

Ozone Community Corp v Advance Magazine Publishers Inc  
[2010] SGHC 16

**Case Number** : Originating Summons No 414 of 2009  
**Decision Date** : 15 January 2010  
**Tribunal/Court** : High Court  
**Coram** : Woo Bih Li J  
**Counsel Name(s)** : Gill Dedar Singh and Ruby Tham (Drew & Napier LLP) for the applicant; Dr Stanley Lai, Vignesh Vaerhn and Eunice Lim (Allen & Gledhill LLP) for the respondent.  
**Parties** : Ozone Community Corp — Advance Magazine Publishers Inc

*Trade Marks and Trade Names – Registration Criteria – Conflicts with earlier marks*

15 January 2010

**Woo Bih Li J:**

**Introduction**

1 This was an appeal by Ozone Community Corporation (“Ozone”), a company incorporated and existing under the laws of Japan, against the decision of the Principal Assistant Registrar of Trade Marks (the “PAR”) in *Advance Magazine Publishers Inc. v Ozone Community Corporation* [2009] SGIPOS 4. Ozone had applied to register the trade mark, “HYSTERIC GLAMOUR” (*ie*, a word mark), in Class 16 (Trade Mark Application No T02/03173J), in respect of the following goods (“Ozone’s goods”):

Paper and cardboard; industrial packaging containers of paper; towels of paper; table napkins of paper; hand towels of paper; handkerchiefs of paper; paper patterns; tailors’ chalk; table cloths of paper; blinds of paper; banners of paper; flags of paper; baggage tags; printed matter; paintings and calligraphic works; photographs, photograph stands; playing cards; stationery and study materials.

2 The application was opposed by Advance Magazine Publishers Inc. (“AMP”), a company incorporated and existing under the laws of New York, United States of America. AMP is the registered proprietor of the following prior marks in Singapore:

Registration No	Mark	Class	Specification of Goods/Services
T98/02808F	“GLAMOUR”	9	CD-ROMS; compact discs; prerecorded audio and video cassettes; electronic publications; computer software and optical apparatus and equipment
T95/08527E	“GLAMOUR”	16	Magazines, books and publications (“AMP’s goods”)

T00/13663B	"GLAMOUR"	35	Advertising and promotion services and information services relating thereto; business information services; all provided on-line from a computer database or a global communication network; compilation of advertisements for use as web pages on a global communication network; retail services in the fields of fashion, beauty, travel and architecture; retail store services in the fields of fashion, beauty, travel and architecture, available through computer communications, interactive television, satellite and wireless means
T00/13664J	"GLAMOUR"	41	Information relating to entertainment or education, provided on-line from a computer database or a global communications network; electronic games services provided by means of a global communications network; providing on-line electronic publications [not downloadable]; publication of electronic books and journals on-line; entertainment in the nature of an on-going television program in the field of fashion, beauty, travel and architectural information
T00/13665I	"GLAMOUR"	42	Computer rental; design, drawing and commissioned writing, all for compilation of web pages on a global communications network; information (only information under Class 42) provided on-line from a computer database or from a global communication network; creating and maintaining web sites; hosting the web sites of others; installation and maintenance of computer software; leasing access time to a computer database (other than by Internet service providers); providing fashion, beauty, architectural information distributed over television, satellite, wireless and global communications networks

3 Before the PAR, AMP based its opposition on the following grounds:

- (a) section 8(2)(b) of the Trade Marks Act (Cap 332, 1999 Rev Ed) ("TMA");
- (b) section 8(3) TMA; and

(c) section 8(4) TMA.

AMP's opposition under ss 8(3) and 8(4) TMA *failed* but its opposition *succeeded* under s 8(2)(b) TMA.

4 In allowing AMP's opposition to *succeed* under s 8(2)(b) TMA, the PAR found that there was a "likelihood of confusion" between Ozone's "HYSTERIC GLAMOUR" mark and AMP's "GLAMOUR" mark in Class 16 covering "Magazines, books and publications" (*ie*, the second entry in the table at [\[2\]](#) above), see [79] of the PAR's Grounds of Decision ("GD").

5 In Ozone's appeal before me, only two grounds were canvassed by the parties, *viz*, ss 8(2)(b) and 8(4) TMA. Counsel for AMP confirmed that AMP was not relying on s 8(3) TMA.

6 After hearing the parties' oral submissions and considering their written submissions, I reversed the decision of the PAR and allowed Ozone's Trade Mark Application No T02/03173J for the "HYSTERIC GLAMOUR" word mark in Class 16 to proceed to registration (see [\[1\]](#) above). I now give the reasons for my decision. To facilitate understanding, I have set out the schematic arrangement of the contents herein as follows:

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## **Background facts**

## **Facts pertaining to AMP**

7 With respect to AMP, the PAR set out the following background facts at [11]–[17] of his GD:

### **[AMP's] Evidence**

11 [AMP's] only statutory declaration was declared on 24<sup>th</sup> August 2005 in the United State [sic] of America by Mr. John W. Bellando, the Vice President of [AMP] since 1 January 2000. [AMP states] that the first issue of GLAMOUR magazine had been published more than 60 years ago in May 1941. Since then [AMP states] that the GLAMOUR magazine has been devoted to the reporting and portraying [of], among other things, women's fashion, beauty, careers, relationships, sex/health, women's issues, travel, food, home decorating, cars, audio, film and more, all directed towards the contemporary working woman.

12 [AMP states] that [it has] secured registrations or [has] pending registrations of the GLAMOUR mark in more than 100 countries. There are some copies of some of the Certificates of Registration attached to the statutory declaration. There is also a table listing the countries in which the GLAMOUR mark has been registered or is pending registration. It should be noted that the number of Certificates of Registration do not match the number of countries where the GLAMOUR mark is listed as registered. I note that [AMP has] made assertions that sought to prove that [AMP has] worldwide reputation. However, to support such an important fact, [it has] only submitted sample copies of the Certificates of Registration in the various countries where [it] had claimed the reputation exists. The list of countries includes 94 countries, whereas the exhibits to the statutory declaration only show copies of Certificates of Registration from 43 countries. This is only as far as I can tell; the next issue that I have with the evidence is that most of it comes without a certified translation. Since the certificates come from all over the world, I am presented with a vast array of languages that I am afraid I do not have the faculty to master. Where this is the case, the Certificate of Registration shall do nothing more to substantiate the assertions of [AMP] than if there was no copy submitted at all. It is truly a pity that, for a fact that is as crucial as the completeness of the worldwide reputation, there is only partial substantiation of the assertions of [AMP]. That is not to say that the statement by Mr. Bellando is of no weight; it was made under oath and the penalties of being found to be untruthful while under oath strongly discourage any untruthful statements. However, the case for the worldwide reputation could have been made much stronger had all the Certificates of Registration been presented, and accompanied by the certified translation of the certificate. I have some understanding of the difficulty that counsel faces when asking for and obtaining this information, but parties who present a bare statement of worldwide reputation without anything more will risk facing significant challenges on their statement, or at least and have their statements bear much less weight.

13 [AMP states] that [its] GLAMOUR magazine is sold and distributed in many countries worldwide. The total global circulation has amounted to at least 2,376,096 copies per month (based on the average circulation figure for September 2002). [AMP tenders] into evidence a table of countries where the GLAMOUR magazine is presently distributed and sold.

14 In terms of domestic sales, [AMP states] that [it] first commenced use of the GLAMOUR mark from at least as early as September 1984. They provide the circulation numbers for Singapore for the years 1990-2002:

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Year	Distribution (copies)	Year	Distribution (copies)
1990	567	1997	780
1991	389	1998	642
1992	427	1999	916
1993	621	2000	972
1994	795	2001	823
1995	720	2002	903
1996	727		

The numeric value of these figures was not challenged by [Ozone].

15 [AMP states] that the magazine has won more than 59 major magazine awards since 1990 and reaches over 12 million readers each month internationally. The magazine also outsells more than 98% of all magazines on the newsstands. The GLAMOUR mark is also world famous by way of the GLAMOUR websites that are accessible worldwide. By virtue of this extremely substantial and extensive use of the GLAMOUR mark, the mark has become distinctive of the Opponents both in Singapore and globally.

16 There were no advertising and promotion figures submitted into evidence.

17 [AMP] did not tender a second statutory declaration.

### **Facts pertaining to Ozone**

8 With respect to Ozone, the following background facts were set out at [18]–[23] of the GD:

#### **[Ozone's] Evidence**

18 [Ozone's] evidence comes by way of a statutory declaration declared in Japan on 5<sup>th</sup> December 2006 by Mr Noriyuki Yamagani. He states that he is a brand manager of [Ozone] and has been for the past 19 years.

19 [Ozone is] a company based in Japan focused on the design and retailing of fashion apparel and accessories for both men and women. [Ozone is] the registered [proprietor] of the trade mark HYSTERIC GLAMOUR in Japan, United Kingdom, United State[s] of America, Hong Kong, Indonesia, Taiwan and Korea. The Certificates of Registration and the certified copies of translation of certificates not in English were duly presented as evidence of their goodwill and reputation. In particular, [Ozone refers] to the HYSTERIC GLAMOUR mark in the UK in Class 16 covering "**Paper and cardboard; industrial packaging containers of paper; towels of paper; table napkins of paper; hand towels of paper; handkerchiefs of paper; paper patterns; tailor's chalk; table cloths of paper; blinds of paper; banners of paper; flags of paper; baggage tags; printed matter; paintings and calligraphic works; photographs, photograph stands; playing cards; stationery and study materials**". [Ozone highlights] that this Class 16 mark co-exists on the UK register with [AMP's] GLAMOUR mark in the UK. [emphasis in original]

20 [Ozone] had invented the mark HYSTERIC GLAMOUR for use in connection with fashion apparel. [Ozone] had subsequently used the mark in Japan since 1984 on clothing, bags, footwear and fashion accessories. [Ozone] tendered evidence of advertisements in Japanese magazines as well as extracts from [its] company website as evidence of the fashion style of the products sold.

21 [Ozone asserts] that the HYSTERIC GLAMOUR brand has become extremely famous as a fashion clothes label in Japan. [Ozone submits] that a travel listing in the website Yahoo! Travel Listing as well as the list of HYSTERIC GLAMOUR retail stores located throughout Japan point to a significant reputation built by [Ozone] since 1984.

22 [Ozone claims] that the HYSTERIC GLAMOUR brand has in recent years gained a business presence in countries apart from Japan. HYSTERIC GLAMOUR stores have been set up in Hong Kong and in the United States of America. [Ozone asserts] that [it has] two stores in Hong Kong and 25 stores in the US. I note that, on a careful examination of the exhibits before me, that the stores that [Ozone claims] are the stores outside of Japan, are actually more likely to be stores belonging to other franchises that merely carry HYSTERIC GLAMOUR goods.

23 [Ozone's] goods bearing the HYSTERIC GLAMOUR mark have yet to be sold or advertised in Singapore. There are no figures pertaining to sales and advertisements in Singapore.

### **The decision of the PAR**

9 As ss 8(2)(b) and 8(4) TMA were raised in this appeal before me (see [\[5\]](#) above), I shall set out the PAR's findings *vis-à-vis* these two sections only.

### **The PAR's findings with respect to s 8(2)(b) TMA**

10 Section 8(2)(b) TMA states:

#### **Relative grounds for refusal of registration**

**8.** —(1)...

(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.

11 With respect to AMP's opposition under s 8(2)(b) TMA, the PAR observed (at [62] of the GD) that AMP had the burden of proving that the following criteria were satisfied:

(a) that AMP had earlier trade mark registrations as defined in s 2 TMA;

(b) that Ozone's mark (*viz*, "HYSTERIC GLAMOUR") and AMP's earlier trade marks (*viz*, "GLAMOUR") were similar;

(c) that the goods of Ozone's mark (*viz*, "HYSTERIC GLAMOUR") and AMP's earlier trade marks (*viz*, "GLAMOUR") were identical or similar; and

(d) there was a likelihood of confusion by virtue of the similarity of the marks and the goods.

12 The several earlier trade mark registrations in favour of AMP (see [2] above) were not disputed by Ozone (see [64] of the GD). The PAR considered whether Ozone's "HYSTERIC GLAMOUR" mark and AMP's "GLAMOUR" mark were "similar" within the meaning of s 8(2)(b) TMA. As correctly noted by the PAR, there are three aspects to similarity, *viz*, visual similarity, aural or phonetic similarity, and conceptual similarity.

#### *Similarity of marks*

##### (1) Visual similarity

13 The PAR found that Ozone's "HYSTERIC GLAMOUR" mark and AMP's "GLAMOUR" mark were visually *dissimilar* on a simple visual analysis and that there was no dominant element in either of the word marks:

68 I have been assaulted [*sic*] with diametrically opposed arguments on which element is the dominant element. But while [AMP tried] valiantly to deflect attention from the visual aspects by advancing [its] argument that the dominant element is GLAMOUR, and [AMP] advance[d] equally trying arguments that the element HYSTERIC is not overshadowed, the simple analysis in visual similarity is merely to look at the marks. In this case, there are many visual differences between the marks. The HYSTERIC GLAMOUR mark has 15 letters, GLAMOUR has 7 letters; the HYSTERIC GLAMOUR mark has two words, the GLAMOUR mark has one. I do not think that the language represented by the letters is so unusual or descriptive that there should be any dominant element. I am of the opinion that the marks are visually dissimilar. ...

##### (2) Aural or phonetic similarity

14 The PAR also found that Ozone's "HYSTERIC GLAMOUR" mark and AMP's "GLAMOUR" mark were aurally *dissimilar*:

69 I still cannot help but find that a simple analysis is all that is required of the test of aural similarity. The simple analysis here is that the complete sound of [AMP's GLAMOUR] mark is different from [Ozone's HYSTERIC GLAMOUR] mark. The simple facts are that [Ozone's HYSTERIC GLAMOUR] mark is made up of five readable syllables in two words with a pause in between, whereas [AMP's GLAMOUR] mark is two syllables in one word. Three of the syllables in [Ozone's HYSTERIC GLAMOUR] mark are not duplicated as sounds in [AMP's GLAMOUR] mark. This basic analysis shows that there is a fair bit of dissimilarity between the two marks in terms of syntax. The question is whether the repetition of two common syllables that form a common word 'glamour' will cause these two marks, as a whole, to be considered as aurally similar. My answer is no, and here again I do not think that [*Matratzen Concord GMBH v OHIM, Case T-6/01, Judgment of the Court of First Instance (fourth Chamber)*] can apply to swing the decision the other way. The case of *Matratzen* decided (at para XLIII) that, as between the elements 'Matratzen' and 'Concord', the element *Matratzen* was an invented word with hard to pronounce consonants and appeared more likely to be remembered by the public. I do not have this distinction before me in the present case, I only have before me the words HYSTERIC and GLAMOUR, and I am hard pressed to say that one is more pronounceable than the other so much so that the public is more likely to remember it. Consequently, and bearing in mind my earlier basic analysis of the two

marks, I am of the opinion that the marks are aurally dissimilar.

(3) Conceptual similarity

15 Having found that Ozone's "HYSTERIC GLAMOUR" mark and AMP's "GLAMOUR" mark were visually and aurally *dissimilar*, the PAR then found that the words marks were however conceptually *similar*:

70 The area of conceptual similarity is the hardest element to determine in this case. The [Ozone's HYSTERIC GLAMOUR] mark and [AMP's GLAMOUR] mark both bear the word GLAMOUR. The crux of the decision lies in whether the word GLAMOUR has been modified by the term HYSTERIC. I note the arguments from both sides relating to the [*sic*] whether I should treat the word HYSTERIC as distinctive or laudatory. I am of the opinion that the word HYSTERIC does not modify the word GLAMOUR in a similar way as the...case [in *Itochu Corporation v Worldwide Brands Inc* [2007] SGIPOS 9]. The word HYSTERIC does modify the concept of GLAMOUR in a way that is described by [Ozone at [51] above] to a certain point. However, the main concept is still 'glamour'. The concept has not been completely reversed, as it has been in [*Itochu Corporation v Worldwide Brands Inc* [2007] SGIPOS 9], where the ruggedness of the Camel concept was essentially reversed by the addition of the prefix 'sweet'. In this case, the HYSTERIC GLAMOUR mark still relies on the concept that they are 'glamorous', albeit injecting the new element of being 'hysterically glamorous'. From another point of view this should still hold true; [Ozone's concept] cannot be that the clothes do not look glamorous at all, otherwise it would frustrate the purpose of their mark, which is to sell designed clothes at a premium price.

71 I am of the view that the HYSTERIC GLAMOUR mark is in some way conceptually similar to the GLAMOUR mark in that both use the 'glamour' concept, one mark appeals to [the] orthodox meaning of 'glamour' while the other mark gives a spin to it but still is based on 'glamour'. ...

16 On the basis of such conceptual similarity *alone*, the PAR concluded that Ozone's "HYSTERIC GLAMOUR" mark and AMP's "GLAMOUR" mark, though visually and aurally dissimilar, were nevertheless "similar" within the meaning of s 8(2)(b) TMA. The PAR then proceeded to consider whether the goods bearing Ozone's "HYSTERIC GLAMOUR" mark and AMP's "GLAMOUR" mark were "similar".

*Similarity of goods*

17 The PAR found that there was similarity in respect of *only* the Class 16 goods specified by Ozone (*ie*, Ozone's goods: see [\[1\]](#) above) and AMP (*ie*, AMP's goods: see [\[2\]](#) above):

73 ... In relation to [AMP's] goods in Classes 9, 35, 41 and 42, there is no similarity in terms of the goods. In relation to [AMP's] Class 16 goods, [Ozone] conceded that there may be an overlap with the goods that they are applying for. Even without this concession, it is clear to me that the scope of [AMP's] description of goods ( "**Magazines, books and publications**" ) is clearly a sub-set of [Ozone's goods](in particular the mention of "**printed matter**" in the description of [Ozone's] goods). There does not seem to be a need to decide along the lines of the...factors [set out in *British Sugar PLC v James Robertson & Sons Ltd* [1996] RPC 281]. [emphasis in original]

*Likelihood of confusion*

18 The PAR then considered whether there was a likelihood of confusion on the part of the public in respect of AMP's and Ozone's Class 16 goods. He noted at [74] of the GD, referring to [66] of the Court of Appeal's decision in *McDonald's Corp v Future Enterprises Pte Ltd* [2005] 1 SLR 177

("McDonald's (CA)") that:

The lack of similarity as between the HYSTERIC GLAMOUR mark and the GLAMOUR mark is only one factor in the determination of the likelihood of confusion, since the element of likelihood of confusion takes into account a lot more than just the similarity of marks and of the goods. ...

19 Following that, the PAR identified the relevant segment of the public to be "the entire group of women who read magazines for leisure and [who] are fashion conscious". As Ozone had "not submitted very much on the intended use of the goods other than the specifications" (see [76] of the GD), the PAR considered notional use by Ozone of the "HYSTERIC GLAMOUR" mark in assessing the likelihood of confusion. In this aspect, the PAR noted that given the similarity of goods (see [17] above) and because it was "reasonable to speculate" (since Ozone had not submitted any evidence of the actual or intended use of its goods) that any use by Ozone of the "HYSTERIC GLAMOUR" mark would not fall far from their core business of "design and retailing of fashion apparel and accessories for both men and women", this "may result in a situation where both the marks will be used on similar goods". The PAR rejected AMP's submission that the public would see Ozone's "HYSTERIC GLAMOUR" mark as a subsidiary or spin-off of AMP's "GLAMOUR" mark purely by the application of the conceptually similar marks onto similar goods and was of the view that there was no calculated attempt to deceive because Ozone's and AMP's "advertising retain their own special flavour, with no attempt to copy each other's style" (see [78] of the GD). Nevertheless, the PAR concluded at [79] of the GD:

79 Having considered all the above factors, I believe that there is a likelihood of confusion on the part of the relevant public, in this case the members of the public who are female who read magazines for leisure and are fashion conscious. Although there are some differences between the [AMP's "GLAMOUR"] mark and [Ozone's "HYSTERIC GLAMOUR"] mark in terms of visual and aural similarity, there are similarities in concept. This similarity could give rise to a likelihood of confusion in the relevant segment of the public if the marks were affixed on similar goods, especially since [Ozone's and AMP's businesses] overlap. Where this is the case, this ground of opposition will succeed as all the essential elements of Section 8(2) [TMA] are made out.

### ***The PAR's findings with respect to passing off under s 8(4) TMA***

20 Section 8(4) TMA states:

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

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

(b) by virtue of an earlier right other than those referred to in subsections (1), (2) and (3) or paragraph (a), in particular by virtue of the law of copyright or any law with regard to the protection of designs.

21 Under this section, the PAR first observed, at [96] of the GD, that to succeed in an action for passing off under s 8(4) TMA, AMP had to satisfy three criteria, viz, that:

(a) AMP's goods and services had acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(b) there was a misrepresentation by Ozone (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by Ozone were goods or services of AMP; and

(c) AMP had suffered or was likely to suffer damage as a result of the erroneous belief engendered by Ozone's misrepresentation.

#### *Goodwill or reputation*

22 With regard to the first element of goodwill or reputation, the PAR observed that although AMP claimed that its use of the "GLAMOUR" mark in Singapore started from 1984, apart from a table and random invoices that did not date beyond the year 2000, there was no "good evidence" that AMP's magazine started selling in Singapore from 1984. The PAR also noted that the highest circulation of AMP's magazine at 903 copies in Singapore was unimpressive and was a "number that [was] disproportionately low for the population of Singapore that [was] around 3 million at that time" (see [88] of the GD). The PAR then concluded that the circulation numbers however indicated that AMP had "some goodwill and reputation in Singapore". Since the further point as to whether the goodwill rested in AMP or the distributor of its magazine was not argued before the PAR, he concluded that the goodwill should belong to AMP in the absence of any challenge (see [98] of the GD).

#### *Misrepresentation*

23 On misrepresentation, the PAR noted that the mere fact that a likelihood of confusion was found under s 8(2) TMA (see [18]-[19] above) did not automatically lead to the finding that there would be misrepresentation under passing off (see [99] of the GD); the element of misrepresentation "require[d] more than just a likelihood of confusion in the sense understood under trade mark law" (see [100] of the GD). Relying on his earlier observation (see [19] above) that there was no evidence that Ozone's "HYSTERIC GLAMOUR" mark was a subsidiary or spin-off of AMP's "GLAMOUR" mark and that Ozone's and AMP's advertising retained their own special flavour, with no attempt to copy each other's style, the PAR concluded that:

101 ... This evidence also goes to show that there is clearly no misrepresentation here, as there is no attempt [by Ozone to try] to mislead or deceive the public as to the origin of the goods.

#### *Damage*

24 Having found that the second criteria of "misrepresentation" was not made out (see [23] above), the PAR then considered it "natural that there cannot be any case to damage that has occurred or that is likely to occur" (see [102] of the GD). However, the PAR also considered the alternative position where "confusing similarity" under s 8(2) TMA may be seen as a misrepresentation. In this aspect, he noted that he was unconvinced by AMP's argument that its magazine was a "class publication" to prove damage:

103 ... I am unconvinced that the mere mention [of or] association with [Ozone's business] will bring about the 'devastating' damage that [AMP claims] will happen. The use of tattooed individuals and of vulgar words on a T-shirt design that will appear on the pages or cover of another magazine is too remote a cause that can be linked to the damage in the goodwill of [AMP's] GLAMOUR magazine.

104 Further, I would think that advertisers are only likely to leave the magazine if the magazine

itself is falling from being a 'class publication', and that is only if the magazine carrying the advertisements themselves are actively carrying out actions (to use the quoted examples, using heavily tattooed models and vulgar words) that will cause the magazine to be seen as a publication that is not a class publication. To say that advertisers will remove advertisements from one magazine because of the association of that one magazine with another offending publication, or because of the association of that one magazine with an offending entity is a tenuous argument, especially since the advertisers' advertisement does not come anywhere near the offending publication.

105 In any event, I note that the 'class publication' principle originated from [AMP's] own literature. There are also no other proofs of damage that were tendered before me.

25 Accordingly, the PAR concluded that because the elements of passing off were not made out, AMP's ground of opposition under s 8(4) TMA failed.

26 Having set out the grounds for the PAR's decision, I now proceed to summarise the parties' main contentions in the appeal before me (see [\[27\]](#)–[\[28\]](#) below), before elaborating further on the parties' arguments in my decision below.

### **Ozone's arguments on appeal**

27 Ozone raised five arguments to contend that the PAR had erred in holding that its "HYSTERIC GLAMOUR" mark was "confusingly similar" to Ozone's "GLAMOUR" mark pursuant to s 8(2)(b) TMA (see [\[10\]](#)–[\[19\]](#) above), viz, that the PAR had erred in:

- (a) finding that its "HYSTERIC GLAMOUR" mark was conceptually similar to Ozone's "GLAMOUR" mark (see [\[15\]](#) above);
- (b) finding that its "HYSTERIC GLAMOUR" mark was "similar" to Ozone's "GLAMOUR" mark on the basis of conceptual similarity *alone*;
- (c) not considering the lack of distinctiveness of AMP's earlier "GLAMOUR" mark (see [\[64\]](#) below);
- (d) finding that Ozone's goods, *excluding* "printed matter" (*viz*, "paper and cardboard; industrial packaging containers of paper; towels of paper; table napkins of paper; hand towels of paper; handkerchiefs of paper; paper patterns; tailors' chalk; table cloths of paper; blinds of paper; banners of paper; flags of paper; baggage tags...paintings and calligraphic works; photographs, photographs stands; playing cards; stationery and study materials") were similar to AMP's goods (*viz*, "magazines books and publications") ( see [\[17\]](#) above); and
- (e) finding that there was a likelihood of confusion between its "HYSTERIC GLAMOUR" word mark and AMP's "GLAMOUR" word mark (see [\[18\]](#)–[\[19\]](#) above).

### **AMP's arguments on appeal**

28 On its end, AMP submitted that the PAR had not erred except in three respects, *viz*, that the PAR had erred in holding that:

- (a) its "GLAMOUR" mark was not *visually* similar to Ozone's "HYSTERIC GLAMOUR" mark (see [\[13\]](#) above);

(b) its "GLAMOUR" word mark was not *aurally* similar to Ozone's "HYSTERIC GLAMOUR" word mark (see [14] above); and

(c) the law of passing off would not prevent Ozone's use of the "HYSTERIC GLAMOUR" word mark pursuant to s 8(4) TMA (see [20] –[25] above).

### **The decision of this court**

29 As stated above at [5], the parties' contentions before me related only to the PAR's decision on the applicability of ss 8(2)(b) and 8(4) TMA. Before elaborating on the law and the parties' respective arguments, it would be useful to first examine the standard of review applicable in the present proceedings.

### ***The role of an appellate tribunal***

30 In *Future Enterprises Pte Ltd v McDonald's Corp* [2007] 2 SLR 845 ("*Future Enterprises*"), the Court of Appeal was of the view that appeals from a decision of the PAR "are not in the nature of a rehearing" and the PAR's findings of fact should be disturbed only where there is a "material error in principle", *ie*, a "significant departure from a proper assessment of the law or the facts" (see [5]–[7] of *Future Enterprises*):

5 ... having regard to the general principles applicable to appeals against findings of fact in trade mark applications, we see no reason why we should disturb the dual findings of fact by the PAR and the trial judge of similarity and likelihood of confusion between the two word marks "MacCoffee" and "McCAFÉ". In *Reef Trade Mark* [2003] RPC 5, Robert Walker LJ considered the function of an appellate tribunal in relation to appeals from the UK Trade Mark Registry, and concluded (at [28]) that "*an appellate court should ... show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle*". In *SC Prodal 94 SRL v Spirits International NV* [2003] EWHC 2756 (Ch), Laddie J expressed the same sentiments (at [19]) as follows:

It is not the duty of this court to overturn a decision of the Trade Mark Registry simply because it comes to the conclusion that it might have decided the case differently had it, that is to say the High Court, been the court of first instance. *It has to be demonstrated that the decision at first instance was wrong in a material way; that is to say there must be some significant departure from a proper assessment of the law or the facts.*

6 This prudent approach has been unequivocally endorsed in the recent case of *Sunrider Corporation v Vitasoy International Holdings Ltd* [2007] EWHC 37 (Ch) (at [10]). *Such an approach is consistent with established principles relating to appeals from tribunals that are not in the nature of a rehearing, such as an appeal from a decision of the PAR.*

7 ... *In the light of the highly subjective nature of assessing similarity and the likelihood of confusion, we agree with the approach that an appellate court should not disturb the findings of fact of a trade mark tribunal unless there is a material error of principle.*

[emphasis added]

31 The abovementioned approach in *Future Enterprises*, *viz*, that appeals from a decision of the PAR "are not in the nature of a rehearing," however, differs from that stated in O 87 r 4(2) of the Rules of Court (Cap 322, R5, 2006 Rev Ed) ("ROC"), which applies to appeals against the decision of

the Registrar of Trade Marks pursuant to s 75(2)(a) TMA. Counsel for both AMP and Ozone confirmed that the present application before me was made pursuant to s 75(2)(a) TMA read with O 87 r 4(2) of the ROC. The latter provision states as follows:

## ORDER 87

### TRADE MARKS ACT

...

#### Appeals (O. 87, r. 4)

#### 4. —(1)...

(2) *An appeal shall be by way of rehearing* and the evidence used on appeal shall be the same as that used before the Registrar and, except with the leave of the Court, no further evidence shall be given.

[emphasis added]

32 The Court of Appeal in *Future Enterprises* did *not* appear to have considered the effect of O 87 r 4(2) of the ROC.

33 This apparent omission to consider O 87 r 4(2) of the ROC was noted by Lee Seiu Kin J in the recent decision of *MediaCorp News Pte Ltd v Astro All Asia Networks PLC* [2009] 4 SLR 496 ("*MediaCorp*"):

26 ... The Court of Appeal in *Future Enterprises* did not appear to have considered the effect of this provision. Nevertheless, the fact that such proceedings are "by way of rehearing" [as stated in O 87 r 4(2) of the ROC] does not necessarily mean that the appeal court's decision is unfettered. An appeal from the High Court to the Court of Appeal is similarly by way of rehearing under O 57 r 3(1) of the ROC. However, the Court of Appeal will be slow to upset an exercise of discretion by the trial judge (*Golden Shore Transportation Pte Ltd v UCO Bank* [2004] 1 SLR 6 at [44]). Further, with respect to finding of facts, the Court of Appeal is generally reluctant to interfere because the trial judge is in a better position to assess the veracity and credibility of the witnesses (*Seah Ting Soon trading as Sing Meng Co Wooden Cases Factory v Indonesian Tractors Co Pte Ltd* [2001] 1 SLR 521 at [22]). *On the other hand, a distinction is drawn between perception of facts and evaluation of facts, the latter of which an appellate court is in as good a position as the trial court to make an evaluation from primary facts* (*Ho Soo Fong v Standard Chartered Bank* [2007] 2 SLR 181 at [20]). *However the authorities are clear that the law pertaining to trade mark infringement is unique in that the final analysis is "more a matter of feel than science"* (*Future Enterprises* at [7]).

27 *Be that as it may, in view of the findings that I have made as set out below, it does not make a difference whether or not the appeal is to be by way of a rehearing.* As mentioned earlier, *MediaCorp* proceeded only on two grounds in this appeal, viz ss 8(2)(b) and 8(3) [TMA], which I now turn to consider.

[emphasis added]

34 O 87 r 4(2) of the ROC was also covered by Chan Seng Onn J in *Valentino Globe BV v Pacific Rim Industries Inc* [2009] 4 SLR 577 (which was subsequently affirmed by the Court of Appeal in Civil Appeal No 46 of 2009) although neither *Future Enterprises* nor *MediaCorp* was mentioned. Chan J said:

9 Order 87 rule 4(2) of the [ROC] provides that an appeal from the Registrar of Trade Marks shall be by way of "rehearing". At para 87/3/7 of Singapore Civil Procedure 2007 (Sweet & Maxwell Asia, 2007 ) ("Singapore Civil Procedure"), it iterates that appeals to the court from the decision of the registrar [of trade marks] is governed inter alia, by O 55 and that the procedure is "by way of rehearing...".

10 On O 55 which governs appeals to the High Court from any court, tribunal or person, para 55/1/2 of Singapore Civil Procedure notes that O 55 r 2(1) stipulates that the appeal is by way of rehearing. Order 55, it suggests, confers upon the Court wider powers than those so conferred under O 53 which deals with, inter alia, judicial review. Hence, O 55 r 6(5) provides that the appellate court can make any order which should have been made by the tribunal. The appellate court is thus not confined to merely determining whether the decision below was compliant with rules of natural justice or reached honestly (*Ling Uk Choon v Public Accountants Board* [2004] 3 SLR 517 at [32]).

11 "By way of rehearing" in my view means that the Court is not constrained to determine only whether the tribunal's decision was proper and/or contained manifest errors of fact and law. If it wishes to, the Court in its discretion may consider the entire ream of evidence before it and venture beyond determining the propriety of the tribunal's decision or inquiring into whether there had been manifest errors of fact or law. However, I do not think that it places an irrevocable burden upon the Courts to hear the matter anew so that the substantive merits fall to be determined afresh. As para 57/3/1 of Singapore Civil Procedure observes with regard to the phrase "by way of rehearing", albeit in relation to appeals to the Court of Appeal:

These words do not mean that the witnesses are heard afresh. They indicate the appeal is not limited to a consideration whether the misdirection, misreception of evidence or other alleged defect in the trial has taken place, so that a new trial should be ordered. They indicate that the court considers (so far as may be relevant) the whole of the evidence given in the court below and the whole course of the trial.

...

The courts' power is therefore discretionary.

[emphasis in original]

35 Be that as it may, as in *MediaCorp*, in view of my findings as set out below, it would make no difference whether or not the appeal is to be by way of a rehearing. I now turn to examine the two grounds raised in this appeal, viz, ss 8(2)(b) and 8(4) TMA.

### **AMP's opposition under s 8(2)(b) TMA**

36 To successfully oppose Ozone's "HYSTERIC GLAMOUR" mark under s 8(2)(b) TMA, AMP must show that the following three conditions are satisfied in a "step-by-step" fashion (see the Court of Appeal's decision in *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2006] 2 SLR 690 ("*The Polo/Lauren Co (CA)*")):

(a) that Ozone’s “HYSTERIC GLAMOUR” word mark and AMP’s earlier “GLAMOUR” word mark are similar (“Condition 1”);

( b ) if Condition 1 is satisfied, then that Ozone’s “HYSTERIC GLAMOUR” word mark is to be registered for goods identical with or similar to those for which AMP’s earlier “GLAMOUR” word mark is protected ( “Condition 2”); and

( c ) if Condition 1 and Condition 2 are both satisfied, then that there exists a likelihood of confusion on the part of the public by virtue of the similarity of the marks (ie, Condition 1) and of the goods (ie, Condition 2) (“Condition 3”).

37 With respect to these three conditions, the following observations at [8] of *The Polo/Lauren Co (CA)* are instructive:

8 ... While we can see some link and overlap between the first and the third conditions, it is clear that they are different. The fact that a sign is similar to a registered mark does not automatically mean that there will be a likelihood of confusion on the part of the public. That is a question of fact to be determined by the court, taking into account all the relevant circumstances. Moreover, the question of similarity is really a matter of degree. In a broad sort of sense, the greater the similarity between a mark and a sign, the greater will be the likelihood of confusion. *However, if either of the first two conditions is not satisfied there will not be any need to go into the third question of determining whether there exists a likelihood of confusion. Neither does it mean that if the mark and the sign are similar, and they are used on similar goods, that there will ipso facto be confusion in the minds of the public.* If that was intended, s 27(2)(b) [see [15] of *The Polo/Lauren Co (CA)* where it was held that this approach also applied to s 8(2)(b) TMA] would have been phrased differently. As presently worded, there is no presumption of confusion once the two aspects of similarity are present. ... [emphasis added]

38 I now proceed to consider these respective conditions against the facts of this case in accordance with this framework.

*Condition 1: Similarity between the “HYSTERIC GLAMOUR” and “GLAMOUR” word marks*

39 At the outset, it must be borne in mind that the word marks compared in this appeal were devoid of any stylisation, embellishment or device, and were as follows:

<b>Ozone’s word mark</b>	<b>AMP’s word mark</b>
HYSTERIC GLAMOUR	GLAMOUR

(1) The approach to be adopted

(A) VISUAL, AURAL AND CONCEPTUAL SIMILARITY

40 As mentioned at [12] above, there are three aspects to similarity, viz, visual similarity, aural or phonetic similarity and conceptual similarity (see *The Polo/Lauren Co (CA)* at [10]). Whether there is a similarity of marks in these three aspects of similarity is essentially a question of fact (see *Johnson & Johnson v Uni-Charm Kabushiki Kaisha (Uni-Charm Corp)* [2007] 1 SLR 1082 (“*Johnson & Johnson*”) at [9]). The law does *not* however require *all* three similarities to be made out before the finding that the

two marks are similar can be made (see *MediaCorp* at [32]). In this aspect, the observations of Bently and Sherman in *Intellectual Property Law* (Oxford University Press, 3rd Ed, 2009) ("*Bently & Sherman*") at pp 863-866 are also apposite (footnotes omitted):

*Visual, aural and conceptual similarity.* The marks should be assessed from the point of view of their visual, aural and conceptual similarities. Typically, tribunals consider each in turn, before reaching an overall conclusion. In so doing, they have observed that a trade-off can occur: visual and conceptual differences, for example, can offset aural similarities.

...

The relative importance of each sort of similarity will vary with the circumstances in hand, in particular the goods and the types of mark. ... Each case is therefore to be viewed in its own context. However, the ECJ has ruled [in *Lloyd Schuhfabrik Meyer v Klijsen Handel BV*, Case C-342/97 [1999] 2 CMLR 1343] that, in an appropriate case, mere aural similarity may make marks so similar as to be likely to cause confusion...

...

*In other situations, conceptual dissimilarity, as for example where one mark has a meaning but its comparator does not, may counteract aural or visual similarity.*

[emphasis added]

41 A useful case in point is that of *Mystery Drinks GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs), Karlsberg Brauerei KG Weber Intervening* [2004] ETMR 217 (which was cited with approval in *Johnson & Johnson* at [13]), where "Mystery" was refused registration for non-alcoholic drinks as the mark "Mixery" had already been registered for beer. The learned authors of *Bently & Sherman* note at footnote 51, pp 864-865 that although the:

... figurative mark MYSTERY with stylized M and MIXERY were neither conceptually nor visually similar, but were aurally similar...in the field of beverages this was sufficient. [emphasis added]

42 Accordingly, the relative importance of each type of similarity will thus vary with the circumstances in hand, in particular the goods and the types of mark. The fact that one type of similarity is made out does not necessarily mean that the marks are similar. Also, regard should be had to the type of marks being compared (see *MediaCorp* at [32]).

## (B) DISTINCTIVENESS

43 The distinctiveness in the earlier trade mark (*ie*, "GLAMOUR" in this case) is also one important factor in the inquiry into the similarity between the marks under s 8(2)(b) TMA. In this vein, Ng-Loy Wee Loon in *Law of Intellectual Property in Singapore* (Sweet & Maxwell Asia, 2009) ("*Law of Intellectual Property in Singapore*") observes as follows (footnotes omitted):

### **Comparison between marks**

...

**[21.5.12]** The distinctiveness in the earlier trade mark is one important factor. *Where a common word is included in the earlier trade mark, the tribunal should be wary of granting a monopoly in its use. This translates into a reluctance to hold that two marks which contain a common word*

are similar marks.

[emphasis added]

44 The learned authors of *Bently & Sherman* note further at pp 866-868 (footnotes omitted):

*Distinctiveness.* The question of whether marks are similar will often be dependent on the inherent or acquired distinctiveness of the mark (for the goods or services for which it is registered). This has a number of effects

First, *the less distinctive the earlier trade mark, the less literal or visual alteration is necessary to ensure that the later mark is not similar.* For example, the CFI comparing two words CASTELLANI and CASTERLLUCA for wine from the point of view of a German consumer found the two marks to be dissimilar, because the 'castel' element is a common descriptive component in wine names and the applicant's suffix 'luca' would be seen as the Italian name and thus sufficient to differentiate the marks. In *Reed Executive plc v Reed Business Information Ltd* [[2004] RPC (40) 767], Jacob LJ stated that '*where a mark is descriptive small differences may suffice to avoid confusion*', giving an illustration from the law of passing-off concerning the terms OFFICE CLEANING ASSOCIATION and OFFICE CLEANING SERVICES. *Where the distinctiveness of the earlier trade mark is very low, the later mark will have to be in close proximity for it to be similar, as with THERMAWEAR and THERMAWARM. The same principle applies to common names which intrinsically have a low level of distinctiveness.*

Second, if the earlier mark is highly distinctive, then a mark that has been substantially modified might nonetheless still be similar. ...

[emphasis added]

45 That this is the approach adopted in Singapore case-law can be seen from the High Court's decision in *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2005] 4 SLR 816 ("*The Polo/Lauren Co (HC)*"):

***The similarity between the plaintiff's marks and the defendant's sign***

26 The decided cases suggest that there are three aspects to similarity: visual, aural or phonetic, and conceptual. In terms of visual similarity, it is clear that the mark and the sign share one common denominator: the word "POLO". *In cases where there is a common denominator, it is important to look at the differences between the mark and the sign in order to decide whether the challenged sign has been able to distinguish itself sufficiently and substantially: The European Limited v The Economist Newspapers Limited* [1996] FSR 431 at 436; see also *Kerly's Law of Trade Marks and Trade Names* (Sweet & Maxwell, 13th Ed, 2001) at paras 16-63 to 16-67... *In other words, sometimes, looking at the challenged sign as a whole, the distinctiveness of the registered word mark is dissolved by the addition of the word. Accordingly, the similarity between the mark and the sign is significantly diminished and may be insufficient to cause a likelihood of confusion.*

2 7 *In the present case, the differences are obvious: the addition of the word "PACIFIC" together with the sign's different font and design. The question, then, is whether these differences are enough so as not to capture the distinctiveness of the registered mark. In order to decide this, I first have to consider whether the plaintiff's mark can be considered to be so distinctive that the differences would not negate the similarity. This is an important issue*

because a more distinct mark generally receives greater protection: *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767 ("Premier Brands"). ...

28 ... [I] am prepared to accept that the plaintiff's word mark is somewhat distinctive but not strikingly so. As such, the differences between the plaintiff's mark and the defendant's sign are sufficient so that the latter does not capture the distinctiveness of the registered mark and is therefore not similar to the defendant's mark. ...

[emphasis added]

46 While the italicised words in [26] of *The Polo/Lauren Co (HC)* (reproduced above at [45]) seem to suggest that the distinctiveness of the earlier trade mark is an important factor in the inquiry into the *likelihood of confusion* (as opposed to *similarity between the marks*: see [43] above), those in [27] (viz, "I first have to consider whether the plaintiff's mark can be considered to be so distinctive that the differences would not negate the *similarity*" [emphasis added] and [28] (viz, "the differences between the plaintiff's mark and the defendant's sign are sufficient so that the latter does not capture the distinctiveness of the registered mark and is therefore not *similar* to the defendant's mark" (emphasis added)) of the decision make it clear that the distinctiveness in an earlier trade mark is an important factor in the inquiry into the *similarity* between the marks under s 8(2)(b) TMA.

47 In any event, the Court of Appeal's subsequent decision in *The Polo/Lauren Co (CA)* does indicate that the distinctiveness in an earlier trade mark is an important factor to be considered in the inquiry into the *similarity* between the marks under s 8(2)(b) TMA and is not confined to the analysis of the likelihood of confusion:

### **Similarity between the mark and the sign**

...

23 ... There was simply no evidence before the court to show that the word "polo" per se is distinctive. Indeed, the word "polo" is an ordinary English word meaning a game played on horseback... We recognise that some marks are inherently distinctive because they consist of inventive words without any notional or allusive quality. An example would be "Volvo". "Polo" is certainly not an inventive word and could claim no inherent distinctiveness. Where common words are included in a registered mark, the courts should be wary of granting a monopoly in their use: see *The European Limited v The Economist Newspaper Limited* [1998] FSR 283 at 289-290 and "FRIGIKING" Trade Mark [1973] RPC 739 at 753. Any alleged distinctiveness must be acquired through use. Thus, the question of distinctiveness must be determined in the light of all the circumstances of the case. ...

24 Bearing in mind that "polo" is a common English word, we are unable to see how it could be said that the sign "POLO PACIFIC" with its special font and design is similar to the mark "POLO" except in the broadest of sense that one word is common. In any event, for the purpose of determining similarity under s 27(2) of the Act, one must look at the mark and the sign as a whole (see *In the Matter of an Application by the Pianotist Company Ltd for the Registration of a Trade Mark* (1906) 23 RPC 774 ("Pianotist") and *Cooper Engineering Company Proprietary Limited v Sigmund Pumps Limited* [1952] 86 CLR 536 ("Cooper")) and, bearing in mind the actual differences between the two, we cannot see how it can be said that the trial judge was wrong when he held that the sign and the mark are not similar. All the more so when the appellant was not even claiming a monopoly of the word "polo". Accordingly, we agree with the judge that the two are visually, aurally and conceptually different.

[emphasis added]

48 In accordance with this approach, I now proceed to examine whether Ozone's "HYSTERIC GLAMOUR" mark is "similar" to AMP's "GLAMOUR" mark under s 8(2)(b) TMA.

(2) Visual similarity

49 In the case of word marks, a determination of visual similarity typically involves looking at the (see *Bently & Sherman* at p 865):

(a) length of the marks;

(b) structure of the marks (*ie*, whether there are the same number of words); and

(c) whether the same letters are used in the marks.

50 When comparing two marks visually, one must also bear in mind the "imperfect recollection" of the consumer (*ie*, that the consumer may not be able to remember a mark perfectly) (see *Nautical Concept Pte Ltd v Jeffrey Mark Richard* [2007] 1 SLR 1071 at [30]). The average consumer only rarely has the chance to make a direct comparison between the marks, and so must place his trust in the "imperfect picture of [the two marks] that he has kept in his mind" (*Lloyd Schuhfabrik Meyer v Klijsen Handel BV*, Case C-342/97 [1999] 2 CMLR 1343, 1358-9). Accordingly, where at first glance two marks may appear to be dissimilar, when the possibility of imperfect recollection is taken into account, the two marks may in fact be similar (see *Bently & Sherman* at p 865). Hence, the court will not compare the two marks side by side and examine them in detail because "the person who is confused often makes comparison from memory removed in time and space from the marks" (*Caterpillar Inc v Ong Eng Peng (formerly trading as Catplus International)* [2006] 2 SLR 669 at [55] per Tay Yong Kwang J). The court should also not take into account "any external added matter or circumstances" as the comparison is mark for mark.

51 I have already set out at [13] above the PAR's reasons for holding that Ozone's "HYSTERIC GLAMOUR" mark and AMP's "GLAMOUR" mark were visually *dissimilar*. While the PAR's statement by itself that:

68 ... the simple analysis in visual similarity is merely to look at the marks...

is *inaccurate* given that the inquiry into the similarity between the marks under s 8(2)(b) TMA must also necessarily consider, if any, the distinctive components of the marks (see [43]-[47] above), this was nevertheless done because the PAR also noted in the same paragraph that:

68 ... I do not think that the language represented by the letters [in Ozone's "HYSTERIC GLAMOUR" mark and AMP's "GLAMOUR" mark] *is so unusual or descriptive that there should be any dominant element...* [emphasis added]

52 The PAR's approach (*viz*, by looking at the word marks *and* considering whether the language represented by the letters in Ozone's "HYSTERIC GLAMOUR" mark and AMP's "GLAMOUR" mark were so unusual or descriptive that there should be any dominant element) was consistent with that adopted

by the High Court in *The Polo/Lauren Co (HC)* (see [\[45\]](#) above), which was affirmed on appeal in *The Polo/Lauren Co (CA)*.

53 In the present instance, although the word marks of Ozone and AMP share one common denominator, *viz*, the word "GLAMOUR", I agreed with the PAR's observation that there were:

... many visual differences between the marks. The HYSTERIC GLAMOUR mark has 15 letters, GLAMOUR has 7 letters; the HYSTERIC GLAMOUR mark has two words, the GLAMOUR mark has one.

Furthermore, given that the word "HYSTERIC", which appears at the beginning of Ozone's word mark, is almost of equal length to the word "GLAMOUR", I could not see how it would be entirely overlooked or overshadowed by the word "GLAMOUR". That Ozone's word mark has two words was to my mind a visual difference. Thus, even if "GLAMOUR" is the more common word of the two (*ie*, "HYSTERIC" and "GLAMOUR") and may come to mind more quickly than "HYSTERIC", the consumer with an imperfect recollection (see [\[50\]](#) above) would still remember that Ozone's word mark has an additional word to "GLAMOUR". In these circumstances, I saw no reason to disturb the PAR's finding that Ozone's "HYSTERIC GLAMOUR" mark was visually *dissimilar* to AMP's "GLAMOUR" mark.

### (3) Aural similarity

54 I have already set out at [\[14\]](#) above the PAR's reasons for holding that Ozone's "HYSTERIC GLAMOUR" mark and AMP's "GLAMOUR" mark were aurally *dissimilar*. It is worth noting that in *Aristoc, Ld v Rysta, Ld* (1943) 60 RPC 87, Luxmoore LJ's dissenting judgment stated, at 108:

[t]he answer to the question whether the sound of one word resembles too nearly the sound of another ... *must nearly always depend on first impression*, for obviously a person who is familiar with both words will neither be deceived nor confused. It is the person who only knows the one word and has perhaps an *imperfect recollection* of it who is likely to be deceived or confused. [emphasis added]

This statement was cited with approval in the House of Lords by Viscount Maugham in *Aristoc, Ld v Rysta, Ld* (1945) 62 RPC 65 at 72.

55 In *Bently & Sherman* at p 865, the learned authors noted that:

When comparing marks aurally, tribunals have tended to carry out a quantitative assessment: do the two signs have more syllables in common than not?

In these circumstances, I was of the view that the PAR's approach in dealing with the question of aural similarity was entirely consistent with the foregoing approach.

56 In this case, both "HYSTERIC" and "GLAMOUR" were English words, although the latter could be said to be the more common English word. However, it must be borne in mind that Ozone's word mark *starts* with the entirely separate word "HYSTERIC" preceding the word "GLAMOUR". Also, Ozone's "HYSTERIC GLAMOUR" word mark would be read and pronounced as two separate and distinct words, in the order of "HYSTERIC" and "GLAMOUR". AMP's "GLAMOUR" word mark, on the other hand, would be read as a single word. The comparison in this case was between a two-word mark and a single word mark, so that even if the actual word "HYSTERIC" was forgotten, it would not be forgotten that there was an additional word in Ozone's word mark. While I did not agree entirely with the reasons of the PAR, I also concluded that the words marks were aurally *dissimilar*.

(4) Conceptual similarity

57 With regard to the requirement of conceptual similarity, *Bently & Sherman* note at p 866 (footnotes omitted):

Because similarity is assessed conceptually as well as visually and phonetically, in thinking about whether marks are similar, it is necessary to take account of the ideas that lie behind or inform the earlier mark. ...

AMP's "GLAMOUR" word mark in the present case clearly relied on the orthodox meaning of "glamour".

58 In this instance, the PAR had held that Ozone's "HYSTERIC GLAMOUR" mark and AMP's "GLAMOUR" mark were conceptually *similar*. Ozone contended that the PAR, who had found the word marks both visually and aurally *dissimilar*, had then subsequently erred in his finding that the word marks were similar on the basis of conceptual similarity *alone*. To this end, it referred to the following passage in the decision of the High Court in *McDonald's Corp v Future Enterprises Pte Ltd* [2004] 2 SLR 652 (*McDonald's (HC)*) (an appeal against which was dismissed by the Court of Appeal in *McDonald's (CA)*):

43 As to the visual and aural similarities of the marks, I do not consider them to be confusingly similar. There are indeed significant visual differences between them – the depiction of an eagle as opposed to the golden arches forming the letter "M" – and aural differences – "McChicken", "McNuggets", "Egg McMuffin" and "Sausage McMuffin" compared to "MacTea", "MacChocolate" and "MacNoodles". Below the word component "MacTea", for example, the legend "3-in-1 Instant Hot Tea" appears. Other than the letter "M" in "MacTea", there is no mark similar to the opponents' "M" logo anywhere on the packaging. The word marks are also different in appearance in terms of colour, font and typeface. The second and third syllables of the application marks are different in sound from the opponents'. The differences leave different impressions on people's minds.

44 Is there a conceptual link between the two in that the common use of the first syllable "Mac" or "Mc" means that both are likely to be taken as indicative of a common identity? The use of the first syllable "Mac" in the applicants' range of products is not unlike the case of the opponents in that TWC has admitted to the use of the same naming system as McDonald's. But it does not, in my view, override the other differences mentioned earlier and, when viewed as a whole, *I do not believe there will be confusion between the rival marks. Having found the dissimilarity in the marks, visually and aurally, the common idea conveyed by competing marks is not overriding or determinative.* In *Sports Cafe Ltd v Registrar of Trade Marks* (1998) 42 IPR 552, the court at 557 observed:

[T]he fact that two marks convey a common idea becomes relevant only if the marks themselves look or sound alike. Commonality of idea might then tip the balance in favour of a finding that the likeness is deceptive.

[emphasis added]

59 Reading the entire passage as a whole, it must be appreciated that the observation in *McDonald's (HC)* at [44] that:

[h]aving found the dissimilarity in the marks, visually and aurally, the common idea conveyed by competing marks is not overriding or determinative.

which was *preceded* by the observation that:

I do not believe there will be confusion between the rival marks.

referred to conceptual similarity not being “overriding or determinative” of the *likelihood of confusion* between the marks therein (*ie*, Condition 3: see [36(c)] above) and *not* to whether the words marks were *similar* (*ie*, Condition 1: see [36(a)] above). In these circumstances, Ozone’s reading of *McDonald’s (HC)* was incorrect in that it *conflated* Condition 1 and Condition 3, which as observed in *The Polo/Lauren Co (CA)*, are separate conditions.

60 The observation of the Australian Federal Court in *Sports Café Ltd v Registrar of Trade Marks* (1998) 42 IPR 552 (“*Sports Café*”) at [557] that:

... the fact that two marks convey a common idea becomes relevant *only* if the marks themselves look or sound alike. [emphasis added]

also merits closer scrutiny. This observation was made by the Federal Court in *Sports Café* after reviewing an extract from the earlier decision of *Cooper Engineering Co Pty Ltd v Sigmund Pumps Ltd* (1952) 86 CLR 536 (“*Cooper Engineering*”). In *Sports Café*, the Federal Court stated at 556-557 that:

### **The idea behind the mark**

In *Cooper Engineering* the application was for registration of the words “Rain King”. The opponent’s mark was RAINMASTER.

...

After pointing out the differences between the suffix “master” and the word “King” in appearance and sound [Dixon, William and Kitto JJ] continued (at 538-9):

The two words are so unlike to the eye and to the ear that counsel for the appellant was forced to rely on the likelihood of deception arising from the two words conveying the same idea of the superiority or supremacy of the article as a mechanism for making a spray similar to falling rain or artificial rain as it was called during the argument. But it is obvious that trade marks, especially word marks, could be quite unlike and yet convey the same idea of the superiority or some particular suitability of an article for the work it was intended to do. To refuse an application for registration on this ground would be to give the proprietor of a registered trade mark a complete monopoly of all words conveying the same idea as his trade mark. The fact that two marks convey the same idea is not sufficient in itself to create a deceptive resemblance between them, although this fact could be taken into account in deciding whether two marks which really looked alike or sounded alike were likely to deceive.

Thus the fact that two marks convey a common idea becomes relevant only if the marks themselves look or sound alike. Commonality of idea might then tip the balance in favour of a finding that the likeness is deceptive.

61 I could not agree with the narrow approach in *Cooper Engineering*. While I agreed that one should be slow to refuse registration of a mark simply on the basis of conceptual similarity alone, I was also of the view that it would be wrong to say that conceptual similarity would be relevant only if there was visual or aural similarity. As mentioned (at [\[42\]](#) above), the relative importance of each

type of similarity must necessarily vary with the circumstances in hand, in particular the goods and the types of mark being compared. The fact that one type of similarity is made out also does *not* necessarily mean that the marks are similar. To adopt an overly generalised and restrictive principle that conceptual similarity is *only* relevant to determining similarity between marks when either visual or aural similarity has been made out would be to ignore the fact that each aspect of similarity can vary in different degrees *vis-à-vis* each other depending on the circumstances, and trade-offs are entirely possible between the three aspects of similarity – for example, conceptual similarity can offset visual and aural dissimilarities. A similar approach was also adopted in *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77 (a decision which was followed by the High Court in *Richemont International SA v Goldlion Enterprise (Singapore) Pte Ltd* [2006] 1 SLR 401) at 84:

28. In order to assess the degree of similarity between the marks concerned, the national court must determine the degree of visual, aural or conceptual similarity between them and, where appropriate, evaluate the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed. [emphasis added]

In these circumstances, I was of the view that, in this instance, despite the word marks being visually and aurally dissimilar, conceptual similarity *nevertheless* deserved consideration.

62 The PAR's reasons for holding that Ozone's "HYSTERIC GLAMOUR" mark and AMP's "GLAMOUR" mark were conceptually *similar* have already been set out above at [15]. Against this, Ozone contended however that the two marks were conceptually *dissimilar*. It pointed out that while the word "GLAMOUR" was defined in the online *Merriam-Webster* dictionary as "an exciting and often illusory and romantic attractiveness", the usage of the word "HYSTERIC", which was defined in the *Longman Dictionary of the English Language* as "someone suffering from hysteria", changed the complexion of the word "GLAMOUR". According to it, although the concept of "GLAMOUR" was still present in "HYSTERIC GLAMOUR", the concept had varied because one does not associate "HYSTERIC" with "GLAMOUR". To support its position, it cited the case of *Itochu Corporation v Worldwide Brands, Inc* [2007] SGIPOS 9 ("*Itochu*"), where the marks under comparison were "CAMEL" and "SWEETCAMEL", as being "closely analogous" to the present factual matrix. In holding that these marks were conceptually *dissimilar*, the PAR in that case made the following observations at [37]:

37 Bearing in mind the Opponents' argument that the average consumer normally perceives the mark as a whole without analysing its various details - a principle which has also been relied on by the Applicants - and that marks should not be compared side by side as marks are generally remembered by general impressions rather than by recollection of the whole; *I find that there is no conceptual similarity between the Opponents' and the Applicants' marks. The Applicants' "SWEETCAMEL" mark does not convey the same idea and impression as the Opponents' marks. The Opponents' "CAMEL" marks evoke the sense of ruggedness, adventure and masculinity whereas the Applicants' mark which is preceded by the adjective "sweet" projects a totally opposite impression.* [emphasis added]

The decision in *Itochu* was upheld on appeal by the High Court.

63 In the present instance, while the PAR was of the view that the word "HYSTERIC" did modify the concept of "GLAMOUR" to a "certain point", the main concept of "GLAMOUR" had *not* been "completely reversed" as in *Itochu*. In this aspect, the PAR observed:

70 ... In this case, the HYSTERIC GLAMOUR mark still relies on the concept that they are 'glamorous', albeit injecting the new element of being 'hysterically glamorous'. From another point

of view this should still hold true; the concept of [Ozone] cannot be that the clothes do not look glamorous at all, otherwise it would frustrate the purpose of their mark, which is to sell designed clothes at a premium price.

71 I am of the view that the HYSTERIC GLAMOUR mark is in some way conceptually similar to the GLAMOUR mark in that both use the 'glamour' concept, one mark appeals to orthodox meaning of 'glamour' while the other mark gives a spin to it but still is based on 'glamour'. ...

64 I saw no reason to disturb the PAR's holding that the word marks in this case were "in some way" (as opposed to completely or to a large extent) conceptually similar. As Ozone conceded, the concept of "GLAMOUR" was still present in "HYSTERIC GLAMOUR".

65 The inquiry however does not stop here. The distinctiveness of AMP's "GLAMOUR" mark must also be considered at this stage.

(5) Distinctiveness of AMP's "GLAMOUR" word mark

66 In the present case, the PAR did not find it:

72 ... necessary to follow the principles [enunciated in *The European Ltd v The Economist Newspaper Ltd* [1998] ETMR 307] of descriptive elements allowing closer similarity...

because he was of the opinion that:

... that principle in particular should only act as a[n] advanced argument in case the basic analyses do not reveal any clear result.

67 This approach is however *contrary* to that set out above at [43]-[47] where the distinctiveness of the earlier trade mark is an important factor in the inquiry into the similarity between the marks under s 8(2)(b) TMA.

68 In these circumstances, I was of the view that the PAR had erred in failing to go *further* after considering the visual, aural and conceptual similarity of the word marks to consider the level of distinctiveness of AMP's "GLAMOUR" word mark in his inquiry into the similarity between the marks under s 8(2)(b) TMA.

69 In the present instance, there was no evidence before me to show that the word "GLAMOUR", which is an ordinary English word (see [62] above) and not an inventive word, is inherently distinctive. The word "GLAMOUR", the title of AMP's magazine, in fact *describes* the very nature of the content in AMP's magazine, which is described, on its website, as a magazine for young women interested in fashion, beauty and a contemporary lifestyle and which contains a number of photographs and advertisements displaying fashionable clothing and accessories. In my view, the word "GLAMOUR" is *not* inherently distinctive.

70 Has the word mark "GLAMOUR" then acquired distinctiveness through use in Singapore? To my mind, based on the limited and unsatisfactory evidence tendered by AMP which did little to support its claim that the "GLAMOUR" mark was extensively used in Singapore, this question must be answered in the negative. As evidence in support of its circulation figures between 1990 - 2002 (see [14] of the GD), AMP tendered *nine* invoices from STP Distributors Pte Ltd dated:

(a) 10 March 2000 to "TIMES THE BOOKSHOP PTE LTD" at Centrepoint Shopping Centre

- (“TIMES”) showing a sale of 30 “GLAMOUR” magazines;
- (b) 14 July 2000 to TIMES showing a sale of 40 “GLAMOUR” magazines;
- (c) 8 September 2000 to TIMES showing a sale of 40 “GLAMOUR” magazines;
- (d) 24 August 2001 to TIMES showing a sale of 30 “GLAMOUR” magazines;
- (e) 7 September 2001 to TIMES showing a sale of 50 “GLAMOUR” magazines;
- (f) 26 October 2001 to TIMES showing a sale of 30 “GLAMOUR” magazines;
- (g) 18 January 2002 to a “COLD STORAGE” supermarket outlet showing a sale of 30 “GLAMOUR” magazines;
- (h) 12 April 2002 to TIMES showing a sale of 30 “GLAMOUR” magazines; and
- (i) 13 September 2002 to TIMES showing a sale of 20 “GLAMOUR” magazines.

71 It may readily be observed that these nine invoices related only to sales in *specific* months in the *limited* period from 2000 to 2002. They did not reflect a monthly distribution from 1984 (the year AMP claimed its use of the “GLAMOUR” mark in Singapore started) and neither did they correspond to the total distribution figures submitted by AMP (see [14] of the GD). For example, although the invoice dated 24 August 2001 reflected only the sale of 30 copies of the September 2001 edition of the “GLAMOUR” magazine to TIMES, AMP claimed a distribution figure of 823 in September 2001. The nine invoices adduced supported only a fraction of the distribution figures claimed by AMP. Furthermore, the nine invoices related only to the distribution of the “GLAMOUR” magazine to *one* branch of TIMES (*viz*, the Centrepont outlet) and *a* single supermarket. There was nothing in evidence to support the promotion and/or subsequent sale of the “GLAMOUR” magazine to the Singapore public. In these circumstances, given the paucity of AMP’s evidence, I was of the view that it could not be said that the “GLAMOUR” mark had acquired distinctiveness through use in Singapore.

72 AMP sought to argue, without raising any relevant authority, that its “GLAMOUR” word mark was distinctive by virtue of the fact that it was a registered trade mark under the Act. However such a line of argument was rejected by the Court of Appeal in *The Polo/Lauren Co (CA)*:

23 ...Thus, the question of distinctiveness must be determined in the light of all the circumstances of the case. No authority has been cited to substantiate the assertion that the

fact of registration is conclusive as to the distinctiveness of a mark. Neither does it follow that the incorporation of an entire registered word mark would automatically lead to infringement. ...

(6) Conclusion on the overall similarity between the marks

73 Given my conclusion that Ozone's "HYSTERIC GLAMOUR" word mark and AMP's "GLAMOUR" word mark was visually and aurally *dissimilar*, but conceptually *similar*, and that "GLAMOUR" was merely descriptive and neither inherently distinctive nor distinctive by use, I was of the view that there was *no* similarity between the marks under s 8(2)(b) TMA. Strictly speaking, having arrived at this conclusion, it was not necessary, for the purposes of s 8(2)(b) TMA to go on to consider Condition 2 (see [36(b)] above) and Condition 3 (see [36(c)] above). Nevertheless, for the sake of completeness, I shall do so.

*Condition 2: Similarity of goods*

74 With regard to this requirement, the learned authors of *Bently & Sherman* note at p 869:

**2.3.2 When are goods or services similar?**

The question of whether goods or services are similar depends on the facts of the case. When deciding whether a trade mark application falls foul of one of the relative grounds for refusal, the comparison is normally between the goods or services for which the earlier mark has been registered and the goods or services to which the application relates. ...

75 The relevant factors for assessing similarity of goods covered by Ozone's "HYSTERIC GLAMOUR" word mark and AMP's "GLAMOUR" word mark are (see *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 ("*British Sugar*") at 296–297):

- (a) the respective uses of the respective goods;
- (b) the respective end users of the respective goods;
- (c) the physical nature of the goods;
- (d) the respective trade channels through which the goods reach the market;
- (e) in the case of self-serve consumer items, whether in practice they are respectively found or likely to be found on the same or different shelves; and
- (f) whether the respective goods are competitive or complementary. This inquiry may take into account how those in trade classify goods, for instance whether market research companies who act for industry put the goods or services in the same or different sectors.

These factors were adopted in *Johnson & Johnson* at [14] and *MediaCorp* at [41]. These factors need not all be satisfied before the goods can be treated as similar (*Johnson & Johnson* at [18]).

76 The learned authors of *Bently & Sherman* explain at pp 869-870 (footnotes omitted) how these factors were applied in *British Sugar vis-à-vis* a non-distinctive mark (as I had adjudged "GLAMOUR" to be (see [66]–[72] above) :

[*British Sugar*] illustrates how the courts have applied the factors in the case of a non-distinctive mark (namely TREAT). There the question was whether a sweet syrup to be poured over desserts

was similar to a sweet-flavoured spread. Jacob J concluded that the goods were not similar, explaining that the goods were used differently (the spread could be used on desserts but generally would not be); were not in direct competition; were located in different places in supermarkets (the spread with jams, the dessert sauce with desserts); were physically different (the spread was more viscous than the sauce); and were treated differently by market researches. In contrast in *Balmoral Trade Mark* [[1999] RPC 297,302], whisky and wine were held to be similar goods: although the two products have very different producers, it is common to find them being bought and sold by the same merchants, and sold through the same outlets.

77 As noted above at [17], the PAR however saw no reason to decide along the lines of the *British Sugar* factors (see [75] above) in coming to his conclusion that:

... the scope of [AMP's] description of goods ( "**Magazines, books and publications**" ) is clearly a sub-set of the goods of [Ozone] (in particular the mention of "**printed matter**" in the description of [Ozone's] goods).

[emphasis in original]

78 The PAR had also referred to an apparent concession by Ozone that "there may be an overlap [between AMP's goods and] the goods that [Ozone is] applying for". For convenience, it would be useful to set out the nature of the parties' respective goods:

Ozone's goods in Class 16	AMP's goods in Class 16
Paper and cardboard; industrial packaging containers of paper; towels of paper; table napkins of paper; hand towels of paper; handkerchiefs of paper; paper patterns; tailors' chalk; table cloths of paper; blinds of paper; banners of paper; flags of paper; baggage tags; <i>printed matter</i> ; paintings and calligraphic works; photographs, photograph stands; playing cards; stationery and study materials	<i>Magazines, books and publications</i>

In the course of the hearing before me, Ozone pointed out that its concession of an overlap with AMP's "magazines, books and publications" was *only* limited to "printed matter" and did *not* extend to "paper and cardboard; industrial packaging containers of paper; towels of paper; table napkins of paper; hand towels of paper; handkerchiefs of paper; paper patterns; tailors' chalk; table cloths of paper; blinds of paper; banners of paper; flags of paper; baggage tags...paintings and calligraphic works; photographs, photographs stands; playing cards; stationery and study materials" ("Ozone's other goods"), which according to Ozone were "very different" from "magazines, books and publications". Ozone submitted that Ozone's other goods could "be broadly classified into stationery, hygiene paper products labels/banners/blinds made of paper and photographs" and that applying the *British Sugar* test, Ozone's other goods were different in function from "magazines, books and publications". Ozone contended that the parties' respective target consumers were also different as people buying magazines would not be purchasing "stationery, hygiene paper products labels/banners/blinds made of paper and photographs" as alternatives and accordingly the compared goods were not in competition. The trade channels were also different. While AMP's "magazines, books and publications" were likely to be sold at newsstands and bookstores, Ozone's other goods would be sold at supermarkets, furniture stores or bookstores and that even if Ozone's other goods were sold in the same stores, they would be placed at different sections of the store as "magazines

are not usually placed together with stationery, hygiene paper products labels/banners/blinds made of paper and photographs”.

79 Ozone referred to the decision of *In the Matter of Application No 2242582A by the Secretary to the Quorn Hunt to register a series of trade marks in Classes 9, 13, 16, 18, 21, 25 and 41 and In the Matter of Opposition No 90056 by Marlow Foods Limited (O-319-04)* [\[note: 11\]](#) (“Marlow Foods”) where the respective goods in Class 16 being compared were as follows (see para 28):

Applicant’s Goods in Class 16	Opponent’s Goods in Class 16
<i>Printed matter, stationery, writing and drawing instruments, cards, postcards photographs, pictures, calendars, coasters, posters, diaries, instruction manuals; but not including any such goods relating to food preparation</i>	Printed matter, books and periodicals concerning the use of myco-protein in food preparation.

[emphasis added]

The compared marks were similar (*ie*, Condition 1 was satisfied). The hearing officer found that the goods “printed matter, “cards”, “calendars” and “diaries” were similar to the Opponent’s goods but allowed the Applicant’s mark to proceed to registration in respect of the remaining goods, *viz*, “... stationery, writing and drawing instruments, cards, postcards photographs, pictures, ...coasters, posters [and] instruction manuals” which were considered dissimilar.

80 I found Ozone’s arguments and the approach in *Marlow Foods* practical and sensible. In these circumstances, I was of the view that although “printed matter” in Ozone’s goods were *similar* to AMP’s goods (*viz*, “magazines, books and publications”), Ozone’s other goods were *dissimilar*. Accordingly, I was of the view that the PAR had erred in finding that Ozone’s other goods were similar to AMP’s goods (*viz*, “magazines books and publications”). Accordingly, I was of the view that Condition 2 was thus satisfied *only* to the extent as described. I now move on to examine Condition 3.

*Condition 3: Likelihood of confusion on the part of the public*

81 As stated above at [\[37\]](#), *even* where the marks are similar *and* the goods are similar, this does not mean that there will *ipso facto* be confusion in the mind of the public. There is *no* presumption of confusion even where these two aspects of similarity are made out (*The Polo/Lauren Co (CA)* at [8]).

82 The learned authors of *Bently & Sherman* elaborate at p 872 (footnotes omitted) as to what the public must be confused about:

**2.3.3 Likelihood of confusion**

...

What must the public be confused about? The next question to consider is what is meant by ‘likelihood of confusion’ in [s 8(2)(b) TMA]? In its ‘classic form’, *consumers must be confused about the source or origin of the goods or services – that is, they must be confused as to the designer, manufacturer, selector or supplier of the goods or services. In other words, classic confusion is concerned with the situation where consumers believe that the goods or services emanate from one organization, but they, in fact come from a different independent*

*organization. This classic form of confusion has been extended to accommodate broader understandings of the source of goods or services. Consequently, a person will be confused for the purposes of [s 8(2)(b) TMA] if they incorrectly assume that there is some broader kind of economic connection between the users of marks, for example, that the goods are being provided by a subsidiary or licensee of the trade mark owner. ...*

*In considering whether there is a likelihood of confusion, the tribunals must consider whether there is a genuine and properly substantiated likelihood of confusion: it is not enough that confusion is hypothetical and remote. The term 'likelihood' indicates probability rather than possibility.*

[emphasis added]

83 As to what constitutes "likelihood of confusion", these principles, as distilled from previous cases, were succinctly laid out in *MediaCorp* (which had similarly dealt with s 8(2)(b) TMA) at [43]:

43 The following principles as to what constitutes "likelihood of confusion" can be distilled from the cases:

(a) The court is entitled to look outside the mark and the sign, as well as the articles, to assess whether there exists a likelihood of confusion (*[The Polo/Lauren Co (CA)]* at [8]).

(b) The question of likelihood of confusion has to be looked at globally taking into account all the circumstances including (*[The Polo/Lauren Co (CA)]* at [28]):

(i) the closeness of the goods;

(ii) the impression given by the marks;

(iii) the possibility of imperfect recollection;

(iv) the risk that the public might believe that the goods come from the same source or economically-linked sources;

(v) the steps taken by the defendant to differentiate the goods from those of the registered proprietor; and

(vi) the kind of customer who would be likely to buy the goods of the applicant and opponent.

(c) One should not determine the likelihood of confusion based on the man in a hurry, and the test should be the "ordinary, sensible members of the public" (*[The Polo/Lauren Co (CA)]* at [31]). The average consumer is someone who would exercise some care and good sense in making his purchases (*[The Polo/Lauren Co (CA)]* at [34]). However, the "average consumer" need not necessarily mean the general public, as more specialised products might be purchased by a more specific cross-section of the public (*Nation Fittings (M) Sdn Bhd v Oystertec Plc [2006] 1 SLR 712* at [97]).

(d) The ambit of the protection offered by the Act to a registered proprietor of a trade mark should be guided by the underlying aim of the trade marks regime, which is to ensure that consumers do not confuse the trade source of one product with another (*[The Polo/Lauren Co (CA)]* at [32]). The policy of s 8 [TMA] is to protect the public against

deception. In *Weir Warman Ltd v Research & Development Pty Ltd* [2007] 2 SLR 1073, V K Rajah JA observed that (at [41]):

It is plain that the trade mark register is intended to be a comprehensive and accurate record of trade marks currently in use. As such, it is crucial to maintain the accuracy of the register and to ensure that undeserving and invalid trade marks are removed from the register without undue delay and complication. In addition, the register is meant to assure and endorse the function of registered trade marks as badges of origin ... so as to protect the public against deception. Hence marks that are misleading or likely to cause confusion or no longer serve their function should not be accepted or allowed to remain on the register, as the case may be.

[emphasis added]

To this end, mere association which the public may make between two trade marks because of their semantic content is not in itself a sufficient basis for concluding that there is a likelihood of confusion, in the absence of any possibility of a misapprehension as to the origin of the goods and services (*Richemont International SA v Da Vinci Collections Pte Ltd* ("Richemont") [2006] 4 SLR 369 at [20]).

(e) The greater the exposure and use of a particular registered mark, the greater its reputation is likely to be, and therefore the greater the protection likely to be afforded to it ([*The Polo/Lauren Co (CA)*] at [34]).

84 It appears that the court is entitled to look outside the mark and the sign, as well as the articles, to assess whether there exists a likelihood of confusion. This proposition was in fact extracted from *The Polo/Lauren Co (CA)* (which was a trade mark *infringement* action under s 27(2) (b) TMA), which had, in turn, relied on *Kellogg Co v Pacific Food Products Sdn Bhd* [1999] 2 SLR 651 and *McDonald's (CA)*, both of which were trade mark *registration* oppositions pursuant to s 15 of the Trade Marks Act (Cap 332, 1992 Rev Ed). The Court of Appeal in *The Polo/Lauren Co (CA)* stated that:

### **The approach to section 27(2) of the Act**

5 Section 27(2) of the Act reads:

A person infringes a registered trade mark if, without the consent of the proprietor of the trade mark, he uses in the course of trade a sign where because —

(a) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered; or

(b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered,

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

...

8 In our opinion, having examined the express wording of s 27(2)(b), the step-by-step approach adopted in *British Sugar* is conceptually more appropriate and is in line with the

structure of the provision. It seems to us that there will be infringement under that provision only if three conditions are present. First, the alleged offending sign must be shown to be similar to the registered mark. Second, both the sign and the mark must be used in relation to similar goods or services. Third, on account of the presence of the first two conditions, there exists a likelihood of confusion on the part of the public. As the judge rightly pointed out, s 27(2)(b) does not make it an infringement if the likelihood of confusion is caused by some other factor. While we can see some link and overlap between the first and the third conditions, it is clear that they are different. The fact that a sign is similar to a registered mark does not automatically mean that there will be a likelihood of confusion on the part of the public. That is a question of fact to be determined by the court, taking into account all the relevant circumstances. Moreover, the question of similarity is really a matter of degree. In a broad sort of sense, the greater the similarity between a mark and a sign, the greater will be the likelihood of confusion. However, if either of the first two conditions is not satisfied there will not be any need to go into the third question of determining whether there exists a likelihood of confusion. Neither does it mean that if the mark and the sign are similar, and they are used on similar goods, that there will *ipso facto* be confusion in the minds of the public. If that was intended, s 27(2)(b) would have been phrased differently. As presently worded, there is no presumption of confusion once the two aspects of similarity are present. *To determine the existence of confusion, the court is entitled to look outside the mark and the sign, as well as the articles, to assess whether there exists a likelihood of confusion: see Kellogg Co v Pacific Food Products Sdn Bhd [1999] 2 SLR 651 and McDonald's Corp v Future Enterprises Pte Ltd [2005] 1 SLR 177. While these two latter cases related to opposition proceedings under s 15 of the then Trade Marks Act (Cap 332, 1992 Rev Ed), there is no reason why the concept of "likely to cause confusion" under that provision should be any different from the concept of "likelihood of confusion" under the present s 27(2)(b).* As we see it, the global assessment test is likely to confound the final issue of confusion with the first two prerequisite conditions. Accordingly, we endorse the *British Sugar* approach which was adopted by Lai J.

[emphasis added]

85 Ozone also referred to the decision of Kitchin J in the English High Court decision of *Julius Sämaan Ltd v Tetrosyl Ltd* [2006] FSR 42 ("*Julius Sämaan*"), which involved, *inter alia*, a trade mark infringement action. The relevant portion of the decision, at 872, reads:

52 There is one further general principle which is important to have in mind at the outset in considering infringement. The court must consider the likelihood of confusion arising from the use by the defendant of the offending sign, discounting added matter or circumstances. *If the sign and the mark are confusingly similar then the defendant cannot escape by showing that by something outside the actual mark itself he has distinguished his goods from those of the proprietor.* In the present case this is important. *Looking at the box in which the Christmas Tree product is sold, the use of the words "Lumber Jack Flashing air freshener" must be ignored, as must the particular circumstance in which the product is sold. The comparison to be made is between, on the one hand, the Tree marks and, on the other, the Christmas Tree product itself, and the picture of it which appears on the box.* [emphasis added]

86 As may be seen, the approach advocated in *Julius Sämaan* to determining the likelihood of confusion, which does *not* look outside the marks, is *different* from that adopted in *The Polo/Lauren Co (CA)* which "look[s] outside the mark and the sign, as well as the articles, to assess whether there exists a likelihood of confusion". This difference was in fact noted at [18]-[20] of *The Polo/Lauren Co (HC)*, with reasons offered as to why the latter approach (*ie*, that adopted in *The Polo/Lauren Co (CA)*) should be favoured:

18 However, while the global assessment test should be rejected, I am equally uncomfortable with a strict adherence to old English jurisprudence. In particular, both parties appeared to agree that *the test for the likelihood of confusion under this approach is an exceedingly narrow one. Once a mark is shown to offend, the user "cannot escape by showing that by something outside the actual mark itself he has distinguished his goods from those of the registered proprietor"*: [*Saville Perfumery Ld v June Perfect Ld and F W Woolworth & Co Ld* (1941) 58 RPC 147] ([11] *supra*) at 161. If this is a correct interpretation of the case, I would decline to follow this lead for the following reasons.

19 Firstly, it is worthwhile to note that even the English cases appear to differ on whether this is the correct approach. In *June Perfect* itself, Sir Wilfrid Greene MR, at 161–162, went on to remark that the degree of similarity required for a likelihood of confusion to be caused depended on, for example, the goods in question. Where the customers of the goods in question were not the sort who would be too careful about the details of the mark and would only remember some distinguishing feature, it would require very little for the likelihood of confusion to be caused. If, on the other hand, this is not the case, then it would require “nothing short of a degree of resemblance apparent to the eye” for there to exist a likelihood of confusion. Thus, the court is allowed to look outside the marks in order to assess how similar the marks must be for there to exist a likelihood of confusion. *Origins Natural Resources Inc v Origin Clothing Limited* [1995] FSR 280 (“*Origins*”) is of no use because the remark there that external added matter or circumstances should be discounted was made in relation to the defendant’s claim that since it and the plaintiff were trading in different markets and in different countries, the likelihood of confusion could never arise. Jacob J, in that case, rightly held that the courts must assume that the mark would be used in a normal and fair manner. Plaintiffs do not need to show that there is actual confusion: *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41; *In the matter of an Application by Edward Hack for the Registration of a Trade Mark* (1941) 58 RPC 91. It is also important to note that in both these cases, there was no discussion of an earlier case, *In the matter of an Application by the Pianotist Company Ld for the Registration of a Trade Mark* (1906) 23 RPC 774 (“the *Pianotist* case”), which was affirmed in *Sime Darby Edible Products Ltd v Ngo Chew Hong Edible Oil Pte Ltd* [2000] 4 SLR 360 (“*Sime Darby*”). In the *Pianotist* case, Parker J, at 777, having reviewed the decisions that came before, summarised the position of the law as such:

You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. ... If, *considering all those circumstances*, you come to the conclusion that there will be a confusion ... then you must refuse the registration in that case. [emphasis added]

In *Wagamama* ([11] *supra*), the court also did not consider the *Pianotist* case. Nonetheless, Laddie J was equivocal about whether the court was to find a likelihood of confusion notwithstanding that the alleged infringer had taken steps to differentiate his products from the plaintiff’s. For instance, he remarked, at 720–721, that:

If ... the marks were too similar, *usually* infringement would be found even if in the market place the infringer took steps to prevent confusion in fact occurring ... To this extent therefore, *a registered trade mark created a monopoly which might sometimes go beyond what was strictly necessary to protect the proprietor’s goods and his reputation*. [emphasis added]

I am in agreement with this observation. *The protection that the law offers to a registered*

*proprietor of a trade mark is wide but it is not infinite. The ambit of that protection should be guided by the underlying aim of a trade marks regime, which is to ensure that consumers do not confuse the trade source of one product with another. For instance, where the consideration of other matters can assist the court in drawing the line at cases where the likelihood of confusion is merely imaginary, there is no reason not to do so. Otherwise, the law will end up extending protection where none is needed.*

20 Secondly, the Singapore cases deciding on the question of the likelihood of confusion, although mostly involving an opposition to the registration of a sign, have been much clearer and more consistent in allowing the consideration of these extraneous factors. In *Sime Darby*, Lim Teong Qwee JC quoted and applied Parker J's summation of the law on the issue of confusion which I quoted at [19] above. In *Kellogg Co v Pacific Food Products Sdn Bhd* [1999] 2 SLR 651 ("*Kellogg*"), the Court of Appeal considered an opposition to the registration of a mark under s 15 of the Trade Marks Act (Cap 332, 1992 Rev Ed). It was held, at [30] and [33], that the likelihood of confusion was to be determined on the basis of several factors, including the actual use of the mark, the reputation of the earlier mark and the packaging of the goods. More recently, in [*McDonald's (CA)*] ([14] *supra*), the Court of Appeal held, at [66], that:

[T]he question whether a proposed mark will likely give rise to confusion on account of some similarity with an existing mark is a question of fact depending on all the circumstances of the case. Besides comparing the marks, also germane are the extent of the reputation of the existing mark, how the proposed mark is to be used, the nature of the goods to which the mark will be put, how the goods are to be sold and who the target customers are: see *In the Matter of an Application by the Pianotist Company Ltd* (1906) 23 RPC 774 at 777. Obviously, these considerations are not exhaustive.

I am not convinced by the plaintiff's submission that these cases should be distinguished simply because they dealt with unregistered marks. Under the relevant statute being considered by the courts in those cases was a requirement of the mark being "likely to deceive or cause confusion". Surely it cannot be argued that this is any different than the requirement of a "likelihood of confusion" under s 27(2)(b) of the current TMA.

21 Finally, *turning to the plain words of s 27(2)(b) of the TMA, I find that a proper construction of the provision does not reject the court's discretion in assessing so-called extraneous factors when deciding whether there is a likelihood of confusion. The only thing that the statute calls for is that the likelihood of confusion arises from the similarity. But where the user of a potentially infringing sign has taken pains to distinguish his products from the registered proprietor's good [sic] and services, the effect may be that the likelihood of confusion, if any, is merely hypothetical or speculative.* This is significant because unlike s 27(1) TMA, s 27(2)(b) does not presume that there is a likelihood of confusion. If there is no likelihood of confusion, there can be no infringement: *Pan-West (Pte) Ltd v Grand Bigwin Pte Ltd* [2003] 4 SLR 755 at [12]. Section 27(2)(b) TMA also does not forbid the court taking into account various factors in deciding the degree of similarity required in order to find that there exists a likelihood of confusion.

22 Having reviewed the cases, and confining myself strictly to what is required to decide the present case, I am of the opinion that *there are two ways in which factors extraneous to the mark come into play. One is to establish the strength of the similarity required in order to decide the question of whether there exists a likelihood of confusion. ...*

*The court cannot know what degree of similarity causes confusion unless it is able to assess, for*

*instance, the trading circumstances of the goods in question and therefore the standard of care that the ordinary consumer will exercise in that particular case. The other is this. Where the court finds that there is a likelihood of confusion by reason of the similarity, the court must go on and enquire whether this likelihood is a real one or whether it is merely speculative or hypothetical. Where the infringer has taken sufficient steps to distinguish his goods from the plaintiff's such that the likelihood of confusion becomes a mere possibility, there is no infringement. Of course, there is no need for plaintiffs to demonstrate that there is actual confusion. However, the courts are not to hold that there is a likelihood of confusion on the basis of "highly speculative eventuality": McDonald's, at [59]...*

[emphasis added]

87 Although *The Polo/Lauren Co (CA)* was a trade mark *infringement* action under s 27(2)(b) TMA, the Court of Appeal in that case was of the view that s 8(2)(b) of the TMA should be *similarly* construed:

15 It is of interest to compare *Polo Textile* with *10 Royal Berkshire Polo Club Trade Mark* [2001] RPC 32 ("*Royal Berkshire*") where an application to register the mark "10 Royal Berkshire POLO CLUB" was opposed by the same party as the appellant in the present case. The relevant English statutory provision read:

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, which includes the likelihood of association with the earlier trade mark.

It would be noted that the material part of the wording of this English provision (except for the last phrase "which includes the likelihood of association with the earlier trade mark") is identical to our s 8(2) of the Act. It is also similar to our s 27(2)(b) (except again for the last phrase). *Of course, this English provision (as our s 8(2)) relates to refusing the registration of a mark, rather than the infringement of an existing mark. However, we do not think this distinction should mean that the meaning to be given to s 27(2)(b) should be any different from that ascribed to s 8(2) or the equivalent English provision considered in Royal Berkshire.* In addition, we also do not think that the inclusion of the ending phrase in the English provision in any way enlarges its meaning. Confusion as to trade origin is already encompassed in the earlier part of the provision: see Christopher Morcom, Ashley Roughton & James Graham, *The Modern Law of Trade Marks* (Butterworths, 1999 Ed) at p 208.

[emphasis added]

Nevertheless, where, as in the present case, there was not much evidence as to how Ozone intends to apply its mark or to distinguish its goods from AMP's in Singapore, the consideration of factors other than the marks themselves would be limited, although the consideration of other factors was in principle permissible.

88 In the course of the hearing before me, AMP produced a copy of a magazine, which was a

"25th anniversary book" bearing the "HYSTERIC GLAMOUR" word mark, which had been purchased from a bookstore in Singapore in September 2009. However, in my view, this itself did not constitute much evidence about Ozone's intentions in Singapore with its mark.

89 As stated above at [19], the PAR had identified the relevant segment of the public to be "the entire group of women who read magazines for leisure and [who] are fashion conscious." I agreed with this classification. However, I would add that as noted at [36] of *The Polo/Lauren Co (HC)*:

### ***The likelihood of confusion***

...

36 The average consumer in Singapore has been described as *literate, educated, exposed to the world and unlikely to be easily hoodwinked*: (*Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd* [1991] SLR 133)([23] *supra*) at 143–144, [30]; and [*McDonald's (CA)*] at [64]. This is the starting point. [emphasis added]

90 Furthermore, in the context of the average consumer of *magazines* and their purchasing habits, it has been noted in *In the Matter of Application No 2136517A in the name of IPC Magazines Limited to register a trade mark in Classes 9, 16 & 35 and In the Matter of Opposition thereto under No 50532 by Liberty Media for Women LLC* [note: 21] that:

36. Magazines are primarily obtained by self-selection, which makes the visual appearance of the title (or trade mark) of primary importance. They are usually displayed alongside other magazines, grouped according to subject matter. It is possible that a women's magazine could be displayed alongside, or in the proximity of one for teenagers and young women, which would afford a side-by-side comparison. I cannot, however say that that would necessarily be the case, particularly in circumstances where the magazine is obtained by subscription. There are circumstances when oral use, such as a consumer making an enquiry regarding the availability of a publication will be of relevance. *Although magazines are relatively inexpensive items, the consumer is, I consider, reasonably discerning in the selection, where able, often picking up the magazine to glance through its contents prior to making the decision to purchase.* [emphasis added]

91 In these circumstances, given my conclusion that there was *no* similarity between Ozone's "HYSTERIC GLAMOUR" mark and AMP's "GLAMOUR" mark under s 8(2)(b) TMA (see [73] above), and bearing in mind the characteristics of the average consumer who would be likely to buy the goods of Ozone and AMP (see [82]-[83] and [89] above) and who would "exercise some care and good sense in making his purchases" (see [83] above), I was of the view that even for "printed matter", let alone Ozone's other goods, the ordinary Singaporean would have little difficulty discerning that Ozone's goods bearing the "HYSTERIC GLAMOUR" mark are not from the same trade source or origin as AMP's goods bearing the "GLAMOUR" mark. In this aspect, it would be useful to refer to *In the Matter of Application No 1568121 in the name of Global Spa and in the matter of Opposition thereto under No 45679 in the name of Advance Magazine Publishers Inc.* [note: 31] Here, the United Kingdom Intellectual Property Office Hearing Officer, adopting a similar stance, observed as follows:

*Titles of magazines by their nature tend to make varying degrees of reference to their subject matter or target readership, and consequently many have a low level of distinctiveness. The word GLAMOUR is no exception. It is an ordinary and well known word in the English language which readily conveys the idea of clothing, make-up, etc, and given that the opponents say that their magazine sold under the GLAMOUR trade mark is well known for its features relating to fashion and related topics I consider that it falls into the category of a mark with a low degree*

*of distinctiveness. I make this observation only insofar as to say that as it is not the strongest of marks this is likely to impact on customer perception of the mark and the issue of confusion.*  
[emphasis added]

I should add that this observation was made even though the opponents in that case, AMP, had claimed, as in this case (see [7] above), that the "GLAMOUR" mark had been registered in several other countries. Furthermore, it bears mention also that, as stated at paras 10 and 11 of the statutory declaration declared in Japan on 5 December 2006 by Mr Noriyuki Yamagani (see [8] above), that AMP's "GLAMOUR" mark in Class 16 covering:

Printed matter (magazines, newsletters and books; computer programs); paper products (posters, paper patterns)

and Ozone's "HYSTERIC GLAMOUR" mark in Class 16 covering:

Paper and cardboard; industrial packaging containers of paper; towels of paper; table napkins of paper; hand towels of paper; handkerchiefs of paper; paper patterns; tailors' chalk, table cloths of paper; blinds of paper; banners of papers; flags of paper; baggage tags; printed matter; paintings and calligraphic works; photographs, photograph stands; playing cards; stationery and study materials

have in fact *co-existed* on the United Kingdom Trade Marks Register since 2001.

*Overall conclusion on AMP's opposition under s 8(2)(b) TMA*

92 For all the foregoing reasons, I was thus of the view that AMP's opposition to the registration of Ozone's "HYSTERIC GLAMOUR" word mark in Class 16 pursuant to s 8(2)(b) TMA should *not* succeed. The PAR's decision on this provision was accordingly *reversed*. I now proceed to examine AMP's opposition pursuant to s 8(4) TMA.

#### ***AMP's opposition under s 8(4) TMA***

93 As stated above at [28], AMP contended that the PAR had erred in holding that the law of passing off would not prevent Ozone's use of the "HYSTERIC GLAMOUR" word mark pursuant to s 8(4) TMA.

94 It is trite that for AMP to succeed in an action for passing off, it had to prove the following classical trinity of elements, *viz*:

(a) a goodwill or reputation attached to the goods and services it supplies in the mind of the purchasing public by association with the identifying "get-up", such that the "get-up" is recognised by the public as distinctive specifically of AMP's goods or services;

(b) a misrepresentation by Ozone to the public (whether or not intentional) leading or likely to lead the public to believe that the goods offered by Ozone are the goods of AMP; and

(c) that it is likely to suffer damage by reason of the erroneous belief engendered by Ozone's misrepresentation that the source of its goods is the same as the source of those offered by AMP.

(See the decisions of the Court of Appeal in *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR 216 ("*Amanresorts*") at [36]-[37] and *City Chain Stores (S) Pte Ltd v Louis Vuitton*

*Malletier* [2009] SGCA 53 (“*City Chain*”). As these three elements were correctly identified by the PAR (see [21] above), I needed only to examine whether the PAR had erred in *applying* these three elements to the facts of the present case.

*Element 1: Goodwill or reputation*

95 In the submissions before me, goodwill and reputation were referred to interchangeably. For present purposes, I will refer to goodwill only. The two essential features of goodwill, which is a question of fact, were summarised recently in *City Chain* as follows:

62 In [*Amanresorts*] at [39], this court held that *the two essential features of goodwill are that “it is the association of a good, service or business on which the plaintiff’s mark, name, labelling, etc ... has been applied with a particular source” and “this association is an ‘attractive force which brings in custom’”. Proving goodwill or distinctiveness is a question of fact. Relevant factors include advertising, trading, volume of sales, and whether it has been registered. But the fact that the mark or indicia is not novel does not mean that it cannot be distinctive of the plaintiff’s goods or services (see *Halsbury Laws of Singapore* vol 13(3) (LexisNexis Singapore) at para 160.8172007). [emphasis added]*

96 It bears mention that where a case involves indicia which are *descriptive* of the goods or services in question (as in this case: see [69] above), the law imposes a *higher* burden on the plaintiff (*ie*, AMP) when proving the existence of his goodwill. The leading decision in this aspect is that of the Court of Appeal in *Lifestyle 1.99 Pte Ltd v S\$1.99 Pte Ltd (trading as ONE.99 SHOP)* [2000] 2 SLR 766 (“*Lifestyle 1.99*”). The facts of and principles stated in that case have been helpfully summarised in *Law of Intellectual Property in Singapore* at p 209 as follows:

**[17.1.15]**.. The plaintiff was the owner of a chain of retail shops which operate under the mark *ONE.99 SHOP*. These outlets sold goods ranging from snack and other foodstuff to cosmetics, fashion accessories, stationery and common household items. The important characteristic of the plaintiff’s business was that all these goods were priced at S\$1.99. The plaintiff was the first in Singapore to start a ‘one-price store’ business. About 1-½ years later, the defendant opened its retail outlets under the mark *Lifestyle 1.99*, selling various goods sold at prices with 99 cents (S\$1.99, S\$3.99, to S\$9.99). On the question whether the plaintiff had acquired goodwill in the mark *ONE.99 SHOP*, the Court of Appeal laid down the legal principles as follows:

(a) The law treats quite differently the mark of a business depending on whether the mark is descriptive or ‘fancy’.

(b) A mark which is *prima facie* descriptive will only be protected if it can be shown to have acquired a ‘secondary meaning’, that is, it has become distinctive of the plaintiff’s business. ‘Distinctive’ is a term of art in the law of passing off. In relation to a mark, this means that the mark denotes the goods of the plaintiffs to the exclusion of other traders.

(c) The fact that a mark is descriptive does not mean that it cannot become distinctive, although it would be difficult to prove. A very great burden is placed on the plaintiff to prove that the mark has acquired a secondary meaning.

...

97 In a similar vein, in *Johnson & Johnson*, where the registered mark was “Carefree” and the mark sought to be registered was “Careree”, the court noted:

24 *In regard to goodwill, it must [be] borne in mind that "Carefree" is a descriptive word and while it is possible for a descriptive word to become associated with goodwill, the courts are slow to allow anyone to claim a monopoly of descriptive words: see Nippon Paint (Singapore) Co Pte Ltd v ICI Paint (Singapore) Pte Ltd [2001] 1 SLR 1 and Super Coffeemix Manufacturing Ltd v Unico Trading Pte Ltd [2000] 3 SLR 145. All the same, in appropriate cases, the courts have held that descriptive words have taken on a "secondary meaning" or become "distinctive in fact". An example is "Mothercare", which is synonymous with the company that sells clothes for pregnant women and young children. ... [emphasis added]*

98 In the present case, bearing in mind the *greater* burden of proof on AMP (in light of my earlier finding that the "GLAMOUR" word mark is purely descriptive: see [69] above), I was of the view that the PAR had *erred* in concluding that there was goodwill (see [22] above). Given the unsatisfactory nature of the evidence tendered by AMP to show volume of sales (*viz*, the nine invoices: see [70] above) as elaborated above at [71] and the lack of evidence of *any* promotions or advertisements undertaken by AMP in Singapore, it cannot be said that the "GLAMOUR" word mark has acquired a "secondary meaning". As the PAR observed:

88 [AMP claims] that the use in Singapore started from 1984, but there does not seem to be good evidence that the magazines started selling in Singapore from that time, only a table and random invoices that do not date beyond the year 2000. [Ozone states] that the circulation numbers for Singapore are not impressive, 903 copies at its highest only. The Opponents have submitted that this is high relative to the numbers of other publications that are sold, as evidenced by the invoices from their distributors. *However, the number 903 copies sounds to me like a number that is disproportionately low for the population of Singapore that is around 3 million at that time.*

...

93 ... [T]he circulation numbers in Singapore are unimpressive, and there is no advertising in Singapore to increase its recognition of [AMP's] marks. [emphasis added]

99 The paucity of evidence in the present case must be contrasted with the ample evidence in *Lifestyle 1.99* of the plaintiff's goodwill. As stated in *Law of Intellectual Property in Singapore* at pp 210-211:

**[17.1.18]** In [*Lifestyle 1.99*], the plaintiff succeeded in discharging this higher burden of proof. The court was impressed with the plaintiff's sales turnover (S\$10.4m in the first two years of operation was substantial in the light of the very low price of each item), the extensive advertisements and media coverage on the plaintiff's business, and the fact that some 48% of the people surveyed were aware or had heard of the *One.99 Shop* and at least 40% knew where the outlets were located. The court found that all this evidence pointed to some goodwill in the plaintiff's business. ...

100 In these circumstances, I was of the view that AMP had failed to establish the element of goodwill (see [94(a)] above). In the light of this conclusion, there was no need for me to set out my views on the second element of misrepresentation (see [94(b)] above) but I shall do so for the sake of completeness.

#### *Element 2: Misrepresentation*

101 With regard to the element of misrepresentation, the learned author of *Law of Intellectual*

*Property in Singapore* notes at p 225 (footnotes omitted):

**[18.0.1]** The key element here is deception. The court is concerned with the following question: *has the defendant made a false representation that led to, or is likely to lead, to deception or confusion amongst the public? The nature of the deception or confusion may relate to the trade source of the goods or services, or to the quality of the goods or services. ...*

**[18.0.2]** *Although the key element is deception, it is not necessary to prove that the defendant has an intention to deceive or mislead the public. For this reason, it has been said that the state of the mind of the defendant is immaterial; rather, what matters is the impact on the persons to whom the misrepresentation is addressed. If the impact on these persons is such that they would be deceived, the element of misrepresentation is made out and the defendant cannot avoid a finding of passing off by the mere fact that his goods are of as good or better quality than the plaintiff's, or that the misrepresentation was made innocently.*

[emphasis added]

102 It would also be useful to refer to *Amanresorts* which confirms that confusion is an essential element of the tort of passing off. As stated in the headnote:

(4) On the issue of misrepresentation, the *target audience of misrepresentation in a passing off action was the actual and potential audience of the claimant. Misrepresentation was actionable only if it caused confusion and while there was no need to show actual confusion, the court had to assess whether there was a likelihood of confusion from the surrounding facts, based on the average reasonable person, with characteristics reflective of the relevant section of the public.* Relevant factors in this case included whether there was any fraudulent intention in using the name "Amanusa" for the housing project, and whether the business of the Appellant and the Respondents were in the same field or closely related fields. The identical names, the similar Balinese themes, and the presentation of the Appellant's housing project as high-quality accommodation were factors increasing the likelihood of confusion... [emphasis added]

103 Be that as it may, where a *descriptive* mark is adopted by a plaintiff, a *slight* difference between the plaintiff's mark and the defendant's mark is sufficient to distinguish them and to undo any possibility of confusion in the mark (see *Law of Intellectual Property in Singapore* at p 211, para 17.1.18, and *Lifestyle 1.99* at [39]).

104 In the present case, the PAR had concluded that there was no misrepresentation because Ozone was not attempting to "mislead or deceive the public as to the origin of the goods":

101 In the present case, I have made the decision that the marks are confusingly similar for the purposes of Section 8(2). However, in paragraph 78 above, I had described that it does not appear to me, on the evidence, that there is any effort to imply that the Applicants' mark is a spin-off mark. Each of [Ozone's] and [AMP's] advertising retain its own special flavour, with no attempt to copy each other's style. *This evidence also goes to show that there is clearly no misrepresentation here, as there is no attempt where [Ozone is] trying to mislead or deceive the public as to the origin of the goods.* [emphasis added]

105 The PAR had made his ultimate finding that there was no misrepresentation on the basis that there was no attempt on the part of Ozone to mislead or deceive the public as to the origin of the goods. This basis of the PAR's conclusion was incorrect because with regard to the element of misrepresentation, what the courts are concerned with is the effect of Ozone's conduct on the actual

and potential audience of AMP (see [\[102\]](#) above) and there can be a misrepresentation even if it was made *innocently* (see *Johnson & Johnson* at [25]). On the other hand, Ozone's state of mind would have been a relevant consideration in finding an increased likelihood of confusion if Ozone had been found (there was no evidence of this in this case) to have had an intention to mislead or deceive. As noted in *Law of Intellectual Property in Singapore* at pp 230-231:

**[18.4.6]** Proof of an intention to deceive is not a necessary ingredient in this second element, but if such an intention is established, the burden on the plaintiff to show confusion is lessened.

...

106 AMP contended that the PAR had "committed a further material error of principle by restricting his analysis to whether there was any confusion...to the origin of the goods as evident from his conclusion that 'there is no attempt where [Ozone was] trying to mislead or deceive the public as to the *origin of the goods*'. [emphasis added]. According to AMP, the "PAR's restriction of the analysis as such defies established law that confusion under the law of passing off is not limited to confusion as to the origin of [Ozone's] goods".

107 I accepted the *general* principle that the nature of the confusion may relate to the trade source of the goods or services *or* to the quality of the goods. As stated in *Law of Intellectual Property in Singapore* at pp 226-228:

## **18.2 MISREPRESENTATION AS TO ORIGIN**

**[18.2.1]** *The nature of the deception or confusion may relate to the trade source of the goods or services, or to the quality of the goods or services. Misrepresentation as to the trade source can take the form of a false representation that the defendant's goods or services are those of the plaintiff, or that the two parties are connected in some way, for example, the defendant's business is an extension, branch or other agency of the plaintiff's.*

...

## **18.3 MISREPRESENTATION AS TO QUALITY**

**[18.3.1]** *Inherent within a misrepresentation as to the source of the goods or services is an element of misrepresentation about the quality of the goods or services. The consumer buying the defendant's goods thinks that he is getting the quality that he is accustomed to finding in the plaintiff's goods. Here the objection is that the defendant is making a misrepresentation about the quality of his own goods.*

**[18.3.2]** It is also possible for the defendant to make a misrepresentation about the quality of the *plaintiff's* goods...

[emphasis added]

108 At [\[96\]](#) above, I had stated that because the present case involved indicia which was descriptive of the goods in question, a higher burden was imposed on AMP in proving the existence of goodwill. This higher burden of proof is *also* extended to the element of misrepresentation, as noted in *Law of Intellectual Property in Singapore* at pp 230-231:

## **18.4 PROVING MISREPRESENTATION**

...

**[18.4.7]** *When the plaintiff's mark or get-up has descriptive connotations or functional value, the principle that the plaintiff bears a higher burden of proof to show goodwill is extended to the second element: the burden of proof on the plaintiff to show confusion is also heavier. The courts will readily regard a slight difference between the plaintiff's mark and the defendant's mark as being sufficient to distinguish them. [Lifestyle 1.99] is a classic illustration of this principle. ... [emphasis added]*

109 In my view, it was clear however that contrary to AMP's contention (see [106] above), the PAR had *not* restricted his analysis to only whether there was any confusion to the origin of the goods but had also considered and rejected AMP's argument that there had been a misrepresentation as to quality, albeit in the context of the third element of "damage" (see [103]-[105] of the GD cited at [24] above). Bearing in mind the higher burden of proof on the shoulders of AMP and the PAR's finding in this aspect, I was of the opinion that there had been no misrepresentation as to quality. I now move on to consider whether there had been a misrepresentation as to the trade source of the goods.

110 In this case, while I accepted that the proximity of a defendant's field of activity to a plaintiff's is a relevant consideration in deciding whether there is likelihood of confusion (see *Law of Intellectual Property in Singapore* at p 231, para 18.4.8 and *Amanresorts* at para 84), and that there was *some* proximity between Ozone's field of activity (*viz*, the design and retailing of *fashion* apparel and *fashion* accessories for both men and women: see [8] above) and AMP's field of activity (*viz*, the "GLAMOUR" mark primarily being used in conjunction with the "GLAMOUR" magazine which is devoted to the reporting and portraying of, *inter alia*, contemporary women's *fashion* and beauty: see [7] above) in that both relate to "fashion", given that:

- (a) the word marks of Ozone and AMP were visually *dissimilar* (see [53] above) and aurally *dissimilar* (see [56] above);
- (b) "GLAMOUR" is merely descriptive and *not* inherently distinctive nor distinctive by use (see [73] above);
- (c) a higher burden of proof is imposed on AMP (see [108] above); and
- (d) Ozone's other goods were *different* from AMP's goods (*viz*, "magazines books and publications") (see [80] above),

I was of the opinion that the element of misrepresentation was also not satisfied *vis-à-vis* Ozone's other goods.

111 With regard to "printed matter", bearing in mind Ozone's concession of an overlap between "printed matter" and AMP's "magazines, books and publications" but taking into account [110(a)]-[110(c)], I was of the view that, on balance, the element of misrepresentation was also not made out.

### *Element 3: Damage*

112 With regard to the element relating to the question of damage, this was accepted by Ozone if the first two elements were made out.

*Overall conclusion on AMP's opposition under s 8(4) TMA*

113 For all the foregoing reasons, I saw no reason to disturb the PAR's eventual conclusion that AMP's ground of opposition under s 8(4) TMA was not made out and must fail.

## Conclusion

114 Given my conclusion that AMP's opposition pursuant to ss 8(2)(b) and 8(4) TMA must fail, I allowed Ozone's appeal and reversed the PAR's decision dated 16 March 2009. In so doing, I ordered that:

- (a) Ozone's Trade Mark Application No T02/03173J for the "HYSTERIC GLAMOUR" word mark be allowed to proceed to registration;
- (b) the costs awarded to AMP in the hearing before the PAR be set aside; and
- (c) the costs of this appeal and the costs of the hearing before the PAR be paid by AMP to Ozone.

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[\[note: 1\]](http://www.ipo.gov.uk/types/tm/t-os/t-find/t-challenge-decision-results/o31904.pdf) Available online at <http://www.ipo.gov.uk/types/tm/t-os/t-find/t-challenge-decision-results/o31904.pdf> (last accessed on 15 December 2009)

[\[note: 2\]](http://www.ipo.gov.uk/types/tm/t-os/t-find/t-challenge-decision-results/o16703.pdf) Available online at <http://www.ipo.gov.uk/types/tm/t-os/t-find/t-challenge-decision-results/o16703.pdf> (last accessed on 31 December 2009)

[\[note: 3\]](http://www.ipo.gov.uk/tm/t-decisionmaking/t-challenge/t-challenge-decision-results/o08400.pdf) Available online at <http://www.ipo.gov.uk/tm/t-decisionmaking/t-challenge/t-challenge-decision-results/o08400.pdf> (last accessed on 15 December 2009)