
Building clarification: Singapore's year in trademark law

A round-up of selected decisions of the Intellectual Property Office of Singapore (IPOS) and the Singapore courts which offer useful guidance to both trademark owners and practitioners

A variety of trademark decisions have been issued by the Trademark Office and the courts in relation to opposition and revocation applications, passing off and infringement actions over the last year. Some cases provide valuable insight on important aspects of trademark practice and procedure, while others clarify the scope of certain substantive trademark principles in Singapore.

Practice points for opposition proceedings before IPOS

Three decisions issued by the IPOS in the last year clarify important practice points relevant to opposition proceedings. In the first case – *Distileerderji En Likburstokerij Herman Jansen BV v Tilaknagar Industries Ltd* ([2013] SGIPOS 3) – the applicant failed to file evidence in opposition proceedings by the stipulated deadline, which led to its trademark applications being deemed as withdrawn. It subsequently filed an application requesting the registrar to exercise its discretionary powers to allow for late filing of the evidence. The registrar found that there was a *bona fide* mistake on the part of the responsible solicitor, who had mixed up the deadline for filing evidence. However, the fact that the request for an extension was filed 11 days after the issuance of the registrar's notification that the trademarks were deemed withdrawn, and without good and sufficient reasons to justify such a delay, weighed heavily against the applicant. Further, no explanation was offered on how filing of the evidence was vital to the case. The contents of the evidence were also not explained at the hearing. Therefore, the registrar refused the request to restore the trademark application and allow the late filing of evidence. It held that a solicitor's genuine mistake *per se* is not necessarily sufficient to enable it to exercise discretion in favour of an extension. A mere assertion that there has been an oversight is obviously insufficient; some extenuating circumstances must be offered in explanation.

In another case involving the registrar's discretion – *Autozone Automotive Enterprise v Autozone Parts, Inc* ([2013] SGIPOS 7) – the opponent sought leave to file further evidence in support of the opposition after evidence had closed. The registrar refused to grant

leave as it found that the evidence sought to be filed was available earlier, and that if the opponent had wanted to, it could have filed the intended further evidence when it was due for filing in the course of the proceedings. This case serves as a reminder that leave to file additional evidence will not be granted as a matter of course. The registrar must balance consideration of the public interest that procedural rules are met with the need to ensure that cases are properly adjudicated based on their merits.

In *J-E Borie SA v MHCS* ([2013] SGIPOS 4) the IPOS had to consider for the first time the question of whether an opponent may rely on trademarks belonging to a third party which is not a party to the opposition proceedings. The decision turned on the interpretation of Section 13(2) of the Trademarks Act, which provides that any person may, within the prescribed time from the application's publication, give notice to the registrar of opposition to the registration. The registrar reviewed case law from the United Kingdom, Australia and Canada, academic literature, other provisions of the Trademarks Act and policy considerations in order to interpret the meaning of 'any person'. He concluded that there is no requirement that the person preventing registration be the proprietor of the earlier trademark or right, and therefore an opponent may rely on third-party trademarks. In particular, the registrar noted that trademark law allows for the invalidation of a trademark by any person on the basis of an earlier mark or earlier right, unless the proprietor of that earlier mark or right consented to the registration. Hence, it would be superfluous if 'any person' were interpreted only to mean the proprietor of the earlier mark or right. He also noted that opponents may rely upon third-party marks to demonstrate that certain elements are common to the industry and are therefore not distinctive under absolute grounds for refusal.

The extent of protection for descriptive marks

It is not uncommon for traders to use a trademark that announces to customers the goods or services being offered. However, there is clearly a risk in using a mark that is overly common or descriptive, as the courts are unlikely to award an overly broad scope of protection, even if the mark has gained a degree of market recognition. Two decisions issued by the Singapore courts explore the extent of protection granted to descriptive marks under common law.

In *Motherhood Pte Ltd v Lau Elaine* [2013] SGHC 258 the plaintiff and its predecessors published a periodical dealing with issues relating to pregnancy, motherhood, parenting and childcare under the name *Motherhood Magazine*, as well as certain special editions with the names *Motherhood Baby Plus*, *Motherhood Guide to*

Childcare and Motherhood Healthy Pregnancy (the Motherhood marks) since 1983. The plaintiff brought an action based on, among other things, the tort of passing off against the defendant for using the name *Today's Motherhood* (the disputed mark) for a competing publication. At the time of use of the disputed mark, the plaintiff owned no trademark registrations for the Motherhood marks.

Based on the evidence submitted, the court noted that the plaintiff's marks had been used in association with its business for decades and had also been advertised through various media in Singapore in relation to the plaintiff's magazine and annual exhibitions. Hence, there was goodwill attached to the Motherhood marks. However, it held that there is a clear policy in the law of passing off against allowing traders to monopolise the use of ordinary descriptive terms for their business, and this policy remains even where a trader has used a descriptive term as part of its mark for a long time. Other traders should be allowed to use the same descriptive term as long as they have taken sufficient steps to distinguish their mark from that of the original user.

Thus, although the plaintiff successfully established goodwill in the Motherhood marks, the court held that the two marks, when viewed in their entirety, were sufficiently dissimilar. Visually, the word 'today's' in the disputed mark was at least as prominent as the word 'motherhood'. In contrast, the word 'motherhood' dominated the title of the plaintiff's magazine, with the word 'magazine' being relegated to an inconspicuous corner. The overall impression that a reader would get was that the title of the plaintiff's magazine consisted of one word, whereas the title of the defendant's magazine consisted of two. Aurally, the beginnings of marks tend to receive more emphasis when pronounced, and here the two marks began with different words altogether. As for conceptual similarity, the two marks were undoubtedly conceptually similar in that both invoked the concept of motherhood. However, the court ruled that the

plaintiff was not entitled to a monopoly on the word 'motherhood', much less the general concept of motherhood.

However, small differences may not always suffice to distinguish between closely similar descriptive marks used in a niche context. In *The Singapore Professional Golfers' Association v Chen Eng Waye* ([2013] SGCA 18) the Court of Appeal considered a passing-off action instituted by the Singapore Professional Golfers' Association, a non-profit golfing association with the shortened name 'Singapore PGA' and initials SPGA. It brought an action against one of its former members and its limited liability partnership – Singapore Senior PGA LLP – for use of the name 'Singapore Senior PGA LLP' and its initials SSPGA. It was argued that the name 'Singapore Professional Golfers' Association' was a descriptive one, in that it essentially described the nature of the association and its activities. It was established by way of evidence that the association had been using its full name, shortened name and initials regularly since 1973, and that the initials were widely used and understood in the sport of golf throughout the world to mean 'Professional Golfers' Association'.

In these circumstances, the court found that the name of the association (in both its full and shortened forms) and initials had acquired a secondary meaning by virtue of their clearly being identified with the association and with the activities that it organised and promoted. The court noted that there was a strong similarity in the respective names and initials, given the order and combination in which the words in the names and the letters in the initials were used. In particular, the court noted that in using the letter 'A' in the name 'Singapore Senior PGA LLP' and in the last letter of the initials SSPGA, when it was neither a society nor an association, and not setting out the full name, the Singapore Senior PGA opened itself to the inference being drawn against it that, having regard to all the circumstances, it intended to reap the benefit of the inevitable association which its choice of name would enjoy with the association's name. To anyone in the relevant segment of the public, the letter 'A'

would have been understood to stand for 'association'. This was especially so because the PGA combination of letters is widely used both in Singapore and internationally in the field of golf to mean 'Professional Golfers' Association'. Based on this, the Court of Appeal held that it was a case of actionable misrepresentation.

Revocation for non-use

In *Autozone Automotive Enterprise v AutoZone Parts, Inc* ([2013] SGIPOS 1) the registrar revoked trademarks that had been registered by AutoZone Parts Inc for retail services in Class 35. The registrar held that while a case for use in Singapore by sale may be made out where the trademarks are registered for goods, in order to show that retail services have been provided in Singapore, the retail services themselves must have been provided in Singapore. In the matter at hand the only evidence of use of the mark was on the registrant's website – along with related advertising on the website – which was targeted at the US market and not the public in Singapore. The website stated that it shipped to the United States, US territories and overseas US military addresses only. It was necessary to insert a ZIP code and select one of the US states before a product could be ordered. Hence, it was not possible for a consumer based in Singapore to order products off the website. While the registrant adduced evidence to show that 282 unique users in Singapore had clicked on its website over a period of about 23 months, there was no evidence of any active steps "which led consumers to the website featuring the trade marks in question". The only two sale transactions with a Singaporean buyer occurred after the buyer had contacted the registrant by email to indicate his interest in purchasing the goods displayed on the website. Thereafter, the registrant confirmed that it could ship goods to Singapore and set out the steps by which the buyer could purchase the goods. The registrar held that the registrant would need to go beyond simply placing the offer for sale or advertising retail services on the Internet and hoping that someone from Singapore would enquire about its services.

This case illustrates that evidence to prove actual use of a registered mark must be directed to show such use in relation to the goods or services for which the mark is registered in Singapore. The mere fact that the proprietor features its mark on a website that is accessible from Singapore is generally insufficient to constitute use within Singapore. There must be evidence to show that some active step has been taken by the proprietor to offer or advertise the goods and services using the trademark. Where services are offered or advertised through the Internet, they can be supplied through a combination of the use of a merchandise website in the global communications network and email communications. However, the proprietor must show how the services are directed at consumers in Singapore through some active step.

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Likelihood of confusion: opposition versus infringement

In the most important decision of last year, *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide* ([2013] SGCA 65), the court for the first time set out the extent to which extraneous factors can be considered in a confusion inquiry and distinguished between the context of a confusion inquiry in opposition versus infringement proceedings. In this case, Australian hotel operator Staywell Hospitality Group filed an application for a PARK REGIS mark in Classes 35 and 43 (the offending mark):

The application was opposed by Starwood Hotels & Resorts Worldwide and its subsidiary, Sheraton International (collectively, the opponents), on the grounds, among other things, that the offending mark was confusingly similar to its ST REGIS mark registered by Sheraton in several classes, including Class 42 (the predecessor class for Class 43) in Singapore (the earlier mark). In 2012 the High Court ruled that there was no confusing similarity between the marks. The court took into consideration the parties' marketing and website design, the modes in which hotel bookings are usually made and the steps taken by Staywell to differentiate its services from those of the opponents and to reduce confusion – for example, the prominent display of the STAYWELL HOSPITALITY GROUP mark on Park Regis Singapore's website, classifying the hotel as a four-star hotel in a different category from the six-star St Regis Singapore, and the marketing of Park Regis Singapore as a business rather than a luxury hotel.

The Court of Appeal reversed the High Court's decision and observed that the inclusion of extraneous factors in the confusion inquiry must be managed so as to strike a balance between the competing goals of the trademark registration regime – preventing confusion and promoting business certainty. The court held that there is a difference in approach because of the difference in the context in which each provision is to be applied. In opposition proceedings, the contest is between the holder of a trademark registration – which enjoys certain monopoly rights associated with the use of its mark – and an applicant that wishes to use the mark in a particular way and also to have the associated monopoly rights that would enable it to prevent others from using their own marks, which would then threaten to dilute or affect the applicant's desired monopoly.

Accordingly, in opposition proceedings, the inquiry must take into account the actual and notional fair uses to which the incumbent proprietor has or might fairly put its registered trademark and compare against the full range of such rights sought by the applicant. In infringement proceedings there is no question of the alleged infringer seeking to establish any monopoly rights. The only question is whether the actual use of a similar or identical sign by the infringer encroaches on the registered proprietor's monopoly rights. Hence, the whole of the actual context of use will be relevant to the confusion inquiry.

Further, the Court of Appeal noted that there is room for the consideration of external factors in the confusion inquiry, but with certain qualifications, as set out below:

- Similarity of marks – the assessment of similarity is mark for mark, without consideration of any external matter. The court must conclude that the marks, when observed in their totality, are similar rather than dissimilar.
- Similarity of goods/services – extraneous factors are not to be considered where the goods and services are identical. Goods and services will be regarded as identical where they are registered or to be registered in the same class and specification in opposition proceedings. In infringement cases, it is permissible to have

2013

Case law review

regard to the classification in which the allegedly infringing item or service would have been inserted had the alleged infringer sought registration of its mark.

- Likelihood of confusion – extraneous factors may be considered to the extent that they inform the court as to how the similarity of marks and goods will likely affect the consumer's perception of the source of the goods, subject to the following qualifications:
 - In opposition proceedings, it is not relevant to consider differences in the intended market segments, trading strategies employed, websites used or the trader's chosen limitations as to its use of the mark. This is because in opposition proceedings, it is the overlap between the notional fair uses of the registered mark on the one hand, and of the applicant's mark on the other, that is at issue. Even in infringement proceedings, to the extent that extraneous factors are advanced in the attempt to negate a finding of likely confusion on the grounds that the marks are being deployed in such a way as to target different types of consumer or to notionally differentiate the goods in question, this must be avoided.
 - Extraneous factors that relate to the purchasing practices and degree of care paid by the consumer when acquiring goods of the sort in question can be considered and assessed without going into the details of particular differentiating steps which the trader might choose to take in relation to the goods and services falling within the specification.

Based on these principles, the Court of Appeal concluded that there was a likelihood of confusion between the marks. Consumers would be induced by the similarity of the marks and the common industry in which they were used to believe that there was at least some economic link between ST REGIS Singapore and PARK REGIS Singapore. This was especially so given that it is common for large hotel chains to operate differently branded hotels carrying different logos, united only by use of a common denominator in their names. This signals to the public that the various hotels, though pitched at different segments of the market, are economically linked. Consequently, the PARK REGIS marks were not allowed to proceed to registration. [WTR](#)

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