

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

Trade Mark Nos. 40201704182U and 40201704183P
14 March 2019

IN THE MATTER OF TRADE MARK APPLICATIONS BY

SENG FONG PAINTS PTE LTD

AND

OPPOSITION THERETO BY

TIGER COATINGS GMBH & CO. KG

Hearing Officer: Lam Chung Nian
IP Adjudicator

Ms Gillian Tan (Infinitus Law Corporation, instructed by Henry Goh (S) Pte Ltd) for
the Applicant

Ms Yvonne Tang (Drew & Napier LLC) for the Opponent

GROUND OF DECISION

1 To what extent does a trade mark registration for a word protect a device representation thereof? How would one compare the similarity of marks in such cases? These are, in essence, some of the questions posed in the instant opposition proceedings.

2 Seng Fong Paints Pte Ltd (“the Applicant”), applied to register the following trade marks (collectively, the “Application Marks”) in Singapore:

Trade Mark No.	Filing Date	Mark	Class	Specification
40201704182U	17 March 2017	 	2	Paints; coatings [paints].
40201704183P	17 March 2017	 	2	Paints; coatings [paints].

3 The application for Trade Mark No. 40201704182U was published on 2 June 2017 for opposition purposes. A little over a month later, the application for Trade Mark No. 40201704183P was published on 14 July 2017 for opposition purposes. Tiger Coatings GMBH & Co. KG (“the Opponent”), filed its Notices of Opposition to oppose both applications on 2 October 2017. The Applicant filed its Counter-Statements on 29 November 2017.

4 The oppositions to both applications were consolidated from the close of pleadings. As such, each party filed a single set of evidence in respect of the consolidated oppositions (hereafter referred to in the singular) to the applications.

5 The Opponent filed evidence in support of the opposition on 18 June 2018. The Applicant filed its evidence in support of the applications on 17 October 2018. Following the close of evidence, the Pre-Hearing Review was held on 16 January 2019. The opposition was heard on 14 March 2019.

Grounds of Opposition

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

Opponent’s Evidence

7 The Opponent’s evidence comprises a Statutory Declaration made by Christian Ebenberger, Sales and Marketing Director of the Opponent on 12 June 2018 in Austria (“Ebenberger’s SD”).

Applicant’s Evidence

8 The Applicant’s evidence comprises a Statutory Declaration made by Loh Sui Khuan, Director of the Applicant on 12 October 2018 in Singapore.

Applicable Law and Burden of Proof

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

Background



The Opponent

10 The Opponent is an Austrian incorporated entity engaged in the business of *inter alia* developing, manufacturing, and supplying powder coatings, wood coatings, paints, lacquer, ink, varnishes, distempers, primers and associated products, addressing the architecture, construction, automotive, appliances, new energy products, general industries, furniture, sports and leisure equipment markets.

11 The Opponent was established in 1930 and today has operations in many countries around the world. In Singapore, the Opponent had previously incorporated a local affiliate, TIGER Drylac Singapore Pte Ltd, but this was deregistered on 8 August 2012 and has since been struck off the Register of Companies. The Opponent’s products are now distributed in Singapore by a third party distributor, Berken Enterprises Pte Ltd (“Berken”).

12 The Opponent has asserted that it has distributed and sold its products globally under the “TIGER” and/or “TIGER Coatings” trade mark and trade name. The Singapore trade mark registrations held by the Opponent and relied upon in the instant proceedings (collectively, the “Opponent Marks”) are as follows:

Trade Mark No.	Filing Date	Mark	Class	Specification
T9508031A	24 August 1995	TIGER	2	Paints and varnishes.
T9507204A	4 August 1995	TIGER DRYLAC	2	Powder coatings, deposited or applied as powders, for industrial application on metal, glass, ceramic and clay substrates, on medium

				density fibreboard and on wood and on plastic, provided that such powder coating products are not offered for sale through retail outlets or otherwise at the retail level.
T8504461D	28 September 1985		2	Paints, lacquers in Class 2.
T1114387B	8 July 2011		2	Lacquers; powder lacquers; colors (paints); coatings; distempers; wood coatings (paints); primers.

The Applicant

13 The Applicant was incorporated in Singapore on 12 March 1996 and is engaged in the business of manufacturing and supplying paints and coatings. The Applicant asserts that it traces the roots to its use of “TIGER” as a brand for its paint products to the 1970s by Loh Nam Kheong Paint Factory, a partnership of 4 brothers first registered in Malaysia in 1969 (“LNKPF Malaysia”), and subsequently in Singapore in 1975 (“LNKPF Singapore”). These brothers were also the shareholders and directors of Loh Nam Kheong Paint Factory Sdn Bhd (“LKNPFSB”), a Malaysian private limited company.

14 In 1975, one of the partners, Low Chan Fay @ Low Chan Fay (“LCF”) filed a trade mark application in Malaysia for a tiger head device in respect of “*undercoat paint, red and black oxide paint, aluminium paint, timber marking paint, emulsion paint, gloss finish, bituminous black bituminous compound thinner, all included in Class 2*”, depicted below, which eventually attained registration as Malaysia Trade Mark Registration No. M/067618 (“the M/067618 Mark”). The proprietor thereof is now LKNPFSB.



15 In April 1996, the partners entered into an agreement pursuant to which LCF transferred all of his shares and interest in LNKPF Singapore to the remaining partners, against the latter *inter alia* transferring their shares and interest in LNKPF Malaysia

and LNKPFSB to LCF, and their resigning from the board of LNKPFSB. In this agreement, the parties acknowledged that the assets of LNKPF Malaysia included the M/067618 Mark. The Applicant further averred that in December 2016, the said trade mark was assigned to LNKPFSB.

MAIN DECISION

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

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

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

...

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

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

Decision on Section 8(2)(b)

17 The law in Singapore on the approach to be taken in applying Section 8(2)(b) of the Act is now well-settled.

18 The Court of Appeal in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 (“*Staywell*”) reiterated that a “step-by-step approach” is to be adopted in relation to an objection under Section 8(2)(b), as opposed to the competing “global appreciation approach” applied in Europe after *Sabel BV v Puma AG, Rudolf Dassler Sport* [1998] RPC 199.

19 Under this step-by-step approach, one should assess each of the following elements systemically and sequentially:

- (a) whether the marks are similar, and if so,
- (b) whether the goods or services are identical or similar, and if so,
- (c) whether as a result of the previous two determinations there exists a real likelihood of confusion.

The first two elements are assessed individually before the final element which is assessed in the round.

Similarity of the Marks

20 The Court of Appeal has in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941; [2013] SGCA 26 (“*Hai Tong*”), and *Staywell* also considered the applicable principles in assessing similarity of marks, which may be summarised as follows:

- (a) The similarity of marks is ultimately and inevitably a matter of impression rather than one that can be resolved as a quantitative or mechanistic exercise: *Staywell* at [17];
- (b) The thrust of the inquiry into similarity is directed at assessing substantive similarity. The three aspects of this evaluation, namely, visual, aural and conceptual similarities, aid the court's evaluation by signposting its inquiry: *Hai Tong* at [40(a)];
- (c) The law does not require all three similarities to be made out before the registered mark and the allegedly infringing mark may be found to be similar. Conversely, the fact that any one similarity is made out does not necessarily mandate a finding that the two marks are similar. Nor is each aspect of similarity of equal importance. Rather, the relative importance of each will depend on the circumstances, including the nature of the goods and the types of marks involved, and a trade-off can be made between the three aspects of similarity: *Hai Tong* at [40(a)];
- (d) It is not part of Singapore law that a low threshold applies when assessing mark similarity such that any modicum of similarity would compel the court to make a finding of marks-similarity. The court must ultimately conclude whether the marks, when observed in their totality, are similar rather than dissimilar: *Staywell* at [14-20];
- (e) The three aspects of visual, aural and conceptual similarity is not a checkbox exercise in which a tick, however faint it might be, in any one box must compel the court to find that the marks are similar when a sensible appraisal of the marks as a whole would show otherwise: *Staywell* at [14-20];
- (f) Technical distinctiveness is an integral factor in the marks-similarity inquiry – a mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it. Distinctiveness in the ordinary and non-technical sense simply refers to what is outstanding and memorable about the mark. Such components tend to draw the consumer's attention, bearing in mind the imperfect recollection of the average customer. Technical distinctiveness, however, is to be contrasted with the concept of descriptiveness – purely descriptive or laudatory words, however striking and memorable, cannot normally be distinctive in the technical sense, though they may in some circumstances acquire distinctiveness. *Staywell* at [22-25];
- (g) 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: *Staywell* at [25];
- (h) The viewpoint adopted in assessing similarity of marks is that of the average consumer who would exercise some care and a measure of good

sense in making his or her purchases, not that of an unthinking person in a hurry. Furthermore, it is assumed that the average consumer has “imperfect recollection”. As such, the two contesting marks are not to be compared or assessed side by side and examined in detail for the sake of isolating particular points of difference. Instead, the court will consider the general impression that will likely be left by the essential or dominant features of the marks on the average consumer: *Hai Tong* at [40(c)-(d)];

- (i) In assessing the similarity between two contesting marks, the court does not take into account “any external added matter or circumstances” because the comparison is “mark for mark”: *Hai Tong* at [40(b)]; and
- (j) At the marks similarity stage this even extends to not considering the relative weight and importance of each aspect of similarity having regard to the goods. This does not mean that the court ignores the reality that the relative importance of each aspect of similarity might vary from case to case and will in fact depend on all the circumstances including the nature of the goods and the types of marks. Rather, such considerations are properly reserved for the confusion stage of the inquiry, because that is when the court is called upon to assess the effect of objective similarity between the marks, on the perception of consumers: *Staywell* at [20]. When assessing the likelihood of confusion, extraneous evidence may be taken into account: *Staywell* at [96].

Visual Similarity

21 I turn now to consider the visual similarity of the marks.

22 In *Hai Tong*, the Court of Appeal considered, at [62], the relevant principles in relation to the visual similarity of composite marks, which are summarised below:

- (a) When assessing two contesting marks or signs, the court does so with the “imperfect recollection” of the average consumer. The two marks or signs should not be compared side by side or examined in detail because “the person who is confused often makes comparison from memory removed in time and space from the marks”;
- (b) The visual similarity of two contesting marks or signs must normally be assessed by reference to the overall impressions created by the marks or signs, bearing in mind their distinctive and dominant components. When the other components of a trade mark are of negligible significance, it is permissible to make the comparison solely on the basis of any dominant element(s);
- (c) 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;

- (d) The textual components of a composite mark could (but will not necessarily or always) be the dominant component of the mark. Some instances where this might be the case include where:
 - (i) The two marks in question each contain a similar device. The overall resemblance between them may then be diminished if they bear words, which are entirely different from each other;
 - (ii) 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 or sign;
 - (iii) The textual component is in itself already widely known; and
 - (iv) The composite mark or sign is applied to goods or services marketed or sold primarily through online trade channels;
- (e) The device component has been found to be an equally significant, if not the dominant, component of a composite mark or sign where:
 - (i) the device is significant and large;
 - (ii) the accompanying word(s) are devoid of distinctive character, or are purely descriptive of the device component or of similar goods of a superior quality; or
 - (iii) the device component is of a complicated nature;
- (f) But usually not where:
 - (i) the device is simple and will not evoke any particular concept for the average consumer;
 - (ii) the device component does not attract the attention of the average consumer of the goods in question because such a consumer is regularly confronted with similar images in relation to those goods; or
 - (iii) the device component is more likely to be perceived as a decorative element rather than as an element indicating commercial origin.


23 Since the Opponent has relied on a number of marks, I will consider each in turn:

Visual Similarity viz T9508031A – “TIGER”, T9507204A – “TIGER DRYLAC” and T1114387B “” (collectively, “Non-Pictorial Marks”)

24 The Opponent’s arguments in relation to visual similarity viz the Non-Pictorial Marks are as follows:

- (a) the distinctive, dominant, and essential part of the Opponent Marks is the textual element of “TIGER”, whereas the Application Marks comprise three components: the tiger device, “LNK”, and “Brand” or “Coatings”;
- (b) as the words “BRAND” and “COATINGS” in the Application Marks are descriptive, they should be disregarded, and they can therefore be viewed as being made up predominantly of the tiger device and “LNK” – neither of which dominates the overall impression;
- (c) having regard to the respective dominant components and when viewed as wholes, by virtue of the distinctiveness of the Opponent Marks in the Application Marks, there is at least some visual similarity between the competing marks; and
- (d) the tiger device of the Application Marks is of a “complicated nature” being “a striking, unmistakable portraiture of a tiger”, set against a contrasting white background. The tiger device will leave an impact in the minds of the average consumers. It stands alone as a distinctive element of the Application Marks and is not subordinated by the word “LNK”.

25 In response, the Applicant argued that its tiger device occupies only approximately 10% of the total area of the Application Marks, and is at the far left of the Application Marks. The presence of the acronym “LNK” in uppercase letters also adds to the visual impact of the textual component.

26 The Applicant has also sought to rely on *Ceramiche Caesar SpA v CaesarStone Sdot Yam Ltd* [2015] SGIPOS 9 (“*Caesarstone*”), where although the learned Principal Assistant Registrar (“PAR”) found at [47] that the device in the mark “ caesarstone” was “rather fancy and quite possibly can be regarded as distinctive on its own”, she recognized that “*there is a need to look at the device in the context of the Application Mark. It is clear that the device, while distinctive, only constitutes a small part of the Application Mark, when the Application Mark is viewed as a whole.*”

27 The Court of Appeal in *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 (“*Caesarstone (CA)*”) agreed with the learned PAR and found that the device component in the application mark was an insignificant component. The Court of Appeal held at [37] that:

We accept the Judge’s observation that the device appears just at the beginning of the textual component, and also the Respondent’s submission that the former is larger (albeit only very slightly) than the font of the latter. On balance, however, we agree with the PAR that the device only constitutes a small part of the Respondent’s CAESARSTONE Mark when the mark is viewed as a whole.

28 Applying the legal principles discussed above, in a mark-for-mark comparison, I am of the view that the Application Marks are not visually similar to the Non-Pictorial Marks.

29 The overall visual impression communicated by the Applicant's mark is a tiger device in combination with the words "LNK Coatings" / "LNK Brand", where the textual elements are presented very prominently, and linked with the device element via a bold, dark frame bounding both elements.

30 Even ignoring the words "Coating" and "Brand" in the Application Marks for being descriptive terms, the tiger device occupies a relatively small part of the marks overall.

31 "LNK" is presented in heavy, bold text, and features prominently in the Application Marks. Being a three letter acronym (presumably derived from the "Loh Nam Kheong" name used in connection with LCF's businesses) without any ordinary meaning, this acronym stands out as a highly distinctive element. This textual component in the Application Marks stands out in the marks as a whole.

32 As such, even with an imperfect recollection of the marks, consumers are likely to recall the "LNK" acronym element in combination with a tiger device, rather than the tiger device alone.


33 In any event, the word "tiger" does not feature at all in the Application Marks. Can the Opponent nonetheless rely on its Non-Pictorial Marks to argue that the word "tiger" in these marks is enough to trigger in the mind of a consumer the image of a tiger, such that the Applicant's mark may still be said to be visually similar?

34 The Opponent has asserted, relying on the Singapore High Court decision in *Han's (F & B) Pte Ltd v Gusttimo World Pte Ltd* [2015] SGHC 39 ("*Han's*") and the decision by the learned Registrar in *Abercrombie & Fitch Europe SAGL v MMC International Services Pte Ltd* [2016] SGIPOS 6 ("*A&F*") as to the distinctiveness of arbitrary terms, that since "tiger" is an arbitrary term with no nexus to the Opponent's goods comprised in the specifications of the Non-Pictorial Marks, it hence enjoys a high degree of technical distinctiveness. Accordingly, a high threshold must be established before a competing sign will be considered dissimilar to it.

35 In response, the Applicant has argued that "tiger" is an ordinary dictionary word with a widely known meaning. It is not an invented word or acronym (unlike in the *A&F* case), and the present case is instead more in line with *Clarins Fragrance Group fka. Thierry Mugler Parfums S.A.S v BenQ Materials Corp.* [2018] SGIPOS 2 ("*Clarins*"), wherein the learned PAR found that the inherent technical distinctiveness of the earlier mark, "angel", is normal or medium in nature by virtue of "angel" being a common English word. Further, the Applicant also relied on *Converse Inc v Southern Rubber Works Sdn Bhd* [2015] SGIPOS 11 ("*Converse*"), where the marks being compared featured a central star device, but were nonetheless found dissimilar because the words "JAZZ STAR" were found to be a distinctive component of the application mark, being non-descriptive and the brand name of the applicants.

36 Whilst I accept that arbitrary marks generally have a higher degree of distinctiveness, these cases do not stand for the proposition that all arbitrary words in relation to any particular goods should be *automatically* classified as having inherently high technical distinctiveness. Indeed, both the *Han's* and *A&F* cases related to marks that referenced names, i.e., Han (a surname), and Abercrombie & Fitch, respectively, hence it is not surprising that a high degree of technical distinctiveness was found.

37 In the present case, however, “tiger” is a common English word. Hence, whilst it is true that “tiger” has no connection with paint and is hence arbitrary, the comparison with the approach taken by the learned PAR in *Clarins* in [30] is more appropriate, i.e., “Obviously, “ANGEL” is an ordinary English word. It is not an invented word or name and therefore does not possess a great degree of inherent technical distinctiveness.”

38 Having so concluded in relation to T9508031A “TIGER”, the above analysis will equally apply in relation to T9507204A “TIGER DRYLAC” and T1114387B “”, since these respectively add the further elements “DRYLAC” (which appears to be an invented word) for T9507204A and the elliptical hexagonal frame bounding “TIGER” as well as colour elements for T1114387B, such that the visual similarity of the Application Marks with each of these marks of the Opponent is even more removed.

39 The Opponent has also sought to rely on the cases *Case C-120/04 Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* [2006] ETMR 13 (“*Medion*”), and *Doctor’s Associates Inc v Lim Eng Wah (trading as SUBWAY NICHE)* [2012] 3 SLR 193; [2012] SGHC 84 (“*Subway Niche*”), to argue that the textual elements of the Application Marks do not change the fact that both of these marks share a common distinctive denominator, namely, the element of a tiger. The Opponent asserted that its word marks, namely T9508031A “TIGER” and T9507204A “TIGER DRYLAC”, retain an independent distinctive role within the Application Marks, given that the tiger device is at least one of the dominant components of the Application Marks. The visual similarity, at least of a moderate degree, lies therein.

40 In response, the Applicant argued that in *Medion*, the marks in question were word marks (“LIFE” vs “THOMSON LIFE”), whereas the Application Marks do not actually contain the word “TIGER”. Likewise, in *Subway Niche*, the word “SUBWAY” appeared in both marks.


41 I would agree that *Medion* and *Subway Niche* are distinguishable as there is no overlap in the textual components in the marks whatsoever.


42 I would round up my comments on the visual similarity comparison of the word marks by observing that in *Hearst Holdings Inc & Another v A.V.E.L.A. Inc & Others* [2014] EWHC 439 (Ch) (“*Betty Boop*”), which was relied upon by the Opponent in the context of arguments on conceptual similarity (and further discussed below), it was held by the learned judge that a word mark registration can be relied upon in establishing a trade mark infringement claim arising from the use of a device element represented thereby, even where the words are not actually used by the defendant.

43 This was not a point specifically canvassed by counsel for the Opponent in the context of arguments on visual similarity, and I will discuss the *Betty Boop* case in greater detail below, but I would observe at this juncture that the above conclusion by the judge was on the very special facts thereof, i.e., that the character Betty Boop was an entirely fictional cartoon character, and the name Betty Boop was practically synonymous with the character’s likeness, such that in the mind of consumers, the depiction of her in an image would have been evocative of her name as well. This is clearly not the case in the present proceedings, since “tiger” is a common English word, which would not call to mind any particular depiction of a tiger.

Visual Similarity viz T8504461D -  (“Cartoon Tiger Mark”)

44 Applying the legal principles discussed above, I am equally of the view that the Application Marks are visually dissimilar when compared with the Cartoon Tiger Mark.

45 The Cartoon Tiger Mark comprises a tiger device combined with . The tiger is presented in a very cartoonish manner, and is depicted wielding what appears to be a paint-spray with its right paw, and its left paw pointing downwards towards what appears to be a container. Clearly, this is a very fanciful and unusual representation of a tiger.

46 In contrast, the tiger device presented in the Application Marks is of a tiger’s head, drawn as a natural or “realist” portrait. The imagery is strikingly different compared with the Opponent’s tiger device. Taking into account the word mark elements of the  component in the Opponent’s Cartoon Tiger Mark, compared with the bold “LNK Brand” / “LNK Coatings” in the Application Marks, the visual differences become further emphasised. Even applying an imperfect recollection test, the consumer should recall the striking differences in the representations of the tiger in the two marks, and further, the word elements.

47 In the circumstances, I find that the Application Marks are not visually similar to the Opponent Marks.



Aural Similarity

48 The Court of Appeal in *Staywell*, at [31] to [32], discussed the two main ways of assessing whether marks are aurally similar, i.e.:


- (a) Considering the dominant components of the mark in assessing the question of whether the competing marks as a whole were similar (the “Dominant Approach”); or
- (b) Undertaking a quantitative assessment as to whether the competing marks have more syllables in common than not (the “Quantitative Approach”).

49 The Opponent’s submissions were largely founded on the argument that the Application Marks would be verbalised as “tiger”, especially since they contain a “manifestly straightforward and direct device” such that the relevant public would be prone to refer to it as a “tiger” mark.




50 The Opponent relied on a few cases in support of this argument. In *S Tous, S L v Ng Wee Ping* [2010] SGIPOS 6, the PAR held in a comparison between the

application mark  and the opponent’s  mark that “both marks consist of the idea of a teddy bear and will be referred to as the “teddy bear” marks by consumers and the general public. Thus, it is undisputed that the two marks are conceptually

similar as well as aurally similar (considering that both marks will be called the “teddy bear” marks).”

51 In *Case T-389/03 Dainichiseika Colour & Chemicals Mfg. Co. Ltd v OHIM* [2008] ECR II-00058, the European Court of First Instance held that the mark applied for, , would be perceived as depicting a pelican and consequently, consumers would refer to it by using the term in their native language corresponding to the term ‘pelican’.

52 Further, the Registrar in *In the Matter of Application No 2633502 by Kate Walton to Register the Trade Mark and the Opposition thereto under No 104530 by J & P Coats, Limited (Case No. O-063-14) (“Kate Wolton”)* found the compared marks (below) to be aurally similar, holding at [51] that “[t]he trade mark of Miss Walton will be perceived as a heart and will be vocalised as the word heart. Consequently, as all of the earlier trade marks include the word heart or the word heart and a device of a heart, there is a degree of ... aural similarity between all of these trade marks and that of Miss Walton”.

Earlier Trade Marks in <i>Kate Walton</i>	Application Mark in <i>Kate Walton</i>
RED HEART RIBBONS	
RED HEART SOFT TOUCH	
RED HEART WITH WOOL	
 RED HEART	
	

53 On the other hand, in *Polo/Lauren Co LP v United States Polo Association* [2016] 2 SLR 667, the learned judge expressed his reservations with regard to finding aural similarity where no aural component exists, observing at [22-23] that:

Whether a mark that is found to have no aural component may nonetheless be found to be aurally similar to another mark does not appear to be settled law; for example, in *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2014] SGIPOS 10, the principal assistant registrar found that there could be no aural similarity given that the mark which the opponent sought to rely on had no aural component. This aspect of the decision was undisputed and was therefore not disturbed in the appeal to the High Court: *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] 5 SLR 618 at [85]. Personally, I have my reservations. To find aural similarity where no aural component exists seems to allow for visual or conceptual similarity to be accounted for within the assessment of aural similarity. ... But even if I were to accept that the Opposition Mark would be verbalised as “polo-player”, I am not persuaded in respect of the Application Mark.

54 The Opponent also argued that to say that a device with no aural component cannot be found to be aurally similar to another mark would be untenable and unrealistic, as it is only natural that the relevant public would verbalise a device when asking for the product bearing the device, as opposed to merely gesturing or pointing at the product.

55 Further, significant reliance was placed by the Opponent on *La Societe Des Brasseries Et Glacieres Internationales v Asia Pacific Breweries Ltd* [2006] SGIPOS 5 (“*Tiger Beer*”) wherein the application mark depicted below was opposed by the proprietor of earlier registered marks including the word “TIGER” and a device of a tiger.



56 The competing marks covered identical goods (beer in class 32). In finding that the competing marks were aurally similar, the PAR came to the conclusion that some consumers would refer to the application mark as “tiger” beer, notwithstanding the words “Biere Larue” being featured in the mark:

When the customer refers to the Applicants’ beer aurally, he may refer to it as a “tiger” beer meaning the beer that has a tiger’s face on it or he may refer to it as Biere Larue. However I am of the view that it is more likely that the Applicants’ beer will be referred to as a “tiger” beer because the predominant feature on the Applicants’ beer is a tiger’s face. The customer who refers to it as Biere Larue will be someone who is already familiar with the Applicants’ beer and who is probably also familiar with the Opponents beer because of their reputation. The customer who is familiar with both brands as Biere Larue and Tiger beer is not going to be confused. I am of the view that the customer who is not familiar with the Applicants’ beer or the Opponents’ beer may refer to both as “tiger” beers. ...

Would the average Singaporean refer to the Applicants’ beer by the name Biere Larue rather than as a “tiger” brand beer as submitted by the Applicants? They have not said why the average Singaporean would refer to the name rather than the device in the mark. Perhaps they mean that as a general principle, if there is a picture in a mark and a word in a mark, the customer is likely to describe the mark by the word rather than the picture. However this depends on a lot of factors. Without going into all of the factors, it is sufficient for me to say that, a mark may have a bigger word and a smaller picture, but if it is the picture that leaves an impression, the mark may be remembered by the picture and referred to by the name of the picture (if the picture has a name) ...

Assessing both elements in the Applicants’ mark, I think that it is more likely that the average consumer will refer to the Applicants’ beer as a “tiger” brand beer because the tiger is more prominent. I have another reason for my view.

The name of the Applicants' beer is in French, not in English. When faced with a foreign name in a mark and when the picture in the mark is the more dominant feature, I am of the view that the mark will be referred to by the picture. It is whether the average Singaporean is more likely to choose to describe the Applicants' beer by its foreign name or by its device. I think that because the device is more dominant and also because the name of the beer is not in English, it is more likely that the average Singaporean would refer to the Applicants' beer by its representation of a tiger's face.

57 In response, the Applicant asserted that the present case may be distinguished from the above cases on the basis that the Application Marks contain textual components ("LNK Brand" and "LNK Coatings") which have no corresponding relation whatsoever to any element of the Opponent Marks. There is thus no need to identify how and whether the Applicant's tiger device would be verbalised by the relevant public simply because the relevant public would verbalise the marks with reference to the textual components.

58 As for the *Tiger Beer* case, the Applicant submitted that the learned PAR was of the view that it is more likely that the average consumer will refer to the applicants' beer as a "tiger" brand beer because the tiger device is more prominent, and the name of the applicant's beer is in French, not in English.

59 The Applicant also sought to rely on the *Converse* case, where the learned IP Adjudicator held that despite the common star devices in the marks in issue, they would be respectively remembered by their textual components which contain their respective brand names, and not as "star" marks, and further, the IPOS Work Manual, where [at Chapter 7, Section 4(a)(14)] it is stated that "*if a consumer wanted to buy a pair of NIKE trainers, he would ask for them by name even through (sic) the "swoosh" device on the side of the trainers is in itself very distinctive. He would not ask for a pair of trainers with a "swoosh" device on the side.*"

60 The case *In the Matter of International Registration No. 1130543 in the Name of Vinprom Peshtera Ad for the Trade Mark in Class 33 and in the Matter of Opposition thereto under No. 400102 by Baron Philippe De Rothschild SA (Case No. 0-147-14)* was also cited by the Applicant, wherein the Registrar found that despite the presence of a ram device in both marks, "*insofar as the aural comparison is concerned, it is well established that where a mark consists of a combination of words and devices, it is by the word elements that the average consumer is likely to refer to the mark. The applicant's mark will be referred to as BLACK RAM whereas the opponent's mark will, despite its size relative to other elements in the mark, be referred to by the surname ROTHSCHILD.*"

61 Upon a review of the authorities, I am of the view that it is clear that one cannot apply an overly technical or mechanistic approach to determining whether textual or device elements of a mark would be more relevant in determining the issue of aural similarity. Rather, this should also be assessed on the basis of what would strike a consumer, looking at the marks fairly and having regard to their imperfect recollection thereof, as being the most prominent and distinctive elements of the marks, what these elements might connote, and whether these elements would be used by consumers in referencing the mark aurally.

62 Indeed, this approach would also be consistent with what the Court of Appeal in *Hai Tong* had held to be the correct approach, albeit in dealing with the test for assessing the visual similarity of marks where one or more of the marks is a composite mark.

63 In *Hai Tong*, at [62], it had been advanced as a proposition of law that in general, words “talk” in composite marks having both textual and non-textual elements, such that the textual elements would override the other. This was attributed to the following passage in *Lee Cooper Group plc v Levi Strauss & Co* [1995] AIPR 457 (“*Lee Cooper*”), which was then applied by the High Court in *Chai Chyau Ling (doing business as Racetech Auto) v Racing Technology Pte Ltd* [2009] SGHC 105:

Words ‘talk’ in trade marks. Thus, if a mark consists of a device in combination with a distinctive word (i.e. a word of a trade mark nature), it is most likely that it is by the word that the public will normally order goods under the mark. Therefore, where two marks resemble each other to the extent that they each contain a similar device, the overall resemblance between them will generally be lessened if they bear words of a trade mark nature which are entirely different from each other.

64 After reviewing various authorities, the Court of Appeal held that the real point the Assistant Registrar for Trade Marks (“TMAR”) was making in *Lee Cooper* was that the textual components in that case stood out, or “talked”, because they were the dominant components of the marks in question. The TMAR’s focus on the textual components of the marks in *Lee Cooper* was not meant to fashion a general principle of trade mark law that the textual component of a composite mark is always and necessarily the dominant element. Rather, the textual components of the two marks in question in that case were in fact the dominant components of the respective marks because of the similarity of the arcuate stitching devices in both marks.

65 The Court of Appeal held that in assessing the visual similarity of two composite marks, 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, rather than applying a general rule that words in trade marks “talk” in determining the issue.

66 The Court of Appeal further noted that in certain circumstances, words can indeed “talk” in trade marks even if they do not form the dominant component of a composite mark. One such instance is if the textual component is in itself already widely known, or where the textual component of a composite mark would generally be the dominant component is where the goods or services bearing the mark are marketed and sold predominantly through online trade channels.

67 Having regard to the above, it is clear that the Opponent Marks will be aurally referred to using the “tiger” element. As for the Application Marks, however, given the prominence of “LNK Brand” and “LNK Coatings”, the terms “brand” and “coatings” whilst non-distinctive would clearly indicate to the consumer that “LNK” is in fact the brand communicated by the mark, hence, adopting the Dominant Approach in *Staywell*, this will be the part of the mark that will be verbalised.

68 The Opponent has also sought to argue that as the tiger device is depicted on the left of the mark, it “*tends to grab the attention of consumers more than the elements that follow*” (*Deutsch v Credit Lyonnais SA* [2007] ETMR 4 at [19]). This might indeed be (momentarily) the first element that might catch the eye of consumers, but one must also have regard to the placement and size of the device relative to the other elements of the Application Marks, and looking at the mark as a whole, it appears to be subordinated to the “LNK Brand” and “LNK Coatings” elements. I am also mindful of the finding in *Caesarstone*, where the device component of the applicant’s mark was found to be non-dominant, notwithstanding that it was at the left of the mark.

69 I would also disagree with the Opponent’s submissions that “consumers who are not familiar with the brand would have a particularly high tendency of referring to it as “TIGER” brand” as the result of an amalgamation of “LNK” being an inventive word that consumers are not familiar with and would have difficulty pronouncing, and consumers’ general familiarity with tigers. On the contrary, as discussed above, given the prominence of the LNK elements and the terms “brand” and “coatings” signalling that “LNK” is in fact the brand communicated by the mark, it is unlikely consumers will verbalise the Application Marks as “Tiger”.

70 For the reasons set forth above, therefore, I therefore consider it more than likely that the Application Marks will be aurally referred to as “LNK Brand” and “LNK Coatings”.

71 Even if I am wrong in concluding that the tiger element would be subordinated to “LNK” in the Application Marks, as the Opponent submits, the Application Marks will be aurally referred to as “TIGER L-N-K”. This will be aurally different from “tiger” simpliciter, since the LNK reference would be enunciated by each letter. On this basis, even applying the Qualitative Approach in *Staywell*, the marks will not be aurally similar.

Conceptual Similarity

72 Conceptual similarity is directed at the ideas that lie behind or inform the marks or sign in question (*Hai Tong* at [70]).

73 The Opponent has sought to argue that the idea or concept conveyed by the Application Marks is that of a tiger, relying on various authorities including:

- (a) the *Tiger Beer* case, where both the Opponent’s word TIGER and the Applicant’s Mark conveyed the idea of a tiger, and the words in the Applicant’s Mark, BIERE LARUE, “[did] not convey any idea to the Singaporean public as they are in French”;
- (b) the *Kate Wolton* case, where all of the earlier trade marks included the word “heart” or the word “heart” and a device of a heart, there was a degree of conceptual and aural similarity between all of these trade

marks and that of Miss Walton’s  mark;



- (c) *EUIPO's Guidelines for Examination of EU Trade Marks* (“*EU TM Guidelines*”), issued by the European Union Intellectual Property Office, where it is stated at Part C, Section 2, Chapter 4 at [3.4.4.5] to [3.4.4.6] that:

“[3.4.4.5] *Conceptual identity also exists between a word and an image showing what the word represents (fictional examples: word mark ‘TIGER’ compared with a figurative mark depicting a tiger; or word mark ‘orange’ and a mark for the colour orange per se).*”

[3.4.4.6] *Where the signs have a meaningful word in common that is distinctive, and one or both of them contains an additional word element without any meaning (a fanciful word or one that will not be understood in the relevant language area), the signs are considered conceptually highly similar, and not identical. In such a case, even if not understood, the relevant public will note the presence of the additional term that prevents the signs from being perceived as conceptually totally identical.”*

- (d) The *Betty Boop* case, where an infringement claim based on the word mark registration for “BETTY BOOP” was successful, the infringer having only used the image of Betty Boop, which the court held triggered the perception of the words.

74 In response, the Applicant argued that the *Tiger Beer* case can be distinguished based on the fact that the applicant’s mark was found to be dominated by the face of the tiger, and the words in the applicant’s mark were found to be a secondary feature, whereas in the present case, the words are dominant and distinctive. Even if the acronym “LNK” did not evoke any underlying meaning, the idea of a brand or entity by reference to “LNK” conveyed by the Application Marks could not be dismissed and would be unlikely to be overlooked by the average consumer.

75 The Applicant also sought to rely on *Monster Energy v Chun-Hua Lo* [2017] SGIPOS 17 (“*Monster*”), where the learned PAR found that the marks “MONSTER” and “” were not conceptually similar because the idea conveyed by the  device was that of a “cute” creature which deviates from the perception of the “Monster” mark, which is normally that of a creature having a frightening appearance.

76 In my view, the authorities cited by the Opponent are of limited application in the instant case. In *Tiger Beer*, as the learned PAR had observed, the words “BIERE LARUE” being in French would have been meaningless to the general public in Singapore. As such, the tiger element would have been the most recognisable or distinctive component of the mark. This, coupled with the prominence of the tiger portrait in the mark would have dominated the idea or concept of the mark.

77 The propositions in *Kate Wolton* and *EU TM Guidelines* that device and word elements in marks can be conceptually similar are not at all controversial, but on the facts, we have to recognise that in the Application Marks, whilst there is indeed a tiger device, the “LNK Brand” and “LNK Coatings” elements feature prominently, with the

result that the concept that is conveyed incorporates these elements, as opposed to the imagery of a tiger on its own. In other words, had the Application Marks only comprised a tiger device, I might have been more prepared to hold that there was conceptual similarity with the Non-Pictorial Marks, but clearly, this is not the case.

78 In relation to the comparison with the Cartoon Tiger Mark, whilst this mark incorporates a tiger device element, as discussed above, it is depicted in a very cartoonish manner and in a pose that is very unnatural, hence whilst there is greater conceptual similarity of the Application Marks to this relative to the Opponent's Non-Pictorial Marks, the idea conveyed is very different, much as the learned PAR concluded in *Monster*.

79 Indeed, the *Betty Boop* case is probably most on point, given that the Application Marks contain a tiger device without actually referencing the word "tiger" at all in its mark. It should be noted however that the court was only prepared to find the visual/conceptual similarity between the marks given the very unique facts. As the learned judge explained:

The words will be perceived spontaneously and inevitably because they are the name of the character. Both the character and her [Betty Boop] name are well known and there is a strong association between the two. As I have said before I think many consumers would not even notice that the words BETTY BOOP are absent. ...

As I have also said before, I reject the idea that this image is purely decorative. It is decorative and attractive but not purely so. The average consumer would recognise it as merchandising and take the presence of Betty Boop as an indication that the product was licensed from a source of merchandising licenses associated with that character. Thus the average consumer would regard the presence of Betty Boop on the product as having origin significance. The conceptual similarity between the image and the word mark BETTY BOOP will cause the average consumer to think that the image conveys the same origin information as the words would. Accordingly they will be confused about the trade origin of the goods and so there is a likelihood of confusion in terms of s 10(2)/art 9(1)(b).

80 It is therefore clear from the judge's reasoning that he was prepared to find the visual and conceptual similarity on the basis of the Betty Boop character being wholly an invented character, and where the public closely associated her imagery with her name to such a degree that the image and name were practically synonymous.

81 On the present facts, however, there is no evidence to suggest such a high degree of association between any particular images of a tiger used by the Applicant with that of the Opponent Marks.

82 In the present case, the presence of the predominant "LNK Brand" and "LNK Coatings" played a significant role in my conclusion that the marks are not conceptually similar.

83 I should also comment however, in response to the Opponent's submissions, that I do not think that the test of the conceptual similarity can be set so low that

similarity may be found so long as some vague general concept may be identified as common across both marks being compared, especially when comparing textual and device representations, such that for example, a word mark for “tiger” should thus be automatically regarded as conceptually similar to any device representation of a tiger.

84 When comparing conceptual similarity between device marks, one would naturally take into account the manner in which each object or thing is depicted in the respective device marks, for example, the characteristics or features portrayed, the context within which each is presented, etc. in deciding whether there is conceptual similarity.

85 The approach taken in relation to whether there is conceptual similarity between a word and a device representation thereof should thus be similar, i.e., whether the meaning conveyed by the textual elements in the mark are conceptually similar to the device elements. Naturally, where the text description is detailed enough or highly distinctive and evocative of any particular imagery, hypothetically, for example “leaping tiger”, or “flying horse”, and the device representation depicts a similar imagery, there will be scope for finding a higher degree of conceptual similarity, as illustrated in the *Betty Boop* case. However, where the word being compared is a mere common English language term or a generic descriptor, the detailing offered by a device representation thereof will likely only allow for a finding that there is little or no conceptual similarity other than a vague general *association* between the word and device representations.

Conclusion on Similarity



86 In the circumstances, I find that there is no similarity between the Application Marks and Opponent Marks.

87 Having regard to the step-by-step approach expounded in *Staywell*, this would also have been dispositive of the grounds of opposition under Section 8(2)(b), TMA. In case I am wrong however, I turn now to consider the remaining issues under Section 8(2)(b), TMA.

Similarity of Goods

88 The goods for which the Application Marks and Opponent Marks have been respectively applied for or registered are as follows:

Application Marks	Opponent Marks
<u>Class 2</u> Paints; coatings [paints].	TIGER (T9508031A) <u>Class 2</u> Paints and varnishes.
	TIGER DRYLAC (T9507204A) <u>Class 2</u> Powder coatings, deposited or applied as powders, for industrial application on metal, glass, ceramic and clay substrates,

	on medium density fibreboard and on wood and on plastic, provided that such powder coating products are not offered for sale through retail outlets or otherwise at the retail level.
	 (T8504461D) <u>Class 2</u> Paints, lacquers in Class 2.
	 (T1114387B) <u>Class 2</u> Lacquers; powder lacquers; colors (paints); coatings; distempers; wood coatings (paints); primers.

89 The Opponent’s registrations for the Non-Pictorial Marks all contain claims for “paint”. It is not contested by the Applicant that the items comprised in the Application Marks are similar.

Likelihood of Confusion

90 In *Staywell* at [55], the Court of Appeal held that the issue of the likelihood of confusion directs the court to look at (a) how similar the marks are; (b) how similar the services are; and (c) given this, how likely the relevant segment of the public will be confused:

As to the relevant segment of the public, there may be characteristics that are particular to the group in question. Each of these factors will have a bearing on the likelihood of confusion. As an illustrative proposition, the likelihood of confusion must be greater where, say, the contesting marks are similar to a high degree, the goods are identical in nature and the segment of the public in question is undistinguished in its attention than would be the case if the marks and the goods are somewhat similar but not exceedingly so, and the relevant segment of the public happens to be highly knowledgeable and very fastidious.
...

91 In *Caesarstone Sdot-Yam Ltd v Ceramiche Caesar SpA* [2016] SGHC 45, Wei J summarised the various authorities on the point as follows at [108-109]:

There are two aspects to the element of confusion: the first is where the relevant public think that the goods or services bearing the later mark are those of the earlier trade mark proprietor. The second is where the relevant segment of the public are led to think that the proprietor or user of later mark is an economically

linked entity such as a licensee: *Sarika Connoisseur Café Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 at [63]; *Staywell* at [74].

Whilst confusion includes the drawing of an economic link between the marks, a mere association between the marks is not in itself a sufficient basis for concluding that there is a likelihood of confusion. It is insufficient that the relevant segment of the public would recognise or recollect similarities between the contesting marks if there is no likelihood of confusion as to origin ensuing (*Hai Tong* at [75]). What is required is the likelihood of confusion above a *de minimis* level (*Hai Tong* at [78(e)]).

92 The Opponent has argued that in the current opposition proceedings, the relevant segment of the public is the average consumer of paints, coatings, and associated products, relying on the judgment in *Colorland Paint Centre Pte Ltd v Toto Group Pte Ltd formerly known as Toto Paint Pte Ltd* [2011] SGIPOS 19 (“*Colorland*”).

93 At [39], the PAR in *Colorland* observed that the relevant public “*is not confined to the renovation contractors, persons from the building industry but potentially any member of the public who owns a home, rents a room or has an item that needs a coat of paint*”.

94 The PAR in *Colorland* further held at [39] that “[*o*]rdinary consumers and purchasers of paint, unlike consumers of retail items like clothing or watches, are not likely to spend an inordinate amount of time carefully choosing the items that are regarded “utility purchases”. Seasoned contractors and those in the building or renovation industry will have their own fixed preferences of brand and type; but the general purchasing public are likely to be swayed by price and assurances of quality, and would rely on the recommendation of the retailer or the glossy product brochure.”

95 The Opponent thus asserted that the Applicant’s claim that the purchase of paints typically also involves interaction with sales personnel was unfounded, and argued that paint and coating products are readily available off-the-shelf at, *inter alia*, arts-and-craft shops and Do-It-Yourself hardware shops in Singapore.

96 The Opponent also adduced print-outs of online websites of various retail stores such as *Spotlight Online* and *Hardwareonline* to demonstrate the point that consumers can purchase paint products online. I would observe that none of the evidence adduced showed the availability of either the Applicant’s or Opponent’s products, and at the hearing it was also confirmed by Opponent’s counsel that the evidence was intended to only show how paint from other manufacturers was generally available via online sites without the assistance of sales personnel.

97 The Applicant accepted that the relevant public in the present case would consist of consumers of paints and coating products such as primers and lacquers. These consumers can either be end-consumers who wish to carry out Do-It-Yourself home improvement in their houses or professional painters.

98 Although price, colour and other objective attributes of the goods in question are important to such consumers, the Applicant submitted that the marks themselves are also relevant considerations which the consumer will not overlook, and brands and

trade marks used in relation to paints and coatings such as “Nippon Paint”, “Kansai Paint”, “Dulux” and “Benjamin Moore” convey distinct brand messages which engender brand loyalty, or at the very least, some brand awareness, such that it cannot be said that consumers would be indifferent to the trade marks used in relation to paint and coating products.

99 In *Staywell*, the Court of Appeal recognised at [96] that for the purposes of assessing likelihood of confusion, I am entitled to review certain extraneous factors, such as:

- (a) Factors relating to the impact of the marks-similarity on consumer perception: the degree of similarity of the marks themselves, the reputation of the marks, the impression given by the marks, and the possibility of imperfect recollection of the marks would all be relevant. Clearly, the greater the similarity between the marks, the greater the likelihood of confusion ...
- (b) Factors relating to the impact of goods-similarity on consumer perception: it would be legitimate to take into account factors concerning the very nature of the goods without implicating any steps that are taken by the trader to differentiate the goods. This includes the normal way in or the circumstances under which consumers would purchase goods of that type. This factor is not directly dependent on the marketing choices that the trader makes ...

100 The Court of Appeal in *Staywell* at [60] and [62] further clarified the setting in which the question of whether there is a likelihood of confusion is assessed, i.e.:

in opposition proceedings the inquiry must take into account the full range of the competing monopoly rights that are already enjoyed on the one hand, namely the actual and notional fair uses to which the incumbent proprietor has or might fairly put his registered trade mark, and compare this against the full range of such rights sought by the applicant by reference to any actual use by the applicant (assuming there has been prior use) as well as notional fair uses to which the applicant may put his mark should registration be granted....

... It would still be necessary to consider the wider question of whether the notional fair uses that the applicant might put the mark to could conflict with the notional fair uses to which the proprietor of the registered mark could put his mark to. As we have noted, this latter inquiry sets a higher threshold for the applicant than an inquiry that focuses only on whether the actual use is infringing, and it follows that as a practical matter, in opposition proceedings, the applicant will have to meet that higher threshold regardless of whether there has already been actual use. In essence, in such proceedings, he will be required to establish that the notional fair use of his mark would not infringe the notional fair use rights of the registered proprietor; whereas in infringement proceedings the only question is whether the actual use by the alleged infringer infringes the notional fair use rights of the registered proprietor of the mark...

101 Much of the evidence tendered before me by the Opponent comprised product brochures and application instructions that suggested that the Opponent’s products were

intended to be applied by specialist professionals, and targeting business customers rather than retail customers, given that detailed technical and engineering specifications and charts were provided. Indeed, at page 152 of Ebenberger’s SD exhibiting a company brochure, for example, the Opponent described its activities as follows:

“With more than 1200 colours and effects, we can offer product solutions for a wide spectrum of applications ranging from high-grade facade coatings to value-optimised industrial utilisations, and from decorative interior grades and functional coatings to special and metallic effects. Based on the RAL standard, our portfolio of standard products offers many different surface and gloss combinations, complemented by fine and rough-textured effects, hammer-tone and antique effects and metallics.” (emphasis added)

102 Ebenberger’s SD also exhibited a brochure for the Opponent’s consultancy services, and extracts from various news reports demonstrating its awards and participation in industry events, wherein I observed repeated references to the Opponent being described as a “powder coatings specialist”, and its participation in powder coating industry events, with relatively fewer references to paint per se.

103 Indeed, the specifications for T9507204A – “TIGER DRYLAC” were for powder coatings “*deposited or applied as powders, for industrial application on metal, glass, ceramic and clay substrates, on medium density fibreboard and on wood and on plastic, provided that such powder coating products are not offered for sale through retail outlets or otherwise at the retail level*” (emphasis added), thereby specifically excluding retail sales channels.

104 In the course of the hearing, counsel for the Opponent highlighted nonetheless that the specifications for the other Opponent Marks were not so limited. When I asked to confirm if any brochures or technical specification documents exhibited demonstrated that the Opponent’s products were targeted at retail customers, Opponent’s counsel indicated there was no specific evidence as to this, but invited me to infer this from two product data sheets of the Opponent, one for “Series 49” powder coatings for interior and exterior applications at Ebenberger’s SD page 248, and another for the “EPO-STRONG” epoxy repair kit at Ebenberger’s SD page 292, where the typical applications of these products included references to “residential windows and doors” and “interior and most exterior applications” respectively.

105 Having perused these product data sheets and others exhibited in Ebenberger’s SD, it appears to me that there is little to no evidence that the Opponent’s products are intended for non-professional use. The “Series 49” product data sheet, for example, also listed a wide range of other applications such as agricultural machinery and internal ship components and other engineering specifications. Whilst there were indeed some home or domestic applications referenced, the overall impression was that this product was directed at the *manufacturers* of products targeted at such markets. Turning to the “EPO-Strong” product data sheet, the technicality of the document as a whole did not seem to suggest that it was a product targeted at retail or DIY customers.

106 The invoices of past sales also evidenced that the Opponent primarily targeted industrial or business customers, without any sales invoices exhibited appearing to have been to a retail customer, and counsel for the Opponent confirmed that this was so.

107 As for the Applicant's evidence, various paint charts were exhibited (though some of these were issued by LNKPFBSB), and invoices from 2012 issued by the Applicant to hardware shops, engineering and scaffolding companies. Some of the brochures also featured photographs of residential home interiors and exteriors, suggesting that they did target the retail market, in addition to the shipbuilding industry.

108 Based on the available evidence, it appears that the Opponent's products are used primarily in specialist applications, and hence the relevant customer segment addressed would appear to be product manufacturers, building materials companies, etc, whereas the Applicant appeared to target both the retail and professional customer segments.


109 In respect of the professional customer segment, I am inclined to the view that purchase decisions will be made very carefully and specifically, and it is unlikely that there will be a real likelihood of confusion by customers in this segment, having regard also to the respective marks of the Applicant and Opponent not being similar.

110 Insofar as the Applicant also serves retail customers, there appears to be no evidence tendered by the Opponent that this is a market segment that is also served by the Opponent, and hence I am of the view that it is unlikely that customers in this segment will be confused as to the source of the goods of the respective parties.

111 Of course, having regard to the Court of Appeal's holding in *Staywell* that the analysis I must undertake should extend to the full range of the actual and notional fair uses to which the Opponent has or might fairly put his registered trade mark to use across the range of items comprised in the Opponent's specifications, even if the Opponent did market its products to the retail segment under the Opponent Marks (save for T9507204A where this market segment was expressly excluded from its specification of goods), I am of the view that the Opponent and Application Marks are sufficiently dissimilar to not give rise to any real likelihood of confusion.

112 In coming to this conclusion, I have also noted the Court of Appeal's rejection of the concept of "initial interest confusion" under Singapore law in *Staywell*, i.e., even if in the unlikely event that there is some initial interest confusion between the Application Marks and the Opponent Marks, such "confusion" would not be relevant in a determination of the likelihood of confusion under Section 8(2)(b), TMA.

113 I am also mindful of the Opponent's significant reliance on the *Colorland* case, but having reviewed the facts of that case, it is clearly distinguishable. In that case, the

application mark was  for paints, and the opponent was the registered proprietor of various "COLORLAND" trade marks, also for paints.

114 The learned PAR held that having regard to the marks in issue, the goods were similar and the impression given by the marks was also the same, and as such, it was highly probable that an ordinary consumer of the goods would experience an imperfect recollection of the marks – recalling the "Colourland" marks as "COLORLAND" and vice versa.

115 The learned PAR also found that the opponent's and the mark applicant's customer base was essentially the same (i.e., retail customers), and bearing in mind the

similarities of the marks and goods, this customer base might potentially believe that the goods all come from the same source or economically-linked sources was very high.

116 This was also compounded by the evidence having shown that the mark applicants made no attempt to differentiate their goods from the opponents, choosing instead to produce brochures and packaging that looked familiarly close to that of the opponent's.

117 It was in this context that the learned PAR found that ordinary consumers and purchasers of paint may be confused as to the source of the opponent's and applicant's marks respectively, hence I find that the *Colorland* case is of limited assistance.

Conclusion on Section 8(2)(b)

118 Accordingly, I find that even if the subject marks were not dissimilar, there is no likelihood of confusion. In the circumstances, for the reasons I have set forth above, I find that the grounds of opposition under Section 8(2)(b), TMA have not been made out.

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

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

(7) A trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented —

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade

Decision on Section 8(7)(a)

120 It is well accepted that to succeed in an action for passing off, a claimant (in this case, putatively the Opponents) must establish the three elements of goodwill, misrepresentation and damage.

Goodwill

121 The definition of goodwill in *The Commissioners of Inland Revenue v Muller & Co's Margarine, Limited* [1901] AC 217 (at 223-224) was regarded by our Court of Appeal in *Novelty Pte Ltd v Amanresorts Ltd and Another* [2009] 3 SLR(R) 216 ("*Amanresorts*") (at [39]) to be "the clearest exposition of what goodwill is":

What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation, and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has a power of attraction sufficient to bring customers home to the source from which it emanates.

122 The Applicant submitted in this regard that the invoices exhibited in evidence were issued were billed to only two entities, Berken and Aero Supplies Systems Engineering Pte Ltd (“Aero”). Only a few of the invoices that were issued and billed to Berken show that the Opponent’s goods were shipped to one other entity in Singapore, Global Technology Integrator Pte. Ltd. Apart from Aero and Global Technology Integrator Pte. Ltd., the Applicant submitted that the Opponent had not provided evidence of other customers in Singapore placing orders for the Opponent’s goods. As such, the number of customers in Singapore, and hence the extent of the Opponent’s business activity in Singapore was, at the most, marginal.

123 Whilst there does not appear to have been a significant volume of transactions evidenced by the Opponent, I accept that the Opponent’s sales activities in Singapore suggest more than a trivial or *de minimis* volume of business in Singapore. I am satisfied the Opponent Marks have been used in Singapore and accordingly, the Opponent enjoys the requisite goodwill in respect of its business to establish this element in a passing off action.

Misrepresentation

124 The Court of Appeal in *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 (“*Singsung*”) provided the following guidance in relation to determining misrepresentation in an action for passing off:

[38] In our judgment, the issue of distinctiveness is best understood as a threshold inquiry in the context of determining whether the defendant has committed an actionable misrepresentation. ...

[40] ... The misrepresentation in question must give rise to confusion (or the likelihood thereof) in order to be actionable under the law of passing off. This is ultimately a matter for the court’s judgment and it is not to be determined on a visual side-by-side comparison. Rather it is to be assessed from the vantage point of a notional customer with imperfect recollection.

125 Where the Opponent Marks are found to be distinctive of their products, it must be demonstrated that there was a misrepresentation made by the Applicant in using the Application Marks in relation to the Applicant's goods, and second, that actual confusion or a sufficient likelihood of confusion arose from this (*Singsung* at [70]).

126 Having regard to my findings in relation to the parties’ respective marks being dissimilar, and there not being a likelihood of confusion above, I do not agree that the element of misrepresentation has been established.

Damage

127 Whilst the finding that there was no misrepresentation would be dispositive of the argument that the use of the Application Marks may give rise to a claim in passing off, I would briefly address the Opponent’s submissions that the Applicant has caused it damage by blurring.

128 In *Amanresorts* at [97], it was held that

[G]oodwill can be damaged, namely, by blurring ... Blurring occurs when the plaintiff's get-up, instead of being indicative of only the plaintiff's goods, services or business, also becomes indicative of the defendant's goods, services or business ... This phenomenon occurs only when the business, goods or services of the plaintiff and those of the defendant are in competition with or are at least substitutes for each other. The damage manifests itself in sales being diverted from the plaintiff to the defendant.

129 The Opponent then relied on *Sarika Connoisseur Café Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 ("*Sarika*") to argue that the Opponent Marks have been used in Singapore from at least as early as 1998, and by virtue of substantial time, money, and effort expended in the use and promotional activities, are recognised by many in Singapore. Further, "TIGER", being an arbitrary word, possesses a high degree of distinctiveness, and as the Opponent Marks were substantially reproduced in the Application Marks, the close similarity between the marks increased the likelihood of a mental association. Further, the goods under the Application Marks were identical or similar to those claimed by the Opponents.

130 In the premises, the Opponent submitted that use of the Application Marks in relation to the goods for which registration was sought created a serious and real likelihood that the distinctiveness of the Opponent Marks may be weakened in the medium to long term, such that they may no longer have the capacity to conjure immediate association with the Opponent's Goods.

131 Based on the evidence before me, I am of the view that the Opponent's assertion that there has been damage by blurring is not established. *Sarika* is distinguishable as it related to the invented word "Nutella", whereas in this case, for the reasons set forth above, the word "tiger" on which the Opponent's arguments are founded would bear at most, a normal level of technical distinctiveness. Furthermore, the degree of similarity between the marks is not so high as to give rise to a real likelihood of a mental connection between the marks.

132 The ground of opposition under Section 8(7)(a) therefore fails.

Overall Conclusion

133 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition fails on both grounds. Trade Mark Nos. 40201704182U and 40201704183P will proceed to registration. The Applicant is also entitled to costs to be taxed, if not agreed.

Date of Issue: 14 June 2019