

## **RELATIVE GROUNDS FOR REFUSAL OF REGISTRATION**

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5.2.5.4.3	No conceptual similarity is not the same as conceptually dissimilar	
	35	
5.2.6	Earlier trade mark registered subject to a disclaimer.....	35
5.2.7	Conclusion on similar marks.....	36
5.3	Comparing the goods or services .....	36
5.3.1	Reading the specification of goods and services .....	36
5.3.2	Identity of the goods or services .....	36
5.3.3	Similarity of the goods or services .....	37
5.3.3.1	Does the class of the goods or services matter?.....	37
5.3.4	Conclusion on similarity of the goods or services .....	38
5.4	Likelihood of confusion.....	38
5.4.1	Two types of confusion .....	38
5.4.2	Mere association does not equate to confusion.....	39
5.4.3	Substantial portion of the consumers must be confused .....	39
5.4.4	Permissible extraneous factors to consider .....	39
5.4.4.1	Factors relating to the impact of marks-similarity on consumer perception .....	39
5.4.4.2	Factors relating to the impact of goods-similarity on consumer perception .....	40
5.5	Family of marks.....	42
6	CITING PRACTICES .....	44
6.1	Where the conflicting marks have the same filing date or priority date .....	44
6.2	Where there is a conflicting mark but the applicant has an identical “earlier trade mark” .....	44
6.3	Late recording of applications with earlier rights .....	46
7	OVERCOMING GROUNDS FOR REFUSAL UNDER SECTIONS 8(1) AND 8(2).....	47
7.1	Methods that may overcome objections under section 8.....	47
7.1.1	Removing the conflicting goods or services .....	47
7.1.1.1	Positively limiting the goods or services of the application.....	47
7.1.1.2	Excluding the goods or services which are in conflict .....	48
7.1.1.3	Withdrawal of class(es).....	49
7.1.2	Obtaining consent from the proprietor of the cited mark.....	49
7.1.2.1	Letter of consent.....	49
7.1.2.2	Consent between companies in the same parent ownership.....	50

7.1.2.3	Agreement between two companies to consent to the registration of each other's marks .....	51
7.1.3	Where the earlier mark belongs to the applicant but IPOS' records do not indicate as such .....	52
7.1.4	Division of the application .....	52
7.1.5	Awaiting the expiry of the cited mark .....	52
7.1.6	File evidence to indicate honest concurrent use .....	53
7.1.6.1	Assessing whether honest concurrent use is made out .....	53
7.1.6.2	Establishing honest concurrent use.....	54
7.1.6.3	Form of evidence of honest concurrent use.....	54
7.1.6.4	Evidence of honest concurrent use is satisfactory .....	55
7.1.7	Other methods which may overcome the citation(s) .....	55
7.1.8	Initiating proceedings against the cited mark.....	56
7.2	Methods that cannot overcome objections under section 8 .....	56
7.2.1	Amending the representation of the subject mark .....	56
7.2.2	Where the cited mark's proprietor is a corporate entity, evidence of its dissolution or non-existence.....	56
7.2.3	Written submissions.....	56
7.2.3.1	Co-existence of other marks on the trade marks register.....	57
7.2.3.2	Co-existence of the subject mark and the cited mark in overseas trade mark registers .....	57
7.2.3.3	Global appreciation approach.....	57
7.2.3.4	Alleging that the cited proprietor uses (or intends to use) the mark only in respect of some goods/services, industries, or groups of consumers etc.....	58
7.2.3.5	Opportunity for the cited mark's proprietor to oppose the subject mark during publication .....	58
7.2.3.6	Prior use .....	58

## **1 INTRODUCTION**

“Relative grounds for refusal of registration” refers to the grounds for refusing the registration of a trade mark due to conflict with another party’s earlier trade marks or other earlier rights.

This chapter deals with the relative grounds for refusal that may apply during the course of examining a trade mark application.

## 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;

"international trade mark (Singapore)" has the meaning given to it under section 54;

"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;

"register" means the register of trade marks maintained by the Registrar under section 66;

"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;

...

**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.
- ...
- (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.
- ...
- (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.

...

#### **Revocation of acceptance**

**16.**—(1) Notwithstanding section 15(1), if, before a trade mark is registered, the Registrar is satisfied —

- (a) that the application for registration of the trade mark was accepted because of an error or omission in the course of the examination; or
- (b) that, in the special circumstances of the case, the trade mark should not be registered,

the Registrar may revoke the acceptance of the application.

(2) If the Registrar revokes the acceptance —

- (a) the application is taken to have never been accepted; and
- (b) section 12 again applies in relation to the application.

...

#### **Cancellation of registered trade mark**

21.—(1) A registered trade mark may be cancelled by the proprietor in respect of some or all of the goods or services for which it is registered.

...

**Revocation of registration**

22.—(1) The registration of a trade mark may be revoked on any of the following grounds:

- (a) that, within the period of 5 years following the date of completion of the registration procedure, it 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;
- (b) that such use has been suspended for an uninterrupted period of 5 years, and there are no proper reasons for non-use;
- (c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for the product or service for which it is registered;
- (d) that, in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

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

(3) The registration of a trade mark shall not be revoked on the ground mentioned in paragraph (a) or (b) of subsection (1) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the 5 year period and before the application for revocation is made.

(4) Any commencement or resumption of use referred to in subsection (3) after the expiry of the 5 year period but within the period of 3 months before the making of the application for revocation shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

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

(7) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from —

- (a) the date of the application for revocation; or
- (b) if the Registrar or the Court is satisfied that the grounds for revocation existed at an earlier date, that date.

...

## 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.

(4) The registration of a trade mark may be declared invalid on the ground of fraud in the registration or that the registration was obtained by misrepresentation.

...

(7) An application for a declaration of invalidity of the registration of a trade mark on the ground that there is an earlier trade mark in relation to which the conditions set out in section 8(3) or (4) apply —

- (a) shall not be made after the expiry of 5 years from 1st July 2004 or the date of completion of the registration procedure, whichever is the later, unless the applicant for the declaration shows that —
  - (i) the registration of the later trade mark was applied for in bad faith; or
  - (ii) the later trade mark was never used; and
- (b) shall not be granted if the registration of the later trade mark was applied for before the earlier trade mark became well known in Singapore, unless the applicant for the declaration shows that the registration of the later trade mark was applied for in bad faith.

(8) In deciding whether the registration of the later trade mark was applied for in bad faith, it shall be relevant to consider whether the applicant for the registration of the later trade mark had, at the time his application was made, knowledge of, or reason to know of, the earlier trade mark.

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

(10) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made, but this shall not affect transactions past and closed.

**Effect of acquiescence**

**24.**—(1) Where the proprietor of an earlier trade mark or other earlier right has acquiesced for a continuous period of 5 years in the use in the course of trade of a registered trade mark in Singapore, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other right —

- (a) to apply for a declaration that the registration of the later trade mark is invalid; or
- (b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used,

unless the registration of the later trade mark was applied for in bad faith.

(2) Where subsection (1) applies, the proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark or, as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trade mark or right may no longer be invoked against his later trade mark.

(3) For the purposes of subsection (1), in deciding whether the registration of the later trade mark was applied for in bad faith, it shall be relevant to consider whether the applicant for the registration of the later trade mark had, at the time his application was made, knowledge of, or reason to know of, the earlier trade mark or other right.

...

**Rights conferred by registered trade mark**

**26.** —(1) The proprietor of a registered trade mark has the exclusive rights —

- (a) to use the trade mark; and
- (b) to authorise other persons to use the trade mark,

in relation to the goods or services for which the trade mark is registered.

(2) The proprietor has the right to obtain relief under this Act for infringement of his trade mark.

...

(5) If the trade mark is registered subject to any disclaimer or limitation, the rights of the proprietor are restricted by the disclaimer or limitation.

...

**Registration subject to disclaimer or limitation**

**30.**—(1) An applicant for registration of a trade mark, or the proprietor of a registered trade mark, may —

- (a) disclaim any right to the exclusive use of any specified element of the trade mark;
- or

- (b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation.

(2) Where the registration of a trade mark is subject to a disclaimer or limitation, the rights conferred by section 26 are restricted accordingly.

...

#### **Power to make provision giving effect to Madrid Protocol, etc.**

**54.—**

(4) For the purposes of this section —

“international trade mark (Singapore)” means a trade mark which is entitled to protection in Singapore under the Madrid Protocol or a trade mark prescribed by the Minister as an international trade mark (Singapore);

“Madrid Protocol” means the Protocol relating to the Madrid Agreement concerning the International Registration of Marks, adopted at Madrid on 27th June 1989, as revised or amended from time to time.

### **Trade Marks Rules**

#### **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.

...

#### **Publication of application**

**26.—**(1) An application which has been accepted for registration shall be published in the Trade Marks Journal during such times and in such manner as the Registrar may direct.

(2) In the case of an application with which the Registrar proceeds only after the applicant has lodged the written consent to the proposed registration of the proprietor of, or the applicant for the registration of, another trade mark, the words “By Consent” and the number of that other mark shall appear in the publication.

...

#### **Notice of opposition**

**29.**—(1) A person (referred to in this Division as the opponent) may, within 2 months after the date of publication of the application for registration, file with the Registrar a notice opposing the registration in Form TM 11 (referred to in this Division as a notice of opposition).

...

(3) A request for an extension of time to file the notice of opposition —

- (a) must be made by filing with the Registrar Form TM 48 within 2 months after the date of the publication of the application for registration; and
- (b) must state —
  - (i) the reason for the extension; and
  - (ii) the name and address of every person likely to be affected by the extension.

...

(4) The total extension of time for which the Registrar may allow to file the notice of opposition shall not exceed 4 months after the date of the publication of the application for registration.

...

**Registration subject to disclaimer or limitation**

**43.** Where the applicant for registration of a trade mark by notice in writing sent to the Registrar, or the proprietor of a registered trade mark by Form TM 27 filed with the Registrar —

- (a) disclaims any right to the exclusive use of any specified element of the trade mark; or
- (b) agrees that the rights conferred by the registration shall be subject to a specified territorial or other limitation,

the Registrar shall make the appropriate entry in the register.

...

**Request for extension of time**

**77.**—(1) Subject to paragraph (6), any period of time —

- (a) prescribed by these Rules; or
- (b) specified by the Registrar for doing any act or taking any proceedings,

may, at the request of the person or party concerned, be extended by the Registrar by such period and upon such terms as the Registrar considers fit.

...

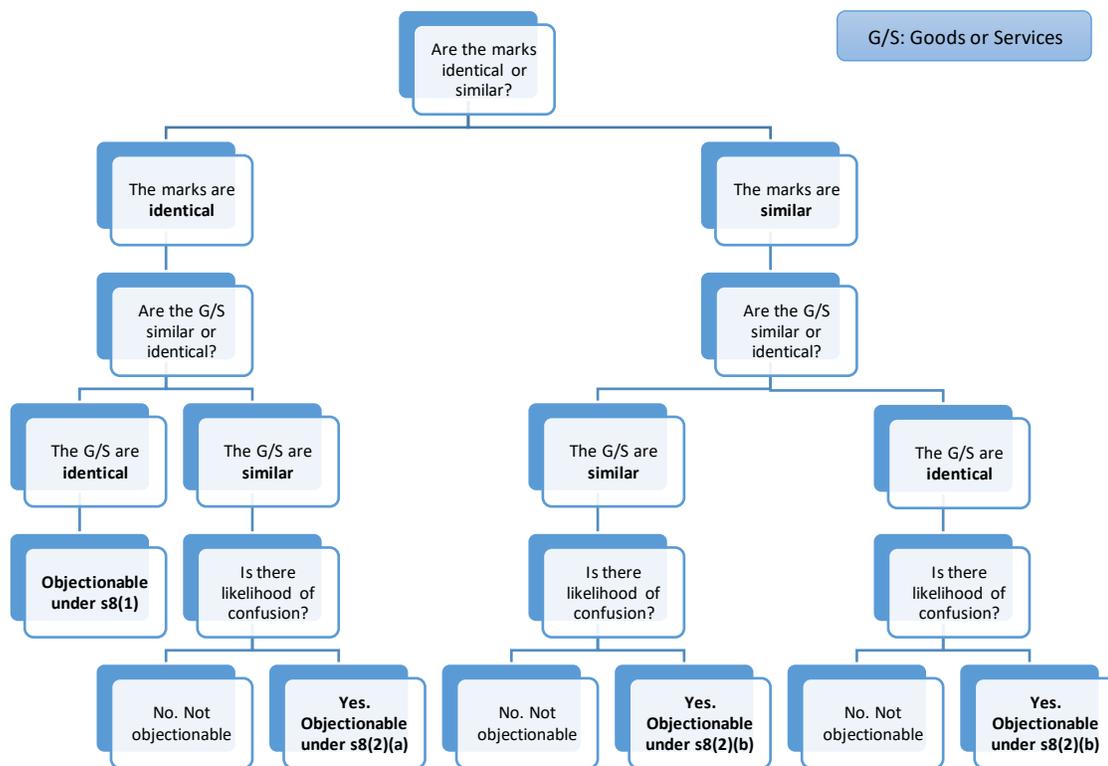
(2) The Registrar may refuse to grant an extension of time if the person requesting the extension —

- (a) fails to show a good and sufficient reason for the extension;

### 3 OVERVIEW

The Trade Marks Act provides that a trade mark shall not be registered if it conflicts with an earlier trade mark in scenarios such as the following:

- (a) The marks and the goods and/or services are identical (section 8(1)); or
- (b) The marks are identical or similar and the goods and/or services are identical or similar, and there exists a likelihood of confusion on the part of the public (section 8(2)(a) or section 8(2)(b)).



#### 4 MEANING OF AN “EARLIER TRADE MARK”

Objection to the registration of a trade mark under section 8 can only be taken if the conflicting mark is an “earlier trade mark” defined under section 2(1).

For the purpose of examining a trade mark application under section 8, an earlier trade mark is a trade mark with an earlier date of filing or priority date than the trade mark under examination (the subject mark). For more information on “priority”, please refer to the Trade Marks Work Manual’s section on “Priority Claims”.

The examiner will conduct a search of the register for potential conflicting marks with an earlier date of filing or priority.

The examiner will consider marks with the following statuses as potential citations under section 8 of the Trade Marks Act:

- Marks that are registered
- Marks that are under examination
- Marks that are published but not yet registered
- Marks whose registration expired for one year or less
- Marks that are treated as withdrawn and pending reinstatement to the register

The Registry’s citation practices will be further elaborated in Part 6 “Citing Practices”.

## 5 CONFLICT WITH EARLIER TRADE MARKS

### 5.1 Step-by-step approach

The approach adopted in Singapore in relation to an objection under sections 8(1) and 8(2) of the Trade Marks Act is known as the step-by-step approach. This approach has been endorsed by the courts including the Court of Appeal in *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2006] 2 SLR(R) 690 (“*Polo (CA)*”) and *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another and another appeal* [2014] 1 SLR 911 (“*Staywell*”).

There are three elements under the step-by-step approach:

1. Similarity of marks

The first step is to assess whether the marks, when observed in their totality, are identical or similar.

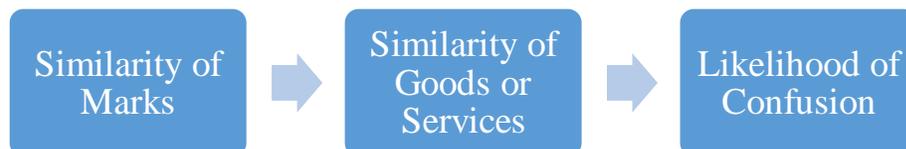
2. Similarity of goods or services

The second step is to assess whether the goods or services in relation to which the marks are applied on are identical or similar.

3. Likelihood of confusion

The third step is to consider whether there exists a likelihood of confusion on the part of the public due to these similarities.

The three elements are assessed sequentially. Each element has to be satisfied before moving on to the next step. This means that the second step of assessing the similarity of the goods or services will proceed only if there is identity or similarity between the marks. In the same vein, if either of the first two conditions is not satisfied, there is no need to go into the third step of determining whether there exists a likelihood of confusion.



## 5.2 Comparing the marks

In the first step of the step-by-step approach, the marks are assessed to determine if they are identical or similar.

### 5.2.1 Mark-for-mark

The assessment of marks similarity is “mark-for-mark”, without consideration of any external matter. This means that the marks are to be compared as they are applied for or registered, and not how they are actually being used in the marketplace.

When there are multiple earlier marks to be compared against the subject mark under examination, each of the earlier marks must be compared separately and independently of the subject mark. The multiple earlier marks cannot be combined to form a single composite mark which is then used to be compared with the subject mark (see *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] 5 SLR 618 (“*Rovio Entertainment (HC)*”) at [70]). This is consistent with the principle that one should not consider extraneous matter at the marks-similarity stage.

### 5.2.2 The average consumer

In the comparison of marks, the viewpoint should be that of the average consumer of the relevant goods and/or services. The average consumer is one who would exercise some care and a measure of good sense in making his or her purchases, not that of an unthinking person in a hurry (see *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 (“*Hai Tong*”) at [40]).

The average consumer may vary depending on the nature of the goods and/or services in question. It is also possible to have more than one group of average consumers. The degree to which persons are involved in selecting a product for the end-use will determine whether these persons are considered as part of the “average consumers”, for example, people who deals with the distribution of the goods (see *Allergan, Inc. v Ferlandz Nutra Pte Ltd* [2016] SGHC 131 at [79].)

It is to be borne in mind that the average consumer has imperfect recollection. That is, the consumer often makes a comparison from memory removed in time and space from the marks. Hence, the earlier mark and the subject mark should not be compared side by side and examined in detail for the sake of isolating particular points of difference (see *Hai Tong* at [40(d)] and [62(a)]).

### 5.2.3 Identical marks

The test of whether a mark is “identical” with another mark under section 8(1) entails a strict interpretation, where minor differences would take the case outside of the definition of “identical” (see *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 (“*City Chain*”) at [39]).

Such a strict approach is taken because once the marks are found to be identical and the goods and/or services are also determined to be identical, there is no need to establish a likelihood of confusion on the part of the public which is the case under section 8(2) and will be elaborated upon later.

The following cases illustrate the approach that will be taken:

Subject mark	Earlier mark	Elaboration
“intuition”	“INTUITION”	The same words in plain font are considered identical despite the difference in letter case.  <i>Intuition Publishing Ltd v Intuition Consulting Pte Ltd</i> [2012] SGHC 149 at [24], citing the decision of <i>Ferrero SPA v Sarika Connoisseur Cafe Pte Ltd</i> [2011] SGHC 176 (“ <i>Sarika (HC)</i> ”) at [58].
“INTUITION CONSULTING”	“INTUITION”	Not identical.  The subject mark has the additional word “CONSULTING”.  <i>Intuition Publishing Ltd v Intuition Consulting Pte Ltd</i> [2012] SGHC 149 at [25].
“Origin”	“Origins”	Not identical.  The subject mark “Origin” is not identical to the earlier mark “Origins” because of the omission of the letter “s”.  <i>Origins Natural Resources Inc v Origin Clothing Ltd</i> [1995] FSR 280; cited as an example in <i>Polo (CA)</i> at [21].

#### 5.2.4 Distinctiveness

Distinctiveness is a factor integrated into the visual, aural and conceptual analysis of the competing marks in order to determine whether they are similar.

“Distinctiveness” in this regard has two different shades of meaning and they are elaborated below:

- Distinctiveness in the ordinary (non-technical) sense:

This refers to what is outstanding and memorable about the mark. Components of a mark which are distinctive in the ordinary and non-technical sense are those which tend to draw the consumers' attention, bearing in mind the imperfect recollection of the average consumer. These distinctive (in the ordinary sense) and memorable components of the mark stand out in the consumer's imperfect recollection. Hence, special regard may be placed on the distinctive or dominant components of a mark, even while the examiner assesses the similarity of the two marks as composite wholes (see *Staywell* at [23]).

- Distinctiveness in the technical sense:

This refers to the capacity of a mark to serve as a badge of origin. Distinctiveness can be inherent, usually where the words comprising the mark are meaningless and can say nothing about the goods or services; or acquired, where the words that do have a meaning and might well say something about the good or services, yet come to acquire the capacity to act as a badge of origin through long-standing or widespread use (see *Staywell* at [24]).

A mark which has greater technical distinctiveness enjoys a high threshold before a conflicting mark will be considered dissimilar to it (see *Staywell* at [25]). In other words, the more distinctive the earlier trade mark, the more it is necessary to show sufficient alterations to, or difference in the later mark in order that it may not be held to be similar to the earlier mark (see *Sarika Connoisseur Café Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 (“*Sarika (CA)*”) at [20]).

One should bear in mind that while the components of a mark may be inherently technically distinctive, ultimately the ability of the mark to function as a strong badge of origin must be assessed by looking at the mark as a whole. Conversely, the components of a mark may not be inherently distinctive, but the sum of its parts may have sufficient technical distinctiveness (see *Staywell* at [25]).

When assessing the similarity of marks, the degree of distinctiveness of the various components of the earlier mark and of the later mark must be considered. The purpose of analysing the components is to determine whether the marks coincide in a component that is distinctive, non-distinctive or weak and in order to assess the extent to which these coinciding components have a lesser or greater capacity to indicate commercial origin. This recognises that the consumer is more likely to consider that a non-distinctive or weak element of a mark is not being used to identify a particular trader, and thus not being used to distinguish goods or services of one trader from those of another.

In *Apple Inc. v Xiaomi Singapore Pte Ltd* [2017] SGIPOS 10 (“*Xiaomi*”), the competing marks, “IPAD” and “MI PAD”, shared the same component “pad”, which the relevant public understands is a synonym for “tablet computers” and has a descriptive meaning in relation to goods and services which are linked to tablet computers. Accordingly, the Hearing Officer found that “Pad” was less likely to be regarded as the dominant or distinctive element of the “IPAD” and “MI PAD” marks.

Instead, the Hearing Officer was of the view that the distinctiveness of the “IPAD” mark resided in the I-prefix and that the elements “I” and “PAD” are conjoined to form a single invented word. On the other hand, the dominant and distinctive component of the “MI PAD” mark was “MI”. Hence, notwithstanding that “MI PAD” contained all the letters of the “IPAD” mark in the same sequence, “MI PAD” does not capture the distinctiveness of the “IPAD” mark.

## 5.2.5 Similar marks

### 5.2.5.1 Visual, aural and conceptual similarities

The earlier mark and the subject mark are to be compared for any visual, aural and conceptual similarities, by reference to the overall impressions of the marks, bearing in mind their distinctive and dominant components.

However, these three aspects of similarities are merely signposts to guide the marks similarity inquiry. There is no requirement that all three aspects of similarity must be made out before the marks can be found to be similar, and trade-offs can occur between the three aspects (see *Staywell* at [18]).

At the marks-similarity stage, the relative weight and importance of each aspect of similarity (that is, visual, aural and conceptual similarities) having regard to the goods or services, is not considered. Rather, this would be a matter reserved for the confusion stage of the step-by-step approach (see *Staywell* at [20]).

As stated earlier, one should bear in mind that ultimately the conclusion to be reached is whether the marks, when observed in their totality, are similar rather than dissimilar (see *Staywell* at [17] and *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 (“*Caesarstone (CA)*”) at [27]).

Further elaboration of how visual, aural and conceptual similarities are assessed can be found in the later parts of this chapter.

### 5.2.5.2 Visual Similarity

Visual similarity deals with the appearance of the marks. It is to be assessed by examining each of the marks in question as a whole, bearing in mind their dominant and distinctive components and by reference to the overall impressions created by the marks.

The following are some considerations to note in assessing visual similarity.

#### 5.2.5.2.1 Substantial reproduction does not equate to visual similarity

The High Court in the case of *The Polo/Lauren Co LP v United States Polo Association* [2016] 2 SLR 667 (“USPA”) (at [17]) has stated that the test for visual similarity is not that of substantial reproduction.

To illustrate, in the case of *Xiaomi* (“IPAD” versus “MI PAD”), the Hearing Officer took the view that the fact the mark “MI PAD” contains all the letters in the “IPAD” mark in the same sequence did not result in an automatic conclusion that “IPAD” was visually similar to “MI PAD”.

#### 5.2.5.2.2 Common denominator in the marks

The Court of Appeal, in the decision of *Caesarstone (CA)* (at [32]) has affirmed the principle that where there is a common denominator, it is important to look at the differences between the competing marks in order to decide whether the challenged mark (the Caesarstone Mark as indicated in the below table) has been able to distinguish itself sufficiently and substantially.

The marks in question in the aforementioned case are:

Caesarstone Mark	
Caesar Mark	

In this case, the common denominator between the two marks was the word “Caesar”. The Court of Appeal considered that the word “Caesar” was the distinctive and dominant component of the “CAESARSTONE” mark, while the device was a somewhat insignificant component, and the word “stone” was descriptive of the goods claimed. For the “CAESAR” mark, the word “Caesar” was the distinctive and dominant component. The differences between the two marks do not serve to distinguish the “CAESARSTONE” mark sufficiently and substantially. The overall impression conveyed by both marks is dominated by the word “Caesar”.

#### 5.2.5.2.3 Colour

Colour is a relevant consideration to be taken into account in assessing visual similarity. The extent to which colours play a role would vary from case to case and the impact of the use of colours in the marks on the perception of the average consumer.

In the case of *Apptitude Pte Ltd v MGG Software Pte Ltd* [2016] SGIPOS 15, the marks were:



Both marks were in colour. The Hearing Officer was of the view that based on visual impression alone, the colours were very different. Taking into account the imperfect recollection of the average consumer, the difference in colours pointed towards the conclusion that the marks were dissimilar.

- Comparing a black-and-white mark with a coloured mark

In the marks-similarity step, the marks are compared as they are represented on the register, that is, “mark-for-mark” and extraneous matter should not be considered. Where one mark is depicted in black-and-white and the other is in colour, colour is *not* a factor which influences the mark-similarity assessment either way; it neither adds to, nor detracts from, the similarity between the marks (see *Starbucks Corporation d/b/a Starbucks Coffee Company v Morianaga Nyugyo Kabushiki Kaisha (Morinaga Milk Industry Co. Ltd.)* [2017] SGIPOS 18 at [37] and *Fox Head, Inc. v Fox Street Wear Pte Ltd* [2018] SGIPOS 8 at [56]).

#### **5.2.5.2.4 Where the earlier mark and the subject mark are word marks**

Marks consisting of text only are known as word marks. When comparing two word marks, the High Court, in the case of *Sarika (HC)*, set out the following guidelines for consideration (at [51]):

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

Applying the above guidelines, the High Court noted that the “Nutella” mark and the “Nutello” mark comprised 7 letters each, with the first 6 letters being identical and only the last being different. Taking into account the possibility of imperfect recollection and that the difference lies only in the single ending letter, the Court of Appeal, in *Sarika (CA)*, affirmed the High Court’s decision that the marks would appear visually similar to an average consumer.

#### **5.2.5.2.5 Where the earlier mark and/or the subject mark are composite marks**

Marks consisting of both textual and figurative elements are known as composite marks.

In assessing the visual similarity of marks where one or more of the marks is a composite mark, the correct approach is to consider the marks in totality without placing undue emphasis on any particular component of such marks unless such emphasis is warranted on the facts (see *Hai Tong* at [41]).

The following non-exhaustive list of principles have been laid out by the courts in various cases (see *Hai Tong* at [62] and *Caesarstone Sdot-Yam Ltd v Ceramiche Caesar SpA* [2016] 2 SLR 1129 (“*Caesarstone (HC)*”) at [30]):

- The visual similarity of two marks is assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components.
- The overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components.
  - When the other components of a complex composite mark are of negligible significance, it is permissible to make the comparison solely on the basis of any dominant element(s).
  - However, it cannot be assumed that there will always be a feature of the mark which dominates the mark’s landscape. In some cases, no particular feature will stand out. Micro-analysing a mark for particular features in such cases is unhelpful.
- Words do not necessarily ‘talk’ in composite marks
  - Words in composite marks do not dominate or constitute the whole of such marks simply because they are words.
  - The textual component of a composite mark could (but will not necessarily or always) be the dominant component of the mark. The textual component is a dominant component of the mark if:
    - the textual component is in itself highly distinctive;
    - the textual component is large, and is in a prominent location in relation to the other components, or stands out from the background of the mark.
  - If the competing marks contain a similar device, the overall resemblance between them may be diminished if they each bear words which are entirely different from each other.
- Significance of the device component

- The device component is an equally significant, if not the dominant, component of a composite mark where:
  - the device is prominent and large;
  - the accompanying word(s) are devoid of any distinctive character, or are purely descriptive of the device component; or
  - the device component is of a complicated nature.
- But usually not where:
  - the device is simple and does not evoke any particular concept for the average consumer;
  - the device component does not attract the attention of the average consumer of the goods or service in question because such a consumer is regularly confronted with similar images in relation to those goods or services; or
  - the device component is more likely to be perceived as a decorative element rather than as an element indicating commercial origin.

Below are some illustrations to show how composite marks would be assessed for visually similarity:

- 1) *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941



The textual element “Lady Rose” was determined to be the dominant component of the mark, as it was distinctive and had no allusive quality in relation to the goods claimed which were perfume products. On the other hand, the device component, which was a simple stylised rose, was found to be relatively insignificant<sup>1</sup>. The rose device emphasised the “Rose” portion of “Lady Rose” and hence, was not a feature which drew any attention away from the words. Furthermore, a customer trying to recollect the mark would be far more likely to recall the textual component rather than the device component.

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<sup>1</sup> At paragraph 65 of the judgement, the device component consisting of a simple stylised rose, was found to be relatively insignificant for several reasons:

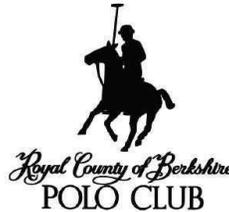
- (a) The device component emphasised the “Rose” portion of “Lady Rose”;
- (b) The simple stylised rose was not a feature that drew any significant attention away from the words;
- (c) A customer trying to recollect the mark would be far more likely to recall the textual component rather than the device component
- (d) It was unlikely that the simple stylised rose would serve as a point of distinction if the textual component of the conflicting marks were found to be substantially similar.

- 2) *The Audience Motivation Company Asia Pte Ltd v AMC Live Group China (S) Pte Ltd* [2015] 3 SLR 321 (“*Audience Motivation (HC)*”)



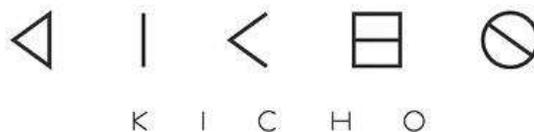
The words “to create, entertain and inspire” were presented in the mark in very small font and were not prominent. Consequently, they had limited visual impact on the consumers.

- 3) *The Polo/Lauren Company L.P. v Royal County of Berkshire Polo Club Ltd* [2017] SGIPOS 19



The Hearing Officer found that none of the elements in the mark, namely the polo player device, the words “Royal County of Berkshire”, or the words “POLO CLUB” were more outstanding or memorable than the others. There was no dominant component in the mark and the mark should be assessed as a whole.

- 4) *Kiko S.p.A. v Dooyeon Corp* [2016] SGIPOS 4



The Hearing Officer was of the view that both the device element and the word element were equally dominant. The word element is distinctive while the device element was significant, large and not simple. The device was also not a decoration but constituted part of the trade mark message of the sign to indicate origin. Both the word and the device elements were distinctive and significant when considering the mark as a whole.

### 5.2.5.3 Aural Similarity

Aural similarity deals with the pronunciation of the competing marks. It is important to bear in mind that the aural analysis involves the utterance of the syllables without exploring the composite meaning embodied by the words (see *Staywell* at [35]).

### 5.2.5.3.1 Dominant Component Approach and Quantitative Assessment Approach

There are two possible approaches in the assessment of aural similarity (see *Staywell* at [31]–[32]), known as the “dominant component approach” and the “quantitative assessment approach”:

#### 1) Dominant component approach

This approach gives special regard to the distinctive or dominant components of the conflicting marks. Where a word in the mark is descriptive (that is, non-distinctive) of the goods or services claimed, that element has less significance in the assessment of aural similarity. An example can be found in the case of *Caesarstone (CA)* (the mark images can be found in the earlier section 5.2.5.2.2 “Common denominator in the marks”). The dominant component of the “CAESARSTONE” mark is the word “Caesar”, as the device is irrelevant (elaborated in the later section “Aural comparison of device mark(s)”) and the word “stone” of the mark is descriptive of the goods claimed. As a result, the competing marks were found to have a high level of aural similarity.

In the case of *Han’s (F & B) Pte Ltd v Gusttimo World Pte Ltd* [2015] 2 SLR 825, the competing marks are:

The Han’s trade marks



The Han’s sign



The Judge stated (at [137]) the following with regard to the application of the above principle in relation to composite marks:

In my view, there is phonetic similarity between the HAN sign and the Han’s trade marks. The main phonetic component of the HAN sign is “HAN”. “Cuisine of Naniwa” is subsidiary. It is doubtful that the average consumer would make constant reference to the seven-syllable “HAN Cuisine of Naniwa” phrase every time he refers to it. “HAN” and “Han’s” are both single-syllable words which share similar pronunciations. Adequate allowance must be made for imperfect recollection and careless pronunciation and speech: *Future Enterprises Pte Ltd v McDonald’s Corp* [2006] 4 SLR(R) 629 at [12].

The slightest mispronunciation would result in complete identity. There is, therefore, phonetic similarity between the HAN sign and the Han's trade marks.

## 2) Quantitative assessment approach

This approach involves determining “*whether the competing marks have more syllables in common than not.*” (see *Staywell* at [32]).

In *Sarika (CA)*, there were three syllables in both the marks, “Nutello” and “Nutella”. The first two out of three syllables in both marks are the same. Hence, the marks had more syllables in common than not.

However, one should also be mindful that realism should be incorporated into the assessment of how the average consumer would aurally perceive the marks and avoid simplistic or formulaic application of the two approaches (see *Apple Inc. v Swatch AG (Swatch SA)(Swatch Ltd.)* [2018] SGIPOS 15 at [43]). For example, it is necessary to take into account the rhythm (and stress) of the marks and their influence on how the marks will eventually sound, before comparing how aurally similar the competing marks are.

### 5.2.5.3.2 Factors to consider in assessing aural similarity

In assessing aural similarity, some non-exhaustive factors to consider are:

- Pronunciation of the marks
- The possibility of slurred pronunciation
- Slurring of the termination of words
- Whether there is a pause in reading the marks
- How different the prefixes and suffixes are
- Quantitative assessment as to whether the marks have more syllables in common than not
- Syntax of the words (marks with inverted word order may still be considered similar)

### 5.2.5.3.3 Pronunciation of Marks

The pronunciation of a mark is based on “how an average Singaporean consumer would pronounce the respective words”, taking into consideration the possibility of “imperfect recollection and careless pronunciation and speech” (see *Sarika (CA)* at [30]-[31]).

It was observed in *London Lubricants (1920) Limited's Application to Register a Trade Mark* [1925] 42 RPC 264 at [279]:

[That] 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 [sic] the most important for the purpose of distinction.

However, this observation should not be taken as a hard and fast rule of pronunciation in the English language. The Court of Appeal in *Polo (CA)* held (at [23]) that there was no rigid principle that the first syllable of a word mark is more important than other syllables.

Further, it was also observed that there is a tendency of persons using the English language to slur subsequent syllables or the termination of words (see *Hyundai Mobis v Mobil Petroleum Company, Inc* [2007] SGIPOS 12 and *Sarika (CA)* at [30]).

The following marks were found to be aurally similar:

- “NUTELLA” and “NUTELLO” (*Sarika (CA)*)
  - The first syllable would likely be emphasized in pronouncing the words “Nutella” (pronounced as Nut-ella) and “Nutello” (pronounced as Nut-ello). Taking into consideration imperfect recollection, the average consumer is likely to regard both marks as aurally similar.
- “CAREFREE” and “CAREREE” (*Johnson & Johnson v Uni-Charm* [2007] 1 SLR (R) 1082)
  - A person with an imperfect recollection of the “CAREFREE” mark (pronounced as two words “care” and “free”) may find that the “CAREREE” mark (pronounced as the two words “care” and “ree”) to be rather aurally similar.

Ultimately, it is the pronunciation of the words as a whole that is critical in ascertaining aural similarity. In the case of *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552, “FESTINA” and “J.ESTINA” were found to share aural similarities. The average consumer is likely to stress the “-estina” portion when pronouncing the words “FESTINA” and “J.ESTINA”, while the beginning letters of the words “F” and “J” would be given less emphasis.

#### 5.2.5.3.4 Pronouncing invented words

In the pronunciation of an invented word, a person would have the tendency to reach for a familiar word in his own vocabulary that is closest to the invented word.

Guidance may be taken from the approach taken in *Appitude Pte Ltd v MGG Software Pte Ltd* [2016] SGIPOS 15 at [41]-[46], citing *Seiko Kabushiki Kaisha (trading as Seiko Corporation) v Montres Rolex S.A.* [2004] SGIPOS 8 (“*Seiko*”). In the *Seiko* case, the Hearing Officer commented on how “ROOX” should be pronounced at [30]:

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 [*sic*] 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.

#### 5.2.5.3.5 Syntax of words (inverted word order)

A mark which consists of the same words as another mark, albeit in reverse or inverted order, may still be considered aurally similar. In *Hai Tong*, the words “Rose Lady” was found to be aurally similar to the words “Lady Rose”.

“Composite Mark”



“Sign”

Rose Lady

The Court of Appeal elaborated at [69]:

In the present case, there is no doubt that both the Composite Mark and the Sign consist of exactly the same syllables. The only difference is in their syntax in that they are read in inverted order. However, we think that the fact that the syllables are articulated in an inverted order does not prevent the Composite Mark and the Sign from being aurally similar.

#### 5.2.5.3.6 Aural comparison of device mark(s)

In general, when one or both marks under comparison is a device mark, no aural comparison may be undertaken, as a device mark has no verbal element to speak of. An aural comparison would result in a neutral conclusion rather than the marks are aurally dissimilar. Finding aural similarity where no aural component exists in a mark may be akin to allowing for visual or conceptual similarity to be taken into consideration within the assessment of aural similarity, which is an incorrect approach.

In the case of *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2014] SGIPOS 10, the competing marks were:

Application Mark	Opponent's Earlier Mark T1111886Z
	

The Hearing Officer stated the following (at [60]):

It is clear that there can be no comparison between the Application Mark and the Opponents' Earlier Mark T1111886Z as the Opponents' Earlier Mark T1111886Z, being a device mark, has no aural component to speak of.

This finding of the Hearing Officer was not disturbed on appeal (see *Rovio Entertainment (HC)* at [85])

#### 5.2.5.4 Conceptual Similarity

Conceptual analysis seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole (see *Staywell* at [35]).

The idea must arise from the mark itself, and not something that is known only to its creator (see *Audience Motivation (HC)* at [43]). It is what the consumer would perceive at surface value—not the actual intention of the creator—that is relevant in the conceptual analysis of a mark.

In considering whether there is conceptual similarity between marks, it is necessary to consider the overall impression created by the marks from the perspective of the average consumer in Singapore, bearing in mind their distinctive and dominant components.

#### 5.2.5.4.1 Conceptual meaning in devices

Aside from words (which may contain semantic meaning contributing to the concept of a mark), conceptual meaning may also be found in devices, if the device is capable of evoking an idea. For example:

Device	Conceptual meaning (underlying idea conveyed by the mark) from the perspective of the average consumer in Singapore	Case
	Moose (Silhouette of a moose)	<i>Abercrombie &amp; Fitch Europe SAGL v MMC International Services Pte Ltd</i> [2016] SGIPOS 6
	Fox (Stylised depiction of a fox head)	<i>Fox Racing, Inc. v Fox Street Wear Pte Ltd</i> [2014] SGIPOS 13
	Game of polo (Image of a person engaging in the game of polo)	<i>Polo/Lauren Co LP v United States Polo Association</i> [2016] 2 SLR 667

#### 5.2.5.4.2 Where marks under comparison are meaningless or invented words

In cases where a word is invented and meaningless, it does not possess what can be said to be a concept. Hence, in the comparison of two marks in which one of the marks has no concept, there is no basis for a conceptual comparison of the marks. Therefore, no conceptual similarity can be found (see *Sarika (CA)* at [34]).

In the case of *Sarika (CA)*, no conceptual similarity was found between the marks “NUTELLO” and “NUTELLA”, because the marks were invented and meaningless terms with no particular idea underlying each of them.

**5.2.5.4.3 No conceptual similarity is not the same as conceptually dissimilar**

Marks found to have *no conceptual similarity* is not equivalent to marks that are *conceptually dissimilar*:

- No conceptual similarity: There is no basis for conceptual comparison of the marks.
- Conceptually dissimilar: The marks evoke different ideas/concepts.

**5.2.6 Earlier trade mark registered subject to a disclaimer**

Where the *only* component of an *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, a citation would 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.

This principle is illustrated in the opposition case *Christie Manson & Woods Limited v Chritrs Auction Pte. Limited* [2016] SGIPOS 1. In this case, the Hearing Officer found that “since the only possible point of similarity between the Application Mark and the Opponents’ mark in Class 35 rests solely on the word “Christie’s”, which has been disclaimed, the opposition under section 8(2)(b) relating to the Opponents’ mark in Class 35 must fail” (at [62]). The Application Mark and Opponents’ mark referred to are reproduced below for ease of reference:

Application Mark	Opponents’ mark in Class 35
	<p data-bbox="911 1304 1222 1339"><b>CHRISTIE'S</b></p> <p data-bbox="1013 1377 1101 1545">佳 士 得</p> <p data-bbox="800 1602 1049 1633"><b><u>Disclaimer clause:</u></b></p> <p data-bbox="800 1654 1349 1755">Registration of this Trade Mark shall give no right to the exclusive use of the word “Christie’s”.</p>

### 5.2.7 Conclusion on similar marks

After considering the three aspects of similarity (visual, aural and conceptual) and bearing in mind that trade-offs can occur between the three aspects of similarity, an assessment will be made on whether the competing marks, when observed in their totality, are similar rather than dissimilar. Similarities in all three aspects need not be present to warrant a finding of similarity, neither is there a strict requirement that all similarities be of equal weightage.

If the competing marks are found to be similar rather than dissimilar, the examiner will move on to the second step of the step-by-step approach to assess whether the goods and/or services of the competing marks are identical or similar. This will be elaborated in the next section.

If the competing marks are found to be dissimilar rather than similar, there is no need to move on to the second step of the step-by-step approach.

## 5.3 Comparing the goods or services

The second step in the step-by-step approach seeks to answer the question whether the goods and/or services of the competing marks are identical or similar.

### 5.3.1 Reading the specification of goods and services

The specification in a trade mark application is a list of goods or services that is classified in various classes according to the Nice Classification (also known as the International Classification of Goods and Services (ICGS)). For more information regarding the Registry's classification practices, please refer to our Trade Marks Work Manual chapter on "Classification of goods and services".

In interpreting the scope of a specification, the words or phrases used are considered in their *ordinary and natural meaning*, without straining the language unnaturally so as to produce a narrow meaning which does not cover the goods or services in question (see *Staywell* at [41]). For example, the item "jam" does not fall within the ambit of "dessert sauce". The ordinary and natural meaning of "dessert sauce" does not include jam and vice versa.

When determining whether the goods or services are identical or similar, the examiner will compare the full spectrum of goods and/or services which the earlier mark is registered (or applied for) against that of the later mark.

### 5.3.2 Identity of the goods or services

The goods or services of two competing marks are *prima facie* identical if the later mark's goods or services fall within the ambit of the specification of the earlier mark (see *Staywell*

at [41]). For example, “lipsticks” will fall within the ambit of “cosmetics”, hence “lipsticks” and “cosmetics” would be considered as identical goods.

Where the goods or services are regarded as identical, “there is no further need to consider whether they are similar or the extent of their similarity” (see *Staywell* at [42]).

### 5.3.3 Similarity of the goods or services

In the assessment of whether or not there is similarity in the goods or services of conflicting marks, numerous Singapore cases have relied on the following factors set out in *British Sugar plc v James Robertsons & Sons Ltd* [1996] RPC 281 (“*British Sugar*”) (at [296]):

- (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.

The factors above merely serve as guidelines and they may not all be relevant to every case. The Court of Appeal stated in *Sarika (CA)* (at [51]) that “the weight which ought to be accorded to each factor is for the trial judge to ascribe after assessing all pertinent factors”.

If the goods or services are found to be similar, they may vary in the degree or extent to which they are similar (see *Hai Tong* at [85(c)]). The extent of similarity between the goods or services has an impact on the confusion-inquiry (i.e. the final step of the step-by-step approach), which is elaborated in the later parts of this chapter.

#### 5.3.3.1 Does the class of the goods or services matter?

The class under which the goods or services are classified does not determine their similarity. The fact that the goods or services of two conflicting marks are in the same class does not automatically mean that the goods or services must be similar. For example, Class 9 covers a broad range of goods. “Fire-extinguishing apparatus” would not be considered as being similar to “Computers”, even though both descriptions are classified in Class 9. Further, goods or services of two conflicting marks in different classes may be found to be similar and the difference in class number does not automatically lead to the conclusion that the goods or services are dissimilar. The assessment for similarity of the

goods or services involves the comparison of the specific goods or services in the specification, rather than just their class number.

### **5.3.4 Conclusion on similarity of the goods or services**

Once similarity between the competing marks and the goods or services has been established, the impact of these similarities on the relevant consumers' ability to understand where those goods and services originate from will be considered in the final step of the step-by-step approach (see *Staywell* at [64]).

However, if it is established that there is no similarity in the goods or services, there is no need to proceed to the next step of the approach to determine whether there is any likelihood of confusion.

## **5.4 Likelihood of confusion**

The final step of the step-by-step approach considers the likelihood of confusion. This step is also known as the confusion inquiry.

Any likelihood of confusion must arise from the similarity of the marks and the goods or services (see *Staywell* at [64]). However, it does not mean that a finding of similarity between the marks and the goods or services will automatically translate to an establishment of confusion.

At this stage, the effect of objective similarities between the conflicting marks and the goods or services in question on the consumer perception is assessed (see *Staywell* at [20]). This entails looking at (i) how similar the marks are; (ii) how similar the goods or services are; and (iii) given this, how likely it is that the relevant segment of the public will be confused (see *Staywell* at [55]).

Before going further into how such similarities affect the likelihood of confusion, some key principles to note are as follows:

### **5.4.1 Two types of confusion**

In general, there are two possible types of confusion. As elaborated by the Court of Appeal in *Caesarstone (CA)* at [57] (citing *Hai Tong* at [74]), the first type of confusion involves mistaking one mark for another. The second is where the relevant segment of the public may well perceive that the competing marks are different, but may yet remain confused as to the origin which each mark signifies and may perceive that goods bearing the two marks come from the same source or from sources that are economically linked or associated. For example, the relevant segment of the public may perceive that the goods bearing the competing marks come from the same provider who has chosen to diversify its range of marks for marketing or promotional reasons or the goods come from sources that are economically linked.

#### **5.4.2 Mere association does not equate to confusion**

The Court of Appeal has clarified (in *Hai Tong* at [75] and *City Chain* at [58]) that “mere association” is not *in itself* sufficient to prove that confusion has occurred. This means that it is insufficient that the relevant segment of the public would recognise or recollect similarities between the conflicting marks if there is no likelihood of confusion as to the trade origin.

#### **5.4.3 Substantial portion of the consumers must be confused**

To establish that there is a likelihood of confusion, the test to adopt is whether a substantial portion of the relevant public will be confused. Although it is not necessary to show that a majority of the public is confused, it is insufficient if only a “single member” of the relevant public is confused or if only a “very small and unobservant section” is confused. (see *Sarika (CA)* at [57] and *Mobil Petroleum Co, Inc v Hyundai Mobis* [2010] 1 SLR 512 (“*Mobil*”) at [79]).

It should be noted that the relevant segment of the public may comprise various groups of consumers. For instance, in *Caesarstone (CA)*, the relevant public is a composite comprising both specialists and lay end-consumers (at [85]). To establish that there is a likelihood of confusion, it has to be shown that a substantial portion of the relevant public composing of the respective groups of consumers will be confused.

#### **5.4.4 Permissible extraneous factors to consider**

There is a limit to the range of external factors that may be taken into account to determine whether a likelihood of confusion exists. The permissible factors are those which (i) are intrinsic to the very nature of the goods or services and/or (ii) affect the impact that the similarity of marks and goods/services has on the consumer (see *Staywell* at [95]).

In contrast, superficial differentiating steps which are not inherent in the goods or services themselves but are dependent on traders’ business strategies are not permissible. These may include pricing differentials, packaging and other superficial marketing choices (see *Staywell* at [95]).

Based on the considerations above, the Court of Appeal in *Staywell* set out a non-exhaustive list of extraneous factors that are admissible in the confusion inquiry (see *Staywell* at [96]). These factors are elaborated below.

##### **5.4.4.1 Factors relating to the impact of marks-similarity on consumer perception**

At this stage, the effect of the similarity between the marks, on the perception of consumers is examined. For example, the significance of aural similarity in relation to beverages normally sold by mail order, and visual similarity in relation to clothing normally sold based on the consumer’s direct perception, would be determined (see *Staywell* at [20]).

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

**(i) the degree of similarity of the marks themselves;**

In general, if there is a greater degree of similarity between the marks, it follows that the likelihood of confusion would be greater (see *Hai Tong* at [85(c)(iii)]).

In the case of *The Polo/Lauren Company, L.P. v United States Polo Association* [2015] SGIPOS 10, it was found that there was identity in the goods, which are mainly eyewear and related goods. Eyewear “are usually purchased based on visual inspection and hence the visual aspect of the marks is likely to have a greater impact on the consumer. In this case, there is only a very low degree of visual similarity between the marks. This, coupled with the fairly high degree of care and attention that the average consumer will pay when purchasing eyewear, are factors which point away from a likelihood of confusion.” (at [112]).

**(ii) the reputation of the marks;**

The reputation of the marks is one of the factors which should be taken into account but it should be noted that the reputation of a well-known mark does not necessarily equate to a higher likelihood of confusion (see *Mobil* at [74]). On the contrary, a strong reputation may have the reverse effect as the average consumer is unlikely to be confused (see *McDonald’s Corp v Future Enterprises Pte Ltd* [2004] SGCA 50 at [64]).

**(ii) the impression given by the marks; and**

**(iv) the possibility of imperfect recollection.**

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

Factors relating to the impact of the similarity of goods or services on consumer perception include (i) the normal way in or the circumstances under which consumers would purchase goods or services of that type; (ii) whether the products or services are expensive or inexpensive; (iii) the nature of the goods or services and whether they would tend to command a greater or lesser degree of fastidiousness and attention on the part of prospective purchasers; and (iv) the likely characteristics of the relevant consumers and whether they would or would not tend to apply care or have specialist knowledge in making the purchase (see *Staywell* at [96(b)]).

**(i) The normal way in or the circumstances under which consumers would purchase goods or services of that type**

The normal way in which the product is sold or the service is procured varies, and can include purchases made entirely via websites, mobile applications, brick-and-

mortar stores or via specialists or professionals as in the case of prescription drugs or renovation fixtures.

The mode of purchase affects how much weightage should be given to the visual, aural or conceptual aspect of the assessment of similarity of marks. For goods/services that are mainly procured via vocal means such as phone ordering, aural similarity would play a greater role in assessing the likelihood of confusion, as compared to visual or conceptual similarity. On the other hand, for purchases made after physical inspection of the conflicting marks, such as via a website or from a physical store, the visual aspect would play a more important role in assessing the likelihood of confusion as compared to aural or conceptual similarity.

**(ii) Whether the products or services are expensive or inexpensive**

At the onset, it should be clear that the price of the type of goods or services is distinct from the issue of price parity between the parties' goods or services (see *Staywell* at [96(b)] and *The Polo/Lauren Company, L.P. v United States Polo Association* [2015] SGIPOS 10 at [108]). It is not the price that different traders set for the same category of goods or services due to the different marketing strategies adopted by the traders, but rather, the average price of a typical item or service from that category which is considered.

To illustrate, a car would generally be considered an expensive item while a piece of clothing would be relatively inexpensive, despite the fact that there can be luxury cars or high-end clothing as well as relatively cheaper ones. The superficial price disparity between the conflicting goods in the same category, which speaks more about the trader's marketing choices rather than differences in the nature of the goods themselves, is not a permissible factor in this inquiry (see *Reed Executive plc v Reed Business Information Ltd* [2003] RPC 12 at [103]).

In general, the purchase of an expensive item or service would point away from a likelihood of confusion due to the greater care that the average consumer would exercise in making such a purchase, provided the attention is directed towards the marks themselves (see *Caesarstone (CA)* at [81]). This means that consumers looking to procure expensive items or services are likely to accord more attention to ensure that they are indeed paying for what they get, which is by making sure that they are purchasing from the correct trade source. This is also based on the consideration that the average consumer is someone who would exercise some care and a measure of good sense in making his or her purchases, and not an unthinking person in a hurry (see *Hai Tong* at [40(c)]).

However, the above is premised on the assumption that the greater care exercised relates to the differences between the two competing marks. In the case of *Caesarstone (CA)* at [81], it was found that the consumers of tiles are likely to be indifferent towards the mark used in relation to the goods. Their focus tends to be on the price and attributes of the goods and the greater care exercised by the consumers

would relate to these attributes and not to the differences between the competing marks. Hence, in this case, while the purchase is considered to be expensive, it was at best a neutral factor in the assessment of likelihood of confusion.

**(iii) The nature of the goods or services and whether they would tend to command a greater or lesser degree of fastidiousness and attention on the part of prospective purchasers**

The nature of the goods or services will also affect the degree of attention consumers pay when making purchasing decisions. For example, purchasers of pharmaceutical goods would generally pay greater care and attention to make sure they are buying from the correct trader, as compared to purchasers of household goods such as cloth wipes. Where the importance of purchasing from the intended trade source is highly desirable or critical, it can be reasonably inferred that the consumer will pay a greater degree of attention in the purchasing process, thereby reducing the likelihood of confusion.

**(iv) The likely characteristics of the relevant consumers and whether they would or would not tend to apply care or have specialist knowledge in making the purchase**

Generally, professionals in a particular field of trade would possess specialist knowledge of the goods or services in that industry. They would most likely come into contact with the goods or services provided under the conflicting marks on a frequent basis and would have developed a discerning eye for the various marks.

Their expertise in the trade origin of the goods or services in their fields may point away from a likelihood of confusion.

Once the examiner has, using the step-by-step approach, established similarities in the marks, similarities in the goods and/services and assessed that as a result there is a likelihood of confusion, a section 8(2)(b) objection will be raised.

## **5.5 Family 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 will 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 are in use at the date of application and is known to the public hence resulting in confusion.

In other words, the registration of a number of marks sharing a common element by a single trader is not sufficient to establish that the average consumer would perceive this group of marks as being a family of marks. The proprietor has to provide evidence to prove that the average consumer readily associates marks sharing the common element as originating from the proprietor in order to establish that the marks are indeed perceived as a family of marks (see *Bridgestone Corporation and Bridgestone Licensing Services, Inc. v Deestone Limited* [2018] SGIPOS 5 (“*Deestone*”) at [39]).

In the case of *Apple Inc. v Xiaomi Singapore Pte Ltd* [2017] SGIPOS 10, the “IPAD” mark was found to be a member within Apple Inc.’s well known I-prefix family of marks (for example, IMAC and ITUNES), based on the evidence submitted.

## 6 CITING PRACTICES

As mentioned in Part 4 “Meaning of an earlier trade mark”, the examiner will conduct a search of the register for potential conflicting earlier trade mark(s).

The Registry’s citation practices in three particular situations are elaborated below:

### 6.1 Where the conflicting marks have the same filing date or priority date

If two or more applications for identical or similar marks and for the same or similar goods or services, have the same filing date or priority date, the Registrar will notify the owners of the marks of the potential conflict. This notification serves to inform the owners of the presence of the other mark(s) and the Registrar will not cite either mark against the other. If the either owner of these marks wishes to oppose the registration of the other mark, he may do so by filing a notice of opposition when the other mark is published in the Trade Marks Journal.

### 6.2 Where there is a conflicting mark but the applicant has an identical “earlier trade mark”

Where an applicant applying to register a trade mark has an earlier identical trade mark that is registered, the Registrar will not cite any conflicting mark filed during the period between these two applications’ filing/priority dates, provided that the following conditions are met:

- (i) The applicant’s earlier trade mark registration has an earlier filing/priority date than that of the conflicting mark(s);
- (ii) The applicant’s later trade mark application is filed in respect of goods and/or services that are protected by the applicant’s earlier trade mark registration; and
- (iii) The applicant’s earlier trade mark registration is not subject to any pending proceeding that may affect its validity.

## Relative Grounds for Refusal of Registration

In the following example, Trade Mark No. 2 will face a citation of Trade Mark No. 1, whereas Trade Mark No. 3 will not face a citation of Trade Mark No. 2 as the same applicant (ABC Company) has an earlier identical trade mark registration covering the goods applied for in Trade Mark No. 3.

	<b>Trade Mark No. 1</b>	<b>Trade Mark No. 2</b>	<b>Trade Mark No. 3</b>
<b>Applicant</b>	ABC Company	XYZ Company	ABC Company
<b>Filing date</b>	1 June 2017	1 August 2017	1 December 2017
<b>Mark</b>	MEZZEN	MEZZEN	MEZZEN
<b>Mark Status</b>	Registered	Pending (Under Examination)	Pending (Under Examination)
<b>Goods (Class 25)</b>	Clothing.	Shirts; trousers.	T-shirts; shirts; trousers; jeans.

However, if the goods and/or services applied for in a later trade mark application are broader than the scope of the goods and/or services covered by the applicant's earlier trade mark registration, the later application will face a citation for those goods and/or services that are not covered in the earlier registration.

	<b>Trade Mark No. 1</b>	<b>Trade Mark No. 2</b>	<b>Trade Mark No. 3</b>
<b>Applicant</b>	ABC Company	XYZ Company	ABC Company
<b>Filing date</b>	1 June 2017	1 August 2017	1 December 2017
<b>Mark</b>	MEZZEN	MEZZEN	MEZZEN
<b>Mark Status</b>	Registered	Pending (Under Examination)	Pending (Under Examination)
<b>Goods (Class 3)</b>	Hair care products.	<b>Fragrances.</b>	Hair care products; <b>Cologne; Perfumes.</b>

In the example above, Trade Mark No. 3 will face a citation of Trade Mark No. 2 in respect of "Cologne; Perfumes".

To overcome the objection, the applicant of Trade Mark No. 3 may choose to remove "Cologne; Perfumes" from the list of goods or obtain a letter of consent from XYZ Company. Please refer to Part 7 "Overcoming grounds of refusal under sections 8(1) and 8(2)" for more information.

### **6.3 Late recording of applications with earlier rights**

It is possible that an “earlier trade mark” may not have yet been recorded on the register when the Registrar conducts similar marks searches when examining a later application. This is likely to arise as a result of a priority claim on the later filed application, or due to the time lag in receiving and recording of an earlier trade mark that is filed via the Madrid Protocol at IPOS.

If the existence of another conflicting application with an earlier filing date or priority date is drawn to the attention of the Registrar, the Registrar may:

- (i) raise a late citation for the later application (if the later application is pending examination); or
- (ii) revoke the acceptance of the later application under section 16 of the Trade Marks Act (if the later application has been published but is pending registration).

## 7 OVERCOMING GROUNDS FOR REFUSAL UNDER SECTIONS 8(1) AND 8(2)

### 7.1 Methods that may overcome objections under section 8

The objection under section 8 may be overcome by the following methods:

#### 7.1.1 Removing the conflicting 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 limit the list of goods or services to cover only the intended activities.

##### 7.1.1.1 Positively limiting the goods or services of the application

The applicant may request an amendment under rule 22(1) of the Trade Marks Rules to limit the goods or services covered by the application so that it no longer covers goods or services which are similar to those of the cited application(s).

This may be done by deleting goods or services from the specification, 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.

<b>Positively limiting the specification</b>	<b>Cited mark</b>	<b>Application mark</b>	<b>Proposed amendment</b>
By deleting	Class 7: “agricultural elevators; crushing machines; cultivators; <b>spraying machines</b> ”	Class 7: “milling machines; mills; millstone; <b>spraying machines</b> ”	Class 7: “milling machines; mills; millstone; <del>spraying machines</del> ”
By substituting	Class 42: “computer system design; graphic arts design”	Class 42: “scientific and technological services and research and design relating thereto”	Class 42: “scientific research”
By defining specific purpose	Class 9: “computer software for use in financial transactions”	Class 9: “computer software”	Class 9: “computer software <u>for use in medical diagnosis</u> ”

### 7.1.1.2 Excluding the goods or services which are in conflict

The applicant may overcome a citation by amending the specification to exclude goods or services which are similar to the goods or services covered by the cited application or registration. Such exclusions or restrictions will usually be phrased as “excluding...”, “not including...” or “none being...” followed by the goods or services which would otherwise fall within the scope of the specification.

Exclusion 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. For example:

- Class 16: Articles of stationery, printed matter; all not including adhesives.
- Class 7: Washing machines and spin driers; none being for domestic use.

Further, a proposed amendment which seeks to exclude goods which are obviously not included in the specification will not be allowed. For example, “Eggs and cheese, but not including butter” is not allowed as butter is not included in the statement “eggs and cheese” and the exclusion is redundant.

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

Application in Class 12	Citation in Class 12	Proposed exclusion
Trishaws	Motor land vehicles	Trishaws <u>but not including</u> motorised trishaws vehicles

The proposed exclusions should distinguish the goods and/or services of the application from the cited mark. For example, the following exclusion is **not** allowed, since a transistor remains the same whether or not it is used in electronics or for other purposes. For example:

Application in Class 9	Citation in Class 9	Unsuitable exclusion
Electric transistors	Sound recordings and reproducing apparatus and parts and fittings therefor	Electric transistors <u>but not including</u> those for recording and reproducing apparatus

It should also be noted that it may not be possible to use an exclusion to overcome the citation if the cited mark covers a very wide scope of goods and services, for example:

<b>Application in Class 10</b>	<b>Citation in Class 10</b>
X-ray imaging apparatus.	Surgical, medical, dental and veterinary apparatus and instruments.

It is the applicant’s responsibility to propose 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.

**7.1.1.3 Withdrawing of class(es)**

In a multi-class application, a citation may be overcome by withdrawing the class(es) of the conflicting goods and/or services. If the application has no other outstanding objection, the remaining class(es) of the application will proceed to be accepted for publication.

<b>Application</b>	<b>Citation</b>	<b>To overcome the citation</b>
Class 16 Pen.  Class 25 Clothing.	Class 16 Stationery.	Withdraw Class 16 from the application such that only Class 25 remains in the application.

**7.1.2 Obtaining consent from the proprietor of the cited mark**

**7.1.2.1 Letter of consent**

Under section 8(9) of the Trade Marks Act, 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.

An applicant may overcome a citation by obtaining consent in the form of a consent letter from the cited mark proprietor consenting to the registration (and not just use) of the mark.

Letters of consent should not contain any conditions, since the Registrar is not in a position to ensure that any condition about the use of the trade mark is met.

The letter of consent must include the following details:

- (a) Details of the subject application:
  1. Application number
  2. Representation of the trade mark
  3. The specification of goods and/or services to which the cited mark proprietor is consenting for registration.
    - If the consented specification of goods and/or services is narrower than that required to withdraw the citation, the specification of the subject application should be amended to reflect only those goods or services to which the consent applies.
- (b) Details of the cited trade mark:
  1. Application number
  2. Representation of the trade mark
- (c) Other content:
  1. A statement unequivocally indicating that consent to the registration of the mark is given.
  2. The name, designation and signature of the signatory must be indicated.
  3. The signatory must be the proprietor of the cited mark or a person authorised to sign on behalf of the cited mark proprietor.
  4. The letter of consent must be dated.

A sample letter of consent can be found on IPOS website.

Upon the Registrar's acceptance of the letter of consent, a clause will be endorsed in the subject application using the following formats:

- *"By consent of the registered proprietor of TM No. T1498765A."*  
(where the cited mark is a registered trade mark)
- *"By consent of the applicant of TM No. T1398765A."*  
(where the cited mark is a pending trade mark application)

If the examiner is not satisfied with the letter of consent furnished, the objection will be maintained.

#### **7.1.2.2 Consent between companies in the same parent ownership**

A general letter of consent may be provided between two companies in the same parent ownership 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 must supply a cover letter stating that the general consent is still valid and in force at the relevant time.

Upon the Registrar's acceptance of the general letter of consent, a clause will be endorsed in the subject application using the following formats:

- *“By consent of the registered proprietor of TM No. T1498765A.”*  
(where the cited mark is a registered trade mark)
- *“By consent of the applicant of TM No. T1398765A.”*  
(where the cited mark is a pending trade mark application)

If the examiner is not satisfied with the general letter of consent or consent agreement, the objection will be maintained.

### **7.1.2.3 Agreement between two companies to consent to the registration of each other's marks**

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

The agreement should include the following:

- the agreement relates to the registration of the mark and not just its use;
- the consent covers registration in Singapore;
- the agreement relates to the mark applied for (the application number or the representation of the trade mark is sufficient);
- the consent covers the goods and/or services applied for; and
- the consent is not conditional, or if conditional, that any such conditions for giving consent are satisfied.

Any general agreement to consent must be valid and in force at the relevant time.

Upon the Registrar's acceptance of the agreement, a clause will be endorsed in the subject application using the following formats:

- *“By consent of the registered proprietor of TM No. T1498765A.”*  
(where the cited mark is a registered trade mark)
- *“By consent of the applicant of TM No. T1398765A.”*  
(where the cited mark is a pending trade mark application)

If the examiner is not satisfied with the general consent agreement furnished, the objection will be maintained.

### **7.1.3 Where the earlier mark belongs to the applicant but IPOS' records do not indicate as such**

The cited earlier mark may belong to the same applicant in the following scenarios but IPOS records do not indicate as such:

**(i) The applicant has changed its name**

The applicant has changed its legal name but IPOS' records of the applicant's earlier mark still indicate the mark under the applicant's former name. As the legal entity remains the same, the applicant should update IPOS' records by filing Form CM2 to update the applicant's name for the earlier mark.

**(ii) The earlier mark has been assigned to the applicant**

Where the earlier mark has been assigned to the applicant but the assignment was not recorded at IPOS, the applicant should update IPOS' records by filing Form CM8 to record the transfer of ownership. Please refer to the Trade Marks Work Manual's chapter on "Assignment" for more information.

### **7.1.4 Division of the application**

Where the section 8 objection does not apply to all the goods and/or services in the application, the applicant may choose to divide the application into two applications, one containing all of the conflicting goods and/or services and another containing only the non-conflicting goods and/or services.

This places the conflicting goods and/or services in a separate application in which the applicant is required to respond to the section 8 objection. The benefit of division would be that the divided application in respect of the non-conflicting goods and/or services will proceed to be accepted for publication if there are no other outstanding objections.

The request for the division of the application may be done by filing Form TM8. This form is not applicable to international registrations under the Madrid Protocol.

### **7.1.5 Awaiting the expiry of the cited mark**

A trade mark is 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 within the prescribed period, it will be removed from the Trade Mark Register and will no longer be a valid citation against marks with later filing date.

For more information on citation of expired and removed marks, please refer to our Trade Marks Work Manual chapter on "Renewal".

### 7.1.6 File evidence to indicate honest concurrent use

In certain circumstances, to overcome a citation, 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 subject application with the cited mark.

#### 7.1.6.1 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 and 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 objection.

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 are 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 objection.

*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 in the marketplace as to the origin of the applicant's goods or services 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 or infringement proceedings, and not in the examination of the application.

**7.1.6.2 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 etc.;
- 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.

**7.1.6.3 Form of evidence of honest concurrent use**

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 our Trade Marks Work Manual chapter on “Evidence of distinctiveness acquired through use” for more information about preparing a Statutory Declaration.

#### **7.1.6.4 Evidence of honest concurrent use is satisfactory**

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 T1498765A.”*
- *“Proceeding under honest concurrent use with trade mark application number T1398765A.”*

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.

#### **7.1.7 Other methods which may overcome the citation(s)**

An applicant whose trade mark application faces a citation under section 8 may negotiate with the cited mark proprietor. Since the potential for negotiation can only be assessed by the applicant, the Registrar will not propose this course of action. The outcome of such negotiation may be one of the following:

##### **(i) Amendment of the specification of the cited mark**

The applicant may seek to negotiate with the owner of the cited trade mark to amend the specification of the cited mark to remove any conflicting goods and/or services. The cited mark’s owner is required to effect the amendment of the specification via:

- Form TM27 if the cited mark is pending; or
- Form CM3 if the cited mark is registered.

Any amendment to the specification of the cited mark must be clear and unambiguous.

##### **(ii) Cancellation of the cited mark’s registration**

The cited mark's proprietor may voluntarily cancel the registration of his trade mark under section 21 by filing Form CM3.

**(iii) Assignment of the application or the cited mark to the same entity**

The section 8 objection may be waived if the owners of the application and the cited trade mark come to an agreement where the trade marks are assigned to a single entity. The transfer of ownership shall be recorded by filing Form CM8.

**7.1.8 Initiating proceedings against the cited mark**

In certain circumstances, the applicant may consider exploring the option of initiating proceedings against the cited mark in order to overcome the citation. Legal advice should be sought in this regard.

**7.2 Methods that cannot overcome objections under section 8**

The following methods will not overcome the objection under section 8:

**7.2.1 Amending the representation of the subject mark**

The mark representation cannot be amended to remove or change the element(s) that is similar to the cited mark in order to overcome the section 8 objection.

As a matter of general practice, the examiner takes a very strict approach to amendments of mark representation given that section 14 of the Trade Marks Act does not permit amendments to a trade mark application except under very limited circumstances.

**7.2.2 Where the cited mark's proprietor is a corporate entity, evidence of its dissolution or non-existence**

Evidence of the dissolution of a cited mark proprietor, or that it no longer exists, assuming it is a corporate entity is not sufficient to overcome a citation.

This is because it is not clear how the assets of the cited mark's proprietor (including the cited mark) has been disposed of. Until there are any changes made by the cited mark proprietor to the registration of the cited mark, the cited mark remains a valid registration and continues to enjoy the rights conferred upon it.

**7.2.3 Written submissions**

The applicant may present written submissions for the Registrar to reconsider the section 8 objection.

Given that each trade mark application is considered on its own merits based on the facts of each case, the following arguments have limited persuasive value:

### **7.2.3.1 Co-existence of other marks on the trade marks register**

Simply because there are other similar marks which co-exist with the cited mark on the trade marks register does not automatically mean that subject application should therefore also be allowed to co-exist.

This is especially so if these other marks are not analogous to the subject application.

In any case, there could be specific reasons why those other marks co-exist and these reasons may not apply to the subject application.

Decisions made by the Registrar in previous cases can do no more than give an indication of what has or has not been thought acceptable at that time, and are not binding on the present case (see *Marvelous AQL Inc.* [2017] SGIPOS 3 at [45]).

### **7.2.3.2 Co-existence of the subject mark and the cited mark in overseas trade mark registers**

Given that the protection of trade marks is territorial, the co-existence of the subject mark and the cited mark(s) in trade mark registers of other countries is of limited persuasive value as the circumstances of the co-existence of the marks in overseas markets are not known and may not apply to the Singapore market.

### **7.2.3.3 Global appreciation approach**

The argument that the marks should be compared using the global appreciation approach, instead of the step-by-step approach, has been rejected by the Court of Appeal in *Staywell*.

As stated in Part 5.1 above, the approach adopted in Singapore is the step-by-step approach. The Court of Appeal stated in *Staywell* (at [15]):

Since this court’s decision in *Polo (CA)*, our courts have given effect to this statutory wording by applying what is now known as the “step-by-step” approach, as opposed to the competing “global appreciation approach” applied in Europe after *Sabel BV v Puma AG, Rudolf Dassler Sport* [1998] RPC 199 (“*Sabel v Puma*”). 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. Under the global appreciation approach the elements of similarity between marks and goods or services, whilst still necessary ingredients in the confusion inquiry, are elided with other factors going towards the ultimate question of whether there is a likelihood of confusion (see *Sabel v Puma* at 223–224, and *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC

117 at 132). Whilst there have been suggestions that the two approaches might be distinct without being different, *we maintain this dichotomy and endorse the step-by-step approach as being conceptually neater and more systematic and, importantly, as being more aligned with the requirements imposed under our statute (see Polo (CA)) at [8].*

[emphasis added]

#### **7.2.3.4 Alleging that the cited proprietor uses (or intends to use) the mark only in respect of some goods/services, industries, or groups of consumers etc.**

Registration confers on the proprietor the exclusive right to use the mark in respect of all the goods and services registered. In the course of examination, the Registrar will consider the full range of goods and services of the earlier mark against the full range of goods and services in the subject application. Therefore, the argument that the cited mark's proprietor uses the mark in respect of only some, and not all, of the goods and services registered is irrelevant.

It should be noted that the full range of notional and fair use of both the subject mark and the cited mark is considered in examination and opposition proceedings.

Notional and fair use refers to use of the trade mark across the range of goods and services claimed *in any way* that would be considered to be normal use in relation to the goods and services, without having regard to its actual use and market circumstances such as how the proprietor markets the goods and services. This means that conflict may be found even though the proprietor markets his goods and services only for a certain industry or a particular group of consumers.

#### **7.2.3.5 Opportunity for the cited mark's proprietor to oppose the subject mark during publication**

The mere fact that the cited mark's proprietor has the opportunity to oppose to the registration of the subject mark during publication is not a valid reason to request for an objection under section 8 to be waived. There is no legislative provision that allows for a citation to be overcome based on such argument.

#### **7.2.3.6 Prior use**

Submissions from the applicant claiming that he has used his mark prior to the filing date or priority date of a cited mark do not serve as a valid reason to overcome the citation. The applicant will need to establish that he has an earlier right by bringing proceedings against the cited mark. The applicant may seek legal advice on the filing of such proceedings.