

RELATIVE GROUNDS FOR REFUSAL OF REGISTRATION

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1 INTRODUCTION

This chapter deals with the grounds for refusal of registration of a mark which arise from conflicts with earlier mark(s). These grounds are accordingly referred to as the relative grounds for refusal of registration.

“Relative grounds” means the reasons set down in the Trade Marks Act for refusing to register a mark by considering it in relation to other earlier trade marks.

2 RELEVANT LEGISLATION

Trade Marks Act (Cap. 332, 2005 Rev. Ed.)

Interpretation

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

...

"Convention country" means a country or territory, other than Singapore, which is a party to the Paris Convention or a member of the World Trade Organisation;

"dilution" , in relation to a trade mark, means the lessening of the capacity of the trade mark to identify and distinguish goods or services, regardless of whether there is —
(a) any competition between the proprietor of the trade mark and any other party; or
(b) any likelihood of confusion on the part of the public;

"earlier trade mark" means —

(a) a registered trade mark or an international trade mark (Singapore), the application for registration of which was made earlier than the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks; or
(b) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was a well known trade mark,
and includes a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph (a) subject to its being so registered;

"Paris Convention" means the Convention for the Protection of Industrial Property signed at Paris on 20th March 1883, as revised or amended from time to time;

"proprietor" means —

(a) in relation to a registered trade mark, the person in whose name the trade mark is registered; or
(b) in relation to an unregistered trade mark that is a well known trade mark, the person to whom the trade mark belongs;

"trade mark" means any sign capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person;

"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;

"WTO Agreement" means the World Trade Organisation Agreement signed in Marrakesh in 1994 as revised or amended from time to time.

Relative grounds for refusal of registration

8. —(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is sought to be registered are identical with the goods or services for which the earlier trade mark is protected.

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

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

(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.

(3) Where an application for registration of a trade mark is made before 1st July 2004, if the trade mark —

(a) is identical with or similar to an earlier trade mark; and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

the later trade mark shall not be registered if —

(i) the earlier trade mark is well known in Singapore;

(ii) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered would indicate a connection between those goods or services and the proprietor of the earlier trade mark;

(iii) there exists a likelihood of confusion on the part of the public because of such use; and

(iv) the interests of the proprietor of the earlier trade mark are likely to be damaged by such use.

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

(a) the earlier trade mark is well known in Singapore; and

(b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —

(i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark; or

(ii) if the earlier trade mark is well known to the public at large in Singapore —

(A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or

(B) would take unfair advantage of the distinctive character of the earlier trade mark.

(5) A trade mark shall not be refused registration by virtue of subsection (4) if the application for the registration of the trade mark was filed before the earlier trade mark became well known in Singapore, unless it is shown that the application was made in bad faith.

(6) In deciding whether any such application was made in bad faith, it shall be relevant to consider whether the applicant had, at the time the application was made, knowledge of, or reason to know of, the earlier trade mark.

(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; or

(b) by virtue of an earlier right other than those referred to in subsections (1), (2) and (3) or paragraph (a), in particular by virtue of the law of copyright or any law with regard to the protection of designs.

(8) A person entitled under subsection (7) to prevent the use of a trade mark is referred to in this Act as the proprietor of an earlier right in relation to the trade mark.

(9) The Registrar may, in his discretion, register a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.

(10) The Registrar may, in his discretion, register any trade mark referred to in subsection (3), (4) or (7) where the proprietor of the earlier trade mark or other earlier right fails to give notice to the Registrar of opposition to the registration in accordance with section 13.

(11) A trade mark which is an earlier trade mark by virtue of paragraph (a) of the definition of “earlier trade mark” in section 2(1) and whose registration expires, shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry, unless the Registrar is satisfied that there was no bona fide use of the mark during the 2 years immediately preceding the expiry.

Raising of relative grounds in case of honest concurrent use

9. —(1) Where, on an application for the registration of a trade mark, it appears to the Registrar —

(a) that there is an earlier trade mark in relation to which the conditions set out in section 8(1), (2) or (3) apply; or

(b) that there is an earlier right in relation to which the condition set out in section 8(7) is satisfied,

but the applicant shows to the satisfaction of the Registrar that there has been honest concurrent use in the course of trade in Singapore of the trade mark for which registration is sought, the Registrar shall not refuse the application by reason of the earlier trade mark or other earlier right unless objection on that ground is raised in opposition proceedings by the proprietor of that earlier trade mark or other earlier right.

(2) Nothing in this section shall affect —

- (a) the refusal of registration on the grounds mentioned in section 7; or
- (b) the making of an application for a declaration of invalidity under section 23 (3).

Claim to priority of Convention application

10. —(1) Subject to subsection (6), where —

- (a) a person has filed an application for the registration of a trade mark in a Convention country in respect of certain goods or services;
 - (b) that application is the first application for the registration of the trade mark to be filed in any Convention country in respect of those goods or services (referred to in this section as the first Convention application); and
 - (c) within 6 months after the date on which the first Convention application is filed, that person or his successor in title applies under this Act for the registration of the trade mark in respect of all or any of those goods or services,
- that person or his successor in title may, when filing the application under this Act, claim a right of priority for the registration of the trade mark in respect of all or any of the goods or services for which registration was sought in the first Convention application.

(2) Where any person claims the right of priority referred to in subsection (1), the person shall have priority from (and including) the date on which the first Convention application was filed.

(3) Where the right of priority referred to in subsection (1) is claimed in respect of a trade mark, the registrability of the trade mark shall not be affected by any use of the trade mark in Singapore in the period between —

- (a) the date the first Convention application was filed; and
- (b) the date the application under this Act was filed.

(4) Any filing which in a Convention country is equivalent to a regular national filing, under its domestic legislation or an international agreement, shall be treated as giving rise to the right of priority.

(5) For the purposes of subsection (4), “regular national filing” means a filing which is adequate to establish the date on which the application was filed in the Convention country, whatever may be the subsequent fate of the application.

(6) Where a subsequent application concerning the same subject as an earlier application is filed, whether in the same or a different Convention country, and these are the first 2 applications concerning that subject to be filed in any Convention country, the subsequent application shall be considered the first Convention application if, at the date the subsequent application is filed —

- (a) the earlier application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding; and
- (b) the earlier application has not yet served as a basis for claiming a right of priority.

(7) For the avoidance of doubt, where subsection (6) applies —

(a) the date on which the subsequent application was filed, rather than that of the earlier application, shall be considered the starting date of the period of priority under subsection (2); and

(b) the earlier application may not thereafter serve as a basis for claiming a right of priority.

(8) The Minister may make rules as to the manner of claiming priority under this section.

(9) A right of priority arising under this section may be assigned or otherwise transmitted, either with the application or independently, and the reference in subsection (1) to the applicant's "successor in title" shall be construed accordingly.

Claim to priority from other relevant overseas application

11. —(1) The Minister may, by order, confer on a person who has filed an application for the registration of a trade mark in a country or territory to which the Government has entered into a treaty, convention, arrangement or engagement for the reciprocal protection of trade marks, a right to priority, for the purpose of registering the same trade mark under this Act for some or all of the same goods or services, for a specified period from the date of filing of that application.

(2) An order under this section may make provision corresponding to that set out in section 10 or such other provision as appears to the Minister to be appropriate.

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.

Withdrawal, restriction or amendment of application

14. —(3) In other respects, an application may be amended, at the request of the applicant, only by correcting —

(a) the name or address of the applicant;

(b) errors of wording or of copying; or

(c) obvious mistakes,

and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.

Registration

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.

(2) A trade mark when registered shall be registered as of the date of the application for registration, and that date shall be deemed for the purposes of this Act to be the date of registration.

(3) On the registration of a trade mark, the Registrar shall issue to the applicant a certificate of registration.

Grounds for invalidity of registration

23. —(3) The registration of a trade mark may be declared invalid on the ground —

(a) that there is an earlier trade mark in relation to which —

(i) the conditions set out in section 8 (1) or (2) apply;

(ii) where the trade mark has been registered pursuant to an application for registration of the trade mark made before 1st July 2004, the conditions set out in section 8 (3) apply; or
(iii) where the trade mark has been registered pursuant to an application for registration of the trade mark made on or after 1st July 2004, the conditions set out in section 8 (4) apply;
or

(b) that there is an earlier right in relation to which the condition set out in section 8 (7) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

Trade Marks Rules

Size of documents

5. Subject to any directions that may be given by the Registrar, all forms, notices and other documents required or authorised by the Act or these Rules to be given or sent to, filed with or served on the Registrar, other than by means of the electronic online system, shall be given, sent, filed or served using A4 size paper.

Amendment of application

22.—(1) An application to amend an application for registration shall be made in —

(a) Form CM1, if it is made to appoint, change or remove an agent;

(b) Form CM2, if it is made to change or correct the name or other particulars of the applicant, and the change or correction does not affect the representation of the trade mark; and

(c) Form TM 27, if sub-paragraphs (a) and (b) do not apply.

...

(5) Before acting on an application to amend an application for registration, the Registrar may require the applicant to furnish such proof as the Registrar thinks fit.

Application to register or give notice of transaction

55.—(1) An application to register particulars of a transaction to which section 39 of the Act applies shall be made, and a notice to be given to the Registrar of particulars of a transaction to which section 41 of the Act applies shall be —

- (a) in the case of any assignment or transaction other than a transaction referred to in sub-paragraphs (b) and (c), in Form CM8;
- (b) in the case of the grant, amendment or termination of a licence, in Form CM6;
- (c) in the case of the grant, amendment or termination of any security interest, in Form CM7;
- (d) in the case of the making by personal representatives of an assent in relation to a registered trade mark, an application for registration of a trade mark, or any right in or under a registered trade mark or an application for registration of a trade mark, by way of a written request; or
- (e) in the case of an order of the Court or any other competent authority transferring a registered trade mark, an application for registration of a trade mark, or any right in or under a registered trade mark or an application for registration of a trade mark, by way of a written request accompanied by a copy of the order.

Application to cancel registered trade mark or registration in relation to certain goods or services

61.—(1) The proprietor may, by filing with the Registrar a notice in Form CM3 —

- (a) cancel the proprietor's registered trade mark, if the cancellation relates to all of the goods or services in respect of which the trade mark is registered; or
- (b) cancel the registration of the proprietor's registered trade mark in relation to at least one of the goods or services in respect of which the trade mark is registered.

(2) A notice under paragraph (1) shall have no effect unless the proprietor in that notice certifies that every other person (if any) having a right in the mark —

- (a) has been given not less than 3 months' notice of the proprietor's intention to cancel the mark; and
- (b) is not affected by the cancellation or if affected has no objection to the cancellation.

(3) The Registrar, if satisfied that the notice complies with paragraph (2) and is otherwise regular, shall make the appropriate entry in the register.

3 MEANING OF “EARLIER TRADE MARK”

Objections to registration of a trade mark under Section 8 can only be taken if the conflicting mark is an “earlier trade mark”. “Earlier trade mark” is defined in Section 2(1). The Examiner must determine whether the conflicting mark qualifies as an earlier trade mark, before it can be raised as a citation. A citation can only be raised if it does.

(a) Where the conflicting mark is registered

Where the search reveals a registered mark that is considered to be in conflict, the determining factor rests on the respective relevant dates (priority dates and application dates).

If no priority dates are claimed, the registered mark is the “earlier trade mark” and will be raised as a citation.

If the later application has a priority date, then it depends on whether the priority date of the later application pre-dates that of the priority date or application date of the registered mark. If so, no citation can be raised.

The above could lead to a situation where two identical marks get onto the register. In such a situation, the owner of the registered mark has the option to oppose the new mark when its acceptance is published. Alternatively, the owner of the new mark can bring invalidation proceedings to invalidate the registration after the new mark is registered. The dispute is best left to be resolved between the parties.

The Trade Marks Act does recognise the existence of identical marks for identical goods on the register, for instance where:

- (i) there is honest concurrent use (Section 9); or
- (ii) where the owner of the earlier trade mark or earlier right has consented to the situation (Section 8(9)).

(b) Where the conflicting mark is pending

Where the search shows the conflicting mark to be a “pending” application, it will be dealt with as follows:

- (i) *Where there are other **absolute** grounds for refusal*, applicants will have to overcome these concurrently. If the absolute grounds for refusal prove fatal to the application, refusal will be based upon them but with a caveat that there are also relative grounds for refusal which need to be addressed.
- (ii) *Where there are other **relative** grounds for refusal based upon **registered** trade marks*, the applicant may be asked to consider the following options: (a) obtaining

a letter of consent for all the owners of all the marks; (b) limiting the specification of goods or services to avoid possible conflict; (c) a combination of (a) and (b) as appropriate.

Note: “Pending” includes published and opposed marks.

(c) Where the conflicting mark has the same application or priority date

If two or more applications, for identical or similar marks and the same or similar goods or services, have the same filing date or priority date, the applicants will be notified of the potential conflict in the examination report. They should also be informed that the Registrar does not intend to take any further action and that the acceptance of both marks will be published in the Journal. The two parties are then left to resolve any conflict between them by way of opposition proceedings.

(d) Where the conflicting mark has expired less than one year ago

Where the search discloses an earlier trade mark which is an unrenewed mark whose registration has expired no more than one year before the application date of the trade mark, the earlier trade mark will be cited. In such a situation, the Registrar will make it clear to the applicant that the Registrar is invoking Section 8(11) in relation to the citation. This will put the applicant on notice that the citation is in its final year of validity. The same applies to partial renewal where particular classes are not renewed.

The applicant may then consider the following options:

- (i) await the end of the Section 8(11) period by requesting for extension(s) of time via Form CM5 to respond to the citation until the expiry of the one-year period to re-assess if the citation will remain valid;
- (ii) demonstrate to the satisfaction of the Registrar that there was no bona fide use of the mark during the two years immediately preceding the expiry;
- (iii) obtain the consent of the expired mark proprietor in the normal way.

(e) Where the expired mark proprietor has been dissolved or has otherwise gone out of existence

The Registrar will not generally waive the citation. However in some cases, it may be possible to persuade the Registrar to reconsider the position if the applicant can provide convincing evidence to suggest that there is no likelihood or possibility of the expired mark being renewed or restored.

(f) Where the conflicting mark is abandoned

The Registrar will not cite a conflicting mark that is reflected as "Treated As Withdrawn (Reinstatable)", "Treated As Withdrawn", "Abandoned" or "Cancelled" on the Register, against a later application.

The applicant of the "Treated As Withdrawn (Reinstatable)" mark, should expeditiously request for the Registrar's consideration to reinstate his mark by lodging Form CM13 with the requisite fee, if intended.

(g) Conflicting mark is a well known trade mark – Sections 8(3), (4), (5) and (6)

Except where the conflicting mark is very well-known and in relation to very similar goods or services, the Registrar will not as a matter of practice, raise citations on the ground of "well known trade mark" for which there is no pending application or registration. The Registrar will leave such dispute to be raised at opposition proceedings since proprietors of well known trade marks are better placed to prove the reputation of well known trade marks in opposition proceedings. As such, conflict based on well known trade marks will not be dealt with fully at the examination stage.

(h) Use of mark prohibited under rule of law or other earlier right – Section 8(7)

An earlier right may arise to prevent a registration e.g., passing off, copyright or registered design. In addition, protection under written law for certain emblems and signs may also prevent registration of signs that closely resemble such emblems, (e.g., "Merlion" symbol protected under Section 24 of the Singapore Tourism Board Act [Cap. 305B, 1997 Ed.]). Except in the latter case, the Registrar will not usually raise an objection on the basis of earlier right at the examination stage as such objections will only be meaningful on the basis of evidence and thus, they are better dealt with during opposition or invalidation proceedings.

4 CONFLICT WITH EARLIER TRADE MARKS

Note:

The decision of the Singapore Court of Appeal in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another and another appeal* [2014] 1 SLR 911 (“*Staywell*”) is the current local authority in relation to section 8 of the Trade Marks Act.

The Court has reaffirmed the step-by-step approach in the *Staywell* case. Under the step-by-step approach, the three requirements of similarity of marks, similarity of goods or services, and likelihood of confusion arising from the two similarities, are assessed systematically. The first two elements are assessed individually before the final element which is assessed in the round.

The Registry will endeavour to update the contents under “Conflict with earlier trade marks” as soon as possible.

The Act provides that a mark shall not be registered if it conflicts with an earlier trade mark in essentially three categories of cases:

- (a) Where the marks and goods or services are identical. In such a case, there is a presumption of confusion;
- (b) Where there is a similarity of marks or of goods or services resulting in a likelihood of confusion on the part of the public; or
- (c) Where an earlier mark has a reputation and use of the later mark would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier mark.

(a) Section 8(1): Where the marks and the goods or services are identical

Section 8(1) of the Trade Marks Act provides that a trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is sought to be registered are identical with the goods or services for which the earlier mark is protected. For an objection to arise a number of requirements must be satisfied.

First, there must be an earlier trade mark. This is defined in Section 2(1) of the Act.

Secondly, the mark that is the subject of the application must be identical to the earlier trade mark. The test is whether the mark that is the subject of the application “is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an **average consumer**.” The **average consumer** is “deemed to be reasonably observant and circumspect”. It must be borne in mind that “a sign produces an overall impression on such a consumer” and

that “a consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind”. Moreover, “his level of attention is likely to vary according to the category of goods or services in question.” (See the ECJ in *LTJ Diffusion SA v Sadas Vertbaudet SA (Case C-291/00)*).

Thirdly, the goods or services the subject of the application must be the same as those the subject of the earlier trade mark.

(i) Meaning of “identical mark”

- 3-D mark is not identical to a 2-D picture of it
- DIGIT is not identical to DIGITS
- JANE not identical to JANE’S

“Virtually identical” marks will be treated as “similar”. In practice, the more similar the marks, the greater the likelihood of confusion. Thus, the end result is the same because “virtually identical” marks are likely to cause confusion, which is the test for similar marks.

(ii) Meaning of “identical goods or services”

That is where there is an overlap of goods or services.

- If the later mark would be registered in a different class to the earlier mark, they are unlikely to be “identical”.
- Look at how the product is regarded for the purposes of trade i.e. by traders and consumers. So, although Robertson’s product (see *British Sugar Plc v James Robertson & Sons Ltd [1996] R.P.C. 281 (also known as TREAT case)*), which the trade regarded as a “spread” could be used as a “dessert sauce” (British Sugar’s specification) and although British Sugar’s product could be used as a spread, they were not considered identical goods.
- Where the product is placed on retailer’s shelves may also be relevant.
- In case of any doubt, the applicant may be asked to produce evidence of how the product is regarded in the trade.

(b) Section 8(2): Where the marks and the goods or services are identical or similar and there is a likelihood of confusion

Section 8(2) of the Trade Marks Act requires that a 3-staged test:

- (i) Is there a similarity of marks?
- (ii) Is there a similarity of goods or services?
- (iii) Is there a likelihood of confusion by virtue of the similarity in (i) and (ii)?

Likelihood of confusion is fundamental to the objection. The objection can only apply where there is a likelihood of confusion on the part of the public.

The following sections will address these important issues relating to this provision: how the likelihood of confusion is to be assessed and the factors to be taken into account; whether or not there is a threshold requirement that the goods or services be “similar”; the factors to be taken into account in assessing similarity; and finally, the nature of the relevant confusion.

The existence of a likelihood of confusion must be found on the evidence (see *Marca Mode CV v Adidas AG [2000] E.T.M.R. 723*). The likelihood of confusion is to be assessed globally, taking into account all factors relevant to the marks and goods and services in issue.

This test has been made clear in *Pianotist Co’s Application (1906) 23 R.P.C. 774*, by the ECJ in *Sabel BV v Puma AG [1998] R.P.C. 199* and in *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV [2000] F.S.R. 77*.

(i) Are the marks similar?

The principles governing the comparison of trade marks are entrenched in the following cases, all of which are applicable.

Pianotist Co’s Application (1906) 23 R.P.C. 774

“You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case.”

Erectiko v Erector [1935] 52 R.P.C. 151

“He (Assistant Registrar) takes the two words “Erector” and “Erectiko” and divides them into two; he eliminates “Erect” from the two words and then proceeds to compare the suffix “or” with the suffix “iko” and points out that there is a great difference between “or” and “iko”. In my judgement, that is a wholly wrong attitude to adopt in considering a case of this kind. I do not think it is right to take a part of the word and compare it with a part of the other word; one word

must be considered as a whole and compared with the other word as a whole. In my judgement, it is quite wrong to take a portion of the word and say that, because that portion of the word differs from the corresponding portion of the word in the other case, there is no sufficient similarity to cause confusion. There may be two words which in their component parts are widely different but which, when read or spoken together, do represent something which is so similar as to lead inevitably to confusion. I think it is a dangerous method to adopt to divide the word up and seek to distinguish a portion of it from a portion of the other word.”

Sabel BV v Puma AG [1998] R.P.C. 199

“The likelihood of confusion must therefore be appreciated globally, taking into account of all factors relevant to the circumstances of the case.”

“That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant component”

“the perception of marks in mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public”

Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV [2000] F.S.R. 77

For the purposes of that global appreciation, the average customer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect.”

“However, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect

picture of them that he has kept in his mind. It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question."

In summary, these are the basic guidelines for comparison of word trade marks:

- (i) the appearance of the two marks;
- (ii) the sound of the two marks;
- (iii) the goods or services to which the subject mark is applied;
- (iv) the kind of customer who is likely to buy the goods or use the services. A more knowledgeable customer is less likely to be confused, and likewise for a customer who is specialised in the particular trade; and
- (v) the surrounding circumstances

In assessing the similarity of the marks by appearance and sound, the Registrar will follow the guidance given in *Sabel BV v Puma AG [1998] R.P.C. 199* and take into account the visual, oral and conceptual similarity of the marks in question, including the overall impression given by the marks, bearing in mind, in particular, their respective distinctive and dominant components.

The Registrar will not conduct a meticulous comparison of the marks. The marks will not be compared side by side, letter by letter or syllable by syllable. The marks should be compared as wholes and should not be spilt up or dissected.

The Registrar will make a global assessment of the likelihood of confusion accordingly taking into consideration the degree of similarity between the relevant marks, the degree of similarity between the relevant goods or services, the likely perception of the marks in the mind of the average consumer of the goods or services in question and the degree of distinctiveness of the earlier mark. The distinctiveness of the earlier mark may be the result of the inherent character of the mark or the reputation attached to it through use as assessed by the Registrar on a prima facie basis.

The Registrar will apply the guidelines in the following sections. In each case, the nature of the trade marks will determine the criteria which will be most appropriate to enable the Registrar to determine whether the marks are confusingly similar.

(1) Sound as well as appearance to be considered

In considering the sound of two marks, the following has to be taken into account:

- possibility of slurred pronunciation;
- distortion of sound in telephone or other conversations;
- the syllabic structure of words;
- slurring of the termination of words;

- importance of first syllable as it is usually accentuated; and
- modern marketing methods for the goods in question e.g. articles of clothing unlikely to be purchased over the counter on a verbal request but are carefully selected by a potential customer from a rack in a shop and very carefully inspected and compared with similar articles. Hence, for some goods such as clothing, the visual impact of the marks will be more important than any aural similarity.

London Lubricants (1925) 42 R.P.C. 264 (also known as Tripcaströid case)

“the tendency of persons using the English language to slur the termination of words also has the effect necessarily that the beginning of words is accentuated in comparison, and ... the first syllable of a word is, as a rule, far the most important for the purpose of distinction”

(2) The doctrine of imperfect recollection

In deciding whether the sound of one mark resembles to nearly the sound of another, allowance will be made for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description but also of the shop assistant ministering to that person's wants.

The doctrine of the first impression and imperfect recollection of the average consumer also means that the global appreciation of the likelihood of confusion must, as regards the visual, aural or conceptual similarity of the marks in question, be based upon the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components. The perception of marks in the minds of the average consumers of the category of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see *Sabel BV v Puma AG [1998] R.P.C. 199; Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV [2000] F.S.R. 77*). Account is to be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect recollection of them he has kept in his mind. It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or service in question; (see *Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV [2000] F.S.R. 77*).

However, the doctrine of imperfect recollection must not be carried too far. In considering its application not only must the class of person likely to be affected be considered, but no more than ordinary possibilities of bad elocution, careless

hearing or defective memory ought to be assumed. In the case of *Seiko Kabushiki Kaisha v Montres Rolex S.A. (TM No. T99/15212J)*, the marks in question were ROOX and ROLEX. The Registrar took into account the argument of imperfect recollection. However, that was weighed against the fact that ROOX was an invented word and not found in the dictionary. The Registrar then considered that,

“when a person is faced with an unfamiliar word, there is a tendency for that person to reach within his own vocabulary of words and mentally look for words that have the same structure in the sense that the chronology of the alphabets is the same as the unfamiliar word. Having identified the similar word or words; he would apply the way in which those words are pronounced to the unfamiliar word. In this case, that person would apply the pronunciation of very normal English words like “roof”, “room” and “root” which look the most identical to the word “ROOX”. The mark “ROOX” would be pronounced phonetically as “rooks”, the letter “X” at the end of a word as most of us have been taught, being enunciated with a “-ks” or “-cs” sound. It would be quite a stretch to consider the word “ROOX” as a dual-syllable word; it is clearly a single-syllable word. The Opponents’ mark “ROLEX” on the other hand would be read phonetically as “roh-leks”, as there are consonants “R” and “L” before the vowels “O” and “E” respectively. Hence although the words “ROOX” and “ROLEX” appear to be of similar length, the way in which both are enunciated is very different from the other. I cannot find any aural or phonetic similarity between the two marks.”

Thus, in that case, imperfect recollection did not cause two phonetically different words to be confusingly similar.

Aristoc v Rysta [1945] 62 R.P.C. 72

“The answer to the question whether the sound of one word resembles too nearly the sound of another so as to bring the former within the limits of the Trade Marks Act 1938, s 12, must nearly always depend on first impression, for obviously a person who is familiar with both words will neither be deceived nor confused. It is the person who only knows the one word and has perhaps an imperfect recollection of it who is likely to be deceived or confused. Little assistance, therefore, is to be obtained from a meticulous comparison of the two words letter by letter and syllable by syllable pronounced with the clarity to be expected from a teacher of elocution. The court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on

the part not only of the person seeking to buy under the trade description, but also of the shop assistant ministering to that person's wants.

(3) The 'idea' of the trade mark

Although the two trade marks under consideration may contain many differences, Section 8(2) may still apply if they did in fact convey the same idea.

Some trade marks which have features in common are seen to be different when viewed side by side. However, if the same idea is engendered by both trade marks and **it is thought that some purchasers are likely to remember the trade marks by the idea engendered rather than by the specific features of the trade marks**, use of the trade marks may lead to confusion.

E.g. while the words DIAL-AN-ANGEL and GUARDIAN ANGEL were not similar, the associated logos which each contained a representation of an angel with children, although different in detail, were considered to be similar as a result of "the idea of the mark" and the similar impression created by them.

In the case of *Tai Say (Import & Export) Pte Ltd v Ayam S.A.R.L. (TM No. T99/08732I)*, the Opponents who are the registered proprietor and applicant of numerous AYAM BRAND or COCK BRAND and rooster device trade marks in Singapore, in various classes covering a large variety of edible goods sought to oppose the Applicants' mark on the basis that the marks carry a similar idea in the minds of the consumer. The marks are reproduced below.



Applicants' Mark



Opponents' Mark (one of the device marks)

The Registrar applied the concept of the "idea" in marks and found that the ideas in the marks were different as *"the Applicants' device is clearly a turkey; the fowl device has the distinctive markings of a turkey - from the fleshy appendage that hangs from the turkey's beak to its distinctive plumage and its*

fan-shaped tail. Further, the Applicants mark has always been used together with the Malay words “CHAP AYAM BELANDA” and the Chinese characters “huo ji shang biao”” whereas the Opponents’ marks depict the device of a rooster instead.

(4) Marks which contain another trade mark

- (a) *Enoch's Application (1947) 64 R.P.C. 119*
VIVICILLIN : CYLLIN

Not similar as it is unlikely that the “Vivi” would be slurred.

- (b) *Darwin's Application (1946) 63 R.P.C. 1*
MOREX : REX.

A monosyllabic word which is familiar to most as compared to an invented word of two syllables, would not likely be confusing.

- (c) ASTRO : ASTRO BOY

Similar

- (d) MICROSOFT : MICROSOFTOLOGY

Similar

- (e) PIONEER : PIONEER MAGNETICS

Similar

- (f) TKR Techniks : Technics

Similar

In the case of *TKR Electronics Pte Ltd v Matsushita Electric Industrial Co. Ltd (TM No. T99/08180J)*, the Registrar, after assessing and examining the evidence carefully, concluded that,

“the Applicants’ mark when in normal and fair use has caused the significance of the letter “TKR” to be diminished. The word “Techniks” is the dominant and distinctive element of the Applicants’ mark and that which catches the eye when viewed. The overall impression of the mark therefore is the word “Techniks” and this is likely the perception of the average consumer when looking at the Applicants’ mark. The letters TKR in the mark are unlikely to alter the conceptual impact of the mark.”

In the circumstances, the Registrar decided that “TKR Techniks” and “Technics” were similar.

(5) The Metro case (notoriety or familiarity of an element of a mark)

Registrar of Trade Marks v Woolworths Limited (1999) 45 IPR 411, concerning similarity of the marks “Metro” and “Woolworths Metro”

“Where an element of a trade mark has a degree of notoriety or familiarity of which judicial notice can be taken, as is the present case, it would be artificial to separate out the physical features of the marks from the viewers’ perception of them. For in the end the question of resemblance is about how the mark is to be perceived. In the instant case the visual impact of the name “Woolworths” cannot be assessed without recognition of its notorious familiarity to consumers.”

The following questions are useful in considering whether a word has the sort of notoriety or familiarity that might be relevant in deciding whether Section 8(2) applies.

- Is there abundant and widespread consumer recognition of the word and its owner?
- Has there been widespread and overwhelming exposure of the word?
- Does the word have an extremely high profile with the average consumer?
- Has the owner become a household name through use of the word?
- Does the owner have an overwhelming commercial profile through its use of the word?
- Have the word and its owner become an icon?

(6) Invented words

Where the similarity is in an invented word, there is a much greater possibility of confusion.

Erectiko v Erector [1935] 52 R.P.C. 151

“No doubt in the case of a fancy or invented word, a word which is not in use in the English language, the possibility of confusion is very much greater. A fancy word is more easily carried in mind and is more easily carried in mind in connection with some particular goods and it may well be that in the case of a fancy word there is much more chance of confusion and therefore less evidence may be

required to establish the probability of confusion in the case of a fancy word than in the case of a word in the English language.”

“Regimental” case 36 R.P.C. 185, at p. 195

“A distinctive invented or fancy word has a much wider scope for colourable imitation than a word primarily descriptive.”

The above may not necessarily apply to a comparison between **short invented words**. For example, in a comparison of the words “Fif” and “Jif” in **FIF Trade Mark [1979] R.P.C. 355**, it was found that:

*“The visual consideration of a monosyllabic trade mark may require that greater significance be attached to the first letter” and
“Prima facie the marks were neither visually or phonetically so close that their use upon the same goods would be likely to lead to confusion.”*

On the other hand, where the words are not short words, the fact that the word is an invented word can be an important factor in the comparison of marks. For example, in the case of **Novogen Research Pty Ltd v Roche Products Limited (TM No. T99/14723B)**, in assessing the marks, RIVOTRIL vs RIMOSTIL, an important factor that affected the outcome of the similarity analysis is that the marks in contention were drug names with no meaning. The Registrar opined,

“In terms of visual similarity both marks are word marks of the same length, that is, they consist of 8 letters. They start with the letters RI and end with the letters IL. The difference in the marks is that the 4 letters in the centre of the marks are different, they are, VOTR and MOST. In making this assessment it appears as if the mark is being dissected and compared side by side but at this stage, it is necessary to compare the exact visual similarities and differences of the marks. The next step is the consideration of whether an average consumer would be confused. In making this assessment, it has to be considered that an average consumer has seen or heard of one mark and has now come across the other mark. In this case, it is more probable that the average consumer has seen or heard of the mark RIVOTRIL because it has been used in Singapore since the late 1970s or early 1980s. The picture that the average consumer would have in his mind is of a word mark and he would be looking at the mark RIMOSTIL on the packaging of a drug before him. It would be impossible for him to recall the earlier mark in terms of a mental picture without remembering what it sounded like as

*well. In this sense, the two factors to be considered, visual and aural similarity, are linked. Therefore the aural similarities of the marks will have to be considered. Aurally both marks have the same vowel sounds I – O – I and in the same order. Both marks have three syllables. The first syllable in both marks starts with the same consonant R and the last syllable ends with the same consonant L. The second syllable starts with the consonant V in the mark RIVOTRIL and the second syllable starts with the consonant M in the mark RIMOSTIL. The third syllable in the mark RIVOTRIL starts with consonant T and had another consonant namely R immediately after it. The third syllable in the mark RIMOSTIL starts with the consonant S and has the consonant T following it. Again it appears as if the marks are being dissected and examined side by side but it is necessary to consider the exact aural similarities and differences of the marks at this point. However when the issue of confusion is considered, what the average consumer may remember as the earlier mark is the sound of a word beginning with the letter R. If he remembers more, he is likely to remember that the earlier mark sounded like the word before him in that it was also 3 syllabic and sounded like the mark before him in the sense that the vowel sounds were I – O – I and in that order. In terms of visual impression, he is likely to remember a word beginning with the letter R and of about the same length as the mark that is before him. It is unlikely that he would go beyond that and remember the earlier mark as RI – VO - TRIL exactly. **It must be taken into account that we are considering drug names which have no meaning.***

(7) Descriptiveness or lack of distinctiveness of the trade mark

When comparing marks, the question of confusion must be answered by comparing the marks as wholes. Thus, for example, if the descriptive matter has been disclaimed, that element will not be discounted when comparing the trade marks.

***Bale & Church Limited v Sutton Parsons & Sutton and Astrah Products (1934) 51 R.P.C. 129 (also known as the Kleenoff case)**
“...the test of infringement where the mark has a descriptive element is the same as the test where it has no descriptive element...”*

However, a non-distinctive matter (whether disclaimed or not) is less likely to be taken as an indication of the origin of the goods or services, and it is therefore usually appropriate to **pay less attention to it** than to the distinctive feature(s), when comparing marks. To that extent a descriptive tinge may limit a proprietor's rights.

Magdalena Securities (1931) 48 R.P.C. 477 at p. 486 (also known as the Ucolite case)

“I think it is true to say that when a registered trade mark...has a descriptive tinge the Courts are rather averse to allowing that fact to tend to become a kind of monopoly in respect to the descriptive character of the word.”

Thus, the distinctiveness of the mark in question could affect the outcome when comparing the similarity of the marks. In the case of *Newmans Chocolates Ltd v Société Des Produits Nestlé SA (TM No. T99/13086J)*, the Registrar considered the level of distinctiveness of the mark in question for the purpose of determining whether another, in comparison, was confusingly similar. The Registrar stated that,

“The more distinctive the first mark, for example, if it is an invented word like KODAK, the easier it is to find that a similar sounding or looking mark, for example PODAK, is confusingly similar. But if the earlier mark is not very distinctive, for example, BABYDRY, it would be more difficult to find that another mark, for example, BABYSMOOTH, is confusingly similar.”

In that case, the marks were MILKY BEAR (Applicant’s Mark) and MILKY BAR (Opponent’s Mark) and both marks were in respect of confectionery products. The Registrar said,

“One may expect when buying chocolates with the words MILKY BAR on them that the chocolates may contain milk and may be in a shape of a bar. This is similar to the assessment of the Applicants’ mark MILKY BEAR - that the consumer may expect to get chocolates which contain milk which may be in the shape of a bear.”

In making the decision that the marks were not confusingly similar, the Registrar considered that,

“one relevant factor is that MILK, which is the prefix in both marks, is commonly used in the chocolate market. Having considered that the Opponents’ mark contains descriptive elements, and that the descriptive component is common in the market, the distinctive components are sufficient to distinguish the Applicants’ mark

MILKBEARS from the Opponents' mark MILKY BAR. The overall impression is that is that MILKY BAR and MILKBEARS are not similar."

(8) Type of customer

Crook's Application (1914) 31 R.P.C. 79

A trade mark should not be barred from registration because "*unusually stupid people, fools or idiots would be deceived*".

Australian Woollen Mills Ltd v F. S. Walton & Co Ltd (1937) 58 CLR 641

"The usual manner in which ordinary people behave must be the test of what confusion or deception may be expected. Potential buyers of goods are not to be credited with any high perception or habitual caution. On the other hand, exceptional carelessness or stupidity may be disregarded. The course of business and the way in which the particular class of goods are sold gives, it may be said, the setting, and the habits and observation of men considered in the mass affords the standard."

(9) Type of goods and services

The nature of the goods and the market through which they will be purchased will affect the care with which purchasers will view trade marks on goods which they select. Generally the more expensive the items being considered the less likely the purchaser will be deceived or confused by the similarities between the trade marks under which they are sold. Similarly, highly technical goods would probably be purchased only by persons who would not be deceived by somewhat similar trade marks. On the other hand, goods such as soaps would be purchased by a large number of people who might well be deceived by receiving goods bearing a similar trade mark.

The same principles would apply to services. A similar trade mark used in respect of shoe repair services provided by different enterprises is more likely to be a source of confusion than if the services were specialist medical services.

Where the goods are pharmaceutical lines available only on prescription, this may be a factor in concluding that there is less likelihood of confusion.

(10) Trade marks in a foreign language

Whether the trade marks being compared are both rendered in Roman characters or in the letters or characters of any system of writing, such as Arabic or Chinese, the usual tests for comparing word trade marks are to be applied in deciding whether the words rendered in a foreign language are confusingly similar to earlier trade marks already and whether there is a reason for rejection under Section 8(2).

The visual or aural comparisons described in, *Pianotist Co's Application (1906) 23 R.P.C. 774* should be made, together with considerations as to the nature of the goods or services specified and the way in which they are marketed. Most importantly, the Registrar will make an assessment of the **likelihood that the ordinary purchasers of the goods or services will understand the meaning of the foreign words constituting the trade mark.** This will vary with the nature of the particular goods or services as indicated by the following examples.

If the goods are mass marketed, for example, clothing or foodstuffs, the purchase may be made largely on the basis of visual selection. The trade mark may be part of packaging which displays other similar textual material and the purchaser may be part of the general monolingual Singaporean public. In such a case, **the meaning of the respective trade marks would be irrelevant,** so the main tests would be visual and phonetic (if verbalisation of the trade mark is possible). In so far as Arabic and Asian characters are concerned, consumers who are not literate in these languages would be expected to pay greater attention to the graphics involved.

Newspapers, books and similar publications, or professional services, such as medical or legal services, for which a trade mark comprised wholly of a foreign language is to be used, are unlikely to be purchased by the general Singaporean public. They will **be targeted towards a particular sector familiar with that language.** The **meaning of the word or words comprising the trade mark must therefore be taken into account,** as well as the visual and phonetic similarities. If the meanings are quite different, it is much less likely that visual or phonetic similarities will lead to deception.

If the goods or services are very specialised and/or expensive, considerable care would be exercised in their selection and purchase. In such circumstances, even minor differences between trade marks might serve to differentiate the goods or services.

When the comparison is between a foreign language trade mark and an English trade mark, the same principles apply. In general, except where the words are visually or aurally similar, the English equivalent of a foreign language trade mark will not be cited as the basis for rejecting an application under Section

8(2). For example, RED MAN will not be cited against ROUGE HOMME or the Chinese or Arabic characters meaning "red man".

(11) Identify the distinguishing or essential features in composite marks and take note of features which strike the eyes and stay fixed in recollection.

(12) Consider the possibility of contextual confusion. In comparing two word marks, it is necessary to consider them in the context of verbal orders for goods ordered under these marks.

For example, a mark consisting of a word or words which in effect describe a particular device mark must be regarded as likely to be confused with that device and vice versa. For instance, the words **RED APPLE** could be confused with the device of a red apple.

(13) Consider the possibility of word marks being used in the plural form. Trade marks are often used by themselves when ordering goods, without any specific mention of the goods as such. In such cases, a person ordering a quantity of goods under the trade mark will often do so by simply adding a "s" to the trade mark itself. Therefore, it is necessary when comparing word marks to allow for the possibility that the marks themselves may in practice be pluralized and to consider whether this process would have the effect of enhancing the likelihood of confusion between the marks. The degree of likelihood that a mark will be used in this manner depends to a large extent on the nature of the goods themselves.

For example, it is quite likely for some to ask for 10 bars of KIT KATS, rather than 10 bars of KIT KAT chocolates.

(14) Take note that if the composite mark consists of a device and a distinctive word, the mark is likely to be referred to by the word. Words are usually more memorable, unless they are very non-distinctive. Therefore, in comparing two composite marks where devices are similar, the likelihood of confusion will be lower if the words are different.

For example, a consumer wanted to buy a pair of NIKE trainers, he would ask for them by name even through the "swoosh" device on the side of the trainers is in itself very distinctive. He would not ask for a pair of trainers with a "swoosh" device on the side.

(15) Consider the length of words as it might have an implication in comparing two marks. In a case where there are two long word marks and the difference is one letter, the likelihood of confusion will be higher. In another case where there are two three-letter word marks and the difference is one letter, the likelihood of confusion will be lower.

(ii) Are the goods or services similar?

The degree of similarity between the respective goods or services is also a relevant matter to take into account in assessing the likelihood of confusion. In determining this, the Registrar will consider all objective factors relating to the goods or services themselves.

A global assessment of the likelihood of confusion implies an interdependence between the various relevant factors. So, a lesser degree of similarity between the goods or services may be offset by a greater similarity between the marks, and vice versa (see *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc [1999] R.P.C. 117*). So also registration of a mark may have to be refused, despite a lesser degree of similarity between the goods or services covered, where the marks are very similar and the earlier mark, in particular its reputation, is highly distinctive (see *Sabel BV v Puma AG [1998] R.P.C. 199*).

The goods and services must be identical or similar before a mark may be refused under Section 8(2) of the Trade Marks Act. There can be no application of Section 8(2) if the goods or services are not sufficiently alike as to be “similar” within the meaning of the provision, irrespective of the likelihood of confusion.

In *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc [1999] R.P.C. 117*, in considering the similarity of goods or services, it is appropriate to take into account both objective considerations and the degree of distinctiveness of the earlier mark, including in particular its reputation. So it may be permissible to consider goods or services to be similar in relation to particularly distinctive marks when such goods or services would not be considered to be similar in relation to other less distinctive marks.

Resolutions of the issue may require evidence directed to the position as at the date of application.

(1) Comparison of goods and services

The principles used to determine whether there is similarity in the goods and services can be found in the case of *British Sugar Plc v James Robertson & Sons Ltd [1996] R.P.C. 281*. The factors to be considered are the uses, the users, the physical nature of the relevant goods or services, the trade channels through which the goods or services reach the market, and the extent to which the respective goods and services are in competition with each other.

Thus, in deciding whether the goods are similar, the following factors will be considered:

- the nature and characteristics (or composition) of the goods;
- the respective uses to which the goods will be put;
- the users of the goods;

- the trade channels through which the goods are respectively bought and sold;
- the origin of the goods;
- the purpose of the goods;
- whether the goods are usually produced by one and the same manufacturer;
- whether the goods are distributed by the same wholesale houses;
- whether the goods are sold in the same shops, over the same counter (if sold in self service outlets, whether they will be positioned on the same shelves), during the same season and to the same class or classes of customers;
- whether those engaged in the manufacture and distribution of the goods are regarded as belonging to the same trade; and
- the extent to which the respective goods are competitive.

Examples

- (a) “Organic fertilizers” are similar goods to “chemicals used in horticulture and forestry” since they have a similar function and are likely to be sold in the same shops.
- (b) “Wines” are similar to “whisky” since people would think that the supplier of one was engaged in the supply of the other.
- (c) “Coffee, tea and cocoa” are similar to “coffee substitutes” as they are intended for the same use.
- (d) “Skin care, sun care and hair care preparations; perfumery, essential oils, soaps” are similar to “perfumes; cosmetics; non-medicated toilet preparations; soaps; shampoos; preparations for the hair; dentifrices; anti-perspirants; deodorants for personal use”
- (e) “Rectifiers and power conversion equipment” are similar to “Electric and electronic apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; recording disc; mechanisms for coin operated apparatus; calculating machines, data processing apparatus; computers”
- (f) “Stereophonic sound reproducing apparatus, headphones, loud speakers, sound tape recorders, apparatus for recording magnetic tapes, apparatus for duplicating the recorded contents of magnetic tapes on to other magnetic tapes, blank audio tapes, recorded audio tapes, sound records” are similar to “Sound recording apparatus, sound recording carriers, sound recording discs, sound recording, amplifying, reproducing and transmitting apparatus, radio cassette recorders, radio cassette players, tapes, tape recorders, amplifiers, blank cassette tapes, headphones, loudspeakers” (*TKR Electronics Pte Ltd v Matsushita Electric Industrial Co. Ltd (TM No. T99/08180J)*)

- (g) In the case of *N.V. Sumatra Tobacco Trading Company v Hero (TM Opposition T00/02450H)*, the Applicant's Mark, HERO was filed in respect of "Hotel and motel services; restaurant and catering services; bar and cocktail lounge services; cafes, cafeterias, canteens, coffee shops; provision of temporary accommodation; snack bars; pub services; all included in Class 42". The Opponents' earlier identical trade marks were filed in classes 5, 29, 30 and 32 and the goods of these registrations are "food for babies and dietetic substances adapted for medical use" (goods in Class 5), "food products such as canned, preserved, dried and cooked fruits, canned, preserved and dried vegetables, jams and jellies for food, candied peels, preserves" (Class 29 goods), "honey, treacle, sauces (condiments), spices, flour and preparations made from cereals, honey and treacle" (Class 30 goods), and "syrups (not alcoholic and not medicinal), fruit juices and non-alcoholic beverages, fruit drinks, preparation for making beverages" (Class 32 goods). The Registrar, after considering the nature of the goods and services in question, found the goods and services to be dissimilar because,

"producers of food products are not usually regarded as trading in such close proximity to providers of services of the nature applied for by the Applicant such that the general public would automatically believe that food producers inevitably engage in the business of providing these services."

- (h) In the case of *JM Collective Pte Ltd v Perlini's Pte Ltd (TM Nos. T01/17732D, T00/17698G)*, the Applicants' Mark, PERLLINI in respect of "Airline travel bags, wallets, bags, satchels, purses, pocket wallets, pouches, tote bags, brief cases, key holders and cases; vanity cases [not fitted], travelling bags, portfolio cases made from leather and imitation in Class 18" and in respect of "Clothing, headgear, footwear made of leather and imitation leather, high heeled pumps, low heeled pumps, boots, sandals, classic pumps, platforms and outdoor slippers, clogs, mules, causal shoes, sport shoes", was opposed by the Opponents' Mark, PERLINI'S in respect of "Jewellery; goods in precious metals or coated therewith, not included in other classes". The Registrar opined that the test on whether the goods are similar requires more than a mere comparison of the description of the goods. The Registrar applied the principles of *British Sugar* in coming to a global assessment of the similarity of goods and ruled that there is no similarity in the goods. The Registrar considered the evidence that the Opponent's primary retail points are the exclusive stores. This evidence

"means that a person intending to buy silver products would have to actively look for the Opponent's stores. It would be impossible for the Applicants goods to be found in these shops. Further, a

person walking into the said exclusive stores would realize immediately that these were stores that sold only silver. The trade channels are very different. Customers of the Opponent are looking for fine pieces of intricate jewellery, and are likely to scrutinise the goods carefully before paying an exclusive price for the items.”

In coming to this conclusion, the Registrar looked at the question from the point of view of “persons of ordinary care and intelligence” (following the guiding principle applied by Justice Lai Kew Chai in the ***Kellogg Co. v Pacific Food Products Sdn Bhd [1999] 2 SLR 651***). The Registrar was not convinced by the proposition that leather bags, like jewellery, should also be seen as “clothing accessories” as in the Registrar’s mind, “*the Opponents goods (trinkets of jewellery) and the Applicants goods (bags, purses, clothing and shoes) are very distinct items and are different goods that are unrelated to each other*”.

The Registrar will consider the whole specification. If part of one specification consists of similar goods or services as that of another specification, the goods or services will be considered to be similar.

British Sugar Plc v James Robertson & Sons Ltd [1996] R.P.C. 281 (also known as the TREAT case)

“The protection for the earlier mark is confined by its specification (Section 12(1)(b)) and class. If the later mark would be registered in a different class to the earlier mark they are unlikely to be “identical goods”.

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade.”

*Jacob J put forward what he described as an elaboration on the old judicial test for goods of the same description (per Romer J in ***Jellinek's Application (1946) 63 R.P.C. 59***). He considered the following factors to be relevant in considering whether there is similarity in the goods or services:-*

- (a) The respective uses of the respective goods or services;*
- (b) The respective users of the respective goods or services;*
- (c) The physical nature of the goods or acts of service;*
- (d) The respective trade channels through which the goods or services reach the market;*
- (e) In the case of self-serve consumer items, where 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;
(f) 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 or different sectors.

So, in *British Sugar Plc v James Robertson & Sons Ltd [1996] R.P.C. 281*, although **Robertson's** product, which the trade regarded as a "spread" could be used as a "dessert sauce" and although **British Sugar's** product could be used as a spread, they were not considered identical goods. In doubt, the Registrar may ask the applicant to produce evidence of how the product is regarded in the trade. Where the product is placed on retailers' shelves may also be relevant.

The Registrar will also emphasize that the classifications contained in the schedules to the Trade Marks Rules are not decisive as to whether two sets of goods are 'of the same description'.

(2) Comparison of services

In deciding whether the services are similar, the following factors will be considered:

- the nature and characteristics of the services;
- the origin of the services;
- the purpose of the services;
- whether the services are usually provided by one and the same business or person;
- whether the services are provided from the same sources, in the same area or district, during the same season or in relation to the same related goods or services and to the same class or classes of customers; and
- whether the services are regarded as the same by those who provide them.

Example

“Consultancy on the organization and management of commercial and industrial businesses” would be considered similar to “assistance to industrial and commercial businesses; consultancy information, research, inquiries or business management” in that both have the same objective of the provision of specific industrial and commercial knowledge to commercial entities in the determination of their choice of business.

(iii) Is there a likelihood of confusion?

In *Sable BV v Puma AG (Case C-251/95)*, the ECJ said that the likelihood of confusion:

“depends upon numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified.

The likelihood of confusion must be appreciated globally, taking into account all factors relevant to the circumstances of the case. That global appreciation of the visual, aural or conceptual similarity of the marks in question must be based upon the overall impression given by the marks, bearing in mind in particular their distinctive and dominant components...the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.”

The ECJ concluded that the likelihood of confusion must be determined taking into account all the factors in the case. The following factors must be considered in deciding whether there is likelihood of confusion:

(1) The degree of similarity in the marks

In assessing the degree of similarity between marks, one must determine the degree of visual, aural or conceptual similarity between them and evaluate the importance to be attached to those different elements taking into account the category of goods or services in question and circumstances in which they are marketed. For example, in clothes, the visual impact is more important than aural similarity as such goods are not normally purchased on verbal request but carefully selected and inspected from a rack in a shop.

(2) The degree of similarity in the goods or services

Where either the respective marks or goods or services are identical, a finding of similarity under the other heading will probably result in a finding that there is a likelihood of confusion.

(3) Interdependence of the relevant factors

A global assessment of the likelihood of confusion requires the Registrar to be conscious of the interdependence between the degree of similarity between marks and the degree of similarity between the goods or services. A greater degree of similarity between the marks may offset a lesser degree of similarity between goods or services. Similarly, registration of a mark may be refused

despite a low degree of similarity between the goods or services covered where the marks are very similar and the earlier mark is highly distinctive.

(4) The likely perception of the marks in the minds of the average consumer

The average consumer:

- normally perceives a mark as a whole and does not proceed to analyse its various details.
- rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect recollection of them he has kept in his mind.
- level of attention likely to vary according to the category of goods or services in question and cost of the goods.
- perception will vary according to the methods by which the goods are normally purchased.

(5) The degree of distinctiveness of the earlier mark which may be the result of inherent character or reputation through use

The greater the distinctive character of the earlier mark, the greater the likelihood of confusion between the earlier and application mark. Distinctive character could be inherent or because of reputation with the public. During ex officio examination, the Registrar will only have regard to the inherent distinctive character of the earlier mark. Evidence will be required to show that the earlier mark is particularly distinctive because of its reputation with the public, and this is more appropriate to opposition or invalidation proceedings.

Conversely, the more descriptive and less distinctive the earlier mark, the less the likelihood of confusion.

(6) Who is the public

“The public” is the average consumer of the type of goods or services in question. The average consumer includes members of the trade as well as the general public.

“The public” is to be regarded as reasonably well-informed, reasonably observant and reasonably cautious. The Registrar need not take into account the carelessness or indifference of consumers.

(7) Confusion is not association

Mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 8(2), *Sable BV v Puma AG* page 224. Further, the reputation of a mark does not give grounds for presuming

a likelihood of confusion in the strict sense, *Marca Mode CV v Adidas AG*. But if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section, *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc*.

(c) Section 8(3): Where the earlier trade mark is well known in Singapore

This prevents registration of a mark which is identical with or similar to an earlier mark and which does **not** cover similar goods or services, provided that the earlier mark has a reputation. This will not be dealt with at the examination stage. It will be up to the proprietors of the earlier mark to prove reputation in opposition proceedings.

(d) Section 8(7): Prevented by rule of law or other earlier right

This prevents registration of a mark the use of which at the date of application would have been prevented by any rule of law e.g. passing off, and also because of any other earlier right, such as copyright, design right or registered design. This can only be determined on the basis of evidence filed in opposition or invalidation proceedings.

5 CITING PRACTICES

(a) How to read a similar mark search report

It is important to scroll through all the hits appearing in the similar mark search report. The report groups similar marks into three types, “conflict”, “associate” and “others”. The “others” category are usually due to Madrid Protocol applications which have been accepted by WIPO because the marks are either certification, collective or guarantee marks. This category of marks will usually appear at the bottom of the report. Hence, it is important to go through all the hits appearing in the report.

(b) Where there are potential cites but the applicant has an identical “earlier trade mark”

Where an applicant for a trade mark is also the proprietor of an earlier trade (whether pending or registered), the application need not normally have any intervening applications from different proprietors cited against it, **provided that:**

- (i) the potential cite does not have an earlier date than that of the applicant’s earlier trade mark;
- (ii) and it is beyond argument that the intervening trade mark conflicts with the applicant’s earlier trade mark;
- (iii) and there is not a further and significantly different conflict of goods or services between the latest and intervening trade marks as between the intervening trade marks and the applicant’s earlier trade mark.

For example there would normally be no need to cite application No. 2 against No. 3 in the situation set out below:-

Applicant A (No. 1)

Filing date : 1 June 2000
 Mark : MEZZEN
 Status of mark : Pending
 Goods : Hair care products

Applicant B (No. 2)

Filing date : 1 July 2000
 Mark : MEZZEN
 Status of mark : Pending
 Goods : Hair care products; skin care products

Applicant A (No. 3)

Filing date : 1 August 2000
 Mark : MEZZEN
 Status of mark : Pending
 Goods : Hair care products; soaps

N. B. Although this applies to marks which are registered **and** pending, care should be exercised if there is an action outstanding against the earlier trade mark.

Where there is a further significantly different conflict of goods or services between the applicant's latest trade mark and the intervening mark(s), the intervening mark(s) should be cited as normal. For example:-

Applicant A (No. 1)

Filing date : 1 June 2000
Mark : MEZZEN
Status of mark : Pending
Goods : Hair care products

Applicant B (No. 2)

Filing date : 1 July 2000
Mark : MEZZEN
Status of mark : Pending
Goods : Hair care products; **skin care products**

Applicant A (No. 3)

Filing date : 1 August 2000
Mark : MEZZEN
Status of mark : Pending
Goods : Hair care products; **skin care products**

In these circumstances, it may be appropriate to request for extension(s) of time via Form CM5 to suspend application No. 3 to await the outcome of the conflict between No. 1 and No. 2.

(c) Families of marks

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

However for the purposes of examination, the examiner should not assume that the mere fact that a search reveals a number of marks in the same ownership with common identical elements, means all the marks must be cited. To do so would be to assume in the prima facie that each and all of the marks in the marks are in use at the date of application and is known to the public hence resulting in confusion.

The examiner should only cite those marks, if any, that are individually confusing, on the grounds of visual and conceptual similarity. For example, company A has registered marks including TECHPRINTER, TECHCAR, TECHHOUSE and

TECHBOOK, and company B has applied for TECHCOPIER. The Registrar should only cite TECHPRINTER.

(d) Earlier trade mark registered subject to a disclaimer

Where the **only** component of the **earlier** trade mark which could be regarded as creating a similarity with a later trade mark is the subject of a disclaimer to any exclusive right, the examiner will not consider the marks to be similar enough to create a likelihood of confusion. In other words, an objection under Section 8 should not be raised in a case where the resemblance between the marks in issue is attributable to nothing more than the presence in the earlier mark of an element for which protection has been disclaimed.

(e) Trade mark with priority claim

Examiner must look at the priority date and the specification for which the priority applies to determine if there is a potential cite. Examiner of the later trade mark number (File B) will inherit the earlier trade mark number (File A) and follow up with the examination of File A.

Examiner must inform TM Registry to

- (i) route In_Queue job from Examiner of File A to Examiner of File B.
- (ii) KIV publication or registration job if File A has been accepted for registration

In addition, Examiner is required to update and inform TM Registry accordingly for file(s) that has/have been KIVed.

Some illustrations:

Example 1: Where the later application has an earlier priority date but not for the identical or similar goods:

File A

Filing date: 1 February 2003
Priority date: 15 January 2003
Priority goods: T-shirts

Mark: MEZZEN
Goods: T-shirts

File B

Filing date: 1 July 2003
Priority date: 2 January 2003
Priority goods: Footwear

Mark: MEEZZEEN
Goods: Clothing; footwear

Examiner of File B:

- (i) ascertain if File A is an identical/similar mark. If yes,
- (ii) ascertain if priority is claimed for identical/similar goods which conflict. If no, raise File A as citation.

Example 2: Where the later application has priority date for the identical or similar goods:

File A

Filing date: 1 February 2003

Priority date: -

Priority goods: -

Mark: MEZZEN

Goods: T-shirts

File B

Filing date: 1 July 2003

Priority date: 2 January 2003

Priority goods: Clothing;
footwear

Mark: MEEZZEEN

Goods: Clothing; footwear

Examiner of File B:

- (i) ascertain if File A is an identical/similar mark. If yes,
- (ii) ascertain if identical/similar goods involved which conflict. If yes, does File B claim priority for those goods which conflict?
- (iii) If yes, ask for B's priority documents
- (iv) Cite File B in File A's application, pending verification of B's claim
- (v) If verified, proceed to register File B
- (vi) If not, withdraw the citation of B's in A's application and cite A in B's application

Example 3A: Where both applications have priority dates for the identical or similar goods:

File A

Filing date: 1 February 2003

Priority date: 15 January 2003

Priority goods: T-shirts

Mark: MEZZEN

Goods: T-shirts

File B

Filing date: 1 July 2003

Priority date: 1 March 2003

Priority goods: Clothing

Mark: MEEZZEEN

Goods: Clothing; footwear

Examiner of File B:

- (i) ascertain if File A is an identical/similar mark. If yes,
- (ii) ascertain if identical/similar goods involved which conflict. If yes, does File B claim priority for those goods which conflict?
- (iii) If yes, is the priority of File B date earlier than the filing date of File A?
- (iv) No need to check File A's priority documents since Priority date of File B is later than the filing date of File A.
- (v) Cite File A in File B's application.

Example 3B: Where both applications have priority dates for the identical or similar goods:

File A

Filing date: 1 February 2003
Priority date: 15 January 2003
Priority goods: T-shirts

Mark: MEZZEN
Goods: T-shirts

File B

Filing date: 1 July 2003
Priority date: 20 January 2003
Priority goods: Clothing

Mark: MEEZZEEN
Goods: Clothing; footwear

Examiner of File B:

- (i) ascertain if File A is an identical/similar mark. If yes,
- (ii) ascertain if identical/similar goods involved which conflict. If yes, does File B claim priority for those goods which conflict?
- (iii) If yes, does File A claim priority for those goods which conflict?
- (iv) If yes, ask for Files A's and B's priority documents
- (v) Cite File A in File B's application, pending verification of A's claim
- (vi) If verified, maintain citation of A in File B
- (vii) If not, withdraw the citation of A in B's application and cite B in A's application.

6 LATE RECORDING OF APPLICATIONS WITH EARLIER RIGHTS

It is possible that an application with an earlier priority date may not be recorded on the search database when a later conflicting application is searched. This is likely to arise as a result of a priority claim on a later filed application or an earlier filed Madrid mark.

If existence of another application with an earlier filing or priority date is drawn to the Registrar's attention, the Registrar will be prepared to consider whether to refuse the proposed registration or revoke the acceptance of the application under Section 16 of the Act. The Registrar does not intend routinely to search applications more than once.

7 OVERCOMING GROUNDS OF REJECTION UNDER SECTIONS 8(1) AND 8(2)

(a) Removing the conflict of goods or services

Applications are often filed with wide specifications, over a number of classes and may include general terms which cover a wide range of goods and services. The applicant may not actually intend to trade in, or offer all the goods or services which might be covered by such wide terms and therefore may be able to be more specific about the intended activities.

(i) Positively limiting the goods or services of the application

The applicant may request an amendment under Rule 22(1) of the Trade Marks Rules which will limit the goods or services covered by the application so that it no longer covers goods or services which are similar or closely related to those of the cited application(s). This may be done by deleting goods or services from the specification as filed, or substituting a more specific list of the goods or services for which protection is required, or defining more specifically the purpose or nature of the goods or services.

Example

Class 7 application	Class 7 citation	Limitation required
Spraying machines	Agricultural machines and parts and fittings therefore	Spraying machines; all for industrial use

In this example, the applicant's area of interest is limited to "spraying machines for industrial use" but as long as the specification reads "spraying machines" without any qualification, the goods claimed are of the same description as some of the goods which are specified in the cited trade mark. Limiting the range of goods covered by the application by means of the qualification "all for industrial use" will allow the citation to be withdrawn in this example.

(ii) Excluding the goods or services which are in conflict

An applicant may attempt to overcome a citation by amending the specification to exclude goods or services which are similar or closely related to the goods or services covered by the cited application or registration. This should not be done in very general terms and the onus is on the applicant to clearly specify goods or services in the application which are not the same or similar to those of a cited trade mark. Similarly, the examiner should not accept a specification which seeks to exclude goods which are obviously not included in the positive part of the statement. For example, "Eggs and cheese, but not including butter" would not be

allowable for the obvious reason that butter is not included in the statement “eggs and cheese” and the exclusion would be clearly redundant.

The area of conflict between the specifications needs to be identified and then the relevant goods or services excluded. The exclusion required will usually be broader than the goods or services covered by the cited application or registration as it is necessary to remove any overlap which may result from the co-existence of similar and closely related goods or services.

It is the applicant’s responsibility to propose and amendments which result in limiting the specification as only the applicant will know the exact area of business interest within which the trade mark is or will be used. Examiners may assist with the wording of a proposed exclusion statement once the area of interest is defined. The usual form of exclusion uses the words “but not including” or “none being” followed by goods or services which would otherwise fall within the scope of the specification.

Example

Class 16: Articles of stationery, printed matter; but not including adhesives.

Class 17: Washing machines and spin driers; not being for domestic use.

An example where exclusions may assist in overcoming grounds for rejection under Sections 8(1) and 8(2):

Class 12 application	Class 12 citation	Exclusion required
Cycles	Motor land vehicles	Cycles but not including motorized vehicles

Proposed exclusions should be considered carefully to ensure that they do distinguish the goods and/or services. The following exclusion would **not** be allowed, since a transistor remains the same whether or not it is used in electronics or for other purposes.

Class 9 application	Class 9 citation	Unsuitable Exclusion
Electric transistors	Sound recordings and reproducing apparatus and parts and fittings therefor	“Electric transistors but not including any such goods for recording and reproducing apparatus”

It is unlikely that an exclusion of goods or services from the application will overcome a citation when the cited trade mark covers all goods in the class. In this situation, unless the applicant can influence an amendment to the specification of the cited application or registration, the application would have to be refused on the ground of similarity with the cited application or registration.

(b) Obtaining consent from the proprietor of the cited mark

(i) Letter of consent

Where the matter is being resolved between parties, the Registrar may give considerable weight to a letter of consent from the cited owner. The Registrar has the discretion to accept an application under the provisions of Section 8(9), and consent to the registration of the later application by the owner of the prior rights may fall within the ambit of these provisions. Since the parties are in a better position to gauge market realities and the likelihood of deception or confusion resulting from the use of the two trade marks, the Registrar may consider a letter of consent as persuasive of the applicant's right to registration. Each case must be considered on its merits and it is unlikely that a letter of consent alone would justify the withdrawal of a citation where the trade marks are substantially identical, the goods or services the same and the trade marks are to be used in the same markets.

Letters of consent should not contain any conditions, since the Registrar is not in a position to ensure that any conditions about the use of the trade mark are met. However, a geographical restriction to a particular state or states is acceptable provided the application is restricted to accord with this. If the specification included in the letter of consent is narrower than that required to withdraw the citation, the specification should be amended to reflect only those goods or services to which the consent applies.

The basic principles to bear in mind are that the consent must be given by the owners of the cited mark, that the application being consented to is clearly identified and that it is clear that consent to registration (and not just use) of the mark is given.

Letters of consent must include the following details:

(a) Details of the application:

1. application number
2. representation of the trade mark
3. the goods or services to which the owner of the cited mark is consenting

(b) Details of the cited trade mark:

1. application or registration number
2. representation of the trade mark

When recommending acceptance on the basis of a letter of consent, the examiner should ensure that:

1. the name of the owner supplying “consent” corresponds to the name of the data base. The letter may only be taken into account if the names are the same.
2. the signatory to the letter must be the owner of the cited mark or a person authorized to sign on behalf of that person.
3. an endorsement in the following terms should be entered at acceptance:

“By consent of the registered proprietor of TM No T00/98765A.”

“By consent of the applicant of TM No T00/98765A.”

(ii) Consent between companies in the same ownership

A general letter of consent may be provided between the two companies setting out the relationship between the two companies and confirming that they are prepared to consent to any trade mark applications made by the other party.

On each occasion that a copy of the general letter of consent is filed, the applicant, or his agent, must supply a covering letter certifying that the general consent is still valid.

(iii) Agreement between two companies to consent to the registration of each others marks

A general agreement to consent to the registration of each others trade mark applications may exist between companies which may not be in the same ownership.

If there is no letter of consent from the owners of the earlier mark(s) in respect of a later application facing a Section 8 objection, the agents acting for the applicants with the later trade mark(s) may request that a true copy of the general agreement to provide consent be considered in lieu thereof.

The party named in the agreement as undertaking to give consent must be the registered proprietor of the cited mark(s). If the applicant for registration is a successor in business to the other party to the agreement, this may be accepted provided that the agents confirm in writing that the agreement continues to apply to the applicant.

The covering letter should also state that the agreement:

- is still in force;
- relates to the registration of the marks and not just use;
- includes Singapore;
- relates to the mark applied for (the application number is sufficient); and
- covers the goods/services applied for;

- is not conditional, or if conditional, that any such conditions for giving consent are satisfied.

Additionally, the agents' covering letter should include confirmation that it has been copied to the recorded address for service for the proprietor of the earlier trade mark(s).

The agent's letter must be in unequivocal terms. Implied disclaimers such as "the agreement is still in force to the best knowledge and belief" or "my client has told me that he thinks the agreement is in force" are not acceptable.

If it is later brought to the Registrar's attention that, for whatever reason, the proprietor of the earlier trade mark is not in fact prepared to give consent, then it will be possible to re-open the matter using the Registrar's powers under Section 16 of the Act. However, matters arising after registration can only be addressed through invalidation proceedings.

In a nutshell:

- Ask for letter of consent first.
- If applicant is having difficulties in getting the letter of consent from the cited proprietor, then we will consider the co-existence agreement.
- Consider the six factors when examining the agreement.
- If the Examiner is not satisfied with the agreement (e.g. is the agreement still in force if it was signed by both parties ten years ago? The name of the proprietor as stated in the agreement is different, etc), Examiner has to clarify the issue(s) with the agent/applicant.
- If need be, Examiner may maintain the requirement of a letter of consent.

(c) Amending and changing name and address

The cited mark could belong to the applicant if there has been some amendments or changes to the name and/or address of the proprietor of the cited mark. The applicant can overcome the Section 8 objection by lodging Form CM 2 to correct or change the name or other particulars of the applicant.

(d) Filing evidence to indicate honest concurrent use

Under the provision of Section 9, an applicant can file evidence to show to the satisfaction of the Registrar that there has been honest concurrent use in the course of trade in Singapore of the trade mark for which registration is sought.

If the Registrar is satisfied that the evidence has established honest concurrent use, the Registrar will accept the trade mark for publication.

An endorsement in the following terms will be entered at acceptance:

“Proceeding under honest concurrent use with trade mark registration number T00/98765A.”

“Proceeding under honest concurrent use with trade mark application number T00/98765A.”

However, even though the trade mark is accepted for publication in the Trade Marks Journal, the proprietor of any earlier mark (including the proprietor of the cited mark) still has the right to oppose the registration of the trade mark. Acceptance by the Registrar of the trade mark on the basis of honest concurrent use therefore does not guarantee registration.

Form of evidence

Evidence must be presented in the form of a Statutory Declaration.

The declaration should, preferably, be typed. Further, the declaration and any exhibits must be sworn before a person authorised to administer oaths, such as a commissioner for oaths or notary public.

Please refer to Appendix 2 of the chapter on “Evidence of distinctiveness acquired through use” for details in preparing a Statutory Declaration.

Establishing honest concurrent use

To establish “honest concurrent use” the applicant should file evidence showing that his use of the trade mark is in accordance with honest practices in industrial or commercial matters.

The evidence should as far as possible include the following:

- The date of first use of the trade mark (prior to date of application) in Singapore;
- Evidence showing the extent of use of the trade mark on the goods and/or services applied for i.e. the length of use of the trade mark in Singapore, the volume of goods sold or services offered;
- The period of concurrent use of the trade mark with the cited mark;
- Evidence of use of the trade mark overlapping with the use of the cited mark;
- Sales turnover pertaining to the goods and/or services claimed for;
- Advertising and promotional expenses pertaining to the goods and/or services claimed for;
- Opinion polls, statements from industry players, surveys (e.g. market surveys on end-consumers, or trade surveys on industry players);
- An explanation of how the applicant came to adopt the trade mark;
- Whether the applicant was aware of the existence of the cited mark;
- Whether the applicant genuinely believed that the use of his trade mark would not cause confusion in the public;

- Information about any actual instances of confusion that the applicant is aware of having occurred between its mark and the cited mark.

Assessing whether honest concurrent use is made out

Was the use “honest”?

It is essential that the concurrent use be honest. The applicant bears the responsibility of establishing that he has been honest in his use of the trade mark.

Depending on the facts of the case, concurrent registration may not be granted to an applicant who wholly reproduced the cited mark as his own trade mark, or adopted the mark knowing that it is very similar to the cited mark and persisted in doing so.

It is to be borne in mind that knowledge of the cited mark does not automatically mean that the applicant was dishonest in use of his trade mark. As long as there is no reason to doubt the honesty of the applicant, a statement within the statutory declaration giving a satisfactory account of the adoption of the trade mark is sufficient proof of honesty.

How long must the honest concurrent use be for?

The length of time of honest concurrent use indicates how long the consumers have been exposed to both the applicant’s trade mark and the cited mark in the marketplace. Therefore, the longer the use, the longer the exposure, the stronger the applicant’s case will be.

While there is no specific law setting a minimum time frame, in practice, the applicant should show honest concurrent use of at least 5 years before the date of application of his trade mark.

Use after the date of application will not assist in overcoming the objections.

Honest concurrent use over a shorter period of time may still be persuasive if there is extensive use of the applicant’s trade mark.

What is the scope of the use?

The exhibits must show use of the applicant’s trade mark in respect of the goods or services (whichever applicable) which is in conflict with the goods or services of the cited proprietor.

Exhibits showing use of the applicant’s trade mark on goods or services which are not in conflict will not assist in overcoming the objections.

Is it necessary to show that there are no instances of actual confusion?

It is not necessary to show that there are no instances of actual confusion the marketplace as to the origin of the applicant's goods as a result of the overlap of the applicant's trade mark with the cited mark.

In any case, whether there were instances of actual confusion would be alleged by an opponent in opposition proceedings, and not in the examination of the application.

(e) Awaiting expiry of the cited mark

A trade mark shall be registered for a period of ten years from the date of registration. Registration may be renewed at the request of the proprietor for further periods of ten years. If a registered trade mark is not renewed, it will be removed from the register. Any objection raised base on this registered trade mark will be waived in the event that the mark is removed from the register.

(f) Negotiating with owner of the cited mark

An applicant who is advised of a ground for rejection under Section 8 may choose to enter into negotiations with owner of the cited application or registration. Since the potential for negotiation can only be assessed by the applicant, and the Registrar must remain impartial in matters relating to the rights of trade mark owners, this is **not a course of action which the examiner should propose**. The outcome of such negotiations might be one of the following.

(i) Amendment of the cited application or registration

In order to overcome grounds for rejection under Section 8 an applicant may seek to negotiate with the owner of the cited trade mark to amend the goods or services of the cited mark. If agreeable, the cited owner will apply to amend the specification of goods or services under the provisions of Rule 22(1) of the Trade Marks Rules in the case of a pending application, and Rule 61(1)(b) in respect of a registered trade mark. The amendment of the specification in the cited registration and, if necessary, in the application, must be clear and unambiguous.

(ii) Cancellation of the cited mark

Seeking voluntary cancellation of a registered trade mark is a method of overcoming citations which is open to the applicant, but which should **not** be suggested by the examiner as he or she is unaware of the commercial circumstances surrounding the use or otherwise of the cited trade mark. If agreeable, the cited owner will apply to cancel the registered trade mark according to the provisions of Rule 61(1)(a).

(iii) Assignment of the application or the cited mark

The grounds for rejection under Section 8 may be removed if the owners of the application and the cited trade mark come to an agreement where one will buy the trade mark from the other or if for some reason there is a transfer of ownership of the trade mark. An application to record the assignment or transfer must be made under Rule 55(1)(a) of the Trade Marks Rules. This can apply to pending or registered citations, and may involve a partial assignment if the conflict between the trade marks only to some of the classes nominated. The applicant must notify the Registrar when this has been actioned.

(iv) Revocation of the cited mark

The applicant may seek to revoke the registration of a cited mark if the applicant is of opinion that

- within the period of five years following the date of completion of the registration procedure, the cited trade mark has not been put to genuine use in the course of trade in Singapore, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use; or
- such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use.

(v) Invalidity of the cited mark

The applicant may apply to have the mark declared invalid to overcome the Section 8 objection.

(g) Additional information

Objections raised under Section 8 **CANNOT** be overcome by:

(i) Prior use

An applicant claiming to have used his mark prior to the date of application of a pending cite cannot expect his mark to proceed to publication in preference to the cited mark, by reason of “*prior use*”.

The mark with the earliest application date or earliest priority date proceeds to publication and it is then up to the other applicant to oppose it.

(ii) Amendment to the representation of the mark

An applicant cannot amend his mark so as to remove that part of it which is similar to the cited mark. Section 14 of the Act does not permit amendments to mark except under very limited circumstances.