The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd
[2005] SGHC 175

Case Number : Suit 733/2004

Decision Date : 23 September 2005

Tribunal/Court : High Court

Coram : Lai Kew Chai J

Counsel Name(s) : Sukumar s/o Karuppiah and Kwong Sze Ken Adrian (Ravindran Associates) for the plaintiff; Lee Hwee Khiam Anthony and Chen Yi Jing Alvin (Bih Li and Lee) for the defendant

Parties : The Polo/Lauren Co, LP — Shop In Department Store Pte Ltd

Trade Marks and Trade Names – Infringement – Whether defendant's sign similar to plaintiff's trade mark – Whether defendant's sign capturing distinctiveness of plaintiff's trade mark – Section 27(2)(b) Trade Marks Act (Cap 322, 1999 Rev Ed)

Trade Marks and Trade Names – Infringement – Whether factors extraneous to mark can be considered in assessing likelihood of confusion – Section 27(2)(b) Trade Marks Act (Cap 322, 1999 Rev Ed)

Trade Marks and Trade Names – Infringement – Whether global assessment test should be adopted – Whether likelihood of confusion should be direct result of similarity between mark and sign and goods applied thereto – Section 27(2)(b) Trade Marks Act (Cap 322, 1999 Rev Ed)

Trade Marks and Trade Names – Infringement – Whether goods to which defendant's sign and plaintiff's mark applying similar – Section 27(2)(b) Trade Marks Act (Cap 322, 1999 Rev Ed)

23 September 2005

Lai Kew Chai J:

The facts

1 The plaintiff, The Polo/Lauren Company, LP, is a limited partnership existing under the laws of New York and is the registered proprietor in Singapore of the following trade marks in Class 25 of the International Classification of Goods and Services ("ICGS"):

Trade Mark	**Registration Number**
POLO (word)	T91/00082H & T99/007713I
POLO BY RALPH LAUREN (word)	T89/05682Z
RALPH LAUREN & polo player device	T85/04342A

POLO RALPH LAUREN & polo player device	T85/03624G
LAUREN RALPH LAUREN	T97/12991A
RALPH LAUREN	T98/05061H

2 The defendant, Shop In Department Store Pte Ltd, is a private company incorporated in Singapore. It operates five stores selling men's and women's clothing, bags, handbags, shoes, watches and household goods.

3 The circumstances giving rise to this case are as follows. Sometime in January 2004, one of the defendant's directors, Ang Chin Pong, decided to import from a factory near Xiamen, China, shoes, bags, handbags and clothes bearing the sign "POLO PACIFIC" because, as he claimed in his affidavit, it was a "sporty and fashionable sounding name". The mark itself is designed such that the height of the individual alphabets of the two words taper towards the centre so as to appear "wave-like". The words are black against a white background or white against a black background.

4 Mr Ang, on returning to Singapore, sought advice from M/s Jing Quee & Chin Joo with the view to registering the mark. An application was filed with the Registry of Trade Marks to register the mark in Classes 18 and 25 (No T0407559Z). Instead of waiting for the mark to be registered, the defendant decided, on advice by its solicitors, to start selling goods bearing the sign. The sign was eventually accepted for publication on 2 December 2004.

5 On 1 February 2005, the plaintiff, though its solicitors, filed a Notice of Opposition with the Registrar of Trade Marks. In the meantime, the plaintiff, through its freelance clerk, purchased several articles of clothing bearing the "POLO PACIFIC" sign from two of the defendant's shops on or about 27 July 2004 and 21 August 2004.

6 In addition to the present state of affairs, there is some history between the parties. It would appear that the defendant had been found selling counterfeit samples of the plaintiff's goods sometime in December 2002. The parties settled the matter and the defendant made an undertaking dated 25 April 2003 not to infringe the plaintiff's trade marks in the future ("the Undertaking").

The issues

7 Arising from these facts are the two claims brought by the plaintiff against the defendant. The first is that the defendant has infringed the plaintiff's trade marks pursuant to s 27(2)(b) of the Trade Marks Act (Cap 332, 1999 Rev Ed) ("TMA"). The second claim is that the defendant has breached its Undertaking with the plaintiff. The plaintiff is therefore contractually entitled to damages for that breach, an injunction to enforce the terms of the Undertaking and costs on an indemnity basis for this portion of the claim.

8 Because the second claim ultimately depends on whether there is an infringement of the plaintiff's trade marks, I will consider the infringement issue first.

Infringement under section 27(2)(*b*) TMA – the applicable law

9 The relevant provision for purposes of this case is s 27(2)(*b*) of the TMA. It 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 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.

10 It is not disputed that the sign used by the defendant was used in the course of trade and that it was also used without the consent of the plaintiff. As such, I only need to consider whether (a) the defendant's sign is similar to the plaintiff's mark; (b) whether the sign was used in relation to goods similar or identical to the mark; and (c) if so, whether there is a likelihood of confusion by reason of the similarity. The question of infringement under s 27 (2)(*b*) of the TMA is novel in Singapore, and as such, counsel for both parties took the opportunity to present two approaches to the construction of the provision. The test of infringement, however, has been extensively discussed in relation to other sections under the TMA.

11 The plaintiff argued that this court should follow the classic formulation as stated in a string of cases including *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 ("*British Sugar*"), *Saville Perfumery Ld v June Perfect Ld and F W Woolworth & Co Ld* (1941) 58 RPC 147 ("*June Perfect*") and *Wagamama Ltd v City Centre Restaurants Plc* [1995] FSR 713 ("*Wagamama*"). The legislation considered in those cases are *in pari materia* with s 27(2)(*b*) of the TMA. Under this approach, it is necessary to show step-by-step that there is a likelihood of confusion *because* the marks are similar and the goods for which the mark is used are identical or similar to those covered by the registration. The plaintiff further contended that the test by which confusion is assessed is extremely strict such that the court cannot take into account added matter or circumstances in assessing whether there is a likelihood of confusion in relation to the way the defendant uses its sign.

12 The defendant, predictably, argued for a more global approach, one which has its roots in a European effort to harmonise their trade marks regime. This is seen in the tenth recital in the preamble to the First Directive 89/104/EEC of the Council of European Communities, of 21 December 1998, to Approximate the Laws of the Member States Relating to Trade Marks (OJ EC No L40 of 11.2.1989) ("the Directive"), where it is stated that "it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion" and that an appreciation of the likelihood of confusion depends on numerous elements, in particular, the recognition of the trade mark in the market, any association which can be made with the used or registered sign, and the degree of similarity between the trade mark and the sign and between the goods and services identified. This so-called "global assessment test" was endorsed in the leading European Court of Justice ("ECJ") decision in *Sabel BV v Puma AG, Rudolf Dassler Sport* [1998] RPC 199 ("*Sabel*") and followed by the English Court of Appeal in *The European Limited v The Economist Newspaper Limited* [1998] FSR 283 ("*The European*").

13 The plaintiff submitted that the global assessment test should not be applied for a few reasons. Firstly, the approach is the result of trade policies and other considerations peculiar to the European Union ("EU") and they are not an implementation of any particular legal system or tradition. Secondly, to import this approach would require the constant monitoring of European jurisprudence without the benefit of proximity and other considerations reflected in EU law. Thirdly, for a common law jurisdiction making a name for itself, accepting EU law would be a retrograde step. Fourthly, there are problems reconciling the different rights acquired under domestic and European law. Fifthly, there is resistance in the UK to the ECJ's decision (although this was on a different point in *Arsenal Football Club Plc v Reed* [2001] RPC 46). Finally, the ECJ decisions do not publish dissents and are a compromise between the judges.

14 I accept the basic proposition that the global assessment test should not apply, but not for the reasons canvassed by the plaintiff. As Singapore globalises and as plaintiffs and defendants themselves operate in many jurisdictions, our local jurisprudence has benefited and can only benefit from examining the jurisprudence of other jurisdictions apart from the English. For example, the Singapore Court of Appeal recently undertook a review of cases from the United States, Australia, Canada and England in another trade marks case in *McDonald's Corp v Future Enterprises Pte Ltd* [2005] 1 SLR 177 ("*McDonald's*"). While foreign cases may be based on policies that we have yet to take into account, this is no reason to reject them out of hand especially if they are sound in principle. Singapore's trade marks regime was amended to take into account its *international* obligations and there is no reason to be blind to the efforts of others in coming to terms with an issue of immense economic importance. If the decisions of foreign jurisdictions are to be rejected (including the English position), it must be because of their incompatibility with our own legislation or their unsuitability to our local circumstances or their inherent insensibility or unsoundness.

15 There are two reasons why I reject the global assessment test. First, the global assessment test is not *in pari materia* with our legislation and, in fact, confuses the elements of infringement required under s 27(2)(*b*) of the TMA. It is clear from the plain words of s 27(2)(*b*) that the likelihood of confusion, if any, must be the direct result of the similarity between the registered mark and the disputed sign and between the goods and services used in relation thereto. The provision does not make it an infringement if the likelihood of confusion is caused by some other factor. Neither does it make similarity merely one among other factors that may be considered. This is obviously sound because the TMA protects the proprietary rights of the owner's *trade mark* and nothing else. This conceptual clarity is lost if we adopt the global assessment test which takes as its ultimate test the question of whether there is a likelihood of confusion: see *Sabel* ([12] *supra*); *The European* ([12] *supra*) ; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 ("*Canon*") ; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77 ("*Lloyd*") and *Marca Mode CV v Adidas AG* [2000] 2 CMLR 1061 ("*Marca Mode*").

16 Second, under the global assessment test approach, because the likelihood of confusion is the ultimate test for infringement, other factors such as the distinctiveness and the reputation of the first trade mark would decide the issue. The greater the distinctiveness of the earlier mark, the greater the likelihood of confusion: *Sabel*, at 224; *Canon*, at [19]; *Lloyd,* at [22]. Therefore, as noted by Jacob J in *British Sugar* ([11] *supra*) at 294, if we are not careful to separate the elements required, a strong mark would get protection for a greater range of goods than a weak mark even though the goods under consideration are vastly different and dissimilar. This does not seem either fair or sensible. If infringement is to be made out, it should be on the basis of the identity or similarity of the sign to the registered mark and the goods applied thereto. I should add that while the global assessment test should be rejected, the cases that have followed this approach contain useful *dicta* particularly in respect of how the court should approach the question of whether two marks are similar.

17 The defendant pointed to Tan Tee Jim, *Law of Trade Marks and Passing Off in Singapore* (Sweet & Maxwell, 2003) wherein the author at p 203, n 31, advocated the adoption of the global assessment test because "whether there is a likelihood of confusion as a result of a similarity of trade marks and of goods or services is a question of fact and as such, the courts should be given a wide measure of flexibility to take account of all factors relevant to the circumstances of the case". With respect, the reason proffered above does not ineluctably lead to the stated conclusion. While the premise is certainly correct, it merely means that the court should be allowed to take into account all the relevant factors and circumstances in assessing the threshold question of similarity. It may even consider all the circumstances in deciding how similar the marks must be before the likelihood of confusion arises. But it does not follow that the courts should find the existence of a likelihood of

confusion notwithstanding the lack of any similarity.

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": *June Perfect* ([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* ([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 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. As Millett LJ said in *The European* ([12] *supra*) at 288:

> Similarity is a matter of degree ... the question is whether the similarity is such as to be likely to cause confusion in the mind of the public. A degree of similarity is tolerable; the question is

whether there is a confusing similarity.

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 infringment. 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]. In that case, counsel for McDonald's Corp tried to argue that the fact that the respondent's goods were sold in a different market (supermarkets as opposed to restaurants or outlets) was irrelevant and that all that should be asked was whether a potential buyer, upon seeing the signs "MacChocolate" or "MacNoodles" would think that they were related to McDonald's. The court gave short shrift to this submission. Such a conclusion is eminently correct. If the aim of trade mark protection is to assist manufacturers in distinguishing the trade source of their goods, and a likelihood of confusion as to the trade source of the registered proprietor's goods is non-existent or highly speculative, there is no reason to hold that there is infringement.

23 Employed in this manner, the plaintiff's argument that the consideration of extraneous factors comes too close to the test employed in a passing-off action is misconceived. In a passing-off action, the requirement of misrepresentation is satisfied if there is a finding that ordinary sensible members of the public would be confused. This, of course, is a question to be decided in the light of all the surrounding circumstances: *Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd* [1991] SLR 133 ("*Tong Guan*"). In an infringement action under s 27(2)(*b*) TMA, the confusion must stem from the similarity between the mark and the sign as well as the goods to which they are applied. If the confusion is caused by other factors, there is no infringement. It is only where the likelihood of confusion is made out by reason of the similarity that the courts can go on to examine whether the likelihood is a real one. Needless to say, this is an important distinction.

Whether there was infringement of the plaintiff's trade marks

24 I now apply the law to the facts of the present case. As mentioned earlier, it is not disputed that the sign used by the defendant was used in the course of trade and that it was also used without the consent of the plaintiff. As such, I only need to consider whether the defendant's sign is similar to the plaintiff's mark, whether the sign was used in relation to goods similar or identical to the mark and, if so, whether, by reason of the similarity, there is a likelihood of confusion.

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

25 It is necessary, before I embark on the analysis, to make clear that while the plaintiff brought its claim for infringement of all its trade marks as I have set out in [1] above, it was prepared, by closing submissions, to proceed mainly on the "POLO" word marks numbered T91/00082H and T99/00713I. I am not certain that it would have made a difference except that it helped to crystallise the issue. In any event, I agree that the fact that the plaintiff has a family of trade marks containing the word "POLO" is significant. This will be considered later.

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 *Samsonite Corp v Montres Rolex SA* [1995] AIPR 244 ("*Samsonite Corp*") at 270, it was held that just because the registered mark was wholly included in the challenged sign, it did not mean that it would necessarily cause confusion between the two. In *Polo Textile Industries Pty Ltd v Domestic Textile Corporation Pty Ltd* (1993) 26 IPR 246 ("*Polo Textiles*") at 250, Burchett J emphasised that decisions, which held that the taking of a word mark and adding to it an additional word constituted infringement, should not be applied mechanically such that no added word could ever save such a taking from infringement. 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.

27 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*"). The plaintiff pointed me to *Polo Textiles* where the court found that the word mark "POLO" was sufficiently distinct and an essential feature of the applicant's mark so that the addition of the word "CLUB" would not cure the likelihood of confusion. However, the defendant also referred me to two cases. The first is *10 Royal Berkshire Polo Club Trade Mark* [2001] RPC 32 ("*Royal Berkshire*"), where the court held the use of the word "POLO" as part of the applicant's mark did not capture the distinctiveness of the opponent's – Polo/Lauren Company LP's – earlier trade marks. Geoffrey Hobbs QC said, at [31], that:

> I do not think that people exposed to the use of the applicant's mark would notice that it contained the word POLO without also noticing that it contained the words ROYAL BERKSHIRE and CLUB. *The message of the mark comes from the words in combination and that is not something that I would expect people to overlook or ignore in the ordinary way of things.* [emphasis added]

The second case was a decision of Choo Han Teck JC (as he then was) in the High Court in *Polo/Lauren Co LP v United States Polo Association* [2002] 1 SLR 326 ("*United States Polo Association*"). He found that the pictorial device of the opponent and the applicant's use of the letters "USPA" as part of their composite marks were sufficient to distinguish the applicant's sign from the opponent's registered marks.

28 As in *McDonald's* ([14] *supra*) case, it is not always possible to reconcile all the cases. While the law is clear, each judge decides on the facts before him and this sometimes gives rise to different outcomes. Having examined the three cases, and for the reasons that follow, 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. In comparing the mark and the sign, I have to have regard to the mark's usage in a normal and fair manner: *Origins* ([19] *supra*) at 284. I must also consider that the way in which the proprietor actually uses the mark can be said, at the very least, to be *prima facie* the paradigm case of its use in a normal and fair manner: *Premier Brands*, at 779.

29 The evidence of Ms Nah Lai Eng, the Merchandising Manager of Dickson Trading (S) Pte Ltd, which is the sole distributor of Polo/Lauren goods in Singapore, on cross-examination is that, first, the plaintiff's most distinctive trade marks are the polo player device and the Polo Ralph Lauren name, and second, that the "POLO" word mark is always used in conjunction with the other trade marks of the plaintiff. There is no advertisement using only the "POLO" word. In situations such as this, the court is entitled to hold that the device used or that the other parts of the composite trade mark are more distinctive and essential in distinguishing the registered proprietor's goods: *The European Limited v The Economist Newspapers Limited* ([26] *supra*) at 436; *Samsonite Corp* ([26] *supra*) at 270; and *McDonald's* at [28]. Where this is the case, the distinctiveness of the word mark is diminished and accordingly the addition of an additional word or other matter may render the challenged sign sufficiently dissimilar. I am aware that in *Shanahan's Australian Law of Trade Marks and Passing Off* (Lawbook Co, 3rd Ed, 2003), the authors, at para 7.105, suggest that in a composite word and device mark, consumers are more likely to place emphasis on the word. I am unable to accept this as true or intuitive in every case. Where, for example, the word is common and the device particularly distinctive, I fail to see why this should be ignored: see *McDonald's* at [26] and [63], where the Court of Appeal was clearly persuaded that given the commonness of the prefix "Mc" and the distinctiveness of the golden arches, goods not bearing the appellant's full name or logo would not be confused as theirs.

30 Furthermore, the word "POLO" is commonly used in everyday language either as a reference to the sport or to a particular style of T-shirts. It is settled that the courts are wary of allowing companies to monopolise words that are either purely descriptive or used in everyday parlance: *The European* ([12] *supra*) at 289; and *Mothercare UK Ltd v Penguin Books Ltd* [1988] RPC 113 at 123. On the other hand, where the trade words are unique or invented, the courts appear more willing to extend protection: *Wagamama* ([11] *supra*); and *De Cordova v Vick Chemical Coy* (1951) 68 RPC 103 ("*Vick*'s case"). The plaintiff in this case argued that it was not attempting to monopolise the word but merely protecting its trade mark. In *The European*, at 289, the English Court of Appeal held that the plaintiff's contention that the word "European" formed an essential feature of its registered mark did not sit comfortably with its disclaimer of any monopoly of the word. I agree. Furthermore, the plaintiff in this case has submitted that the defendant's disclaimer of the words "POLO" and "PACIFIC" proves that the sign is not distinctive. Likewise, the plaintiff's denial that it seeks a monopoly on the word "POLO" suggests that its word mark is not all that unique. The lack of distinctiveness of the word "POLO" also addresses the plaintiff's argument that having a family of trade marks beginning with the word "POLO" makes the defendant's sign appear to be part of a series. As the Court of Appeal held in *McDonald's* at [62], citing *Kerly's* ([26] *supra*), "the strength of this 'series' objection depend[s] on how distinctive the common feature is". Since the common feature – "POLO" – is not all that distinctive, this objection fails.

31 Taking all of these factors into consideration, and comparing the defendant's sign as a whole with the plaintiff's mark as used in a normal and fair manner, I have no doubt that the mark and the sign are not visually similar. I also have no doubt that they are not aurally similar, notwithstanding the fact that the plaintiff and defendant use the "POLO" word as the first word of their composite mark or sign. This is not a case where it is likely that the defendant's brand title would be abbreviated such that the defendant's products will become known as "POLO" as well: see *Associated Newspapers Ltd v Express Newspapers* [2003] FSR 51 (where the defendant's tendency to abbreviate its newspaper titles to "The Mail" was found to infringe the plaintiff's trade mark which was also "The Mail"). Nor is this a case where the words would be mispronounced and mistaken for each other: *Hille International Ltd v Tiong Hin Engineering Pte Ltd*
[1982–1983] SLR 173; and *Jordache Enterprises Inc v Millennium Pte Ltd* [1984–1985] SLR 566. Finally, the mark and sign convey rather distinct concepts. The defendant's evidence is that its sign conveys images of the sand and the sea, while the plaintiff's mark does not. As such, the plaintiff's

claim that the defendant infringed its trade mark – or trade marks – failed. However, for the sake of completeness, I will consider the other requirements for infringement.

The identity or similarity of the goods

32 A preliminary question was raised by the defendant that seemed to make some significance of the fact that the list of goods under Class 25 for first registration of the plaintiff's mark in 1991 was narrower than the second registration in 1999 and excluded T-shirts. The critical date of assessment for the specification of the goods is the date of application of the registration of the defendant's sign or otherwise when it was first used. The record is very clear that the earliest date that the defendant's products were registered was in 30 April 2004. Thus, the list of goods against which the defendant's products are compared would be those included under Class 25 as it stood in 1999, which included T-shirts.

33 Accordingly, I have very little doubt that the goods carried by the plaintiff and the defendant are similar, if not identical, for the purposes of s 27(2)(*b*) of the TMA. The plaintiff's trade marks were registered under Class 25 of the ICGS and the defendant's products which are being complained of (mainly T-shirts) would qualify to be registered in the same class, as evidenced by their attempted registration. This being the case, it is not necessary for the court to engage in the test set down in *British Sugar* ([11] *supra*). The test in that case was employed because the defendant's product would not have been registered in the same class as the plaintiff's and thus there was a need to decide if it was similar enough to the plaintiff's product. It would be a very rare case, if ever, that a defendant could claim that its products, if listed in the same classification as the plaintiff's, were not similar. The defendant here attempted to make some argument about this issue though very briefly and somewhat half-heartedly. The considerations it listed – price, design and quality of the goods – are relevant in considering the likelihood of confusion but not whether the goods are identical or similar. Even if I were to apply the *British Sugar* test, I am persuaded that the goods to which the marks and the sign are applied are similar, if not identical – all being articles of casual clothing.

The likelihood of confusion

34 Even if the plaintiff's trade mark and the defendant's sign are similar, the critical question is whether by virtue of the degree of similarity between the mark and the sign and the goods used in relation thereto, there is a likelihood of confusion. As I explained above, the first step to resolving this question is to decide the strength of the similarity required in order for there to exist a likelihood of confusion. This is determined by reference to the ordinary consumer with an imperfect recollection: *Kellogg* ([20] *supra*) at [32]; *"Bali" Trade Mark* [1969] RPC 472 at 485. Furthermore, the ordinary consumer is likely to judge the mark and the sign by general impressions or by some significant detail rather than by any photographic recollection of the whole: *Vick*'s case ([30] *supra*) at 106.

35 It is useful, however, to bear in mind that the law assumes that the ordinary consumer will exercise some care and intelligence in the selection of their merchandise: *McDonald*'s ([14] *supra*) at [60]. Furthermore, the critical moment for assessing the likelihood of confusion is when the consumer has entered the shop and has had a chance to examine the product carefully: *McDonald*'s at [60] and [65]; and *United States Polo Association* ([27] *supra*) at [9]. It is also established that mere association between the mark and the sign does not constitute confusion: *Royal Berkshire* ([27] *supra*) at [21].

36 The average consumer in Singapore has been described as literate, educated, exposed to the world and unlikely to be easily hoodwinked: *Tong Guan* ([23] *supra*) at 143–144, [30]; and *McDonald*'s at [64]. This is the starting point. As explained above, the court may find, in some cases, that the

trading circumstances of the goods in question warrant assuming that the ordinary purchaser of those goods would exercise a higher or lower standard of care: *Wagamama* ([11] *supra*) at 732; and *Premier Brands* ([27] *supra*) at 222. In this case, I accept the plaintiff's contention that the standard of care is not exceptionally high because while its goods are expensive and sold exclusively, they are not particularly so. There are certainly far more high-fashion brands around. But the standard of care is not exceptionally low either. In fact, Ms Nah testified that the ordinary customer of the plaintiff's goods would check the merchandise before making payment by looking at the product, the label and the price. It certainly cannot be argued that the average Singaporean would not care about the brand of their clothing, no matter how casual. Given the circumstances, the strength of the similarity required in order for there to exist a likelihood of confusion is neither weak nor strong; it is somewhere in between. It is not necessary, desirable or possible to draw concrete boundaries. As Laddie J remarked in *Wagamama*, at 732, "[w]hether there has been trade mark infringement is more a matter of feel than science". Taking into account my analysis of the similarities and differences between the mark and the sign above, I find that even if it could be said that they are similar, it would not be to the extent that is sufficient to confuse the ordinary consumer in this case. I have no doubt that the ordinary Singaporean would have little trouble discerning that the defendant's T-shirts are not from the same trade source as the plaintiff's.

37 Furthermore, it appears to me that the plaintiff's claim that there will be confusion is purely speculative. The evidence tendered by the plaintiff admitted that its products are sold in a selective manner in five boutiques managed and operated by its sole distributor and in five other "corners" located within segregated areas of various department stores. The location of these retail spaces are in the very nerve of the country's shopping district: Takashimaya, Raffles City Shopping Centre and Suntec City Mall. This is in stark contrast to the defendant, which operates out of five stores located in far less glamorous places outside the central shopping strip. The target market of the plaintiff is the upper middle-class and possibly upwards, and the prices of its goods reflect its sophisticated image. On the other hand, the defendant targets mostly lower-income earners. When asked whether it was realistic to suggest that a T-shirt costing $7.90 or $12.90 could ever be a product of the plaintiff, Ms Nah answered in the negative. Ms Nah also admitted that the plaintiff packages its goods in an attractive paper bag.

38 The plaintiff urged that I consider that there is a possibility of confusion because of the presence of parallel imports that might sell at locations outside the city's main shopping district. I am unimpressed by this submission for the simple fact that the plaintiff admitted that it has been rigorously clamping down on parallel imports so that their presence in Singapore, if any, is negligible. No evidence was tendered demonstrating the price range that these goods would be offered at either. Taking all these circumstances into account, it is far-fetched to suggest that confusion could ever arise even in the simplest of minds and that, at best, the likelihood of confusion is a mere possibility and not a real one.

Breach of the Undertaking

39 The second issue of whether there has been a breach of the Undertaking is triggered only if there has been an infringement of the plaintiff's trade marks. I have found that this is not the case and accordingly it is not necessary for me to decide on this issue.

Conclusion

40 For all the reasons stated above, the plaintiff's claims were dismissed with costs.

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