

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

Trade Mark No. T1205572A
Hearing Date: 7 August 2018

IN THE MATTER OF A TRADE MARK APPLICATION BY

NEW YORKER S.H.K. JEANS GMBH & CO. KG

AND

OPPOSITION THERETO BY

DAIDOH LIMITED

Hearing Officer: Ong Sheng Li, Gabriel
Principal Assistant Registrar of Trade Marks

Representation:

Ms Francine Tan (Francine Tan Law Corporation) for the Opponent

Mr William Ong and Ms Amanda Soon (Allen & Gledhill LLP) with Ms Dhiviya Mohan (Marks & Clerk Singapore LLP) for the Applicant

GROUND OF DECISION

Introduction

1 There is something about New York that ignites the popular imagination. Frank Sinatra famously sang of wanting to “*wake up in [New York] a city that never sleeps*”; where “*if I can make it there, I can make it anywhere*”.¹ Playing on those words, Jay-Z rapped that “*I’m the*

¹ “Theme from New York, New York” (1980), produced by Sonny Burke, songwriters: Fred Ebb and John Kander.

new Sinatra, and since I made it here, I can make it anywhere, yeah they love me everywhere".² And who could forget Alicia Keys' refrain in that same song (with Jay-Z), Empire State of Mind: "*New York, concrete jungle where dreams are made of*", where "*There's nothing you can't do / Now you're in New York*"? Two songs, almost thirty years apart, with one core message: New York is a place where dreams can become reality.

2 It is perhaps unsurprising, then, that New York—or at least the idea of it—has found its way across oceans and seas, to places and things far removed from the Big Apple.³ The present case exemplifies this: Here is a tussle between two traders in the fashion industry, neither of which are from New York, over trade marks (or more precisely: trade mark rights) in Singapore that comprise the word "NEWYORKER".

Background to the dispute

3 The incumbent, Daidoh Limited ("Opponent"), is a fashion/clothing company from Japan and the registered proprietor, in Singapore, of the trade mark **NEWYORKER** (T0720728D) in Class 25 ("Prior Mark") for, among other things, clothing, headgear and footwear.⁴ The relative newcomer, New Yorker S.H.K. Jeans GmbH & Co. KG ("Applicant"), is a fashion/clothing company headquartered in Germany.

4 On 7 September 2011, the Applicant sought to register the trade mark **NEWYORKER** (T1205572A) in Class 35 ("Application Mark") in Singapore for a wide variety of services, including retail services with regard to clothing. (The full list is set out at [11] below.) The Opponent filed this present opposition to it. In response, the Applicant commenced separate proceedings against the Prior Mark wherein it sought the revocation of the Prior Mark for "non-use". The Applicant also requested that the order for revocation, should one be made, take effect from a date *earlier than* the Application Mark ("the Backdating Request"). This was a tactical manoeuvre intended to, among other things, eliminate the Prior Mark from these opposition proceedings.

5 About a year ago, I heard the "non-use" revocation dispute and thereafter issued a decision: see *New Yorker S.H.K. Jeans GmbH & Co. KG v Daidoh Limited* [2017] SGIPOS 16 ("*NewYorker (No. 1)*"). In summary, I found that the Prior Mark had been put to genuine use in relation to most, but not all, of the goods in respect of which it was registered. However, I declined to grant the Applicant's Backdating Request since the date it was seeking fell within the first 5 years from the date of the completion of the Prior Mark's registration procedure and in my judgment the Registrar has no power to make such an order. After consideration, I made

² "Empire State of Mind" (2009) produced by Al Shux, songwriters: Alicia Keys, A. Hunte, A. Shuckburgh, B. Keyes, J. Sewell-Ulepic, S. Carter, and S. Robinson.

³ The Big Apple is one of the more popular nicknames for New York City.

⁴ The Prior Mark was registered in Class 25 in respect of the following goods: "*Clothing; hats; neckties; shawls; underwear; socks; belts (clothing); boots; shoes; sandals; gloves (clothing); scarves; caps (headwear); garters; sock suspenders; braces for clothing (suspenders); bands (for wear); sweat bands for the head; sweat bands for the wrist; costumes (masquerade); sports clothes (other than golf gloves); shoes and boots for sports; suits; jackets; shirts; knitwear (clothing); clothing of knitted textiles; pants; skirts; coats; dresses; vests; blouses; sweaters; trousers; outerclothing; bathing drawers; bathing suits; breeches (for wear); top coats; collar protectors; combinations (clothing); cuffs; footwear; fur (clothing); gabardines (clothing); dressing gowns; half-boots; headgear for wear; hoods (clothing); hosiery; stuff jackets (clothing); jumpers (shirt fronts); muffs (clothing); overcoats; overalls; pajamas; parkas; pullovers; ready-made clothing; slippers; spats; waistcoats*"

an order for partial revocation effective as of the earliest possible date: 3 January 2014.⁵ (A detailed summary can be found at paragraphs [5] – [7] of the *NewYorker (No.1)* decision.)

6 It is trite law that the parties’ rights in opposition proceedings are assessed as at the date of the trade mark application (7 September 2011). And at that date, the full specification of goods protected under the Prior Mark (as originally filed for) was valid and subsisting. Put simply, what this means (and this was undisputed by the parties) is that the order for partial revocation in *NewYorker (No. 1)* has *no impact* on the comparison of goods and services in the present opposition proceedings.

The Evidence

7 The following Statutory Declarations (“SD(s)”) were tendered in evidence.

- a. SD of Mr Fumitaka Saito dated 2 June 2015. Mr Saito was the Opponent’s Senior Executive Officer, General Manager, Management Planning Office.
- b. SD of Mr Friedrich Knapp dated 31 January 2018. Mr Knapp was the Applicant’s Chief Executive Officer. The reason for the delay between Mr Saito’s SD and Mr Knapp’s SD is that these proceedings were held in abeyance pending the outcome of the “non-use” revocation proceedings in *NewYorker (No. 1)*.
- c. SD in Reply of Mr Saito dated 2 May 2018. By this time, Mr Saito was the Director, Executive Officer, of the Opponent.

There was no cross-examination. Thus the SDs formed the whole of the evidence in this case.

Grounds and Scope of Opposition

8 When the Notice of Opposition was originally filed, three grounds of opposition were pleaded: Sections 8(2)(a), 8(2)(b) and 8(4)(b)(i) of the Trade Marks Act (Cap. 332, Rev Ed. 2005) (“TMA”).

9 After all of the evidence was filed, the Opponent did the following.

10 First, it informed the Registrar that it would not be pursuing the Section 8(4)(b)(i) TMA ground of opposition. Instead, it would only be proceeding on the first two grounds of opposition (*viz.* Section 8(2)(a) and 8(2)(b) TMA).

11 Second, it offered to withdraw the opposition in respect of certain services under the Application Mark in Class 35, while maintaining the opposition to the rest of them. Specifically, the Opponent offered to withdraw its opposition to the following:

“Retail services with regard to bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, and dentrifrices; retail services in relation to scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and

⁵ The order for partial revocation was made in respect of the following goods only: “*boots; shoes; sandals; shoes and boots for sports; footwear; half-boots; slippers; spats; costumes (masquerade)*”.

teaching apparatus and instruments, electric apparatus and instruments, apparatus for recording, transmission or reproduction of sound or images, automatic vending machines and mechanisms for coin-operated apparatus, cash registers, calculating machines.” (The “Uncontested Services”.)

At the same time, it was proposed that the opposition be maintained in relation to the following:

“Advertisement; business management; business administration; office functions; sales promotion; retail services with regard to soaps, perfumery, toilet waters of all kinds, particularly perfume, eau de perfume, eau de toilette, deodorants for personal use, essential oils, products for beauty and body care, hair lotions, hair cleaning and hair caring substances, cosmetics, creams for the skin, lotions for cosmetic purposes, shaving substances and substances for after-shave care, cosmetic bathing additives, lipsticks, cotton buds for cosmetic purposes, nail polish, shoe polish, make-up; retail services in relation to spectacles and parts therefor, in particular sunglasses, sports goggles, ski goggles, protective goggles, spectacle frames, spectacle lenses, spectacle cases, protective helmets, helmet visors, protective face shields for protective helmets, protective equipment for athletes, in particular elbow and knee pads, wrist and ankle guards, body protection articles, protective gloves; retail services in relation to precious metals and their alloys and goods in precious metals or coated therewith, jewellery, costume jewellery, precious stones, horological and chronometric instruments, watch bands; retail services with regard to leather and imitations of leather, and goods made of these materials, animal skins, hides, trunks, attaché cases and travelling bags, bags, sports bags, handbags, school satchels, rucksacks, travelling sets (leatherware), small leather goods, purses, pocket wallets, key wallets, belt bags and waist bags, umbrellas, parasols and walking sticks, whips, harness and saddlery; retail services with regard to clothing, footwear, headgear, outerwear for gentlemen and ladies, children's fashion, clothing for babies, underwear, undergarments, corsetry, hosiery, belts, suspenders, scarves, gloves, ties, headbands, swimwear for gentlemen and ladies, clothing for hiking, trekking, outdoor sports and climbing, leisure and city shoes for gentlemen and ladies, children's shoes, shoes for hiking, trekking, outdoor sports and climbing, clothing, footwear and headgear for soccer, basketball, handball and volleyball, clothing, footwear and headgear for jogging, fitness training and gymnastics, clothing, footwear and headgear for tennis, squash and badminton, clothing, footwear and headgear for inline skating, skateboarding, roller skating and hockey, football, baseball and boxing, clothing, footwear and headgear for cycling, clothing, footwear and headgear for equestrian sports, clothing, footwear and headgear for golf, clothing, footwear and headgear for water sports, clothing, footwear and headgear for surfing, sailing, rowing, canoeing and diving, clothing, footwear and headgear for alpine skiing, cross-country skiing and snowboarding, clothing, footwear and headgear for ice skating and for ice hockey; retail services with regard to games and playthings, gymnastic and sporting articles, and parts therefor, particularly sporting articles for trekking, climbing, football, basketball, handball, volleyball, tennis, squash, badminton, hockey, football, baseball, cycling, riding, golf, surfing, sailing, rowing, canoeing, diving, alpine skiing, cross-country skiing and for snowboarding, ice skating and ice hockey, for fitness training, inline skating, roller skating and skateboarding, and in relation to ski bags, special bags for storing and transporting sports equipment, particularly bags for skis, snowboards, skateboards, ski boots, roller skates, ice skates and inline skates.” (The “Contested Services”.)

For the avoidance of doubt, the Contested Services and the Uncontested Services collectively constitute the entire specification of services in Class 35 under the Application Mark.

12 The Opponent’s abandonment of the Section 8(4)(b)(i) TMA ground was relatively uncontroversial. It is not uncommon for an initiating party to abandon a ground, especially after viewing the evidence in totality. And, in certain instances, the early abandonment of an unsustainable ground can be welcome news to the defending party because it does not have to expend time and costs to address it in its written submissions only to find out at the hearing itself that the ground is no longer being pursued by the initiator.

13 However, the proposal to withdraw the opposition in respect of some—but not all—of the services under the Application Mark was not a straightforward one, and so I convened a case management conference (“CMC”).

- a. During the CMC, the key issue discussed was whether the proposed withdrawal of the opposition in respect of the Uncontested Services would have the unintended side effect of creating, in substance (although perhaps not in form), a partial opposition? (The issue of whether partial trade mark oppositions are possible under the TMA is a thorny one: see *Monster Energy Company v Tencent Holdings Limited* [2018] SGIPOS 9 at [78] – [91].^{6 7 8})
- b. It was common ground that the key issue could not be addressed by way of division of the trade mark application to hive off the Uncontested Services. The application for the Application Mark is an international registration designating Singapore and such applications currently cannot be divided: see Rule 5A of the Trade Marks (International Registration) Rules (Cap. 332, R 3), which excludes the operation of Rule 17 of the Trade Marks Rules (Cap. 332, R 1).

The Opponent was given time after the CMC to consider, having regard to the issues described above, how it intended to proceed. (The Applicant did not offer to amend its specification of services to delete the Contested Services.)

14 Afterwards, the Opponent indicated that it would *not* be making a formal request to withdraw its opposition to the Uncontested Services. Instead, it would be taking the position that the Uncontested Services should be treated as being dissimilar to the goods covered in the Prior Mark. This meant that the parties’ arguments should be confined to dealing with the Contested Services only. As this appeared to be a time and cost effective way of narrowing the issues in dispute (one, I might add, more practitioners would do well to consider in an appropriate case), and since the Applicant had no objections, I endorsed it by way of direction.

MAIN DECISION

15 Section 8(2) TMA provides as follows:

⁶ The decision was issued after the said CMC, so the parties did not have an opportunity to comment on it.

⁷ *Monster Energy Company* (“MEC”) filed an appeal against the decision, which is presently scheduled to be heard in November 2018. Nevertheless, since I agreed with MEC on the issue of partial oppositions, it is not clear whether the point will be taken up in argument.

⁸ My observations and views are set out in [78] – [91] of that decision.

“8.

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

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

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

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

16 In *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc.* [2014] 1 SLR 911 (“*Staywell*”), the Court of Appeal held, in the context of Section 8(2)(b), that the provision requires a 3 step test: First, are the competing marks similar? Second, are the goods (or services) identical or similar? Third, is there a likelihood of confusion arising from (that is to say: *because of*) the foregoing?

17 Section 8(2)(a) differs from 8(2)(b) TMA in only two material aspects. One: the former is concerned solely with identical trade marks (and not similar trade marks). Two: the former only deals with situations where the goods or services are similar (but not identical).⁹ Notwithstanding these differences, both paragraphs are structured in the same way. Therefore, it must logically follow that the three step test set out in *Staywell* applies, with the appropriate modifications, to Section 8(2)(a) TMA as well.¹⁰

Opposition under Section 8(2)(a) TMA

18 Under the first step, the question is this: are the competing marks *identical*?

Whether the marks are identical?

The law

19 In *SA Société LTJ Diffusion v Sadas Vertbaudet SA* [2003] FSR 34 (“*LTJ Diffusion*”), the European Court of Justice (ECJ)¹¹ was asked to provide a preliminary ruling on the interpretation of Art. 5(1)(a) of the First Council Directive 89/104/EEC of 21 December 1988 (which is *in pari materia* with our double-identity *infringement* provision, Section 27(1) TMA). More specifically, the ECJ had to rule on what it means for trade marks to be considered “identical”. The ECJ held, in material part, as follows:

“[50] The criterion of identity of the sign and the trade mark must be interpreted strictly. The very definition of identity implies that the two elements compared should be the same in all respects [...]

⁹ Cases of “double-identity” (that is: where the marks are identical and the goods or services are identical) fall within Section 8(1) TMA and do not require the third “likelihood of confusion” step to be established. In this case, Section 8(1) TMA was rightly not pleaded since the goods and services are clearly not identical.

¹⁰ One might also observe that whether this tribunal finds the marks to be identical or similar is somewhat academic in the sense that likelihood of confusion is required in any event.

¹¹ Now known as the Court of Justice of the European Union.

[51] There is therefore identity between the sign and the trade mark where the former reproduces, without any modification or addition, all the elements constituting the latter.

[52] However, the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect. The sign produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind. Moreover, his level of attention is likely to vary according to the category of goods or services in question [...]

[53] Since the perception of identity between the sign and the trade mark is not the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between the sign and the trade mark may go unnoticed by an average consumer.

[54] In those circumstances, the answer to the question referred must be that [...] a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

20 *LTJ Diffusion* has been cited with approval in a number of local decisions including *Nation Fittings (M) Sdn Bhd v Oystertec plc and anor* [2006] 1 SLR(R) 712 (see [78] – [86]) and *Mitac International Corp v Singapore Telecommunications Ltd and another action* [2009] 4 SLR(R) 961 (“*Mitac*”) (see [92] – [96]). It is undisputed that the principles set out in these cases concerning the test for trade mark identity are applicable to Section 8(2)(a) TMA as well.

Application to the facts

21 It is trite law that the competing marks ought not to be judged in a side-by-side comparison. While I have not lost sight of that principle, I think that it is convenient to reproduce them alongside each other in this decision for illustrative purposes.

Prior Mark



Application Mark



22 It is common ground between the parties that the marks are *aurally identical*. (There can only be identity of trade marks if there is both aural and visual identity: *Mitac* at [95] citing *Reed Executive plc v Reed Business Information Ltd* [2004] RPC 40.) The Applicant also conceded that the marks are *conceptually identical*.

23 Therefore, the only outstanding sub-issue is whether the marks are *visually identical*.

24 The main thrust of the Applicant’s case on the visual aspect is that the font, shape and stylistic differences between the respective marks in this case are obvious and cannot be

considered so insignificant that they may go unnoticed by the average consumer. In its submission, the marks cannot be said to be identical on account of these visual differences.

25 As for the Opponent, while it accepts that there are visual differences between the two marks, its case is that they are not sufficient to distinguish and do not possess trade mark significance. Rather, they are so insignificant that the average consumer, who is assumed to have imperfect recollection, and who does not have the benefit of a direct comparison of all of the characteristics of the elements compared, would not notice and/or remember the differences. Consequently, in its submission, the marks are visually identical.

26 It is undeniable that visual differences exist as between the competing marks. But, in my judgment, they are so minor and insignificant that one would need to scrutinise the marks side-by-side in order to be able to tell how they differ. It is only when one engages in a side-by-side analysis (which case law holds to be impermissible) that one would notice the following slight cosmetic differences.

- a. One: the Prior Mark, “NEWYORKER” appears in serif typeface, whereas in the Application Mark it appears in sans-serif. (In typography, a serif is a small line attached to the end of a stroke. An example of a serif typeface is Times New Roman. Sans-serif, as the name suggests, is a typeface without that small line. An example of a san-serif typeface is Arial font.)
- b. Two: in the Prior Mark, the font appears to be thinner in size in comparison to the thicker font employed in the Application Mark.
- c. Three: the letters in the Application Mark are stylised in such a way as to create the impression of being represented in three-dimensions, whereas the letters in the Prior Mark all appear to be on the same level plane (except, perhaps, for the first stroke on the letter “N” and the tail on the last “R”).

27 Put another way, there is nothing distinctive (in all senses of the word: see *Staywell* at [23] – [24]) about the visual differences between the marks. They would not stand out in the average consumers’ imperfect recollection. And average consumers would surely not consider the presence or absence of typeface serifs, the width of the font, or slight variations in font shape, as being “trademark-y” in nature (*i.e.* as a guarantee, or badge, of origin).

28 My findings are consistent with case law, which does not require that every jot or tittle of the marks be identical in every respect. The following case, which the Opponent helpfully drew to my attention, is instructive. *In the Matter of Application No. 2217085 by Apple Computer, Inc. to Register a Trade Mark in Class 9 and In the Matter of Opposition thereto under No. 52694 thereto by TKS-Teknosoft SA* (Case No. O-160-03) (“*QUARTZ*”) was a trade mark opposition before the UK Intellectual Property Office. There, the trade mark applicant had sought to register *QUARTZ* in plain block capital letters. The mark upon which the opponent placed primary reliance was **QUARTZ**. On the issue of whether the marks are identical, the Hearing Officer, Mr Allan James, had this to say:

“[16] [...] There is some underlining of the last five letters, but in my view, this is insignificant. The only other modification is the replacement of the crossbar of the letter A with a downward pointing triangle. Even with this modification, the letter will be clearly seen as a letter A, and I have no doubt that both marks would clearly be seen as

the word QUARTZ. Visually, the differences between the marks are wholly insignificant. Their presence or absence would, I believe, be easily overlooked by an average consumer of the goods and services in question. Conceptually and aurally, the marks are identical. I therefore find that the mark applied for is identical to that of the opponent.”

29 If anything, the font and stylisation differences in this case play an even less significant role than in *QUARTZ*. Moreover, as the Opponent rightly pointed out, the overall impression of visual identity between the two marks is reinforced by two factors. First, both marks contain a protruding/prominent letter “Y”. And second, both marks appear in upper-case block letters. For these reasons, I consider the marks to be visually identical. And, since the Applicant does not dispute the fact that the marks are aurally and conceptually identical, I have no trouble finding that the marks are identical on the whole.

Whether the Goods are similar to the Contested Services?

30 Next, is the Application Mark sought to be registered for *services* (here: in Class 35) which are similar to the *goods* for which the Prior Mark is protected (here: in Class 25)?

The law

31 Under the present *Nice* trade mark classification system, there are 34 classes of goods and 11 classes of services. Logic dictates that since goods are goods and services are services, a good in any given class cannot—by nature—be identical to a service in any given class.

32 However, it does not follow that goods can never be similar to services (or *vice-versa*). There is authority for the proposition that goods and services can, in certain circumstances, be regarded as similar to each other. In *Guccio Gucci S.p.A. v Guccitech Industries (Private Ltd)* [2018] SGIPOS 1 (“*Guccitech*”), the learned Professor David Llewelyn (sitting as IP Adjudicator) held (at [35]) as follows:

“As far as the specification of services in T1319783Z is concerned, the Opponent cites Tan, *Law of Trade Marks and Passing Off in Singapore* (3rd ed, 2014) at [8.115] that:

“goods and services can also be regarded as similar to each other. This will, for instance, be the case where the earlier mark is registered for retail services of certain goods and the mark applied for is registered for those goods as such, and vice versa”.

I would respectfully agree with the general view expressed by the learned author Mr Tan Tee Jim SC, although I consider that the example given is the only circumstance where goods could be found to be similar to the retail services in a specification (it cannot be the case that a general retail services specification that does not refer to any particular goods must be regarded as similar to any goods that may be sold in a retail outlet.)”

33 The above statements of principle find support¹² in a remark that Jacob J (as he then was) made, *obiter*, in *British Sugar Plc v James Robertson & Sons Ltd.* [1996] RPC 281 at 297:

“... I do not see any reason in principle why, in some cases, goods should not be similar to services (a service of repair might well be similar to the goods repaired, for instance).”

34 During the hearing, I asked counsel for the Applicant, Mr William Ong, whether he was aware of any authorities that stood for a contrary position. Mr Ong conceded that they were unable to locate any. That being the case, all that remains is for me to conduct the analysis having regard to the applicable principles and the IP Adjudicator’s qualification in *Guccitech*, which I respectfully agree with.

Application to the facts

35 The second step of the three step test can be satisfied by showing that at least one of the goods under the Prior Mark is similar to at least one of the Contested Services under the Application Mark. There is no need to establish that all of the respective goods and services are similar. It is useful to begin by considering the relevant goods and services alongside each other. (The Opponent accepts that the Uncontested Services are dissimilar to the goods protected under the Prior Mark: see [14] above.)

| Prior Mark (Class 25) Specification of Goods | The Application Mark (Class 35) Specification of “Contested Services” |
|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <p>“Clothing; hats; neckties; shawls; underwear; socks; belts (clothing); boots; shoes; sandals; gloves (clothing); scarves; caps (headwear); garters; sock suspenders; braces for clothing (suspenders); bands (for wear); sweat bands for the head; sweat bands for the wrist; costumes (masquerade); sports clothes (other than golf gloves); shoes and boots for sports; suits; jackets; shirts; knitwear (clothing); clothing of knitted textiles; pants; skirts; coats; dresses; vests; blouses; sweaters; trousers; outerclothing; bathing drawers; bathing suits; breeches (for wear); top coats; collar protectors; combinations (clothing); cuffs; footwear; fur (clothing); gabardines (clothing); dressing gowns; half-boots; headgear for wear; hoods (clothing); hosiery; stuff jackets (clothing); jumpers (shirt fronts); muffs (clothing); overcoats; overalls; pajamas; parkas; pullovers; ready-made clothing; slippers; spats; waistcoats”</p> | <p>“Advertisement; business management; business administration; office functions; sales promotion; retail services with regard to soaps, perfumery, toilet waters of all kinds, particularly perfume, eau de perfume, eau de toilette, deodorants for personal use, essential oils, products for beauty and body care, hair lotions, hair cleaning and hair caring substances, cosmetics, creams for the skin, lotions for cosmetic purposes, shaving substances and substances for after-shave care, cosmetic bathing additives, lipsticks, cotton buds for cosmetic purposes, nail polish, shoe polish, make-up; retail services in relation to spectacles and parts therefor, in particular sunglasses, sports goggles, ski goggles, protective goggles, spectacle frames, spectacle lenses, spectacle cases, protective helmets, helmet visors, protective face shields for protective helmets, protective equipment for athletes, in particular elbow and knee pads, wrist and ankle guards, body protection articles, protective gloves; retail services in relation to precious metals and their alloys and goods in precious metals or coated therewith, jewellery, costume jewellery, precious stones, horological and chronometric instruments, watch bands; retail services with regard to leather and imitations of leather, and goods made of these materials, animal skins, hides, trunks, attaché cases and travelling bags, bags, sports bags, handbags, school satchels, rucksacks, travelling sets (leatherware), small leather goods, purses, pocket wallets, key wallets, belt bags and waist bags, umbrellas, parasols and walking sticks, whips, harness and saddlery; <i>retail services with regard to clothing, footwear, headgear, outerwear for gentlemen and ladies, children's fashion, clothing for babies, underwear, undergarments, corsetry, hosiery, belts, suspenders, scarves, gloves, ties, headbands, swimwear for gentlemen and ladies,</i></p> |

¹² See Tan Tee Jim SC, *Law of Trade Marks and Passing Off in Singapore* (3rd Ed., 2014) at [8.114] and in particular footnote 192 thereto.

| | |
|--|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| | <p><i>clothing for hiking, trekking, outdoor sports and climbing, leisure and city shoes for gentlemen and ladies, children's shoes, shoes for hiking, trekking, outdoor sports and climbing, clothing, footwear and headgear for soccer, basketball, handball and volleyball, clothing, footwear and headgear for jogging, fitness training and gymnastics, clothing, footwear and headgear for tennis, squash and badminton, clothing, footwear and headgear for inline skating, skateboarding, roller skating and hockey, football, baseball and boxing, clothing, footwear and headgear for cycling, clothing, footwear and headgear for equestrian sports, clothing, footwear and headgear for golf, clothing, footwear and headgear for water sports, clothing, footwear and headgear for surfing, sailing, rowing, canoeing and diving, clothing, footwear and headgear for alpine skiing, cross-country skiing and snowboarding, clothing, footwear and headgear for ice skating and for ice hockey; retail services with regard to games and playthings, gymnastic and sporting articles, and parts therefor, particularly sporting articles for trekking, climbing, football, basketball, handball, volleyball, tennis, squash, badminton, hockey, football, baseball, cycling, riding, golf, surfing, sailing, rowing, canoeing, diving, alpine skiing, cross-country skiing and for snowboarding, ice skating and ice hockey, for fitness training, inline skating, roller skating and skateboarding, and in relation to ski bags, special bags for storing and transporting sports equipment, particularly bags for skis, snowboards, skateboards, ski boots, roller skates, ice skates and inline skates.”</i></p> <p>(Note: emphasis in <i>italics</i> mine.)</p> |
|--|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|

36 In advancing a case of similarity, the Opponent systematically broke down the lengthy list of Contested Services into several categories and presented arguments in relation to each with a view to showing why they are similar to various goods under the Prior Mark. During the hearing, however, counsel for the Opponent, Ms Francine Tan, acknowledged that its strongest case is in relation to the category of services which I have emphasised in italics above. Ms Tan made the point in the following, rather impactful, way: the *service* of retailing clothing, footwear, and headgear *cannot exist* without the relevant *goods*. Thus, in her submission, it should follow that they are similar.

37 In response, the Applicant—which naturally contended that the goods and services are dissimilar—aligned its arguments along the so-called *British Sugar* factors or guidelines which have been applied or looked to in a number of local decisions (see e.g. *Staywell* at [43]; *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 (“*Hai Tong*”) at [92]). As I understood it, the essence of its case is that retail services are distinguishable from goods that clothe the body in various ways, including the following: they have different uses; they are of a different physical nature (one tangible, the other intangible); they reach the public through different channels and in different ways; and they are not competitive in nature.

38 I do not propose to deal with all of the submissions advanced on both sides. It is preferable to focus instead on the category of services in italics in the table at [35] above.¹³ There can be no doubt, to my mind, that the italicised services are similar to at least some of

¹³ Different categories of services (or goods) are separated by semicolons, whereas commas are used as qualifiers to separate different items within the same category of services (or goods) which are related to each other. (See IPOS Trade Marks Work Manual, Chapter 18, Version 6 (August 2018), at p 13.) Here, all of the italicised items relate to the same category of services: retail services.

the goods covered under the Prior Mark. Take for example the good “Clothing” and the service “retail services with regard to clothing”. Or “boots; shoes; sandals” on the one hand and “retail services with regard to” “footwear” on the other. The common thread between these two instances is that one is the *good itself* whereas the other is the *service of providing the specific good*. This is the very situation envisaged by the authorities where goods and services can be considered to be similar for the purposes of the provision: see [32] – [33] above). (These examples are by no means exhaustive, and many other points of similarity between the italicised services and the relevant goods can be identified though this same lens.)

39 Consequently, I have no difficulty reaching the conclusion that the requirement of similarity of goods and services has been established. Just because I have not spelt out my analysis by reference to the so-called *British Sugar* factors in the usual way (that is, by comparing the respective uses, users, and so on) does not mean that I have fallen into error. There are numerous decisions which have confirmed that these factors or guidelines are not rigid rules of law. And, lest it be forgotten, the judge who formulated those factors opined in that very same case that goods and services might, in appropriate cases, be similar to each other. When all is said and done, the point is this: If “a service of repair might well be similar to the goods repaired” (*British Sugar* at 297), surely it must follow that the *service of retailing a specific good* ought to be similar to the *good itself*.

40 It is not necessary for me to make any findings as to whether the other items in the specification of services in Class 35 are dissimilar to the goods in Class 25 in order to dispose of these proceedings, and I would refrain from further comment.

Whether there exists a likelihood of confusion?

41 Finally, is there a likelihood of confusion?

The law

42 In *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 (“*Caesarstone*”) the Court of Appeal summarised the law on this third step as follows:

“[56] The likelihood of confusion inquiry directs the court to look at (a) how similar the marks are; (b) how similar the goods or services are; and (c) given this, how likely it is that the relevant segment of the public will be confused (*Staywell* ([26] *supra*) at [55]). In opposition proceedings, the inquiry takes into account the actual and notional fair uses of both the existing and the application mark (*Staywell* at [60]). The factors which are admissible in the confusion inquiry include:

(a) *factors relating to the impact of marks-similarity on consumer perception*: (i) the degree of similarity of the marks themselves; (ii) the reputation of the marks; (iii) the impression given by the marks; and (iv) the possibility of imperfect recollection of the marks (*Staywell* at [96(a)]); and

(b) *factors relating to the impact of goods-similarity on consumer perception*: (i) the normal way in or the circumstances under which consumers would purchase goods of that type; (ii) whether the products are expensive or inexpensive items; (iii) 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; and (iv) the likely characteristics of the relevant consumers and whether they would or would not tend to apply care or have specialist knowledge in making the purchase (*Staywell* at [96(b)]).

[57] There are at least two specific aspects to the element of confusion. The first is mistaking one mark for another. The second is where the relevant segment of the public may well perceive that the contesting marks are different, but may yet remain confused as to the origin which each mark signifies and may perceive that goods bearing the two marks emanate from the same source or from sources that are economically linked or associated (*Hai Tong* ([27] *supra*) at [74]). Further, in *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 (“*Sarika*”), we held (at [57]) (following our earlier decision in *Mobil Petroleum Co, Inc v Hyundai Mobis* [2010] 1 SLR 512 (“*Mobil*”) at [77]–[82]) that the test to be adopted in determining likelihood of confusion is whether a substantial portion of the relevant public will be confused. Although in *Sarika* and *Mobil* we were concerned with other provisions of the TMA and the Trade Marks Act (Cap 332, 1999 Rev Ed), in our judgment, the same principle applies in the present case. In this regard, we also said in *Sarika* (at [57]) that:

... the essence of this requirement is that there must not be an insubstantial number of the relevant public being confused. This standard is above *de minimis* and must be appreciable, though it is not necessary to show that a majority of the public is confused. It is insufficient, however, if only a ‘single member’ of the relevant public is confused or if only a ‘very small and unobservant section’ is confused ...”

Application to the facts

(1) *Factors relating to the marks: identity of marks*

43 Given that the competing marks have been adjudged to be identical, it is superfluous to speak of the degree to which they are similar. (See also *Hai Tong* at [87] where the Court of Appeal stated—albeit in the context of identity of goods or services—that once an element is found to be identical, it ceases to be material to inquire whether it is similar, and consequently, the degree to and the ways in which it may be differentiated.) It would also stand to reason that most—if not all—of the usual factors relating to the impact of marks-similarity on consumer perception *either* do not come into play *or* would at best be neutral in the overall assessment.

44 In my judgment, perhaps the only relevant extraneous factor that falls to be considered under this segment is the impact of the identical marks on the consumers’ perception. If one begins with the trite premise that the greater the similarity between the marks, the greater the likelihood of confusion (see *Staywell* at [96(a)]), one must also accept the next logical step: where the marks are identical, the likelihood of confusion would be even greater still.

(2) *Factors relating to the marks: alleged reputation*

45 An attempt was made by the Applicant to argue that it has garnered a substantial reputation in the Application Mark on account of the fact that it has been used since 1971 in more than 40 countries. Due to this substantial reputation, or so the Applicant’s argument goes, consumers would be less likely to confuse the competing marks as they would easily recognise that the Application Mark belongs to the Applicant.

46 I would reject this argument. The Applicant might have over a thousand stores in over forty countries but none of them are (or were, at the relevant date) located in this country. Most of the Applicant's stores are located in Central and Eastern Europe. Outside of Europe, there are stores in a number of places including the United Arab Emirates. There is even one in West Nyack in the state of New York, USA, some distance away from the boroughs of New York City. However, there is no evidence to link any of these stores located abroad with consumers in Singapore, and so I decline to find that the Applicant enjoys reputation in this jurisdiction in connection with the Application Mark.

47 Further and in any event, a strong reputation does not necessarily equate to a higher likelihood of confusion, and could in fact have the contrary effect (see *Staywell* at [96(a)]). Even if the Applicant had been able to show evidence of substantial reputation, this may undermine its case. Why? Well, as I have found earlier, the marks are identical and this is a case involving a good (*e.g.* "clothing" under the Prior Mark) on the one hand and a corresponding service (*e.g.* "retail services with regard to clothing") on the other. It is common knowledge that shops often sell goods that bear the same trade mark as their retail store. Equally, it is not uncommon for manufacturers of clothing to branch out into clothing retail services. Given this, average consumers might well be likely to believe, upon encountering the Application Mark, that the Opponent has branched out into providing retail services for clothing. All of this supports, rather than militates against, a finding of likelihood of confusion.

(3) *Factors relating to the goods and services: permissible and impermissible factors*

48 It was argued by the Applicant that the following factors lead to a finding of no likelihood of confusion. First, the goods covered under the Opponent's Prior Mark are only available through the Opponent, whereas the services under the Application Mark are only provided by the Applicant through its stores. Second, the Opponent's clothing is branded with the Prior Mark whereas the clothing sold in the Applicant's stores bear other labels such as "FB SISTER", "AMISU" and "CENSORED" instead of "NEWYORKER". Third, the respective goods and services travel through entirely different trade channels. Fourth, the target markets of the services and the goods are dissimilar to the extent that the Opponent's brand is "[for men's wear] *particularly known for its business suits, made from high quality fabrics and tailoring*" and "[for women's wear] *associated with a high level of sophistication*" whereas the Applicant's clothing and apparel are casual and focused on affordable and trendy wear, focused on a younger demographic of society. (See Applicant's Written Submissions at [29] and [30].)

49 For the most part, these submissions were misguided. In *Staywell* the Court of Appeal made it crystal clear that differences such as the trader's marketing choices and steps taken by the trader to differentiate the goods are factors which are not relevant to the inquiry (see *Staywell* at [94] – [96]). It is also trite law that one must have regard to the notional fair uses of the marks in relation to the respective goods (as registered) and services (as applied for) and since "hotel services are hotel services", differences such as hotel star classifications should not be given such a high degree of significance. (See *Staywell* at [99] and [100].)

50 Given this, perhaps the only relevant factor to be considered out of those listed above is the third (which concerns the trade channels through which the respective goods and services reach consumers). But this does not assist the Applicant's case. No matter how one slices and dices "retail services with regard to clothing", and no matter how the service is actually

provided in the market, everything comes back to the fact that one is ultimately retailing the good (“clothing”) to the average consumer. Put simply: the trade channels are connected.

Overall assessment on likelihood of confusion

51 In my judgment, the Opponent is obviously right that if the Application Mark were allowed to proceed to registration, a substantial portion of the relevant public would likely be confused on account of the fact that the marks are identical and the similarity between the respective goods and services. I fail to see how it could be otherwise. There might be no evidence of actual confusion, but that is only to be expected since the Applicant has no “NEWYORKER” stores in this country.

52 I would therefore allow the opposition under Section 8(2)(a) TMA.

Opposition under Section 8(2)(b) TMA

53 Although my decision in respect of Section 8(2)(a) TMA is sufficient to dispose of this dispute (the Opponent needs only succeed on any one ground), in case I am wrong in my view that the marks are *identical*, I will touch on this ground of opposition very briefly as well.

54 To echo Mr Allan James’ words in *QUARTZ* (at [17]), even if I had come to the opposite view about the marks being identical, I would have found that the marks are as closely similar as it is possible to be without being identical.

55 I also consider the goods and services to be similar for the same reasons that I gave in the context of Section 8(2)(a) TMA.

56 And, I also find that the third requirement of likelihood of confusion to have been established. My reasoning on this third step under Section 8(2)(a) TMA applies here, with the appropriate modifications, as well.

57 Therefore, if I am wrong in my view that the marks are *identical*, I would have allowed the opposition under Section 8(2)(b) TMA for substantially the same reasons as those given in respect of Section 8(2)(a) TMA.

Conclusion

58 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I would allow the opposition under Section 8(2)(a) TMA or alternatively under Section 8(2)(b) TMA, with costs to the Opponent.

Coda

59 In *NewYorker (No. 1)*, I introduced the dispute with the following words:

“From time to time, the term “Pyrrhic victory” is used to describe the outcome of litigation. This dispute was Pyrrhic in the sense that a disproportionate amount of time and costs was expended by both sides for what, in essence, was a relatively straightforward case. But who was the victor? Perhaps it is too early to tell: After all,

the parties are embroiled in parallel trade mark opposition proceedings, and it remains to be seen how the result of this skirmish impacts on the larger war.”

It gives me no pleasure to observe, at the end of the proverbial day, that *NewYorker (No. 1)* was indeed a Pyrrhic war which had no genuine impact on the material issues arising in this opposition. And if *NewYorker (No. 1)* was straightforward, the issues in this dispute were—if anything—simpler still. If only the Applicant had been willing to delete the Contested Services from the specification of services, the dispute might have been resolved without the need for adjudication by this tribunal.

Date of Issue: 24 October 2018