

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

Trade Mark No. T1005795F
24 April 2018

IN THE MATTER OF A TRADE MARK REGISTRATION

IN THE NAME OF

STAYWELL HOSPITALITY PTY LIMITED

AND

APPLICATION FOR INVALIDATION THEREOF BY

**STARWOOD HOTELS & RESORTS WORLDWIDE, INC
AND
SHERATON INTERNATIONAL IP, LLC**

Hearing Officer: Ms Sandy Widjaja
Principal Assistant Registrar of Trade Marks

Representation:



Ms Elaine Tan and Mr Marcus Liu (Amica Law LLC) for the Applicants

Mr Gilbert Leong, Mr Alvin Lim and Ms Quek Jie Ying (Rodyk IP) for the Proprietor

GROUND OF DECISION

1 This is not the first time that Starwood Hotels & Resorts Worldwide, Inc and Sheraton International IP, LLC¹. (“Applicants”) and Staywell Holdings Pty Limited² (“Proprietor”) crossed swords before this Tribunal. The seminal case of *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide Inc & anor* [2014] 1 SLR 911 (“*Staywell Court of Appeal*”) arose out of a dispute between the parties before this Tribunal. It would appear that the contention lingers; this case is intricately intertwined with the previous chain of disputes.

2 The Opposition before IPOS³ then (“*Staywell IPOS*”) was against the Proprietor’s mark T0802642I in Classes 35 and 43 brought by the Applicants. For ease of reference, this chain of disputes shall be referred to as the “*Previous Opposition Decision*”⁴. The marks in contention were:

<i>Previous Opposition Proceeding</i>	
<i>Application Mark</i>	<i>Opponent’s Earlier Mark</i>
 PARK REGIS  PARK REGIS	ST. REGIS

3 A brief chronology of the dispute is necessary and is as follows:

S/N	Date	Event
1	8 September 2008 ⁵	Applicants ⁶ initiated an Opposition action before this Tribunal.
2	19 July 2011	<i>Staywell IPOS</i> was issued and the Applicants succeeded in the Opposition action.
3	18 April 2012	The Proprietor’s appeal to the High Court was heard on 18 April 2012.
4	9 October 2012	The High Court issued its decision ⁷ (“ <i>Staywell High Court</i> ”). The Proprietor succeeded and IPOS’ decision was reversed.
5	5 July 2013	The Applicants’ appeal to the Court of Appeal was heard on 5 July 2013.

¹ In the previous chain of actions, the Initiators were Starwood Hotels & Resorts Worldwide, Inc and Sheraton International, Inc.

² There was a transfer of ownership from Staywell Holdings Group Pty Limited to Staywell Holdings Group Pty Limited via CM8 filed on 15 February 2018 (see letter of 3 April 2018).

³ *Starwood Hotels & Resorts Worldwide, Inc and Another v Staywell Hospitality Group Pty Ltd* [2011] SGIPOS 7. In the Opposition, the current Proprietor was the Applicant and the current Applicants were the Opponents.

⁴ This reference is used as a general reference to the dispute regardless of the forum.

⁵ *Staywell IPOS* at [2].

⁶ For ease of reference, the parties shall be referred to as per the current action.

⁷ *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another* [2013] 1 SLR 489.

6	29 November 2013	<i>Staywell Court of Appeal</i> was issued. The appeal succeeded. The High Court decision was reversed and the IPOS' decision reinstated.
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4 In this instance, the Applicants are seeking to invalidate the registered mark T1005795F (“*Subject Mark*”)



registered for the following services:

(i) Class 35

Advertising, marketing, promotion and publicity services; business management; business administration; office functions; administration of the business affairs of retail stores, advisory, information and consultancy services relating to all the aforesaid; all the aforesaid services also provided on-line from a computer database or via the global communications network; all included in class 35; and

(ii) Class 43

Services for providing food and drink; temporary accommodation; hotel services; motel services; tourist homes; resort hotel services; hotel accommodation services; hotel catering services; hotel reservation services; hotel restaurant services; provision of hotel accommodation for business exhibitions, business fairs, conferences, congresses, lectures and meetings; providing facilities [accommodation] for conducting conferences, conventions, exhibitions, fairs and holidays; rental of meeting rooms; hospitality services [accommodation]; hospitality suites [provision of accommodation, food or drink]; holiday information and planning relating to accommodation; inn keeping [bar, restaurant and accommodation]; restaurants; cafes; bar and catering services; advisory, information and consultancy services relating to all the aforesaid; all the aforesaid services also provided on-line from a computer database or via the global communications network; all included in Class 43.

5 It is obvious that the only difference between the instant case and *Staywell Court of Appeal* is the addition of the Chinese characters 柏·伟诗酒店 to the *Subject Mark*. I therefore have to decide whether the addition of these Chinese characters will result in a different conclusion from that in *Staywell Court of Appeal*.

6 The transliteration and translation of the Chinese characters (as set out in the Register⁸ reads:

⁸ See Exhibit 2 of the Applicants' 3rd SD.

The transliteration of the Chinese characters [柏•伟诗酒店] appearing in the mark is “Bai” which means “Cypress”, “Wei Shi” which has *no meaning*⁹ and “Jiu Dian” which means “Hotel”.

[Emphasis in italics mine]

7 However, the Proprietor argued at the oral hearing that the clause in Register is for search purposes only¹⁰ and instead referred to the version tendered via their evidence¹¹:

S/N	Chinese character	Transliteration	Translation
1	柏	bai	Cypress
2	伟	wei	Great
5	诗	shi	Poetry, poem
4	酒店	Jiu dian	Hotel

8 I am inclined to accept the transliteration clause in Register as a more accurate indication since it is more contemporaneous to the point of genesis of the *Subject Mark*. This is in contrast to the Proprietor’s 1st SD, which was tendered following the current invalidation action brought against the Proprietor. Nonetheless, as we shall see, this issue does not make much difference to the final conclusion.

9 Processwise, the Applicants filed their Form TM 28 and Statement of Grounds on 6 July 2015. The Proprietor filed its Counter-Statement on 5 November 2015. The Applicants filed evidence in support of the invalidation on 12 October 2016. The Proprietor filed evidence in support of the registration on 29 May 2017. The Applicants filed their evidence in reply on 15 November 2017. A Pre-Hearing Review (“PHR”) was conducted on 13 December 2017¹². The matter ultimately was set down for hearing, and heard, on 24 April 2018.

Grounds of Invalidation

10 The Applicants relied on Section 23 read with Section 7(6), Section 8(2)(b), Section 8(4)(b)(i) and 8(4)(b)(ii)(A)¹³ and Section 8(7)(a) respectively of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“Act”).

⁹ This clause was inserted via TM27B filed on 30 July 2010.

¹⁰ Searches for earlier marks are conducted in the Trade Marks Registry under Section 8 of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“Act”).

¹¹ See the Proprietor’s 1st SD at [7]. More discussion below.

¹² Following the PHR, the Applicants confirmed via their letter of 10 January 2018 that they are not pursuing Section 8(4)(b)(ii)(B) of the *Act* and that the primary marks relied upon are (i) T9512253G; and (ii) T0402585A for this action. For the avoidance of doubt, while there was a reference to T1014070E in the letter, this cannot be relied on since the date of application for that mark is after the relevant date of 7 May 2010 (see below).

¹³ See above.

Applicants' Evidence

- 11 The Applicants' evidence comprises the following:
- a) statutory declaration of Marshall Donat, Vice President & Assistant Secretary of the Applicants, dated 11 October 2016 ("Applicants' 1st SD");
 - b) statutory declaration of Elaine Tan, agent for the Applicants dated 12 October 2016 ("Applicants' 2nd SD"); and
 - c) statutory declaration of Marshall Donat, dated 13 November 2017 ("Applicants' 3rd SD").

Proprietor's Evidence

- 12 The Proprietor's evidence comprises the following:
- a) statutory declaration of Ng Chin Bee, Associate Professor in the division of Linguistics and Multilingual Studies in Nanyang Technological University's School of Humanities and Social Sciences, dated 25 May 2017 ("Proprietor's 1st SD"); and
 - b) statutory declaration of Richard Robert Macfie Doyle, Executive Director and Corporate Counsel of the Proprietor, dated 26 May 2017 ("Proprietor's 2nd SD").

Burden of Proof for Invalidation

13 Under Section 101(c)(i) of the Act, "the registration of a person as proprietor of a registered trade mark shall be *prima facie* evidence of the validity of the original registration". Thus the burden of proof lies with the Applicants to establish the grounds of invalidity on a balance of probabilities.

Background

14 The Applicants deposed that they are one of the leading hotels and leisure companies in the world¹⁴ ([5] of the Applicants' 1st SD), and that they manage more than 1200 properties worldwide, including properties under brands such as W Hotels, Westin and Sheraton ([6] of the Applicants' 1st SD). The first St Regis was opened in New York in 1904. The Applicants deposed that the St Regis hotels and luxury accommodation are known for their unrivalled dimension of luxury ([7] of the Applicants' 1st SD). To date, there are more than 38 St Regis properties in about 23 countries worldwide and as many as 19 properties scheduled to open in the coming years ([8] of the Applicants' 1st SD).

15 The Proprietor deposed it is one of the largest independently owned hotel management groups in the Asia Pacific region ([6] of the Proprietor's 2nd SD). The PARK REGIS brand has been continuously put to use worldwide since 1968 by the Proprietor and

¹⁴ The Applicants deposed that Sheraton International IP, LLC is a subsidiary of Starwood Hotels & Resorts Worldwide, Inc. ([5] of the Applicants' 1st SD).

its predecessors in respect of the services covered under the **Subject Mark** in Classes 35 and 43 ([7] of the Proprietor's 2nd SD). Accommodations provided under the PARK REGIS brand are usually 4-star hotel styled, targeted at business travellers ([8] of the Proprietor's 2nd SD).

16 Currently, the Proprietor has a network of over 30 properties in Australia, Singapore, Indonesia, India, the UAE and the UK. It also has properties under development in, amongst others, China ([9] of the Proprietor's 2nd SD).

17 For ease of reference, the parties' submissions are as follows:

- (i) The Applicants' written submissions filed on 26 March 2018 ("AWS1");
- (ii) The Applicants' rebuttal written submissions filed on 23 March 2018 (AWS2");
- (iii) The Proprietor's written submissions filed on 26 March 2018 ("PWS1");
- (iv) The Proprietor's additional written submissions filed on 10 April 2018 ("PWS2").

MAIN DECISION

Ground of Invalidation under Section 7(6)

18 The relevant provisions of the Act are Sections 23 and 7:

23.—(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 7.

7(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

*Decision on Section 7(6)*¹⁵

19 The legal test for determining the presence of bad faith is fairly settled and is encapsulated in *Valentino Globe BV v Pacific Rim Industries Inc* [2010] 2 SLR 1203 ("**Valentino**"). The key principles were helpfully summarised by the Principal Assistant Registrar ("PAR") in *Christie Manson & Woods Limited v Chritrs Auction Pte. Limited* [2016] SGIPOS 1 at [166]:

[166(a)] "Bad faith" embraces not only actual dishonesty but also dealings which would be considered as commercially unacceptable by reasonable and experienced persons in a particular trade, even though such dealings may otherwise involve 'no breach of any duty, obligation, prohibition or requirement that is legally binding' upon the registrant of the trade mark': **Valentino** at [28].

¹⁵ No cross-examination was requested in this action.

[166(b)] The test for determining bad faith is the combined test of bad faith which contains both a subjective element (*viz*, what the particular applicant knows) and an objective element (*viz*, what ordinary persons adopting proper standards would think). Thus, “bad faith” as a concept is context-dependent. In the final analysis, whether bad faith exists or not hinges on the specific factual matrix of each case: *Valentino* at [29].

[166(c)] Once a *prima facie* case of bad faith is made out by the [Applicants], the burden of disproving any element of bad faith on the part of the [Proprietor] would arise: *Valentino* at [36].

[166(d)] An allegation of bad faith is a serious claim to make and it must be sufficiently supported by the evidence, which will rarely be possible by a process of inference: *Valentino* at [30]...[However] this is not an absolute prohibition...in *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 at [115]...the High Court pointed out that a finding of bad faith is largely, if not invariably, based on circumstantial evidence.

[166(e)] Once bad faith is established, the application for registration of a mark must be refused even though the mark would not cause any confusion: *Valentino* at [20].

20 In addition, *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 provided at [100] and [115]:

[100] Bad faith is to be determined **as at the date of application** and matters which occurred **after** the date of application which may assist in determining the applicant’s state of mind as at the date of application can be taken into consideration...

[115] ...despite the broad nature of the notion of bad faith, one must show *some sort of nexus* between the parties in dispute. Otherwise, the notion of bad faith would have to be decided in vacuum...In other words, while the finding of bad faith is largely, if not invariably, based on **circumstantial evidence**, the party alleging bad faith needs to show some link between the parties, perhaps by way of a **pre-existing relationship** or some acts of association with the proprietor or some **nexus** between the two competing marks.

[Emphasis in bold mine]

In this case, the relevant date is the date of application of the *Subject Mark*, that is, 7 May 2010 (“*Relevant Date*”).

21 The Applicants’ case is that ([17] and [18] AWS1):

- a) By reason of the *Previous Opposition Decision* as well as the concurrent proceedings in several other jurisdictions, the Proprietor had actual knowledge of the Applicants’ earlier trade marks¹⁶.
- b) The Proprietor is well aware of the Applicants’ opposition to the registration of any mark that contains the word “REGIS” by the Proprietor.
- c) The conduct of the Proprietor in applying to register the *Subject Mark* fell short of the normally accepted standards of commercial behaviour as it was merely an attempt to put some distance between the Proprietor and the Applicants for the purposes of securing a registration, but without the mark being a true reflection of the intended or actual form of use.

22 The Applicants submitted that “[i]t is unclear when the Proprietor started to actually use the Chinese characters 柏•伟诗酒店 together with its “Park Regis” name” ([22] AWS1). Importantly, where there is use of the Chinese characters, the Proprietor has not used the *Subject Mark* in the form as registered:

S/N	<i>Subject Mark as used</i>	Reference
1		[23] AWS1 ¹⁷
2		[23] AWS1 ¹⁸
3		[12] PWS2

23 The Applicants relied on *PT Swakarya Indah Busana v Dhan International Exim Pte Ltd* [2010] 2 SLR 109 (“*PT Swakarya*”) ([6] AWS2) and highlighted that the Chinese characters as shown are in a font size which is significantly smaller than that used for the English portions of the mark ([23] AWS1)¹⁹. The Applicants argued that “[e]ven though

¹⁶ More below.

¹⁷ There are added Chinese characters, 新加坡 (meaning “Singapore”) in front,

¹⁸ As above.

¹⁹ Contrast this to the *Subject Mark* (above).

the evidence relates to use of the mark after the **Relevant Date**²⁰...the evidence is still relevant and useful as they ‘assist in determining the applicant’s state of mind at the date of registration’” ([25] AWS1²¹).

24 I agree with the Applicants that it is clear from the Proprietor’s 2nd SD²² that they have not been using the **Subject Mark** as registered, and that at first blush, it appears that the facts of this case are analogous to the facts in **PT Swakarya**.

25 However, in the current case, I am of the view that such an intention not to use the **Subject Mark** as registered could *not* be attributed to the Proprietor as at the **Relevant Date**. This is because, as the Proprietor submitted at the hearing, as at the **Relevant Date**, there was nothing to suggest that the Proprietor will not prevail in relation to the **Previous Opposition Decision** (see also [33] PWS1).

26 For ease of reference, the brief chronology in relation to the **Previous Opposition Decision** is replicated below:

S/N	Date	Event
1	8 September 2008	Applicants initiated an Opposition action.
<i>Relevant Date, i.e. 7 May 2010</i>		
2	19 July 2011	Staywell IPOS was issued. The Applicants succeeded in the Opposition action.
3	18 April 2012	The Proprietor appealed and the matter was heard in the High Court.
4	9 October 2012	The High Court allowed the appeal and Staywell High Court was issued. <i>The Proprietor succeeded.</i>
5	5 July 2013	The Applicants appealed and the matter was heard in the Court of Appeal.
6	29 November 2013	Staywell Court of Appeal was issued and the Court of Appeal allowed the appeal.

As can be seen from the above, the Proprietor did *succeed* in **Staywell High Court**.

27 Further, the Proprietor provided a credible explanation as to the genesis of the **Subject Mark** ([8] of PWS2). The Proprietor deposed that “[t]he words “PARK REGIS” were chosen to reflect the fact that the “PARK REGIS” hotel in Sydney was built on Park Street, near Hyde Park...” ([22] of the Proprietor’s 2nd SD).

²⁰ The evidence of use of the **Subject Mark** submitted by the Proprietor suggests that the Proprietor first commenced use some time in or about mid-2015. See for example the bottles of water at page 87 of Exhibit 3 of the Proprietor’s 2nd SD, which is part of a blog dated 2 June 2015 (see page 85).

²¹ Quoting *Sotheby’s v Sichuan Softbill Auction Co, Ltd* [2010] SGIPOS 15 at [30].

²² See for example, page 240 Exhibit 3 of the Proprietor’s 2nd SD; which was dated for the period 1 July - 30 September 2015.

28 As the Court of Appeal stated in *Valentino* at [21], “[i]t is in line with common sense and logic that he who asserts must prove”. In the current case, in light of all of the above, I am of the view that the Applicants have not made out “a *prima facie* case of bad faith”²³.

29 It is questionable why the Proprietor initiated use²⁴ of the *Subject Mark* in Singapore as reflected above (that is, with the Chinese characters in a font size which is significantly smaller than that used for the English portions of the *Subject Mark*) in 2015,²⁵ in light of *Staywell Court of Appeal* which was issued on 29 November 2013. Nonetheless, this was *not* the state of affairs as at the *Relevant Date*.

30 In light of the above, the objection under Section 7(6) fails.

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

31 The relevant provisions are:

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

- (a) that there is an earlier trade mark in relation to which —
 - (i) the conditions set out in section 8(1) or (2) apply...

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

8(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)

Step-by-step approach

32 The 3-step test approach in relation to an objection under Section 8(2)(b) was re-affirmed in *Staywell Court of Appeal* (at [15] and [55]):

- a) The first two elements - namely similarity or identity of the marks and similarity or identity of the goods / services - are assessed individually before the final element which is assessed in the round.

²³ See *Valentino* at [33]; the Proprietor honestly believed that it had a right to registration and/or use the *Subject Mark* as at the *Relevant Date* (PWS2 at [7]).

²⁴ This is in contrast to making an application as at the *Relevant Date*.

²⁵ See for example, Exhibit 3 of the Proprietor’s 2nd SD at page 266 which was dated around the 4th quarter of 2016.

- b) Once the two threshold requirements have been met, the issue of the likelihood of confusion arises and the tribunal / court is directed to look at (a) *how* similar the marks are, (b) *how* similar the goods / services are, and (c) given this, how likely the relevant segment of the public will be confused.

Similarity of Marks

33 The law in relation to this issue is as follows (*Staywell Court of Appeal* at [15] to [30]):

- 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. The court must ultimately conclude whether the marks, when observed in their totality, are similar or dissimilar.
- b) The three aspects of similarity (i.e. visual, aural and conceptual similarities) are meant to guide the court's inquiry. Trade-offs can occur among the three aspects of similarity.
- c) A productive and appropriate application of the step-by-step approach necessitates that the court reaches a meaningful conclusion at each stage of the inquiry.
- d) The assessment of marks similarity is mark-for-mark without consideration of any external matter.
- e) 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.
- f) 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.
- g) When speaking of the assessment of a mark as a whole, the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.

34 Further, the Court of Appeal provided in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941 at [40(c)] and [40(d)] ("*Hai Tong*"):

[40(c)] The relevant viewpoint is that of the average consumer who would exercise some care and a measure of good sense in making his or her purchases, not that of an unthinking person in a hurry.

[40(d)] It is assumed that the average consumer has “imperfect recollection” such that the two contesting marks are not to be compared or assessed side by side (and examined in detail). 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.

35 The Opponent relies on the following earlier marks (collectively, *Applicants’ Earlier Marks*) ([11] AWS1):

S/N	<i>Applicants’ Earlier Marks</i>	Class
1	ST. REGIS T9512253G	<u>Class 42</u> Hotel, motel, resort, restaurant, bar, cocktail lounge, food and beverage services.
2	ST. REGIS T9512252I	<u>Class 41</u> Entertainment services, casino and gaming services, amusement and theme park services.
3	ST. REGIS T0511703B	<u>Class 36</u> Real estate brokerage, real estate and land acquisition, real estate agencies relating to the managing and arranging for ownership of real estate, condominiums, apartments; real estate investment, real estate management, real estate agencies relating to real estate time sharing and leasing of real estate and real estate property, including condominiums and apartments.
4	ST. REGIS T0511704J	<u>Class 37</u> Building construction services.
5	ST. REGIS T0902836J	<u>Class 30</u> Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.
6	瑞吉 T0402585A ²⁶	<u>Class 43</u> Hotel, motel, resort, restaurant, bar, cocktail lounge, food and beverage services and reservation services.


²⁶ The transliteration of the Chinese characters of which the mark consists is "Rui Ji" which has no meaning. (as set out in the Register).

36 In response to the PAR’s queries at the PHR, the Applicants clarified via their letter of 10 January 2018, that they will be relying on the following marks as their primary marks:



S/N	<i>Applicants’ Earlier Marks</i> ²⁷	Class
<i>Applicants’ Earlier St Regis Mark</i>		
1	ST. REGIS T9512253G	Class 42 Hotel, motel, resort, restaurant, bar, cocktail lounge, food and beverage services.
<i>Applicants’ Earlier 瑞吉Mark</i>		
6	瑞吉 T0402585A	Class 43 Hotel, motel, resort, restaurant, bar, cocktail lounge, food and beverage services and reservation services.

37 It is clear that between the 2 marks above, the *Applicants’ Earlier St Regis Mark* is closer to the *Subject Mark*. This means that if the *Applicants’ Earlier St Regis Mark* is found not to be similar to the *Subject Mark*, the same will hold true for the *Applicants’ Earlier 瑞吉Mark*. Thus, the focus of the analysis below will be on *Applicants’ Earlier St Regis Mark*.

38 The Applicants’ central line of argument is as follows ([34] AWS1):

[34] In [*Staywell Court of Appeal*], the Court of Appeal found the “Regis” component in the [*Applicants’ Earlier St Regis Mark*] and the [Proprietor’s mark  PARK REGIS in *Previous Opposition Decision*] to be the dominant and distinctive component in both marks...For reasons set out below, we submit that the dominant component in the [*Subject Mark*] remains the word “Regis”, notwithstanding the addition of the Chinese characters 柏伟诗酒店..

39 Not surprisingly, a key tenet of the Proprietor’s argument is that *Staywell Court of Appeal* is not binding since the mark in contention in this instance, is different ([47], [48], [50] and [50] PWS1):

[47]The Applicants allege that the word, “REGIS” is the dominant part of the [*Applicants’ Earlier St Regis Mark*]. The Applicants relied heavily on the judgment in [*Staywell Court of Appeal*] particularly on the findings of similarity by the [*Staywell Court of Appeal*]...that “REGIS” is the distinctive element and that the “ PARK REGIS” ST. REGIS” and “ PARK REGIS ” marks are similar on the basis that there is a high degree of aural similarity and a fair degree of conceptual similarity.

On the otherhand, the Chinese characters were translated to mean “lucky” at the Proprietor’s 1st SD.

²⁷ See above footnote about T1014070E.

[48] The Applicants contended in the [Applicants’ 1st SD] at [30], that, “the above finding of facts are incontrovertible and cannot be challenged in Singapore. I have been advised and verily believe that this decision is binding on the Registrar”. In essence, the Applicants have averred that the **finding of facts** in the [*Staywell Court of Appeal*] is binding on the Registrar to find that, notwithstanding ...the changes...in the [*Subject Mark*], the word “REGIS” remains the dominant feature of the [*Subject Mark*] and must be similar to the [*Applicants’ Earlier St Regis Mark*].

...

[50] We submit that the Applicants are wrong in law. What is “dominant” in a mark, and what “stands out” must necessarily depend on the various components that make up the mark...The Applicants should know that the principle of *stare decisis* only applies to the *ratio decidendi* of the case and not a finding of fact.


[51] The [*Subject Mark*] combines the Chinese characters “柏伟诗酒店” with the “PARK REGIS” words and the purple *fleur-de-lis* device. It cannot be said that [*Staywell Court of Appeal*]...(which deals with a different mark owned by the Proprietor) binds the Registrar in this case. Clearly, the Registry is concerned with a completely different mark with that in [*Staywell Court of Appeal*].

40 For clarity, *Osborn’s Concise Law Dictionary* (Sweet & Maxwell, 8th Ed) defines these terms as follows:

- (i) *stare decisis*: The ‘sacred principle’ of English law by which precedents are authoritative and binding...
- (ii) *ratio decidendi*: The legal reason (or ground) for a judicial decision.
- (iii) Precedent: A judgement or decision of a court of law cited as authority for deciding a similar set of facts; a case which serves as an authority for the legal principle embodied in its decision.

41 While the *ratio decidendi* is the legal reasoning in a decision, it does not exist in a vacuum and is grounded on a particular set of circumstances. Whilst *Staywell Court of Appeal* is not strictly binding on me as the marks involved are different, nonetheless, its findings and observations are obviously *highly persuasive*, in light of the fact that the marks involved there are *highly similar* to the marks here.

42 For ease of reference only, the marks are as follows:

<i>Current Invalidation Proceeding</i>	
<i>Subject Mark</i>	<i>Applicants’ Earlier St Regis Mark</i>
	<p>ST. REGIS</p>
<i>Previous Opposition Proceeding</i>	

<i>Application Mark</i>	<i>Opponent's Earlier Mark</i>
 PARK REGIS  PARK REGIS	ST. REGIS

43 It is clear that the only difference between the *Subject Mark* and the *Application Mark* in the Previous Opposition Decision are the Chinese characters, “柏•伟诗酒店”²⁸. On the other hand, the Applicants are relying on the *exact same mark* as their earlier mark in the current case, namely, the *Applicants' Earlier St Regis Mark*. Thus the key is whether the inclusion of the Chinese characters in the *Subject Mark* will result in a different outcome to that in *Staywell Court of Appeal*.

Distinctiveness

44 As elucidated in *Staywell Court of Appeal*, distinctiveness is a factor integrated into the visual, aural and conceptual analysis as to whether the competing marks are similar and it is not a separate step within the marks-similarity inquiry. However, having regard to the approach in *Hai Tong* at [26]²⁹), I make the following observation.

45 The High Court in *Staywell High Court* opined at [18], [19] and [20]:

[18]...In the present case, the Opponents contend that the word “REGIS” is inventive and fanciful when used for hotel services as it is in no way descriptive of the hotel on offer. It is a randomly chosen word which distinguishes the Opponents’ hotels from others. Although Staywell had argued that “REGIS” is a common name and “Saint Regis” may be a historical person who had been elevated to sainthood, *the marks had to be considered in the light of the services for which they were registered*. The choice of “ST. REGIS” or “REGIS” for a commercial hotel was *entirely random*.

[19] From the evidence, the word “regis” has various applications. In Latin, it means “of the king”...It is also the name of a catholic saint, one St John Regis, who lived in France in the 16th century. The word “regis” has been used as the first name of a number of notable, though not world famous, people. It is also used as a surname and a place name in England and Germany. Despite all the examples of its use that have been given to me by Staywell³⁰, however, I cannot conclude that it is a common place word in English...It is also irrefutable that the word is *not descriptive* of and does not connote the hospitality industry or hotel services in any way.

[20]...In the present case, “regis” is *not a common word used in the hotel industry*... it is distinctive enough that a higher threshold for dissimilarity would apply than that used in *Ozone* where the court had to determine the similarity of the marks

²⁸ The fact that the *Application Mark* was portrayed in a series does not affect the analysis. See Section 17 of the Act as to the definition of a “series of trade marks”.

²⁹ The Court of Appeal commented at [26] that for the purpose of elucidating the analytical process, they have highlighted distinctiveness as a separate step.

³⁰ The Proprietor also argued that “ST. REGIS” will be understood as “a census-designated place in Mineral County, Montana, United States (PWS1 at [75]). However, I am of the view that it is highly unlikely that *Applicants' Earlier St Regis Mark* will be understood as such in the local context.

“HYSTERIC GLAMOUR” and “GLAMOUR”. Although the Opponents emphasised the word “REGIS”, the registered mark is “ST. REGIS” and the Opponents’ Mark must be looked at as a whole in comparison with the Application Mark as a whole, *ie*, “PARK REGIS”. However, even taking the whole of the mark “ST. REGIS”, that name when applied to a hotel is as fanciful as “Regis” on its own since a saint is not generally associated with a hotel of any sort, let alone a luxurious one. *Thus, the addition of “St.” does not change the mark’s place on the scale of distinctiveness.*

[Emphasis in italics mine]

It is to be noted that the Court of Appeal in *Staywell Court of Appeal* did not disagree with *Staywell High Court* on this (subject to the issue of conceptual similarity, below).

46 In light of the above, *Applicants’ Earlier St Regis Mark* “is distinctive enough that a higher threshold for dissimilarity would apply” (*Staywell High Court* at [20]), having regard to the main distinctive component REGIS (subject to the issue of conceptual similarity, below).


Visual Similarity

47 The PAR held in *Staywell IPOS* at [54] that:

[54] Visually, other than the word, "REGIS", both the Application Mark and the Opponents' mark are quite different as the Application Mark contains visual elements such as the *fleur-de-lis* device...Based on a visual comparison of the Application Mark and the Opponents' mark, there are some differences.


48 Curiously, the finding on visual dissimilarity was not appealed against in the High Court³¹ and the Court of Appeal³². Nonetheless, the finding in *Staywell IPOS* is not binding on me. With the benefit of *Staywell Court of Appeal*, the issue of visual similarity can be viewed in a different light.

49 Again, for ease of comparison only, the marks are as follows:

<i>Current Invalidation Proceeding</i>	
<i>Subject Mark</i>	<i>Applicants’ Earlier St Regis Mark</i>
	ST. REGIS
<i>Previous Opposition Proceeding</i>	
<i>Application Mark / Previous Park Regis Mark</i>	<i>Opponents’ Earlier Mark</i>

³¹ See *Staywell High Court* at [21].

³² See *Staywell Court of Appeal* at [12(a)(i)].

 <p>PARK REGIS PARK REGIS</p>	<p>ST. REGIS</p>
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50 As submitted by the Applicant at [50] AWS1, “[w]here marks share a common element, the starting point of the analysis is whether the common element in the marks is so dominant as to render the differences ineffective to obscure the similarity between the two”.³³

51 The Proprietor argued that ([58] PWS1):

[58] While both marks share a common element, “REGIS”, this is not sufficient to conclude that the marks are visually similar (see *Polo/Lauren* at [26]). In the present case, we submit that the overall visual impression created by the [*Subject Mark*] and the [*Applicants’ Earlier St Regis Mark*] is totally different due to the distinguishing graphic device and the presence of distinctive set of Chinese characters in the [*Subject Mark*].

52 In assessing the visual similarity of composite marks, the guidelines set out by the Court of Appeal at [62] of *Hai Tong* is pertinent:

[62(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 component of a composite mark or sign *could* (but will not necessarily or always) be the dominant component of the mark or sign. Some instances where this might be the case include where:

(i) The two marks or signs 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.

(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;

³³ Citing *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2005] 4 SLR(R) 816.

(ii) the accompanying word(s) are devoid of any distinctive character, or are purely descriptive of the device component; 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.

[Emphasis in italics mine].

53 I start by saying that I am unable to agree with the Proprietor’s argument at the oral hearing that the 3 different elements, namely the device, “Park Regis” and the Chinese characters are respectively of equal importance. In my view, if there is a need to accord weight in terms of the size of the components relative to the **Subject Mark**, I would apportion (i) device – 20%; (ii) PARK REGIS – 45%; and (iii) 柏•伟诗酒店 - 35%. Also, notably, 柏•伟诗酒店 appears *below* PARK REGIS.

Device

54 I am of the view that the *fleur-de-lis* device is not dominant as it will only be viewed as a decorative element having regard to the distinctiveness of the word “Regis” as well as the positioning of the same.

55 Even if I am wrong, and there is some significance to be accorded to the device, it does not change the conclusion that REGIS remains as the distinctive component of the **Subject Mark**. This is because aside from the visual attributes of the various components of a mark, the meaning of the same also affects the visual appreciation of a mark³⁴.

56 I refer to Exhibit 5 of the Proprietor’s 2nd SD, which is an extract of a Wikipedia entry in relation to the *fleur-de-lis* (page 410 of Exhibit 5 of the Proprietor’s 2nd SD):

Usages

While the *fleur-de-lis* has appeared on countless European *coat of arms and flags* over the centuries, it is particularly associated with the French *monarchy* in a historical context...

³⁴ In this regard, there is some overlap with the issue of conceptual similarity.

[Emphasis in italics mine]

57 The concept of kingship exuded by the device is unmistakable³⁵. Thus if any significance is to be attached to the *fleur-de-lis* device, it merely augments the word “Regis”. In this regard, it is to be recalled that “Regis” means “of the King” in Latin³⁶. Thus the *fleur-de-lis* device does not and cannot displace the similarity between the marks due to the presence of the common word REGIS.

“PARK”

58 The Court of Appeal in *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 (“*Caesarstone*”) commented at [41] (see [52] AWS1):

[41] We agree with the Appellant that the word “stone” is merely descriptive of the goods in Class 19. In this regard, the public will not generally consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark...and, for this reason, *we do not think that the presence of such a descriptive element can fairly be regarded as being effective to displace similarity.*

[Emphasis in italics mine].

59 In the current case, the Applicants argued at [53(b)] AWS1:

[53(b)] The word “Park” in the [*Subject Mark*] could be *descriptive of the location of the Proprietor’s property*³⁷ and therefore is unlikely to be regarded as a dominant and distinctive element in the overall impression to be conveyed by the mark.

[Emphasis mine]

60 I agree. This is particularly so in light of the services³⁸ for which the *Subject Mark* is registered³⁹. For example, PARK can clearly be descriptive of *hotel services* for which the Subject Mark is registered⁴⁰.

³⁵ It is observed that *Staywell Court of Appeal* implied, in the context of discussing conceptual similarity, that the *fleur-de-lis* device exudes a connotation of royalty (see [36] *Staywell Court of Appeal*).

³⁶ See *Staywell High Court* at [19], above and also [75] PWS1.

³⁷ See also *Staywell Court of Appeal* at [37] in the context of conceptual similarity, commenting that:

[37] ...Similarly, the word “Park”, as noted by the Judge, *connotes the idea of a geographical location though not necessarily of any particular type...*

[Emphasis in italics mine]

³⁸ See *Staywell High Court* at [18], above. See also *Monster Energy Company v Mixi Inc.*, SGIPOS [2017] 12 at [35] where the learned Assistant Registrar commented that “technical distinctiveness (in the marks-similarity assessment) is not necessarily confined to technical distinctiveness in the abstract. The services (or goods) *can* be taken into account insofar as they relate to distinctiveness.”

³⁹ See above for the specifications in Class 35 and 43 for which the *Subject Mark* is registered.

⁴⁰ Notably, the Proprietor deposed that “[t]he words “PARK REGIS” were chosen to reflect the fact that the “PARK REGIS” hotel in Sydney was built on Park Street, *near Hyde Park...*” ([22] of the Proprietor’s 2nd SD). While the intention of the Proprietor is not relevant to the perception of the consumer (see *Carolina*

61 Thus, quoting from *Caesarstone* at [41], I “do not think that the presence of such a descriptive element [namely, PARK] can fairly be regarded as being effective to displace similarity” between the marks.

Chinese Characters – “柏•伟诗酒店”

62 As alluded to above, the transliteration and translation of the Chinese characters are as follows⁴¹:

S/N	Chinese character	Transliteration	Translation
1	柏	bai	Cypress
2	伟	wei	Great
5	诗	shi	Poetry, poem
4	酒店	Jiu dian	Hotel

63 The Applicants submitted ([43], [45],⁴² [54] and [56] AWS1):

[43] First, from the point of view of consumers who are not conversant in Chinese, the Chinese characters 柏•伟诗酒店 would likely be viewed simply as a decorative element which has little or no significance⁴³... It cannot be assumed that consumers in Singapore would understand and/or read Chinese; there exists a significant part of the Singapore population that do not read or understand Chinese....insofar as the likely users of the services of both parties are going to be foreign tourists, a significant portion of such tourists would not understand Chinese. The [*Subject Mark*] is therefore likely to be remembered by the English elements in the mark.

[45] It bears highlighting that most of the evidence of use submitted by the Proprietor is in the English language. The evidence of use submitted by the Proprietor reinforces the fact that English being the working language in Singapore, makes it all the more likely that most consumers in Singapore would refer to the English components in the [*Subject Mark*] when referring to the Proprietor of its hotel in Singapore. This was recognized in the case *Seiko Holdings Kabushiki Kaisha (Trading as Seiko Holdings Corporation) v Seiko Advance Limited* [2011] SGIPOS 3 (“*Seiko*”) where it was held at [45]:



[45] I agree with the Opponents who have correctly pointed out that the members of the public will be more likely to refer to the composite Application

Herrera, Ltd v Lacoste [2014] 3 at [56], in the context of the analysis of conceptual similarity), it does support the argument above.

⁴¹ See the Proprietor’s 1st SD at [7]. More discussion below.

⁴² Paragraphs [43] to [45] AWS1 were argued in the context of the issue of distinctiveness.

⁴³ The Applicants relied on *Youyou Food Co Ltd v Tien Lei Trading Ltd and Yongsong Zhao*, Case O-270-

16 (UKIPO), where the marks in dispute were the registered mark  and earlier mark .

mark by the readable portion which contains English words⁴⁴. The tendency is to refer to that portion because English is the working language in Singapore, is spoken by the majority as a first language and people in general will gravitate towards the language most familiar to them

[54] The Chinese characters 柏•伟诗酒店 in the [*Subject Mark*] does little to alter the fact that the [*Subject Mark*] is visually similar to the [*Applicants’ Earlier St Regis Mark*]...consumers in Singapore are more likely to recollect the English portion of the marks.

[56] ...the dominant and distinctive element in both marks is the word “Regis”. As such...it is submitted the [*Subject Mark*] is visually similar [to the *Applicants’ Earlier St Regis Mark*] notwithstanding the addition of the *fleur-de-lis* device and the Chinese characters 柏•伟诗酒店 in the [*Subject Mark*].

[Emphasis as underlined the Applicants’]

64 The Proprietor stressed at the oral hearing that 柏•伟诗酒店 is not a mere transliteration or translation of PARK REGIS. The Proprietor submitted that 柏•伟诗酒店 is a new trade mark, namely, the Proprietor’s Chinese trade mark. Being the Chinese name of the Proprietor, the Chinese characters are distinctive in their own right such that they cannot be ignored. In particular, the Proprietor pointed out that having no fixed meaning, the Chinese characters can be considered to be inventive and thus possess a “high level of distinctiveness” (see [36] PWS2).

65 The Proprietor deposed at the Proprietor’s 1st SD at [7]:

[7] ...the Chinese characters 柏•伟诗酒店 are translated and transliterated...as follows:

S/N	Chinese character	Transliteration	Translation
1	柏	bai	Cypress
2	伟	wei	Great
5	诗	shi	Poetry, poem
4	酒店	Jiu dian	Hotel

The phrase, 柏•伟诗酒店 *does not have a fixed meaning in the Chinese language*...This dictionary contains *no* mention of the phrase 柏•伟诗酒店 either as a distinct entry in the dictionary or as an example (i.e. used in a phrase when that character is conjoined with other characters) in connection with *each* of the character in the *Subject Mark*.

⁴⁴ While the application mark in *Seiko* is different from the current case in that it consists of English words and Japanese Kanji and Katakana characters, this does not in anyway diminish the PAR’s view that “English is the working language in Singapore...[and]...is spoken by the majority as a first language..”.

[Emphasis in italics mine]

66 The Proprietor further clarified that it is referring to the 3rd method of creating Chinese marks as described in the article *Issue 10 – Focus on Trade Mark Names in China* in the Applicants’ 3rd SD at Exhibit 1, pages 12 - 14:

Three ways to choose your Chinese trade mark name

1. Create a literal translation

A literal translation works when the trade mark has a distinctive meaning. For example, Apple computers chose the brand name “Ping Guo” (苹果), which is Chinese for ‘apple’...The disadvantage of this method is that the Chinese characters will sound different from your original trade mark. This means that marketing time and money will need to be spent on building association between your Roman character trade mark and the Chinese character trade mark.

2. Create a phonetic translation

A phonetic translation involves creating a Chinese character name which sounds like your trade mark. Pinyin is the official Chinese phonetic alphabet that uses Roman characters, which can be used to create the transliteration. For example, “McDonald” is known as “Mai Dang Lao” (麦当劳) to local Chinese consumers...

3. Combine a literal and phonetic translation

The *best* trade marks are those which sound the same *and* also make reference to a defining characteristic of your brand or *have a positive meaning in Chinese culture*. For example...Coca Cola finally settled with “Ke Kou Ke Le” (可口可乐), which means “taste and be happy”...

[Emphasis in italics mine]

67 As mentioned above, aside from the visual attributes of the various elements of a mark, the meaning of the mark also affects the visual appreciation of a mark⁴⁵. This necessarily means that the visual perception of the ***Subject Mark*** is influenced by the language of the different constituents of a mark.

68 As there is no clear guide in relation to the comparison of marks consisting / containing Chinese characters and Roman letters in the local context, I turn to the Hong Kong Intellectual Property Department (HKIPD) Work Manual⁴⁶. In the chapter *Foreign words, letters or characters*:

⁴⁵ In this regard, there is some overlap with the issue of conceptual similarity.

⁴⁶

https://www.ipd.gov.hk/eng/intellectual_property/trademarks/registry/Foreign_words_letters_or_characters.pdf

Examination on *prima facie* basis

In examining applications for registration of trade marks which include foreign words, letters or characters on *prima facie* basis, we will generally consider the following factors:

- *Meaning generally known?*

There are no grounds for refusing registration of trade marks on the basis that they are relevantly descriptive or non-distinctive in a language which is *unlikely to be understood by the relevant Hong Kong consumers of the goods or services in question...*

On the contrary, trade marks which include foreign words, letters or characters which are descriptive or indistinctive of the applied-for goods or services and are generally known to the relevant consumers of such goods or services in Hong Kong are unregistrable. For example, the word “ICHIBAN” meaning “the best” in Japanese is unregistrable in respect of any types of applied-for goods or services since *the average consumer in Hong Kong will understand this laudatory meaning.*

[Emphasis in italics mine]

Therefore, a key consideration is whether the language of the words/characters in question (of the various constituents of a mark) will be understood by the relevant consumer.

69 Having regard to the demographics of Singapore, I am of the view that Chinese will be understood in the local context such that it is not likely that 柏•伟诗酒店 will be viewed simply as a decorative element⁴⁷. Nonetheless, having regard to the fact that English is the working language in Singapore, I am also of the view that 柏•伟诗酒店 are of *secondary* significance in comparison to “PARK REGIS”.

70 As acknowledged by the learned PAR in *Seiko*⁴⁸ “English is the *working language* in Singapore...[and]...is spoken by the majority as a *first language*”. I also take judicial notice of the following excerpt from Wikipedia⁴⁹:

...English became the *lingua franca* due to British rule of Singapore, and was made the main language upon Singaporean independence. Thus, English is the medium of instruction in schools, and is also the *main language* used in formal settings such as

⁴⁷ In the recent case of *Inner Mongolia Little Sheep Catering Chain Co. Ltd. v Grassland Xiao Fei Yang Pte Ltd* [2018] SGIPOS 6, where the marks at issue were “XIAO FEI YANG” and “小肥羊”, the learned AR commented, albeit *obiter dicta* that:

[70(c)] ...In Singapore, the demographics are such that a large majority of the population is of Chinese ethnicity or descent. And, apart from ethnicity, a large proportion of the public in Singapore would have at least a basic command of Mandarin Chinese...

⁴⁸ At [45]; see above discussion.

⁴⁹ https://en.m.wikipedia.org/wiki/Languages_of_Singapore 11/ [viewed on 9 July 2018.]

in government departments and the courts. As President Halimah Yacob said during her 2018 speech, “Through the education system, we adopted a *common working language* in English.”...

71 I agree with the Proprietor that Singapore is a multi-ethnic and multi-lingual society of which the majority are Chinese ([4] of the Proprietor’s 1st SD) who are literate in both Chinese and English ([5] of the Proprietor’s 1st SD). I refer to 2 publications from the Singapore Department of Statistics, *Population Trends 2016* and *General Household Survey 2015* (at [4] and [5] of the Proprietor’s 1st SD). Both were published after the **Relevant Date**. Nonetheless, they do include some figures for the year 2010, which can be used as an approximate⁵⁰.

72 Pages 23 and 24 of Exhibit 2 of the Proprietor’s 1st SD contain extracts of *Population Trends 2016*. In 2010, the local population stood at 5.1 million, of which 3.8 million were residents. With regard the ethnic composition of the population, there are only figures for 2006 and 2016 (page 24 of Exhibit 2 of the Proprietor’s 1st SD). I will refer to the 2006 figures rather than the 2016 figures having regard to the **Relevant Date**⁵¹. In 2006, 75.3% of the population were Chinese, while 13.8 % were Malays, 8.6% were Indians and 2.3% were indicated as “others”. Therefore, the Chinese made up about ¾ of the population in Singapore⁵².

73 Pages 26 and 27 of Exhibit 2 of the Proprietor’s 1st SD contain extracts of the *General Household Survey 2015*. In 2010, 66.5% of the total number of Chinese residents in Singapore were literate in 2 or more languages, of which 58% were literate in both English and Chinese⁵³. Following the above, the *second* most widely understood language in the local context is Chinese, *after* English, which is the official working language of Singapore.

74 Both parties also argued about the language proficiency of tourists in Singapore. On the one hand, the Applicants argued that “[i]nsofar as the likely users of the services of both parties are going to be foreign tourists, a significant portion of such tourists would not understand Chinese” ([43] AWS1). On the other hand, the Proprietors argued “[o]ver the years, Singapore has maintained its attraction to Chinese-speaking tourists, particularly those from China, Hong Kong and Taiwan ([20] PWS1; see also [30] of the Proprietor’s 2nd SD⁵⁴ and Exhibit 7 of the same).

⁵⁰ It is unclear if the population figure takes into account the whole of the calendar year of 2010. Nonetheless, it is still a close approximation.

⁵¹ Nonetheless, it is observed that the dividing lines across the 4 main ethnic groups remain largely stable between 2006 and 2016.

⁵² This has remained more or less consistent between 2006 and 2016, above.

⁵³ This translates to about 40% of the population.

⁵⁴ Figures which occurred after the **Relevant Date** will be ignored.

75 There is no need to dwell too much into this issue. Even if there is an influx of Chinese-speaking tourists in recent years, the proportion of this group in relation to the total annual number of visitors to Singapore would still appear to be relatively low⁵⁵.

76 In summary, using the learned PAR’s explanation in *Seiko* at [45], “[t]he tendency is to refer to [PARK REGIS] because English is the working language in Singapore, is spoken by the majority as a first language and people in general will gravitate towards the language most familiar to them”.

77 This conclusion does not detract from my agreement with the Proprietor’s argument that “consumers who are literate in English and Chinese are capable of recognising the Chinese characters” and “are unlikely to ignore” them ([16] Proprietor’s 1st SD). However, it does mean, and I disagree with the Proprietor to this extent,⁵⁶ that the Chinese characters will be seen as *secondary* in the **Subject Mark**. This is because literacy in a language does *not* equate with significance accorded to the same. In my opinion, this conclusion is *buoyed* by the position of the Chinese characters *below* the English characters.

78 I now come to the meaning of the Chinese characters 柏•伟诗酒店. As mentioned above, I am inclined to accept the transliteration clause in the Register⁵⁷ as a more accurate indication. Nonetheless, even if I were to accept the transliteration and translation of 柏•伟诗酒店 as provided in the Proprietor’s 1st SD above, the Chinese characters 柏•伟诗酒店 are still “ineffective to obscure the similarity” between the **Subject Mark** and the **Applicants’ Earlier St Regis Mark**.

79 For ease of reference, the transliteration and translation as per the Proprietor’s evidence⁵⁸ is replicated below:

S/N	Chinese character	Transliteration	Translation
1	柏	bai	Cypress
2	伟	wei	Great
5	诗	shi	Poetry, poem
4	酒店	Jiu dian	Hotel

The reason is that the characters 柏•伟诗酒店 do not possess any *fixed* meaning⁵⁹ as a phrase (see above) *while* sounding similar to “PARK REGIS” at the same time. Thus, 柏•伟诗酒店 would be understood, *first and foremost*, as a phonetic transliteration of “Park Regis”.

⁵⁵ See page 450 of Exhibit 7 of the Proprietor’s 2nd SD which pertains to the year 2009. The proportion of “Chinese-speaking tourists” is 263,825 (including China, Hong Kong and Taiwan) / 1,301,268 = 0.2 or 20%.

⁵⁶ See [16] of the Proprietor’s 1st SD.

⁵⁷ See Exhibit 2 of the Applicants’ 3rd SD. The clause reads:

The transliteration of the Chinese characters appearing in the mark is “Bai” which means “Cypress”. “Wei Shi” which has *no meaning* and “Jiu Dian” which means “Hotel”.

[Emphasis in italics mine]

⁵⁸ Proprietor’s 1st SD at [7].

⁵⁹ See Proprietor’s 1st SD at [7].

80 This is underscored by the description below:⁶⁰

3. *Combine a literal and phonetic translation*

The *best* trade marks are those which *sound* the same *and* also make reference to a defining characteristic of your brand or have a *positive meaning* in Chinese culture. For example...Coca Cola finally settled with “Ke Kou Ke Le” (可口可乐), which means “taste and be happy”...

[Emphasis in italics mine]

The methodology is clear. First, find Chinese characters which sound aurally similar to PARK REGIS. *From* the wide range of similar sounding characters, select those characters, which, when put together, imbue a positive meaning to the brand.

81 I agree that the Chinese name of the Proprietor is not a mere transliteration or translation of PARK REGIS. The final product is clearly more than just a transliteration or translation of PARK REGIS *per se*. Nonetheless, the Chinese characters which were “cobbled together by the Proprietor⁶¹” ([36] PWS2), must, as a matter of prerogative, sound aurally similar to “PARK REGIS”.

82 The need to draw an association with the original brand name⁶² is obvious for it is an “old brand” which draws custom. As explained in *The Commissioners of Inland Revenue v Muller & Co's Margarine, Limited* [1901] AC 217 at 223 – 224 (“*Muller*“)⁶³, custom is “the one thing which distinguishes an old-established business from a new business at its first start... it [is the] power of attraction sufficient to bring customers.” The need to draw the link to the original mark is highlighted by the description above:

1. **Create a literal translation**

A literal translation works when the trade mark has a distinctive meaning. For example, Apple computers chose the brand name “Ping Guo” (苹果), which is Chinese for ‘apple’...The disadvantage of this method is that the Chinese characters will *sound different* from your original trade mark. This means that marketing time and money will need to be spent on *building association* between your Roman character trade mark and the Chinese character trade mark.

[Emphasis in italics mine]

⁶⁰ See the Applicants’ 3rd SD at Exhibit 1, pages 12 – 14.

⁶¹ In comparison to the PARK REGIS brand, which “has been continuously put in use...since 1968 by the Proprietor’s and the Proprietor’s predecessors...” ([7] of Proprietor’s 2nd SD).

⁶² In this case, the Proprietor originates from Australia (see [22] of the Proprietor’s 2nd SD), an English speaking country.

⁶³ Albeit in the context of the meaning of goodwill.

83 Together with the size of the font and the positioning of the characters, 柏•伟诗酒店 is clearly subsidiary and it would not significantly erode any distinctiveness exuded by “Regis”.

84 For the avoidance of doubt, the cases raised by the Proprietor⁶⁴ can be distinguished:

- (i) In *Raffles Fine Arts Auctioneers Pte Ltd v Raffles Corporate Consultants Pte Ltd*⁶⁵, the word “Raffles” is “peculiar to Singapore...as the name of the founder of Singapore and is common (*sic*) used in trade...the public, being accustomed to names incorporating “Raffles” in trade are likely to be more discerning of marks consisting the word “Raffles” and will focus on the dissimilar aspects.” ([16(a)] AWS2).
- (ii) *Multi Access Limited v Guangzhou Pharmaceutical Holding Limited*⁶⁶ is distinguishable as both marks are device marks where the Chinese characters therein appear in a different order ([16(b)] AWS2).
- (iii) In *Eley Trading Sdn Bhd v Kwek Soo Chuan*,⁶⁷ the device is large in size and is prominently placed, serving as a clear distinguishing factor.
- (iv) In *Mitac International Corp v Singapore Telecommunications Ltd*⁶⁸, both the word marks are highly stylised, acting as a differentiating factor.
- (v) Last but not least, decisions emanating from China (see [60] and [61] PWS1) must be read with caution. In addition to differing laws, the demographics of the 2 countries are also different⁶⁹.

Conclusion

85 I have concluded above that:

- (i) the size of the components relative to the **Subject Mark** are as follows:
 - (a) device – 20%;
 - (b) the words Park Regis – 45%; and
 - (c) the Chinese characters 柏•伟诗酒店 - 35%.
- (ii) 柏•伟诗酒店 is positioned *below* “Park Regis”.

⁶⁴ [59] – [61] PWS1.

⁶⁵ [2010] SGIPOS 1

⁶⁶ [2017] SGIPOS 13

⁶⁷ [2017] SGIPOS 15

⁶⁸ [2009] 4 SLR(R) 961

⁶⁹ While the majority of the population in Singapore are Chinese, of which a large proportion has some proficiency in Chinese, English is still the common working language in Singapore (above).

- (iii) the *fleur-de-lis* device will only be viewed as a decorative element. If any connotation is warranted, it is that of royalty, which simply accentuates “Regis”.
- (iv) “Park” is descriptive of the service and thus accorded low weight in the distinctiveness spectrum.
- (v) the Chinese characters 柏•伟诗酒店 will, in the main, be understood as a phonetic transliteration of “PARK REGIS” and thus be of subsidiary significance.

86 In light of all the above, I am of the view that the *fleur-de-lis* device, the word PARK and the Chinese characters 柏•伟诗酒店 are “ineffective to obscure the similarity” between the **Subject Mark** and the **Applicants’ Earlier St Regis Mark** as a result of the common distinctive element REGIS.

87 In coming to this conclusion, I am mindful that the assessment of marks is based on the overall impression given by the marks. However, bearing in mind the distinctive and dominant component, I am of the view that visually, the marks are more similar than dissimilar to some degree.

Aural Similarity

88 With regard to aural similarity, *Staywell Court of Appeal* stated at [31] and [32] that there are two approaches. One approach is to consider the dominant component of the mark (“Dominant Component Approach”).

89 As alluded to above, *Staywell Court of Appeal* held at [31]:

[31] ...*At least in relation to hotels and hospitality services, “Regis” enjoys a substantial degree of technical distinctiveness. In relation to both the competing marks “Regis” is the element that is distinctive in the non-technical sense because it is what will stand out in the imperfect recollection of the consumer. The Judge was therefore entitled to find this is the common dominant element of both marks in assessing the question of whether the competing marks as a whole were similar. The Judge found on this basis that the marks were aurally similar and we agree.*

[Emphasis in italics mine]

90 As in the case of the discussion on visual similarity, the only issue left is whether the addition of Chinese characters 柏•伟诗酒店 in the **Subject Mark** will result in a different conclusion.

91 Applying the Dominant Component Approach, and having regard to my conclusion with regard to the issue of visual similarity, the answer clearly must be a “no”. As alluded above, the dominant element remains as REGIS and the Chinese characters 柏•伟诗酒店

⁷⁰ are ineffective to obscure the similarity between the *Subject Mark* and the *Applicants' Earlier St Regis Mark*.

92 There is of course, the alternative approach which simply involves asking the question whether competing marks have more syllables in common than not (“Quantitative Assessment Approach”).

93 The Proprietor argued at [71] – [73] PWS1:

[71] The Proprietor’s Mark reads as seven separate and distinctive words, in the order of “PARK”, “REGIS”, “柏”, “伟”, “诗”, “酒店”, and is pronounced as “PARK REGIS BAI WEI SHI JIU DIAN”.

[72] In comparison, the textual components in [*the Applicants' Earlier St Regis Mark*] are the words, “ST. REGIS”. It reads as two separate and distinctive words in the order of “SAINT”, “REGIS”.

[73] On a quantitative assessment of the marks, it is evident that there are clear differences in the enunciation of the respective marks when though both marks contain the word, “REGIS”. Such pronounced differences in the pronunciation of the textual components in each mark renders the marks aurally dissimilar.


94 I do not think that a strict application of the Quantitative Assessment Approach is appropriate in this instance. For example in *Han’s (F&B) Pte Ltd v Gusttino World Pte Ltd* [2015] 2 SLR 825 (“*Han’s*”),⁷¹ the High Court provided:

[136] The Defendant argues that the Han’s trade marks contain only a single syllable. The HAN sign, on the other hand, consists of seven syllables (“HAN Cuisine of Naniwa”)...

[137] In my view, there is phonetic similarity between the HAN sign and the Han’s trade marks. *The main phonetic component of the HAN sign is “HAN”*. “Cuisine of Naniwa” is *subsidiary*. It is *doubtful* that the average consumer would make constant reference to the seven-syllable “HAN Cuisine of Naniwa” phrase every time he refers to it...There is, therefore, phonetic similarity between the HAN sign and the Han’s trade marks.

⁷⁰ The device is not taken into account for aural similarity.

⁷¹ This was decided *after Time Inc v Li San Zhong* [2014] SGIPOS 14 (“*Time Inc*”) (see [70] PWS). In any

case, *Time Inc* can be distinguished. The subject mark in *Time Inc* was . Having regard to the prominence of the both the Chinese characters and English letters, it is no wonder that the learned PAR came to the conclusion that both English and Chinese components were to be taken into account when assessing aural similarity. This in contrast to the current case.

95 I am of the view that the above principle is applicable to the current case. To paraphrase *Han*'s: “[t]he main phonetic component of the [*Subject Mark*] is [“PARK REGIS”]. [“柏•伟诗酒店”] is subsidiary. It is doubtful that the average consumer would make constant reference to the seven-syllable [“PARK REGIS 柏•伟诗酒店”] every time he refers to it...”

Conclusion

96 In light of the above, applying the Dominant Component Approach, the marks are aurally more similar than dissimilar to a fair extent.

Conceptual Similarity

97 *Staywell Court of Appeal* expounded at [35] as follows:

[35] ...Unlike the aural analysis, which involves the utterance of the syllables without exploring the composite meaning embodied by the words, the conceptual analysis seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole...*Greater care is therefore needed in considering what the conceptually dominant component of a composite mark is, because the idea connoted by each component might be very different from the sum of its parts...*

[Emphasis in italics mine]

98 The Court of Appeal in *Staywell Court of Appeal* provided:

[35] ...we do not agree that “Regis” was a dominant component on a *conceptual* analysis...

[37] However, we find that there is some conceptual similarity between the marks but for a different reason. There is some strength in the Opponents’ argument that both the Applicant and Opponent Marks evoke the idea of a place or location. Although the ST. REGIS mark might conjure the image of a saintly person, in Singapore by far the most common manifestation of saintly names is in relation to *places*...many of which have no particular association whatsoever with the saintly character whose name they have adopted. Similarly, the word “Park”, as noted by the Judge, connotes the idea of a geographical location though not necessarily of any particular type (see [26] of the GD). Therefore, in the Singapore context, the marks share a tendency to connote *a place or location or building* which, as between the competing marks in question, *are linked by the common reference to “Regis”*.

[Emphasis in italics mine]

99 Similarly, the issue is whether the inclusion of the Chinese characters 柏•伟诗酒店 will result in a different conclusion. Again, the answer must be a “no”. As alluded above, the English portion will stand out more than the Chinese characters. This is because they

are of a larger font and placed more prominently than the Chinese characters. Further, the English characters will capture the attention of most of the population since it is the working language in Singapore.

100 In fact the meaning of the individual Chinese characters⁷² which literally translates into “Cypress Great Poetry Hotel,” simply enforces the concept of “a park (Cypress) or a place (Hotel) of grandeur (Great), elegance and culture (Poetry)”. For the avoidance of doubt, the inclusion of the *fleur-de-lis* device completes the imagery of royalty, emanating ideas of a geographical location bearing some class and prestige.⁷³

101 Taking all of the above into consideration, I am of the view that the marks are conceptually more similar than dissimilar to a fair extent.

Conclusion on the similarity of marks

102 It is to be recalled that:

- (i) The court must ultimately conclude whether the marks, when observed in their totality, are similar rather than dissimilar. In this regard, trade-offs can occur between the three aspects of similarity.
- (ii) The average consumer:
 - (a) has an “imperfect recollection” and there is a need to consider the general impression that will likely be left by the *dominant* features of the marks.
 - (b) is one who would exercise some care and a measure of good sense in making his or her purchases, not that of an unthinking person in a hurry.

103 I have concluded that the *Applicants’ Earlier St Regis Mark* in comparison to the *Subject Mark* is visually similar to some degree and aurally and conceptually similar to a fair extent, such that overall, the marks are more similar than dissimilar⁷⁴.

Identity of Services

104 The Court of Appeal in *Staywell Court of Appeal* clarified the applicable principles as follows at [40] and [41]:

[40] The comparison before us was between the services falling under [the Proprietor’s] intended Class 35 and Class 43⁷⁵ registrations, and [the Applicants’]

⁷² See above; as deposed by the Proprietor, there is *no* mention of the phrase 柏•伟诗酒店 as an example (i.e. used in a phrase when that character is conjoined with other characters) in connection with *each* of the character in the *Subject Mark*.

⁷³ See above discussion in relation to the device.

⁷⁴ All that is required is that the marks are *more similar than dissimilar*. See *Staywell Court of Appeal* at [17].

⁷⁵ See <http://www.wipo.int/classifications/nice/en/preface.html>

About the Nice Classification

...The Committee of Experts has, since the entry into force of the Nice Agreement, on April 8, 1961...revised class 42 with the creation of classes 43 to 45 (in 2000)...

existing [Class 42⁷⁶] registration. In relation to the Class 43 [or Class 42] registration, we agree with the Judge’s observation that the fact that the parties’ hotel services were branded for different market segments did not render the services dissimilar...

[41] ...Where a good or service in relation to which registration is sought falls within the ambit of the specification in which the incumbent mark is registered, the competing goods or services would be regarded as *identical*...

[Emphasis in italics mine]

105 For ease of reference, the services are as follows:

<i>Subject Mark</i>	<i>Applicants’ Earlier St Regis Mark</i>
<p><u>Class 43</u></p> <p><i>Services for providing food and drink; temporary accommodation; hotel services; motel services; tourist homes; resort hotel services; hotel accommodation services; hotel catering services; hotel reservation services; hotel restaurant services; provision of hotel accommodation for business exhibitions, business fairs, conferences, congresses, lectures and meetings; providing facilities [accommodation] for conducting conferences, conventions, exhibitions, fairs and holidays; rental of meeting rooms; hospitality services [accommodation]; hospitality suites [provision of accommodation, food or drink]; holiday information and planning relating to accommodation; inn keeping [bar, restaurant and accommodation]; restaurants; cafes; bar and catering services; advisory, information and consultancy services relating to all the aforesaid; all the aforesaid services also provided on-line from a computer database or via the global communications network; all included in Class 43</i></p>	<p><u>Class 42</u></p> <p><i>Hotel, motel, resort, restaurant, bar, cocktail lounge, food and beverage services.</i></p>

The identical services are set out in *italics* above. Clearly this element has been satisfied.

Likelihood of confusion

106 The law in relation to this issue is as follows (*Staywell Court of Appeal* at [60], [65], [95] and [96]):

- (i) 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*

⁷⁶ As above.

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 ([60] Staywell Court of Appeal).

- (ii) The similarity of marks and that of the goods or services are threshold questions but they are not determinative questions; in short these are necessary but not sufficient conditions. The plain words and the scheme of the Act do not preclude the court's discretion to consider extraneous factors to the extent that these inform the assessment of the *effect* of the required similarity on consumer perception ([65] *Staywell Court of Appeal*).
- (iii) The permissible factors are those which (a) are intrinsic to the very nature of the goods and/or (b) affect the impact that the similarity of marks and goods has on the consumer. The impermissible factors are those differences between the competing marks and goods which are created by a trader's differentiating steps. ([95] *Staywell Court of Appeal*).
- (iv) The following represents a non-exhaustive list of factors which we regard as admissible in the confusion inquiry ([96] *Staywell Court of Appeal*):
 - (a) Factors relating to the impact of marks-similarity on consumer perception:
 - A. the degree of similarity of the marks themselves;
 - B. the reputation of the marks⁷⁷;
 - C. the impression given by the marks;
 - D. the possibility of imperfect recollection of the marks.
 - (b) Factors relating to the impact of goods-similarity on consumer perception:
 - A. The normal way in or the circumstances under which consumers would purchase goods of that type;
 - B. Whether the products are expensive or inexpensive items;
 - C. The nature of the goods and whether they would tend to command a greater or lesser degree of fastidiousness and attention on the part of prospective purchasers;
 - D. The likely characteristics of the relevant consumers and whether they would or would not tend to apply care or have specialist knowledge in making the purchase.

107 *Staywell Court of Appeal* then proceeded to analyse the facts in that case as follows [99], [101] to [103]:

⁷⁷ A strong reputation does *not* necessarily equate to a higher likelihood of confusion, and could in fact have the contrary effect (*Mobil Petroleum Co, Inc v Hyundai Mobis* [2010] 1 SLR 512 at [74]).

[99] ...Confusion in trade mark law *extends* to consumers believing that the users of the competing marks are *economically linked*...⁷⁸

[101] As to the similarity of the marks, we have already observed that there is no visual similarity, some degree of conceptual similarity, and a significant degree of aural similarity. On the whole, we have found that the marks were similar. We also agree that “Regis” is the dominant component of the mark on an aural analysis.

[102] Turning to the likelihood of confusion...we find it not unlikely that the public would be induced by the similarity of the marks and the common industry in which they are used into believing that there is at least some *economic link* between the ST. REGIS Singapore and the Park Regis Singapore. This is 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...The common denominator serves as an assurance of

source and therefore quality. Examples are  **Hilton** HOTELS & RESORTS  **Hilton Garden Inn**® or  **HYATT** REGENCY  **GRAND | HYATT**  **PARK HYATT**

[103] In our view, therefore, the similarity arising from the use of the common denominator “Regis” in both marks takes on particular significance and there is ample ground for finding that there is a sufficient likelihood of confusion as to the existence of an *economic link* between the two hotels in question.

[Emphasis in italics mine]

108 I have already concluded above that the *Applicants’ Earlier St Regis Mark* in comparison to the *Subject Mark* is visually, aurally and conceptually more similar than dissimilar and the services are identical. Given the Court of Appeal’s finding as to the state of the hotel industry, which remains applicable as at the *Relevant Date*, I am of the view that there is a likelihood of confusion in that consumers would believe that the Applicants and the Proprietor are economically linked.

109 The Proprietor argued that it is unlikely for there to be a likelihood of confusion (see [98(i) – (iv)] PWS1). For example, the Proprietor argued that hotel stays are expensive purchases which tend to command greater attention ([98(ii)] PWS1). However, as discussed in *Staywell Court of Appeal* above, the type of confusion envisaged here is that

⁷⁸ Thus the Proprietor’s argument at [135] PWS1 that “[w]hile the marks are registered for use in the same class, it is unlikely that the Proprietor’s services and the Applicants’ services are in competition with or are substitutes for each other. A luxury accommodation cannot be substituted with or be in competition with a 4-star accommodation and vice versa.” does not apply.

the Applicants have expanded from 6-star to 4-star hotels, catering to a different market segment.

110 Importantly, the Proprietor vehemently argued ([100] and [101] PWS1) that it is “*St Regis*” and not “*Regis*” which forms the core identity of the Applicants. The Proprietor submitted that this is borne out in the evidence. The Applicants was / is always referred to as “*St Regis*” and not “*Regis*” alone. The Proprietor argued that in light of the above, the comparison should be made between *PARK REGIS* and *ST REGIS*.

111 Further, the Proprietors pointed out⁷⁹ that in all the examples cited in [102] of *Staywell Court of Appeal* (above), the brands were replicated entirely. For example, *Hyatt Regency* versus *Grand Hyatt* versus *Park Hyatt*. Following this logic, any expansion by the Applicants should be in the format of, for example, [prefix] *ST REGIS*.

112 The issue has been definitively dealt with by *Staywell Court of Appeal* (see [31]⁸⁰):

[31] ...[the Proprietor’s] argument that the Judge erred in considering the dominance of “*Regis*” because [the Applicants] had never used or registered the component “*Regis*” alone was *misconceived* simply because, as we have pointed above, a component can clearly be *dominant* even if it is part of the mark as a whole and is not and *has never been used on its own*...[the Proprietor’s] argument that any distinctiveness of [the Applicants’] mark *lay in “St. Regis” as a whole rather than in “Regis”* overlooked the permissibility of examining the distinctive components of the competing marks in both the technical and nontechnical senses.

[Emphasis in italics mine]

113 In light of the above, the Proprietor’s arguments do not stand⁸¹. In conclusion, on balance, taking into account the permissible extraneous factors, I find that there is a reasonable likelihood of confusion.

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

Ground of Invalidation under Section 8(4)

115 The relevant provisions in the Act are:

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

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

⁷⁹ See [101] PWS1.

⁸⁰ In their analysis of aural similarity.

⁸¹ The Proprietor also argued that “*REGIS*” is a common word used in the names of hotels’ in other jurisdictions (see [102] PWS1). This fact is irrelevant for the purposes of this decision, having regard to the principle of territoriality.

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

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

8(4) Subject to subsection (5), where an application for registration of a trade mark is made on or after 1st July 2004, if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark, the later trade mark shall not be registered if —

- (a) the earlier trade mark is well known in Singapore; and
- (b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —

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

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

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

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

Similarity of marks

116 In relation to this ground, it is clear that the first element that must be satisfied is that "the whole or essential part of the trade mark must be identical or similar to an earlier mark". This element is essentially the same as the similar element under Section 8(2)(b) (see *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 (“*Sarika*”) (at [70] and [71])). I have already found that the Applicants have satisfied this element.

Well known in Singapore

117 The critical question is whether the *Applicants’ Earlier St Regis Mark* is well known in Singapore as at the *Relevant Date*.

118 The starting point for this inquiry is Section 2(7), (8) and (9) of the Act. Section 2(7) of the Act states:

Subject to subsection (8), in deciding, for the purposes of this Act, whether a trade mark is well known in Singapore, it shall be relevant to take into account any matter

from which it may be inferred that the trade mark is well known, including such of the following matters as may be relevant:

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

Section 2(8) of the Act reads:

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

Section 2(9) states:

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

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

119 The provisions have been the subject of further exposition by the Courts:

- (i) Section 2(7)(a) is arguably the most crucial factor when determining whether a trade mark is well known in Singapore. This because Section 2(8) *deems* a trade mark to be well known in Singapore where it is determined to be well known to *any* relevant sector of the public in Singapore (see [139] of *Novelty*

Pte Ltd v Amanresorts Ltd and another [2009] 3 SLR (R) 216 ("Amanresorts").

- (ii) Aside from Section 2(7)(a), the court is ordinarily free to disregard any or all of the factors listed in Section 2(7) as the case requires and to take additional factors into consideration (*Amanresorts* at [137]).
- (iii) In relation to Section 2(8), the Court of Appeal in *Caesarstone* clarified that:

[101] ...we said in *Amanresorts* that it is “not too difficult” for a trade mark to be regarded as well known in Singapore⁸²...

[102] We do not think that this comment in *Amanresorts* was made to lay down a general principle...the context of this comment was the desire to clarify that, in order for a mark to be well known in Singapore, the relevant sector to which a mark must be shown to be well known can be any relevant sector of the Singaporean public, and this sector need not be large in size. *Beyond this, it should not be read as suggesting (more generally) that the threshold for a trade mark to be regarded as well known in Singapore is a low one.*

[Emphasis in italics mine]

- (iv) Last but not least, with regard to the ambit of Section 2(9)(a), the inquiry is into the specific goods or services to which the Opponent’s trade mark has been applied or the Opponent’s goods or services ([152] *Amanresorts*).

120 The Applicants submitted at [83], [84], [85] AWS1:

[83] It bears highlighting that the Proprietor, in its appeal to the Court of Appeal in the [*Previous Opposition Decision*], did not challenge the PAR and High Court Judge’s finding that the [*Applicants’ Earlier St Regis Mark*] was well known as at the date of application of the [*Previous Park Regis Mark*]. If the [*Applicants’ Earlier St Regis Mark*] was well known as at 3 March 2008⁸³, it must follow that the [*Applicants’ Earlier St Regis Mark*] continues to be well known as at the [*Relevant Date*]⁸⁴.

[84] Even if the Applicants are wrong in this regard, it is submitted that the [*Applicants’ Earlier Marks*] and in particular, the [*Applicants’ Earlier St Regis Mark*], is well known for the reasons set out...

⁸² The Court of Appeal in *Amanresorts* commented that it is *not too difficult* for a trade mark to be regarded as “well known in Singapore” since the trade mark in question need only be recognised or known by “any relevant sector of the public in Singapore” which could in certain cases be *miniscule* ([229] *Amanresorts*).

⁸³ Relevant date in the *Previous Opposition Decision*.

⁸⁴ The Applicants are relying on the same mark here.

[85] ...Since the opening of the St. Regis hotel in Singapore in 2008, the Applicants enjoy a gross sales revenue of its (sic) services of amounts in excess of USD 23 million.

121 I refer to the Applicants' 1st SD at [12]:

[12] In the years preceding the application date of the [*Subject Mark*], the Gross Revenue for...the ST REGIS in Singapore in particular, were as follows, in excess of the below amount in U.S. dollars [in millions]:

S/N	Year ⁸⁵	Singapore Sales Revenue
1	FY 2008	15
2	FY 2009	15
3	October 2009 – 7 May 2010 ⁸⁶	13.4 ⁸⁷

122 I agree with the Applicants that on the basis that the Proprietor did not challenge in *Staywell IPOS* and *Staywell High Court* that the *Applicants' Earlier St Regis Mark* was well known as at 3 March 2008, it is likely that the *Applicants' Earlier St Regis Mark* continues to be well known as at the *Relevant Date*.

123 In any event, I am of the view that in light of the *Singapore* sales revenue above, which amounts to an annual average of *SGD 23.3 million*⁸⁸, the *Applicants' Earlier St Regis Mark* is well known to all actual consumers and potential consumers in Singapore of the Applicants' services to which the *Applicants' Earlier St Regis Mark* has been applied. For the avoidance of doubt, I come to the above conclusion having regard to the Court of Appeal's comments in *Caesarstone* above.

Confusing connection

124 In relation to this element, *Staywell Court of Appeal* provided that "*Amanresorts* has put it beyond doubt that the connection requirement of s 8(4)(b)(i) and s 55(3)(a) of the Act will be satisfied where there is a likelihood of confusion" (see [120] *Amanresorts*).

125 Thus, I am of the view that there will a confusing connection here for largely the same reasons that I have provided for my conclusion in relation to the likelihood of confusion under Section 8(2)(b).

⁸⁵ Having regard to the *Relevant Date*, the figures for the period FY 2011 – 2016 are excluded.

⁸⁶ It is assumed that the financial year is that of the United States of America, since the quantum is in USD. This means that FY 2010 includes the period October 2009 – September 2010.

⁸⁷ As FY 2010 consists of the period October 2009 – September 2010, the figure for the period October 2009 – 7 May 2010 is approximately $23/12 \times 7 = \text{USD } 13.4$ million.

⁸⁸ The average sales revenue in USD is $15 + 15 + 13.4 = 43.4 / 2.6 = 16.7$ million. Using the exchange rate of 1 USD = 1.3957 as at the *Relevant Date* from XE.com Inc., $16.7 \times 1.3957 = \text{SGD } 23.3$ million.

Likelihood of Damage

126 In relation to this element, *Amanresorts* provided “that the tests to be adopted for the purposes of ...the “likely to damage the [plaintiff’s] interests” requirement in s 55(3)(a) of the current [Act] would yield the same results as those obtained from applying the corresponding tests *vis-à-vis* the Respondents’ claim for passing off” (see [234] *Amanresorts*).

127 The Applicants submitted at [99] and [100] AWS1:

[99] The Court of Appeal in [*Staywell Court of Appeal*] recognized that a likely head of damage could be the limitation or restriction on the Applicants’ ability to expand into the 4-star hotel market in Singapore. Whether the Applicants have any such plans is *irrelevant*⁸⁹...

[100] In this present instance, it is submitted that there is little reason for the Registrar to depart from the finding of the Court of Appeal in [*Staywell Court of Appeal*] that the businesses of the parties are in “close proximity”...

[Emphasis as underlined the Applicants’]

Having regard to the highly similar circumstances (between the *Previous Opposition Decision* and the current action), the above is highly persuasive on me. In any event, I agree with these findings.

128 Before I leave this element, the Proprietor attempted to argue that the fact that there were no actual instances of confusion, “goes to show that use of the [*Subject Mark*] in relation to the services for which the [*Subject Mark*] is registered would not indicate a connection between those services and the Applicants.”^{90 91} Clearly this argument does not stand; it is trite that a likelihood of damage suffices⁹².

129 In light of all of the above, the ground of opposition under Section 8(4)(b)(i) succeeds.

⁸⁹ See [126] of *Staywell Court of Appeal*: “[o]nly if there was no such proximity would the incumbent have to display a genuine intention to expand into the prospective market”.

⁹⁰ See PWS1 at [126].

⁹¹ Following the Proprietor’s argument above that what is dominant for the Applicants is *ST REGIS* rather than *REGIS* alone, the Proprietor argued at the oral hearing that the Applicants are free to expand into the 4 star range of hotels as long as they replicate *ST REGIS* in its entirety, such that there can be no damage to the Applicants. This has been dealt with above under the issue of the confusion connection.

⁹² See *Law of Intellectual Property of Singapore (Sweet & Maxwell, 2014 Rev Ed)* by Professor Ng-Loy Wee Loon at [19.1.2]. This paragraph pertains to damage for a passing off action. As indicated above, the tests are the same.

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

130 The critical question is whether the *Applicants' Earlier St Regis Mark* is well known to the public at large (in Singapore) as at the *Relevant Date*.

Well known to the public at large

131 It is obvious that the relevant provisions and case law which relate to the limb “well known in Singapore” (above) apply. Further, the following are pertinent:

- (i) The test “well known to the public at large in Singapore” has to mean *more* than just “well known in Singapore”. The mark has to necessarily enjoy a much *higher* degree of recognition. It has to be recognised by *most* sectors of the public though not so far as to all sectors of the public (*City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 at [13]).
- (ii) A much more *extensive* level of protection is granted to trade marks which have attained the *coveted* status of being “well known to the public at large in Singapore”. These form *a rare and exclusive class*, and are entitled to protection from use of the defendant’s trade mark on dissimilar goods or services even in the absence of a likelihood of confusion (*Amanresorts* at [233]).

132 The Applicants submitted at [103] – [106] AWS1:

[103] To assist the Registrar in arriving at this finding, we would also compare the reputation of the [*Applicants' Earlier St Regis Mark*] in the instant case with precedent cases where the Court made a finding that a mark was well known to the public at large. For convenience, we will be highlighting two prior cases i.e. the SEIKO mark in [*Seiko*] and the CLINIQUE mark in *Clinique Laboratories, LLC v Clinique Suisse Pte Ltd* [2010] 4 SLR 510 (“*Clinique*”).

[104] With regard to the Applicants’ Revenue (per year), the relevant figures from the instant case, *Seiko* and *Clinique* are reproduced as follows:

	Applicants	SEIKO	CLINIQUE
Revenue	USD15 – [USD 23 million] ⁹³ = S\$ 19 – 30 million	S\$14 million	S\$10 million

⁹³ The Applicants did not elaborate how they arrived at the quantum of USD15 – 23.3 million. I venture to guess that it is the Singapore sales revenue for FY 2008 – FY 2010 (above). If so, the figure for FY 2010 is USD 23 million and not USD 23.3 million (see [12] of the Applicants’ 1st SD).

[105] From the above, it is immediately apparent that the Applicants' estimated yearly revenue is more than either of the precedent cases. On this measure, it is submitted that the [*Applicants' Earlier St Regis Mark*] would qualify to be considered as a mark "well known to the public at large".

[106] In addition to the above:

- (a) the Applicants have gained widespread news coverage over several local publications such as the Straits Times, New Paper, Business Times Singapore, CNA, Today, and The New Paper...
- (b) the Applicants' St Regis hotels (including the St Regis Singapore) are also the subject of numerous accolades and awards.

[107] For the reasons set out above, it is submitted that the [*Applicants' Earlier St Regis Mark*] are well known to the public at large as at the *Relevant Date*.

[Emphasis as underlined the Applicants']

133 It is observed that this ground of objection failed in *Staywell IPOS* (see [94]):

[94] ...The question is, is the Opponents' mark recognised by *most sectors* of the Singapore public? I do not think so...I am not convinced that the Opponents' mark is known to the general public, let alone most sectors of the public, bearing in mind also that this assessment has to be made as at the date of the application for the Application Mark, i.e., March 2008...the ground of opposition under section 8(4)(a) and (b)(ii) necessarily fails...

[Emphasis in the original]

However, time has elapsed since then and the critical issue is whether the *Applicants' Earlier St Regis Mark* is well known to the public at large as at the *Relevant Date*, that is, about 2 years since March 2008.

134 For ease of comparison, below is a table with the Applicants' numbers in contrast to cases where the element has been made out (for the avoidance of doubt, the table is a guide only):

All figures pertain to activities in Singapore					
S/ N		Expenditure on marketing	Exposure via physical sales outlets	Sales figures	Survey, if any

1	"Seiko"	More than \$4 million <i>each year</i> for 5 years	100 optical shops	\$14 million <i>per annum</i> for 5 years	70% of consumer awareness
2	"Clinique"	\$3 million <i>each year</i> for 4 years	13 stores and counters	\$10 million <i>per annum</i> for 4 years	
3	"Nutella" ⁹⁴	NA	94-98% of stores in Singapore that sell food items	2 million units of "Nutella" bread spread sold <i>every year</i>	70% of consumer awareness
4	Intel ⁹⁵	US\$600 million per annum for 4 years		US\$1 billion per annum for 7 years	85% of consumer awareness
5	Gucci ⁹⁶	<p>- "[I]n the region of hundreds of thousands of euros"... "for many years, including in Singapore"⁹⁷</p> <p>- Exposure via approximately 30 publication.</p> <p>- Exposure via social media (Facebook with 15.9 million likes; Instagram – 17.8 million followers; Twitter – 4.97 million followers; Youtube – 136,000 subscribers)</p>	<p>- Changi Airport, the Paragon shopping mall in Orchard Road, the Takashimaya department store in Orchard Road and at The Shoppes retail complex in Marina Bay Sands</p>	<p>"[M]ore than tens of millions SGD" for 5 years⁹⁸</p>	

⁹⁴ *Ferrero SPA v Sarika Connoisseur Cafe Pte Ltd* [2011] SGHC 176

⁹⁵ *Intel Corporation v Intelsteer Pte Ltd* [2015] SGIPOS 2

⁹⁶ *Guccio Gucci S.P.A v Guccitech Industries (Private Ltd)* [2018] SGIPOS 1 ("**Guccitech**"). See [75] of **Guccitech**:

[75]...In my view, there is far more than sufficient evidence on which to find that the GUCCI trade mark is indeed a member of the rare and exclusive class of trade marks that is well known to the public at large in Singapore. It would be contrary not only to the weight of that evidence but also to corroborative common general knowledge (to borrow a term from patent law) to find otherwise...

⁹⁷ See [14] of **Guccitech**.

⁹⁸ See [13] of **Guccitech**.

6	<i>St Regis</i> ⁹⁹	<ul style="list-style-type: none"> - Exposure via approximately 32 local publications¹⁰⁰. - Average online hits from Singapore – 779, 710 (in excess of¹⁰¹) - Starwood Preferred Guest (SPG) (number of members of SPG who have stayed at the St Regis Singapore and are residents of Singapore – an average of 1,921 for the period 2008 – May 2010¹⁰² - Exposure via hosting of conferences (2 events in 2009¹⁰³) 	NA	An average of USD 16.7 (SGD 23.3 million ¹⁰⁴) annually for a period of 3 years.	NA
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135 Before I come to a conclusion on this issue, I agree with the Proprietor as argued at the oral hearing that many of the accolades as attached to Exhibits 3 and 5 of the Applicants’ 1st SD are (i) not proven as to their circulation in the local market; and (ii) dated after the **Relevant Date** (or undated). These will not be taken into consideration.

136 So the question is whether the Applicants’ figures above are comparable to the cases where this element has been made out. My view is that the answer is no. This is because:

⁹⁹ Exposure via social media, namely, Facebook, Twitter and Instagram are excluded as they are dated after the **Relevant Date** (see [15] of the Applicants’ 1st SD which deposed that the figures were provided “[a]s at the date of the filing of this action”).

¹⁰⁰ Spanning the period January 2006 – April 2008, dealing mainly with the imminent opening (then) of St Regis Singapore (see Exhibit 4 of the Applicants’ 1st SD).

¹⁰¹ For the years 2008 – 7 May 2010 (each year = calendar year and having regard to the **Relevant Date**) => $690\,000 + 870\,000 + [(700\,000 \times (4/12))] = 1,793,333 / 2.3 = 779,710$ (see [14] of the Applicants’ 1st SD).

¹⁰² See [18] of the Applicants’ 1st SD. Any period after the **Relevant Date** are excluded. As the **Relevant Date** was 7 May 2010, the calculation is: $870 + 2,800 + [2,500 \times (0.3)] = 4,420/2.3 = 1,921$.

¹⁰³ See [20] of the Applicants’ 1st SD. Events for the period 2010 – 2016 are excluded as they occurred after the **Relevant Date** (events which occurred in 2010 are also excluded as it is unclear if they occurred before the **Relevant Date** in 2010).

¹⁰⁴ See above computation.

- (i) while the quantum of the sales revenue would appear to exceed those of other cases at first blush, having regard to the price per unit, the quantity sold may not be comparable;
- (ii) the Applicants had been in the local market for 3 years only as at the *Relevant Date*; and
- (iii) the extent of promotional exposure is not as extensive in contrast to the other cases.

137 In light of all of the above, this element has not been made out. (For the avoidance of doubt, I make no finding as to whether the *Applicants' Earlier St Regis Mark* is well known to the public at large today, i.e. some eight years after the *Relevant Date*.) Thus, there is no need for me to look at the other limb of dilution.

138 The ground of opposition under Section 8(4)(b)(ii)(A) therefore fails.

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

139 The relevant provisions in the Act are:

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

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

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

8(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)

140 In relation to this ground, there are three elements to be established:

- (i) Goodwill;
- (ii) Misrepresentation; and
- (iii) Damage.

141 The law in relation to goodwill can be summarised as follows:

- (i) Goodwill is “the benefit and advantage of the good name, reputation, and connection of a business...the attractive force which brings in custom” (see *Muller*, above).
- (ii) The position in Singapore is still the “hardline” approach¹⁰⁵, albeit having been softened to include pre-trading activity (*Staywell Court of Appeal* at [136]).
- (iii) The Opponent must establish that they have acquired goodwill as at the *relevant date*, that is, the date on which the defendant's conduct complained of started. Applying this principle, it is the *Relevant Date* in this instance (*Law of Intellectual Property of Singapore (Sweet & Maxwell, 2014 Rev Ed)* by Professor Ng-Loy Wee Loon (“*Law of Intellectual Property of Singapore*”) at [17.2.5]).
- (iv) Goodwill, in the context of passing off, is concerned with goodwill in the *business as a whole*, and not specifically in its constituent elements. The issue of *whether a mark or get-up is distinctive* of a plaintiff's products or services is a question best dealt with in the context of the inquiry as to whether the defendant has made a misrepresentation (*Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading* [2016] 4 SLR 86 (“*Singsung*”)).
- (v) Evidence of sales and income of the business are a “proxy for the attractive force of the business” (*Singsung* at [58]).
- (vi) The “get up” can include various aspects of the business, *including* a mark (*Law of Intellectual Property of Singapore* at [17.2.10] – [17.2.11]).
- (vii) Section 8(7)(a) at the very least requires an opponent to adduce sufficient evidence to establish a *prima facie* case on goodwill, misrepresentation, and damage (*Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] SGHC 216 at [164]).

142 In *Staywell Court of Appeal*, the Court of Appeal found that “[t]he evidence of advertising activity adduced by the Opponents was insufficient to warrant a finding that there was an attractive force that would bring custom to the ST. REGIS Singapore as at the date Staywell applied to register the Applicant Mark” (see headnote (13) of *Staywell Court of Appeal*). However, time has elapsed since then¹⁰⁶ and the issue is whether there is relevant goodwill as at the *Relevant Date*.

¹⁰⁵ See [132] *Staywell Court of Appeal*:

...[t]he traditional position is that for goodwill to exist, it is essential for the trader to have carried on his trade within the jurisdiction... This has become known as the “hard-line” school of thought.

¹⁰⁶ While the decision was issued on 29 November 2013, the relevant date then was 3 March 2008 (date of application of the *Previous Park Regis Mark*).

143 As alluded to above, the Applicants’ average sales revenue is *SGD 23.3 million annually for a period of 3 years*. I am of the view that Applicants have the relevant goodwill in Singapore.



Misrepresentation

144 In relation to this element, the Court of Appeal in *Sarika* held that:

(20) ...The test for the “connection” requirement was similar in substance to the test for the misrepresentation requirement in passing off, and the findings for the misrepresentation requirement were in turn based on the finding of a likelihood of confusion under s 27(2)(b)...

Thus for largely the same reasons that I have found that the element of “confusing connection” and “the likelihood of confusion” has been made out respectively under Sections 8(4)(b)(i) and 8(2)(b), I am of the view that misrepresentation has been made out here as well.

145 Further, as alluded to above, in an action for passing off, it is permissible for the Applicants to rely on their *get-up* (which includes the *Applicants’ Earlier St Regis Mark*). For ease of reference, the indicia as sought to be registered / used by the Applicants are as follows:

<i>Subject Mark</i>	<i>Applicants’ Indicia</i>
	ST. REGIS
	瑞吉
	
	ST REGIS


146 With regard , *Staywell High Court* commented at [28]:

[28] ...Further, the device used by the St. Regis Hotel group is designed to look like a crest, with similarly elaborate lettering *reminiscent of royal opulence*...

[Emphasis in italics mine]

In this regard, the Court of Appeal in *Staywell Court of Appeal* disagreed with the *inclusion*



of  at the stage of marks-similarity assessment but *not* with the inference drawn from the same¹⁰⁷ (see [36] *Staywell Court of Appeal*).

147 In light of the above, having regard to the degree of similarity of the indicia and the proximity of the fields of trade (see *Amanresorts* at [84]), I am of the view that, on a balance of probabilities, there is a likelihood of misrepresentation that the Applicants and the Proprietor are economically linked.

Damage

148 In relation to this element, the test is either “*actual or probable damage*” to the plaintiff’s goodwill ([94] *Amanresorts*).

149 As alluded to above, it has been held by the Court of Appeal in *Amanresorts* “that the tests to be adopted for the purposes of ...the “likely to damage the [plaintiff’s] interests” requirement in s 55(3)(a) of the current [Act] would yield the *same results* as those obtained from applying the corresponding tests *vis-à-vis* the Respondents’ claim for passing off” (see [234] *Amanresorts*).

150 Therefore, for largely the same reasons for the same element under section 8(4)(b)(i), I am of the view that this element has been made out.

151 One last comment before I conclude the matter. The Proprietor argued that the Applicants have not suffered any damage as “[t]here is...no evidence that the Applicants are likely to suffer any financial loss” ([146] PWS1). The Court of Appeal in *Amanresorts* has already determined that (see [117] and [118]):

[117] We accept the principle that a plaintiff who has established goodwill in one form of commercial activity (“the established activity”) may be entitled to protection from passing off *vis-à-vis* another form of commercial activity which is a natural expansion of the first (“the extended activity”)...

[118] It is, however, important to stress the close connection which must exist between the established activity and the extended activity for that connection forms the foundation for this head of damage...

Thus, regardless of the growth of the Applicants’ revenue, the Applicants can claim an obstruction of expansion into the 4-star range of hotels as a form of damage.

Conclusion

152 The ground of opposition under Section 8(7)(a) therefore succeeds.

¹⁰⁷ In both instances in the context of the analysis of conceptual similarity.

Conclusion

153 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the invalidation succeeds on Sections 8(2)(b), 8(4)(b)(i) and 8(7)(a) (in accordance with Section 23(10) of the Act, the registration is deemed never to have been made, although this shall not affect transactions past and closed) but fails on Sections 7(6) and 8(4)(b)(ii)(A). The Applicants are entitled to costs to be taxed, if not agreed.

Date of Issue: 17 July 2018