK MULLER" mark, as demonstrated by each of the watch images in the website printouts.<sup>43</sup> This is true throughout the Applicant's evidence: each usage of the Application Mark is accompanied by the use of the "FRANCK MULLER" mark. Therefore, in much the same way that the constant presence of the "ROLEX" mark prevents a finding of acquired distinctiveness for the Opponent's Mark (see [30] to [31] above), I consider the lack of evidence that the Application Mark has ever been used on its own to be fatal to a finding that the Application Mark possesses an established reputation.

#### *Factors Relating to the Impact of Goods-similarity*

81 I have concluded already that there is identity of goods between the Opponent's Mark and the Application Mark in respect of "horological instruments" – in a word, watches.

82 The Applicant sought to impress upon me that watches of the sort sold under the Opponent's Mark and the Application Mark would be sold either in brand-specific watch boutiques, or in multi-brand retail outlets which both separate watches of different brands and have on hand knowledgeable salespeople to help customers tell watches apart. Either way, a consumer seeking to purchase watches of the sort sold under the Opponent's Mark and the Application Mark would not be easily misled.<sup>44</sup>

83 However, these submissions did not take into account the notional fair uses of each of the marks. It may not always be the case that the Opponent's Mark and the Application Mark are applied to watches that are sold through the channels outlined by the Applicant. I am very mindful that in much the same way that the Court of Appeal in *Staywell* considered that the notional fair use of a luxury hotel operator's mark encompassed potential future use of that mark in relation to business hotels, it cannot be discounted that the Opponent and the Applicant may one day decide to apply their marks to non-luxury watches. Consequently, the proper consideration here is the circumstances under which a consumer may purchase watches in general, which I think does not include as many protections against confusion as the Applicant would like to submit.

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<sup>43</sup> Opponent's SD at page 136–137.

<sup>44</sup> Applicant's written submissions at [54(a)].

84 The same considerations mean that the watches to be properly considered – watches in general – are not necessarily as expensive as the luxury watches in respect of which the Applicant made its submissions.<sup>45</sup> Similarly, while I would agree that consumers tend to be somewhat attentive and fastidious while purchasing watches, I do not think that they would be quite so invested as to preclude a likelihood of confusion.

85 Finally, both the Applicant and the Opponent agreed with the Court of Appeal in *City Chain* (at [56]) that “a watch is a product which is commonly available and purchased by the general public”.<sup>46</sup> As has been memorably put, this member of the general public is not a “moron in a hurry”; he would exercise some care and good sense in making his purchases. However, I do not think that this average consumer would have specialist knowledge in relation to watches that he might bring to bear in making a purchase.

#### *Other Factors Raised*

86 At the hearing, the Applicant put forth an additional point which was not raised in the Applicant’s submissions: if there were truly a likelihood of confusion, the Opponent would have started infringement proceedings earlier.

87 My attention was not drawn to any authority on this matter. Nonetheless, in my view, this cannot be a relevant consideration. While the list of extraneous factors set out in *Staywell* is non-exhaustive (at [96]), the extraneous factors listed therein share the common restriction that they must “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” (at [83]). A trader’s litigation strategy does not provide such information. Therefore, I did not take this submission into account.

#### *Conclusion on Likelihood of Confusion*

88 Taking into consideration all of the above – with the exception of the litigation strategy point – I find that there is a likelihood of confusion between the Application Mark and the Opponent’s Mark, both over the origin of the goods and in the belief that the users of the competing marks are economically linked.

#### **Conclusion on Section 8(2)(b)**

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

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

90 The relevant portion of Section 8(4) of the Act reads:

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<sup>45</sup> Applicant’s written submissions at [54(a)].

<sup>46</sup> Applicant’s written submissions at [52(b)]; Opponent’s submissions made orally at the hearing.

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

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

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

*Similarity of Marks*

91 This first element is essentially the same as the marks-similarity inquiry under Section 8(2)(b) (see ***Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd*** [2015] SGHC 216 (“***Rovio***”) at [142] to [146]).

92 Therefore, in light of the considerations already addressed (see [38] to [61] above), I find that this element is satisfied.

*Well known in Singapore*

93 This element is the critical question for the purposes of the present inquiry under this ground.

94 Well known trade marks are defined in Section 2(1) of the Act:

2.—(1) ...

“well known trade mark” means —

- (a) any registered trade mark that is well known in Singapore; or
- (b) any unregistered trade mark that is well known in Singapore and that belongs to a person who —
  - (i) is a national of a Convention country; or
  - (ii) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in Singapore  
...

95 Sections 2(7), 2(8) and 2(9) provide further guidance on the concept of “well known in Singapore”:

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

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

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

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

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

96 The considerations set out at [28] to [36] above in relation to acquired distinctiveness operate similarly here to indicate that Opponent's evidence does not support a finding that the Opponent's Mark is well known in Singapore.

97 In relation to this element, however, the Opponent additionally cited a number of foreign decisions (from the European Union, Switzerland, Saudi Arabia, the United Arab Emirates and Kazakhstan) relating to the Opponent's Mark and the Applicant's Mark in its written submissions.<sup>47</sup> This was ostensibly pursuant to Section 2(7)(d) of the Act.

98 By the time of the hearing, however, the Opponent had ceased to rely on these foreign decisions in support of its arguments that the Opponent's Mark is well known in Singapore. This was just as well. The Court of Appeal in *Caesarstone (CA)* elaborated upon the application of Section 2(7)(d) (at [113]):

113 In *Formula One Licensing BV v Idea Marketing SA* [2015] 5 SLR 1349, Tay Yong Kwang J (as he then was) stated (at [66]) that "registrations do not automatically equate to trade mark use". As for foreign decisions, he held (at [72]) that they do not assist in determining the threshold issue of whether the mark in question is well known to the relevant sector of the public *in Singapore*. Indeed, although the overseas registrations of the mark and the successful enforcement of rights are relevant factors under s 2(7)(c) and (d) of the TMA, the language of s 2(7) of the TMA makes it abundantly clear that the ultimate inquiry is whether a trade mark is well known *in Singapore*. The crucial point, therefore, is that the Appellant has to show how the overseas registrations of the Appellant's CAESAR Mark and the successful enforcement of its rights has *led to* its mark being well known *in Singapore*. In our judgment, this has not been done. These factors therefore do not go towards establishing that the Appellant's CAESAR Mark is well known in Singapore.

[emphasis original]

99 The Opponent's written submissions did not demonstrate the necessary causative relationship. As such, its initial citation of these foreign decisions would not have assisted in satisfying this element in any way.

100 Accordingly, this element has not been made out based on the evidence before me.

101 While this conclusion disposes of this ground of opposition, I shall proceed to consider the remaining two elements very briefly.

#### *Connection*

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<sup>47</sup> Opponent's SD at [15]. In its written submissions (at [39]), the Opponent mistakenly stated that it was relying on decisions from the European Union, Switzerland, Saudi Arabia and Bahrain. This was clarified at the hearing.

102 Given my findings that there exists a likelihood of confusion (see [69] to [88] above), this element of connection is satisfied as well (*Staywell* at [120]).

#### *Likelihood of Damage*

103 The test for likelihood of damage under Section 8(4)(b)(i) is substantively the same as that relating to the element of damage under the law of passing off (*Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 (“*Amanresorts*”) at [234]; *Rovio* at [192] to [193]). One distinction, however, between these tests is that while the element of damage under the law of passing off relates to a proprietor’s *goodwill*, the corresponding test under Section 8(4)(b)(i) concerns the *interests* of a proprietor and not its goodwill (*Amanresorts* at [234]; *Rovio* at [193]).

104 A likelihood of damage by blurring – when a plaintiff’s get-up becomes indicative of the defendant’s goods or services, resulting in a diversion of sales from the plaintiff to the defendant – is readily inferred where parties are in direct competition with each other (*Allergan, Inc v Ferlandz Nutra Pte Ltd* [2016] 4 SLR 919 at [210]). As previously stated (see [67] to [68] above) there exists an overlap between the goods in respect of which the Applicant seeks registration of its mark and those for which the Opponent’s Mark is protected. The parties are therefore clearly in direct competition with each other. As such, had the Opponent established all the preceding elements of this ground of opposition, I would have found that a real likelihood of damage to the Opponent’s interests exists.

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

105 In light of the Opponent’s failure to prove that the Opponent’s Mark is well known in Singapore, the ground of opposition under Section 8(4)(b)(i) fails.

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

106 The relevant portion of 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 —
  - ...
  - (ii) if the earlier trade mark is well known to the public at large in Singapore —

- (A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or
- (B) would take unfair advantage of the distinctive character of the earlier trade mark.

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

107 While my decision with regard to Section 8(4)(b)(i) clearly disposes of this ground of opposition as well (i.e. it is not made out), I will set out some further observations on the submissions that the parties have laboured to provide.

***Well Known to the Public at Large in Singapore***

108 It is plain that “well known to the public at large in Singapore” is a more difficult test to satisfy than just “well known in Singapore”. The Court of Appeal held in *City Chain* at [94] that to come within the former test, “the mark must necessarily enjoy a much higher degree of recognition”: “[i]t must be recognised by most sectors of the public”. This is in accordance with the observation in *Amanresorts* at [229] that protection under Section 8(4)(b)(ii) should “properly be the preserve of a rare and privileged few”.

109 However, in its written submissions and at the hearing, the Opponent did not tender any arguments which recognised this elevated threshold or explained how its evidence might satisfy it.

110 As an indication of how high the bar is, it is helpful to refer to the following table from *Guess?, Inc v Jen, Chi* [2019] SGIPOS 3 at [79] which sets out the cases where this element was made out (for the avoidance of doubt, the table is a guide only):

| <b>All figures pertain to activities in Singapore</b> |                           |  |                                     |   |                           |
|---|---------------------------|--|-------------------------------------|---|---------------------------|
| S/No.   | Trade mark                | Expenditure on marketing                           | Exposure via physical sales outlets | Sales figures                             | Survey, if any            |
| 1   | "Seiko <sup>48</sup> "    | More than \$4 million <i>each year</i> for 5 years | 100 optical shops                   | \$14 million <i>per annum</i> for 5 years | 70% of consumer awareness |
| 2   | "Clinique <sup>49</sup> " | \$3 million <i>each year</i> for 4 years           | 13 stores and counters              | \$10 million <i>per</i>                   |                           |

<sup>48</sup> *Seiko Holdings Kabushiki Kaisha (trading as Seiko Holdings Corporation) v Choice Fortune Holdings Limited* [2014] SGIPOS 8.

<sup>49</sup> *Clinique Laboratories, LLC v Clinique Suisse Pte Ltd and another* [2010] 4 SLR 510.

|   |                         |  |   | <i>annum</i> for 4 years   |                           |
|---|-------------------------|--|---|--|---------------------------|
| 3 | "Nutella" <sup>50</sup> | NA   | 94-98% of stores in Singapore that sell food items  | 2 million units of "Nutella" bread spread sold <i>every year</i> | 70% of consumer awareness |
| 4 | Intel <sup>51</sup>     | US\$600 million per annum for 4 years  |   | US\$1 billion per annum for 7 years                              | 85% of consumer awareness |
| 5 | Gucci <sup>52</sup>     | - “[I]n the region of hundreds of thousands of euros”... “for many years, including in Singapore” <sup>53</sup><br><br>- Exposure via approximately 30 publications<br><br>- Exposure via social media (Facebook with 15.9 million likes; Instagram – 17.8 followers; Twitter – 4.97 followers; Youtube – 136,000 subscribers) | - Changi Airport, the Paragon shopping mall in Orchard Road, the Takashimaya department store in Orchard Road and at The Shoppes retail complex in Marina Bay Sands | “[M]ore than tens of millions SGD” for 5 years <sup>54</sup>     |                           |

<sup>50</sup> *Sarika (HC)*.

<sup>51</sup> *Intel Corporation v Intelsteer Pte Ltd* [2015] SGIPOS 2.

<sup>52</sup> *Guccio Gucci S.P.A v Guccitech Industries (Private Ltd)* [2018] SGIPOS 1 (“Guccitech”).

<sup>53</sup> See [14] of *Guccitech*.

<sup>54</sup> See [13] of *Guccitech*.

111 In studying the table above, it is clear that the Opponent’s evidence (see [28] to [36] above) is lacking in comparison to the other cases in which the element of being “well known to the public at large in Singapore” was made out.

#### *Unfair Advantage*

112 In relation to the elements of unfair advantage and/or unfair dilution, the Opponent made submissions only in relation to the former, and hence it is the former I will consider.

113 The concept of “taking unfair advantage” “covers, in particular, cases where there is clear exploitation on the coattails of the mark with a reputation, *viz*, when the defendant’s mark freely rides on the coattails of the well known mark in order to benefit from its power of attraction, its reputation and its prestige and to exploit the marketing effort of the proprietor without any financial compensation” (*Sarika (HC)* at [180]).

114 The factors that are to be considered in assessing the question of unfair advantage are (*Sarika (HC)* at [182] to [187]):

- (a) The strength of the well-known mark’s reputation and the degree of distinctive character of that mark;
- (b) The degree of similarity between the marks;
- (c) The nature and degree of proximity of the goods or services concerned; and
- (d) The immediacy and strength with which the well-known mark is brought to mind by the challenged mark.

115 At first glance, it appears that these factors largely favour the Opponent. I have found that the marks are substantially similar (see [14] to [61] and [70] above), and that goods-identity has been established in relation to the overlap of “horological instruments” (see [62] to [68] above). I also consider that “MARINER” will remind consumers of “SUBMARINER”. I note, however, my earlier findings that the Opponent’s evidence does not substantiate any level of reputation in the Opponent’s Mark (see [28] to [36] and [71] above) and that the Opponent’s mark is ultimately only of medium distinctiveness (see [25] to [37] above).

116 Notwithstanding these factors, however, I am reminded that “the question of unfair advantage has to be considered using a global assessment” (*Sarika (HC)* at [182]). In *Sarika (HC)*, even though all four factors were made out in the plaintiff’s favour, the High Court nonetheless found that:

188 In the final analysis, there was insufficient proof to convince me on the balance of probabilities that the Defendant gained any advantage from naming the drink “Nutello”, let alone an unfair advantage. [...] The Plaintiff had no other

evidence that “Nutello” sold better because it was named in a manner similar to “Nutella”. Therefore, I conclude that the claim under s 55(3)(b)(ii) is not made out, because it had not been satisfactorily proven that the Defendant had taken unfair advantage of the “Nutella” mark.

117 In the present case, the Opponent’s submissions have amounted to a bare assertion that “the Applicants may benefit unfairly from the reputation, attraction and prestige associated with the Opponent’s “SUBMARINER” trade mark by taking advantage of the distinctive character and reputation of the “SUBMARINER” trade mark by riding on the coattails of the Opponent’s successful and painstaking cultivation and brand building for the “SUBMARINER” trade mark and thus allowing the Applicants to gain significant traction in the market place for little effect, advertising and/or expenditure.”<sup>55</sup> No evidence has been adduced by the Opponent in support of this claim. On the contrary, the Applicant has been using its mark in Singapore for the past ten years.<sup>56</sup>

118 On the balance of probabilities, therefore, I find that use of the Application Mark would not result in the accrual of an unfair advantage to the Applicant.

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

119 In light of the considerations above, the ground of opposition under Section 8(4)(b)(ii) fails.

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

120 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)*

121 It is trite that to succeed on this ground, the Opponent must make out the so-called classical trinity of goodwill, misrepresentation and damage.

##### *Goodwill*

122 As the Court of Appeal stated in *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 (“Singsung”) at [34], “goodwill,

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<sup>55</sup> Opponent’s written submissions at [46].

<sup>56</sup> Applicant’s SD at [4].

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”. In addition, “goodwill clearly exists in Singapore when a business offers a product or service for sale in this jurisdiction, and a customer purchases the product or consumes the service here” (*Singsung* at [67]).

123 Here, the Opponent referred to the same evidence as it did for the supposed acquired distinctiveness of the Opponent’s Mark (see [28] above). While it was insufficient in that context (see [28] to [36] above), I am satisfied that the Opponent’s evidence – particularly in relation to its established network of retailers throughout Singapore – demonstrates goodwill in the Opponent’s business as a whole.

#### *Misrepresentation*

124 The test for misrepresentation under the law of passing off is substantively the same as the “connection” element under Section 8(4)(b)(i) (*Rovio* at [192] to [193]).

125 Given my findings above that the element of “connection” under Section 8(4)(b)(i) is made out (see [69] to [88] and [102] above), I am satisfied that, on a balance of probabilities, there is a likelihood of misrepresentation that the Applicant and the Opponent are one and the same or that they are economically linked.

#### *Damage*

126 To establish this element, it must be shown either that there has been actual damage to the Opponent’s goodwill or that there is a real likelihood of damage (*Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 at [106]).

127 As previously stated at [104], a likelihood of damage by blurring is readily inferred where parties are in direct competition with each other, as the Opponent and the Applicant are. Consequently, I am prepared to accept that had the Opponent succeeded in establishing goodwill, there would have been a real likelihood of damage to that goodwill.

#### *Conclusion on Section 8(7)(a)*

128 Accordingly, I find that the ground of opposition under Section 8(7)(a) succeeds.

### **Overall Conclusion**

129 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition succeeds on Section 8(2)(b) and Section 8(7)(a). Accordingly, the Application Mark shall not proceed to registration. The Opponent is to have 70% of the costs of the opposition, having regard to the fact that the opposition succeeds under Section 8(2)(b) which formed a larger part of the

opposition as well as Section 8(7)(a) but failed under Section 8(4)(i) and Section 8(4)(b)(ii). The costs are to be taxed, if not agreed.

Date of Issue: 15 June 2020