IN THE GENERAL DIVISION OF
THE HIGH COURT OF THE REPUBLIC OF SINGAPORE

[2021] SGHC 163

Suit No 723 of 2020

Between

(1) TMRG Pte Ltd
(2) Luke's Tavern Holdings Pte Ltd

… *Plaintiffs*

And

(1) Caerus Holding Pte Ltd
(2) Lukes Seafood LLC

… *Defendants*

JUDGMENT

[Intellectual Property] — [Trade marks and trade names] — [Infringement]
[Intellectual Property] — [Trade marks and trade names] — [Invalidity]
[Intellectual Property] — [Trade marks and trade names] — [Defences] — [Own name]
[Intellectual Property] — [Trade marks and trade names] — [Passing off] — [Goodwill]
[Intellectual Property] — [Trade marks and trade names] — [Passing off] — [Misrepresentation]
[Intellectual Property] — [Trade marks and trade names] — [Passing off] — [Likelihood of damage]
[Intellectual Property] — [Trade marks and trade names] — [Defences] — [Prior user]

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TMRG Pte Ltd and another
v
Caerus Holding Pte Ltd and another

[2021] SGHC 163

General Division of the High Court — Suit No 723 of 2020

Andre Maniam JC
9, 10, 11 March, 26 April 2021

13 July 2021 Judgment reserved.

Andre Maniam JC:

Introduction

1 "What's in a name?" said Juliet, "[t]hat which we call a rose, by any other name would smell as sweet" (William Shakespeare, *Romeo and Juliet* (Duke Classics, 2012) at p 56). Despite that brave proclamation, Juliet's name (Capulet) and Romeo's (Montague) indicated the families they came from, families whose strife would keep them apart.

2 In the intellectual property context, a name may likewise be an indication of origin: it may be a trade mark, or its use may be actionable as passing off.

3 Local cases have considered names like "Taylor" (see *Taylor, Fladgate & Yeatman Limited v Taylors Wines Pty Ltd* [2014] SGIPOS 11 ("*Taylor*")),

"Kenzo" (see *Kenzo v Tsujimoto Kenzo* [2013] SGIPOS 2 ("*Kenzo*")), "Valentino" (see *Valentino Globe BV v Pacific Rim Industries Inc* [2009] 4 SLR(R) 577 ("*Valentino (HC)*")), and "Han" (see *Han's (F & B) Pte Ltd v Gusttimo World Pte Ltd* [2015] 2 SLR 825 ("*Han's*")). The present case involves the name "Luke", more specifically its possessive form, "Luke's".

Background

The parties

4 The plaintiffs are Singapore companies.[1] The first plaintiff operates a restaurant under the name, "Luke's Oyster Bar & Chop House" at Gemmill Lane, which opened in May 2011.[2] The second plaintiff operated another restaurant by the same name at The Heeren from 2014 until it closed in December 2020 because its landlord Robinsons ceased operations. The second plaintiff intends to reopen its restaurant at a new location.[3] The plaintiffs' restaurants are fine dining restaurants.

5 The first plaintiff is the registered owner of the following mark in Class 43 of the International Classification of Goods and Services ("ICGS") (the "Luke's Oyster Bar & Chop House trade mark"):[4]

Trade mark no	Trade mark	Specifications
T1314356Z	LUKE'S OYSTER BAR | CHOP HOUSE TRAVIS MASIERO RESTAURANT GROUP	Café, providing food and drink, take away food services,

1 Affidavit of Evidence-in-Chief of Masiero Travis Jon ("Mr Masiero's AEIC") at para 4.

2 Mr Masiero's AEIC at para 5 and pp 34–35.

3 Mr Masiero's AEIC at para 6.

4 Mr Masiero's AEIC at para 10 and pp 21–22.

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		preparation of meals, restaurants, catering services, bar services.

6 The plaintiffs also use an unregistered mark (the "Luke's Oyster Bar & Chop House logo"):



7 The Luke's Oyster Bar & Chop House trade mark and Luke's Oyster Bar & Chop House logo both contain words other than "Luke's" – specifically, "Oyster Bar", "Chop House" and "Travis Masiero Restaurant Group" or "Travis Masiero". Restaurateur Travis Masiero ("Mr Masiero"), a director and shareholder of the plaintiffs, had named the "Luke's Oyster Bar & Chop House" restaurants after his son, Lucas.[5] The plaintiffs contend that the word "Luke's" by itself is distinctive of their restaurant business. The defendants dispute this.

8 The second defendant is a United States company. It opened the first "Luke's Lobster" shack on 1 October 2009 in New York City.[6] Directly or through franchisees, some 37 Luke's Lobster shacks were opened in the United States, Japan, and Taiwan, before the first Luke's Lobster shack was opened in

5 Mr Masiero's AEIC at para 7.

6 Affidavit of Evidence-in-Chief of Luke Holden ("Mr Holden's AEIC") at para 8.

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Singapore on 23 September 2020, at Isetan, Shaw House.[7] That lobster shack in Isetan was opened through the first defendant, the exclusive Singapore franchisee of Luke's Lobster.[8] Luke's Lobster shacks are small, casual, self-service restaurants.[9] Much of their business is "grab-and-go", with limited seating for those who wish to dine in.[10]

9 In January 2021, the defendants opened a second Luke's Lobster shack in Singapore at Jewel, Changi Airport.[11] Luke's Lobster's frozen seafood products are also available in NTUC FairPrice Finest supermarkets.[12]

10 Luke's Lobster gets its name from another Lucas: its co-founder and Chief Executive Officer ("CEO") Lucas Alexander Holden, who is known as "Luke Holden".[13]

11 The second defendant is the registered owner of the following trade marks in Class 43 of the ICGS (the "Luke's Lobster word mark" and the "Luke's Lobster logo" respectively, and collectively, the "Luke's Lobster trade marks"):[14]

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7 Affidavit of Evidence-in-Chief of Luke Holden ("Mr Holden's AEIC") at para 9; Affidavit of Evidence-in-Chief of Vijay Kumar s/o Sreekumar Pillai ("Mr Pillai's AEIC") at para 9(e).

8 Mr Pillai's AEIC at para 8.

9 Mr Pillai's AEIC at paras 15(a) and 16(b).

10 Mr Pillai's AEIC at para 16(a).

11 Transcript, 11 Mar, p 53 line 25; p 54 lines 1–6.

12 Transcript, 9 Mar, p 139 lines 1–14; Defendants' Bundle of Documents Volume I ("DBOD Vol I") at pp 236–241.

13 Transcript, 11 Mar, p 1 lines 18–20; p 2 lines 22–25; p 3 lines 1–12.

14 Agreed Bundle of Documents Volume I ("ABOD Vol I") at pp 4–9.

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Trade mark no	Trade mark	Specifications
40201812193V	Luke's Lobster	Restaurants featuring lobster.
40201809854R	LUKE'S:	Restaurant services.

12 The Luke's Lobster trade marks were registered in Singapore on or about 3 April 2018.[15] The marks have also been registered in other countries.[16]

13 Luke's Lobster's best-selling product is its lobster roll, which has chunks of lobster meat served on a buttered roll:



15 Mr Holden's AEIC at para 18; ABOD Vol I at pp 4 and 7.

16 Mr Holden's AEIC at para 20.

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14 The lobster roll is the most popular item sold by Luke's Lobster in Singapore; followed by lobster bisque and the "Luke's Trio" (half-rolls of lobster, crab, and shrimp).[17] Lobster features prominently, as one might expect from the name "Luke's Lobster".

15 The plaintiffs, however, assert that their Luke's Oyster Bar & Chop House restaurants also had an established reputation for lobster dishes, although these only accounted for 5% of their restaurants' revenue,[18] with their lobster rolls only available at lunch, and not listed on their main menu.[19]

16 The plaintiffs contend that by opening Luke's Lobster in Singapore, the defendants are liable for trade mark infringement and passing off. Would a customer, however, purchase Luke's Lobster's lobster rolls thinking that they came from Luke's Oyster Bar & Chop House, or that the two establishments were associated in some way?

The proceedings

17 In July 2020, the plaintiffs came to know that the defendants were intending to open a Luke's Lobster shack in Singapore. On 7 August 2020, the plaintiffs commenced the present suit, and on 11 August 2020 they sought an interlocutory injunction to restrain the defendants from doing so. The interlocutory injunction was not granted on the balance of convenience; instead an early trial was directed.

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17 Mr Pillai's AEIC at para 16(c).

18 Mr Masiero's AEIC at paras 17–18; Transcript, 9 Mar, p 111 lines 20–25; p 112; p 113 lines 1–18; p 114 lines 8–13.

19 Mr Masiero's AEIC at para 16.

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18 The plaintiffs claim against the defendants for:[20]

(a) trade mark infringement under s 27(2)(*b*) of the Trade Marks Act (Cap 332, 2005 Rev Ed) ("the TMA") for using marks that are similar with the plaintiffs' trade mark in respect of identical services for which that trade mark was registered;

(b) passing off, with the plaintiffs asserting that "Luke's" is their distinctive name; and

(c) a declaration that the Luke's Lobster trade marks are invalid pursuant to s 23 of the TMA on the basis that they were registered in breach of ss 8(2)(*b*) and/or 8(7) of the TMA because there is passing off in respect of "Lukes" [*sic*].

19 Besides the declaration of invalidity in [18(c)] above, the plaintiffs seek:

(a) an injunction to restrain the defendants from using any sign that incorporates the word "Luke's" for goods and services identical or similar to those for which the Luke's Oyster Bar & Chop House trade mark is registered;

(b) an inquiry as to damages or alternatively, at the plaintiffs' option, an account of profits; and

(c) an order for the delivery up or destruction upon oath of all infringing material in the defendants' possession, power, custody or control.

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20 Statement of Claim dated 7 August 2020 ("SOC") at pp 9–10.

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20 I will first address the claim for trade mark infringement (see [21] below), then the claim for passing off (see [120] below), and finally whether the Luke's Lobster trade marks are invalid (see [179] below).

Are the defendants liable for trade mark infringement?

Analytical framework

21 Section 27(2) of the TMA provides as follows:

> 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.

22 Whether there is infringement under s 27(2) of the TMA is assessed by the step-by-step approach (*The Polo/Lauren Co, LP v Shop-In Department Store Pte Ltd* [2006] 2 SLR(R) 690 ("*Polo*") at [8]):

> 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.

23 In *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another and another appeal* [2014] 1 SLR 911 ("*Staywell (CA)*"), the Court of Appeal explained (at [15]):

> … the only relevant type of confusion for the purpose of grounding an opposition or an infringement action, is that which is *brought about by* the similarity between the competing

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> marks and between the goods and services in relation to which the marks are used … Under the step-by-step approach, the three requirements of similarity of marks, similarity of goods or services, and likelihood of confusion arising from the two similarities, are assessed systematically. The first two elements are assessed individually before the final element which is assessed in the round.
>
> [emphasis in original]

24 In comparing the marks, the court will consider visual, phonetic (or aural), and conceptual similarity (*Han's* ([3] above) at [105]). This is done mark-for-mark without consideration of any external matter (*Han's* at [105]; *Staywell (CA)* at [20]).

25 Distinctiveness is a factor integrated into the visual, aural and conceptual analysis of the marks (*Staywell (CA)* at [30]). Distinctiveness in the ordinary and non-technical sense refers to what is outstanding and memorable about the mark; distinctiveness in the technical sense is contrasted with descriptiveness (*Staywell (CA)* at [23]–[24]). In *Staywell (CA)*, the court found that, at least in relation to hotels and hospitality services, "Regis" enjoys a substantial degree of technical distinctiveness, and there was a high degree of aural similarity between the competing "St Regis" and "Park Regis" marks because of the distinctiveness of the common "Regis" component in both the technical and non-technical senses (at [31]).

26 The plaintiffs similarly contend that "Luke's" in the plaintiffs' trade mark was, by itself, distinctive of their restaurants. Thus, they argue that the Luke's Lobster trade marks (both of which have the word "Luke's") are similar to the plaintiffs' trade mark, indeed confusingly so. I address this below.

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Similarity of marks

Visual similarity of marks

27 The plaintiffs contend that here, the dominant and distinctive component of the marks is the word "Luke's" – that is the most visually noticeable and memorable part of the marks:[21]

(a) in the Luke's Oyster Bar & Chop House trade mark, the word "Luke's" is at the top, in a font that is twice the size of the words "Oyster Bar" and "Chop House", and about three times the size of the words "Travis Masiero Restaurant Group"; and

(b) in the Luke's Lobster trade marks, "Luke's" is coupled with "Lobster" (either as a word or as a lobster device).

28 "Luke's" is, however, not the only word in the plaintiffs' mark. The plaintiff did not register "Luke's" as a trade mark and then use that for restaurants named "Luke's Oyster Bar & Chop House". Instead, the plaintiffs registered a trade mark with nine words: Luke's / Oyster Bar / Chop House / Travis Masiero Restaurant Group.

29 In *Ozone Community Corp v Advance Magazine Publishers Inc* [2010] 2 SLR 459 ("*Ozone*"), the High Court held that the "GLAMOUR" and "HYSTERIC GLAMOUR" marks were visually dissimilar (and also aurally dissimilar) (at [53] and [56]). In determining the visual similarity of the marks, the court considered the length of the marks, the structure of the marks (*ie*, whether there are the same number of words), and whether the same letters are used in the marks (at [49]).

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21 Plaintiffs' Closing Submissions ("PCS") at para 161.

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30 Similarly, in *Taylor* ([3] above), the Assistant Registrar of Trade Marks found that the "Taylor's" and "Taylors Wakefield" marks were not visually similar (at [73]).

31 So, too, the Court of Appeal found in *Polo* ([22] above) that the 

mark was not similar to the "POLO" word mark. The court said (at [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.

32 Here, the plaintiffs' trade mark consists of – Luke's / Oyster Bar / Chop House / Travis Masiero Restaurant Group: nine words, 51 letters (see [5] above). On the other hand, the Luke's Lobster word mark has two words, 12 letters; the Luke's Lobster logo has one word, five letters, and a lobster device (see [11] above).

33 There are also differences in font, and design. The fonts and typefaces of the Luke's Oyster Bar & Chop House trade mark and Luke's Lobster trade marks are noticeably different (see [61] below). In terms of design, the Luke's Oyster Bar & Chop House trade mark is made up almost exclusively of words (save for a separator between "Oyster Bar" and "Chop House"), while the Luke's Lobster logo is represented by both a word ("Luke's") and a lobster device. Unlike the Luke's Lobster word mark, which is a simple word mark representing "Luke's Lobster" in a single file, the Luke's Oyster Bar & Chop House trade mark is a composite mark comprising "Luke's", "Oyster Bar", "Chop House" and "Travis Masiero Restaurant Group" occupying their respective positions within the mark. The comparison is:

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as compared to

Luke's Lobster and 

.

34 Such differences were also noted in several other cases where the marks were found to be dissimilar:

(a) in *Valentino Globe BV v Pacific Rim Industries Inc* [2010] 2 SLR 1203 ("*Valentino (CA)*"), between the opponent's marks 

and 

, and the applicant's mark 

;

(b) in *Discovery Communications, LLC v A-Star-Education Discovery Camps Pte Ltd* [2020] SGIPOS 4, between the opponent's mark 

and the applicant's mark 

; and

(c) in *Han's* ([3] above), where the court held that the HAN Cuisine of Naniwa sign 

("HAN sign") was similar to the Han's word marks 



but dissimilar to the Han's composite marks

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. The court found that the HAN sign had visual similarity with the Han's word marks but not with the Han's composite marks, phonetic similarity with all four of the Han's marks, but was conceptually dissimilar to all of the Han's marks (particularly with the Han's composite marks) (at [122]–[143]). In the event, the court found that although the HAN sign was similar to the Han's word marks, it was not confusingly so (at [183]).

35 These cases may be contrasted with *Staywell (CA)* ([23] above), where the Court of Appeal found that Staywell's mark 

was similar to Starwood's "ST. REGIS" word mark (at [38]).

36 In all the above cases, there was some common element between the marks: "Glamour", "Taylor", "Polo", "Valentino", "Discovery", "Han", "Regis", but the competing marks were only found to be similar overall in *Han's* (in respect of the word marks) and *Staywell (CA)* (comparing "Park Regis" to "St Regis").

37 As for the plaintiffs' contention that "Luke's" *per se* is distinctive of their restaurants, case law indicates that a commonly used personal name (like "Luke") is considered of low distinctiveness:

(a) in *Taylor* ([3] above), there was evidence that it was used as the trading name of a number of live businesses in Singapore (at [52]);

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(b) in *Kenzo* ([3] above), that was likewise noted in relation to "Kenzo" and the Principal Assistant Registrar of Trade Marks moreover stated that the average member of the public is equally likely to construe the word "KENZO" as a personal name of Japanese origin, as much as a sign that may serve as a badge of origin (at [40]).

(c) in *Luciano Sandrone v European Union Intellectual Property Office* (Case T-268/18), the European General Court compared the "DON LUCIANO" and "Luciano Sandrone" marks, and concluded that as the first name "Luciano" was a common first name in Spain, Italy, Portugal and France (at [74]), there was only a weak degree of visual and phonetic similarity between the competing marks (at [78] and [80]), and no likelihood of confusion (at [92]–[103]).

38 In Singapore, the words "Luke", "Luke's" and "Lukes" are found in the registered trading names of various entities:[22]

	Name of business entity	Description of business
(a)	Leia&Luke Express	Renting and leasing of private cars without operator
(b)	Luke & Bean	Retail sale via vending machines (with income mainly from vending machine sales)
(c)	Luke Edward Communication and Consultancy	Commercial printing (*eg* printing of brochures, cards, envelopes, labels and stationery)
(d)	Luke Lee & Co	Legal activities
(e)	Luke N Leia	Retail sale of handicrafts, collectibles, and gifts

[22] DBOD Vol I at pp 327–337.

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(f)	Luke Partners	Management consultancy services (general)
(g)	Luke Services	Management consultancy services N.E.C.
(h)	Luke's Consortium	Information technology consultancy (except cybersecurity)
(i)	Luke's Technologies	Information technology consultancy (except cybersecurity)
(j)	Luke Alexander Pte Ltd	Manufacture of metal precision components
(k)	Luke Capital Management Pte Ltd	Corporate finance advisory services
(l)	Luke Investments Pte Ltd	Other holding companies
(m)	Luke Medical Pte Ltd	Insurance agencies and agents (including financial planning services)
(n)	Luke Philips International Pte Ltd	Retail sale of clothing for adults
(o)	Luke Systems Technology Pte Ltd	Information technology consultancy (except cybersecurity)
(p)	Luke Tan ENT Surgery Pte Ltd	Specialised medical services (including day surgical centres)
(q)	Lukes Marine Engineering and Consulting Services Pte Ltd	Wholesale of marine equipment and accessories (including marine navigational equipment and radar)
(r)	St Luke's Eldercare Ltd	Other personal service activities N.E.C.
(s)	St Luke's Hospital	Acute hospitals

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39 "Luke" and "Luke's" also feature in the trade marks of other parties registered in the following classes of the ICGS:[23]

	Class	Trade mark
(a)	Classes 20 and 42	LUKE HUGHES
(b)	Class 28	LUKE SKYWALKER
(c)	Class 3	St. Luke's
(d)	Classes 29, 30 and 35	TOM & LUKE Tom & Luke tom & luke

40 Food products are also sold under the names "Luke's Organic" and "Tom & Luke" (see: <https://coldstorage.com.sg/search?q=lukes> (accessed 17 February 2021); <https://www.fairprice.com.sg/search?query=lukes> (accessed 17 February 2021)):[24]

[23] DBOD Vol I at pp 338–352.

[24] DBOD Vol I at pp 363–372.

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41 In *Reed Executive plc and another v Reed Business Information Ltd and others* [2004] ETMR 56 ("*Reed*"), the plaintiff's registered mark was "REED", registered for employment agency services, whereas the defendant's sign was "Reed Business Information". The English Court of Appeal observed that "Reed" is a common surname, and the additional words "Business Information" in the defendant's sign would be recognised by the average consumer as serving to differentiate the defendant from Reeds in general (at [37]–[38]). Indeed, the court considered the additional words "as prominent as the word 'Reed'" (at [39]). In the event, the court found there was no likelihood of confusion (at [105]–[106]).

42 The court, citing Lord Simonds in *Office Cleaning Services v Westminster Window and General Cleaning* (1946) 63 RPC 30 (at 43), stated that "where a mark is largely descriptive 'small differences may suffice' to avoid confusion" (at [84]). In that cited case, "Office Cleaning Association" was sufficiently different from "Office Cleaning Services" to avoid passing off (at [85]). The court went on to say (at [86]):

> The same sort of consideration applies when there is use of two common surnames, as in this case. The average consumer will

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> be alert for differences – just in the same way as one distinguishes WH Smith from other Smiths by the initials.

43 The plaintiffs' trade mark is not "Luke's", it is: "Luke's / Oyster Bar / Chop House / Travis Masiero Restaurant Group" [emphasis added]. Neither are the Luke Lobster trade marks just "Luke's": they are "Luke's Lobster" [emphasis added], with "lobster" either in word form, or graphically depicted by the lobster device. Adopting the English Court of Appeal's reasoning in *Reed*, the words "Oyster Bar" "Chop House" and "Travis Masiero Restaurant Group" in the plaintiffs' trade mark serve to differentiate the plaintiffs' restaurants from other "Luke's" establishments, as does the word "Lobster" or the lobster device in the respective Luke's Lobster trade marks.

44 The risk inherent in the use of a name in a trade mark, was well noted by the IP Adjudicator Professor David Llewelyn in *Valentino SpA v Matsuda & Co* [2020] SGIPOS 8 (at [1]):

> Where a business chooses as its trade mark (or one of its trade marks) a name, whether a given name, a surname or a combination of the two, that choice comes with a risk: that others may be able to use it (or them) in good faith without impinging upon the trade mark owner's rights, including the right to successfully oppose subsequent third party applications to register another combination as a trade mark. The more common the name, the more likely this is: for example, WANG would be extremely difficult, if not impossible, to protect as a trade mark for fashion articles except in combination with a given name such as ALEXANDER or VERA; as would CHOO without JIMMY or LIM without PHILLIP. Likewise, to take some examples from further afield: SMITH without PAUL; RALPH without LAUREN; KLEIN without CALVIN or ANN; LOUIS without VUITTON.

45 The words besides "Luke's" in the plaintiffs' trade mark serve to differentiate them from "Luke's" *per se*, in much the same way as adding a surname to "Luke" or "Luke's", *eg* "Luke Masiero" or "Luke Masiero's".

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46 The words "Oyster Bar", "Chop House" and "Travis Masiero Restaurant Group" in the plaintiffs' trade mark contribute to the mark *as a whole* being distinctive of the plaintiffs' restaurants. Which "Luke's" are they? They are the Luke's Oyster Bar & Chop House restaurants that are part of the Travis Masiero Restaurant Group. Having chosen to differentiate themselves in that way, it is ironic that the plaintiffs now seek to focus on "Luke's", and to downplay the rest of their trade mark.

47 In effect, the plaintiffs are claiming a monopoly over "Luke's" – at least in relation to restaurants.

48 Such an assertion was roundly rejected in *Valentino (HC)* ([3] above) where the High Court said (at [36]), "[t]he Appellant certainly does not have a monopoly over the word 'Valentino'"; and in *Valentino (CA)* ([34(a)] above), where the Court of Appeal said (at [22]):

> … the allegation that the Respondent had hijacked the Appellant's Valentino Marks because the Application Mark contained the same word 'Valentino', was a *non sequitur* and had absolutely no merit and we do not think there is any further need to address it. This assertion would amount to saying that the Appellant had a proprietary claim to a common name such as 'Valentino'.

49 I likewise reject the plaintiffs' attempt to claim a monopoly over "Luke's".

50 I find that the Luke's Lobster trade marks are not visually similar to the plaintiffs' Luke's Oyster Bar & Chop House trade mark, and that the Luke's Lobster logo is particularly dissimilar.

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Phonetic/aural similarity of marks

51 The plaintiffs submit that aurally, the marks are virtually identical. I do not agree.[25]

52 In *Staywell (CA)* ([23] above), the Court of Appeal noted that one approach would be to undertake a quantitative assessment as to whether the competing marks have more syllables in common than not, which was the approach taken in *Ozone* ([29] above) (at [55]) – on that approach, "St Regis" and "Park Regis" had more syllables in common than not, two out of three (at [32]).

53 The other approach, which the High Court judge adopted in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another* [2013] 1 SLR 489 ("*Staywell (HC)*"), was to consider if the marks have a dominant and distinctive component when each is read out (at [22]–[23]). The judge found that that was "Regis", while "St" and "Park" were not as dominant, but not to be ignored (at [24]). The Court of Appeal upheld the finding that the marks were aurally similar (*Staywell (CA)* at [33]).

54 Here, the plaintiffs' trade mark has 15 syllables; the Luke's Lobster word mark has three syllables, and the Luke's Lobster logo has one syllable. Only one syllable is common between the competing marks: "Luke's". Moreover, "Luke's" is of low distinctiveness (see [37]–[40] above).

55 This case is very different from *Wagamama Ltd v City Centre Restaurants plc and another* [1995] FSR 713 ("*Wagamama*") where Wagamama Ltd sued for trade mark infringement and passing off, the

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[25] PCS at para 161(c).

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comparison being between its "Wagamama" restaurant, and the defendant's subsequent restaurant "Rajamama". As the court noted, "Wagamama" means selfishness or wilfulness in Japanese, but it was not in dispute between the parties that the word has no meaning to the overwhelming majority of the population in England (at 717). As such, a significant section of them would regard it as an entirely artificial and meaningless mark (at 732). An artificial mark has greater distinctiveness in the technical sense (see *Staywell (CA)* at [24]). Moreover, in *Wagamama*, the court noted that much of the plaintiff's business is likely to come from oral recommendation, and as such the possibility of confusion and imperfect recollection are significant (at 736). In the event, the plaintiff succeeded in both its trade mark infringement and passing off claims (at 733 and 737). In the present case, "Luke's" (which *per se* is of low distinctiveness: see [37]–[40] above) does not have the technical distinctiveness of a word like "Wagamama", and there was no evidence that much of the plaintiffs' business is likely to come from oral recommendation.

56 I find that the Luke's Lobster trade marks are not phonetically (or aurally) similar to the plaintiffs' trade mark.

Conceptual similarity of marks

57 The plaintiffs submit that the marks have a high degree of conceptual similarity given that they both denote a food and beverage establishment owned by a person called "Luke" (due to the use of "Luke's"), and both lobsters and oysters are seafood.[26] That is an over-simplification.

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[26] PCS at para 161(d).

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58 In considering conceptual similarity, the court "seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole" (*Staywell (CA)* ([23] above) at [35]).

59 Here, the phrases "Oyster Bar" and "Chop House" in the plaintiffs' trade mark bring to mind a place, just like "Kenzo Estate" in *Kenzo* ([3] above) (at [36]–[37]). The Luke's Lobster trade marks, on the other hand, bring to mind an animal (the lobster), or a type of food (lobster), rather than a place. While a "Lobster shack" (see [8] above) would be the equivalent of an "Oyster Bar", here, the Luke's Lobster trade marks simply state "Luke's 'Lobster'" (in word or by the lobster device).

60 The phrase "Travis Masiero Restaurant Group" in the plaintiffs' trade mark indicates that the plaintiffs' Luke's Oyster Bar & Chop House restaurants are part of a larger group – the Travis Masiero Restaurant Group. Moreover, the restaurant group bears the name "Travis Masiero" rather than "Luke's" or "Luke's Oyster Bar & Chop House". The Luke's Lobster trade marks, on the other hand, make no reference to any restaurant group, or any person other than the eponymous "Luke".

61 Further, the words in the plaintiffs' trade mark are all in capital letters, upright, and in gold typeface. The impression given is one of formality and sophistication (see *Han's* ([3] above) where the same observation was made about the HAN sign (see [34(c)] above) (at [142])). In contrast, the Luke's Lobster word mark only has the initials "L" capitalised. "LUKE'S" in the Luke's Lobster logo is curved, with the word forming the body of the lobster, and "lobster" is conveyed by a lobster device rather than a word. The Luke's Lobster trade marks come across as casual, even playful (especially the Luke's Lobster logo).

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62 I find that the marks are conceptually dissimilar.

Overall similarity of marks

63 As discussed above, I consider the marks to be visually dissimilar, phonetically (or aurally) dissimilar, and conceptually dissimilar. On the whole, the Luke's Lobster trade marks are dissimilar to the Luke's Oyster Bar & Chop House trade mark, and the Luke's Lobster logo especially dissimilar.

Similarity of goods or services

64 The marks are all registered in Class 43 of the ICGS. The plaintiffs' registration is for (among others) "restaurants"; the defendants' registrations are for "restaurants featuring lobster" and "restaurant services" (see [5] and [11] above).

65 In *Staywell (CA)* ([23] above)), the Court of Appeal stated that registration in the same specification within a class establishes a *prima facie* case for identity (at [40]). In this regard, I accept that the Luke's Lobster trade marks are used in relation to goods or services identical with or similar to those for which the plaintiffs' trade mark is registered.

66 This does not mean there is no distinction between the defendants' Luke's Lobster shacks and the plaintiffs' restaurants – there is (see [76], [79] and [132]–[140]). But these differences should more appropriately be considered when evaluating the likelihood of confusion. In *Staywell (CA)*, the Court of Appeal stated (at [61]):

> In infringement proceedings … [t]he only question is whether the actual use of a similar or identical sign by the infringer encroaches on the registered proprietor's monopoly rights under s 26 of [the TMA], to use the mark in relation to goods

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> and services for which he is already using it as well as the penumbra of fair uses for which he might want to use it.

67 That was, however, part of the discussion on likelihood of confusion, rather than in relation to the issue of similarity of services (on which the court had already concluded that the services were identical or similar: *Staywell (CA)* at [42]–[43]).

Likelihood of confusion

Considerations of marks-similarity and goods/services-similarity

68 The next question is whether there is likelihood of confusion arising from marks-similarity and goods/services-similarity (see [22]–[23] above). The plaintiffs accept that for trade mark infringement the likelihood of confusion must arise from marks-similarity and goods/services-similarity.[27]

69 As I have found the defendants' Luke's Lobster trade marks to be dissimilar from the plaintiffs' Luke's Oyster Bar & Chop House trade mark, strictly speaking, the question of confusion does not arise, as the Court of Appeal observed in *Polo* ([22] above) (at [25]). But even if there is similarity of marks, and similarity of goods or services, it does not necessarily follow that confusion will automatically arise. A broader approach is appropriate to determine if there is confusion.

70 The confusion analysis is, however, relevant to the passing off claim, and so I consider if there is likelihood of confusion, assuming that the Luke's Lobster trade marks are regarded as similar to the plaintiffs' trade mark.

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[27] PCS at para 169.

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Nevertheless, if there is only a low degree of similarity between the marks, the likelihood of confusion would be low (see *Staywell (CA)* at [96(a)]).

71 What needs to be established is a likelihood of confusion as to the origin of the goods or services in question – that extends to the situation where the average consumer mistakenly assumes some kind of economic link or connection between the goods or services of the opposing parties (*Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 ("*Hai Tong*") at [73]–[74]). The likelihood of confusion required is that which is to be expected amongst a substantial portion of the relevant segment of the public – that does not need to amount to a majority, but it must go beyond a "*de minimis*" level (*Hai Tong* at [78(e)]).

72 "Initial interest confusion" does not constitute "confusion" for the purposes of ss 8(2) and 27(2) of the TMA. As the Court of Appeal stated in *Staywell (CA)* ([23] above) (at [113]):

> If a consumer is initially confused but this is unlikely to persist to the point of purchase because of a lack of sufficient similarity in the marks or the goods then the purpose of the trade mark as a 'badge of origin' has not been undermined.

73 In the case of restaurants, the relevant time for evaluating confusion is thus the point of purchase.

74 In *Staywell (CA)*, the Court of Appeal provided a non-exhaustive list of factors which would be admissible in the confusion inquiry (at [96(a)]–[96(b)]):

> (a) Factors relating to the impact of marks-similarity on consumer perception: the degree of similarity of the marks themselves, the reputation of the marks, the impression given by the marks, and the

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possibility of imperfect recollection of the marks. The greater the similarity between the marks, the greater the likelihood of confusion.

(b) Factors relating to the impact of goods-similarity on consumer perception: factors concerning the very nature of the goods without implicating any steps that are taken by the trader to differentiate the goods. This includes the normal way in or the circumstances under which consumers would purchase goods of that type, whether the products are expensive or inexpensive items, the nature of the goods and whether they would tend to command a greater or lesser degree of fastidiousness and attention on the part of prospective purchasers, and the likely characteristics of the relevant consumers and whether they would or would not tend to apply care or have specialist knowledge in making the purchase.

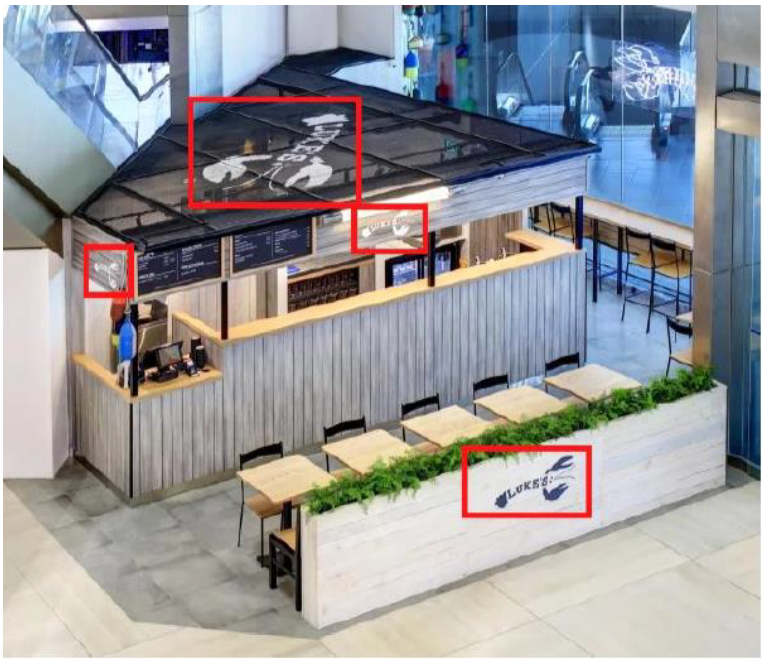
75 In relation to restaurants, the following discussion in *Han's* ([3] above) is instructive (at [162] and [175]) (see also [34(c)] above):

> 162 Both the Plaintiff's restaurants and the Defendant's restaurant are brick-and-mortar establishments. The visual and conceptual aspects of the marks in question will therefore have a significant impact on customers. Potential patrons, who will be physically present at the establishments, will have direct perception of the respective marks as they are displayed. They will likely glance at the menu and the fare on offer, both of which are likely to be adorned by the respective marks, before deciding to patronise the establishment. Phonetic similarity, while present, plays only a diminished role in assessing the likelihood of confusion. I have considered the three aspects of similarity above … and have concluded that there is conceptual dissimilarity and slight visual similarity between the [Han's marks] and the [HAN sign].
>
> …
>
> 175 These three reasons lead me to conclude that there is no likelihood of confusion from the Defendant's use of the HAN sign. There is only slight visual similarity. The conceptual dissimilarity is manifest. Further, the reputable Han's trade

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> marks militate against confusion. The average consumer who approaches the Defendant's restaurant, and observes the HAN sign that is applied at various positions in and around the restaurant, would be disabused of any notion that there is an economic connection between the Plaintiff's goods and services and those of the Defendant.

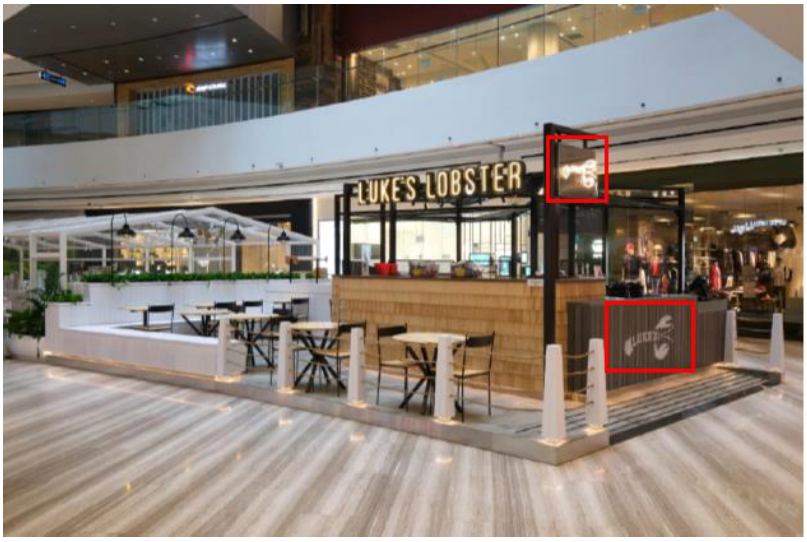
76 In the present case, too, the plaintiffs' restaurants and the defendants' Luke's Lobster shacks are brick-and-mortar establishments. The Luke's Lobster trade marks are indeed prominently displayed at the defendants' restaurants, as the following photographs show (with the locations of the Luke's Lobster logo marked):[28]



Luke's Lobster at Isetan, Shaw House

[28] Mr Pillai's AEIC at paras 14–15.

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Luke's Lobster at Jewel, Changi Airport

77 Having registered the Luke's Oyster Bar & Chop House trade mark, the plaintiffs then did use it much. It is used on the shopfront window of the plaintiffs' Gemmill Lane restaurant;[29] it is also on business cards of the plaintiffs' representatives.[30] However, it is the Luke's Oyster Bar & Chop House logo (see [6] above) – which is not a registered trade mark – that is used on the plaintiffs' Facebook[31] and Instagram pages,[32] the plaintiffs' website,[33] the plaintiffs' menu,[34] and the plaintiffs' products.[35] Gregory Ian Coops ("Mr Coops") of Asian Strategies Pte Ltd ("Asian Strategies") – which did a survey for the plaintiffs ("the Survey") – confirmed that the Luke's Oyster Bar & Chop

29 ABOD Vol I at p 20; DBOD Vol I at p 82.

30 ABOD Vol I at p 25.

31 ABOD Vol I at p 42.

32 ABOD Vol I at p 261.

33 ABOD Vol I at pp 11–16.

34 ABOD Vol I at pp 36–40.

35 ABOD Vol I at pp 29–30.

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House logo "was the one that was most commonly in use".[36] That survey, which the plaintiffs relied on for both its trade mark and passing off claims, did not use the plaintiffs' registered trade mark at all, but only the unregistered Luke's Oyster Bar & Chop House logo, a point I will return to (see [192] below).

78 For the present, I would simply observe that given the limited use of the plaintiffs' Luke's Oyster Bar & Chop House trade mark, that mark did not have a strong reputation (and neither were the plaintiffs' restaurants widely known). Indeed, Mr Coops' evidence was:[37]

> Luke's Oyster Bar & Chop House would not be known by the general population. It's a very, very narrow audience.
>
> …
>
> Everyone in the world has heard of Clinique, but very few people would have heard of Luke's Oyster Bar & Chop House.
>
> [emphasis added]

79 These are some photographs of the Luke's Oyster Bar & Chop House restaurants:[38]



36 Transcript, 9 Mar, p 130 lines 8–10.

37 Transcript, 10 Mar, p 63 lines 6–8; p 64 lines 12–14.

38 Mr Pillai's AEIC at para 15(b).

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Interior of the plaintiffs' restaurant at Gemmill Lane



Interior of the plaintiffs' (now closed) restaurant at Heeren

80 In *Han's* ([3] above), the court noted that restaurant services embrace a broad range of different types of food outlets, and went on to hold that the significant differences in style, price, range and type of food and services offered are relevant in considering the likelihood of confusion – in that case, the plaintiff's "Han's" restaurants were relatively inexpensive, whereas the defendant's "Han Cuisine of Naniwa" restaurant served fine dining Japanese food (at [179]–[181]).

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81 In similar vein is the decision in *Doctor's Associates Inc v Lim Eng Wah (trading as SUBWAY NICHE)* [2012] 3 SLR 193 ("*Subway*"), which pre-dated *Staywell (CA)* ([23] above). *Subway* concerned the international sandwich chain "Subway" and the defendant's "Subway Niche" stalls which sold Nyonya kueh, bubble tea, and other local snacks. The court held that it had not been established that even a *de minimis* section of the public would be confused by the plaintiff's and the defendant's marks, which the court had found to be similar (at [41]), and noted (at [51]):

> The pains taken by the defendant to distinguish his goods from the plaintiff's weigh in strongly against the likelihood of any confusion. In particular, the sale, display and handing over of the sandwiches to customers differed … Similarly, the prices of the sandwiches sold by the two parties differ significantly. Finally, the defendant's sandwiches are sold in the defendant's outlets which employ a very different interior design scheme from that shared by the plaintiff's SUBWAY outlets.

82 Given the mark-centric approach set out in *Staywell (CA)* (at [96(a)]), for the inquiry into confusion for the purposes of trade mark infringement, I would first not factor in the significant differences in style, price, range and type of food and services in the present case. Even so, I find that there is no likelihood of confusion, having regard to:

(a) the non-similarity (or low similarity) of the marks (see [63] above);

(b) the sparse use the plaintiffs made of their Luke's Oyster Bar & Chop House trade mark (see [77] above), coupled with the plaintiffs' restaurants not being known by many (see [78] above); and

(c) some degree of fastidiousness and attention being expected on the part of prospective purchasers, in relation to restaurant services (see *Hai Tong* ([71] above) at [85(c)]).

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83 If I then took into account the significant differences in style, price, range and type of food and services in the present case (as the court did in *Han's* ([3] above)), that would only accentuate the differences between the plaintiffs' restaurants and the defendants' Luke's Lobster shacks. I elaborate on this at [132]–[140] below.

The plaintiffs' survey evidence

84 The plaintiffs relied heavily on the Survey conducted by Asian Strategies, whose principal Mr Coops testified at trial (see [77] above).

85 The Court of Appeal in *Sarika Connoisseur Café Pte ltd v Ferrero SpA* [2013] 1 SLR 531 ("*Sarika (CA)*") stated, "[s]urvey evidence is relevant in assessing whether there is a likelihood of confusion on the part of the relevant public", but went on to agree with the High Court judge that survey evidence should not be conclusive; rather it is only one factor in the global confusion analysis (at [64]).

86 In determining the weight to be accorded to survey evidence, the High Court in *Ferrero SpA v Sarika Connoisseur Cafe Pte Ltd* [2011] SGHC 176 ("*Sarika (HC)*") adopted guidelines from Whitford J's decision in *Imperial Group Ltd v Philip Morris & Co* [1984] RPC 293 ("the Whitford Guidelines"), which included (at [134]):

> (a) the interviewees in the survey must be selected so as to represent the relevant cross-section of the public;
>
> …
>
> (c) the survey must be conducted fairly;
>
> …
>
> (e) the totality of the answers given must be disclosed and made available to the defendant;

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> (f) the questions must neither be leading, nor should they lead the person answering into a field of speculation he would never have embarked upon had the question not been put;
>
> …

87 Having regard to the Whitford Guidelines, there were a number of deficiencies in the plaintiffs' survey evidence. In the event, I place no weight on the findings of the Survey in so far as they are said to show a likelihood of confusion. That too was the fate of the survey in *Han's* ([3] above) (at [172]). My review of the plaintiffs' survey evidence and its shortcomings is at [191]–[241] below.

The plaintiffs' evidence of actual confusion

88 The plaintiffs rely not only on the Survey as evidence of *likelihood* of confusion, they also say that statements made by some participants interviewed by Mr Coops for the Survey show *actual* confusion.[39] Aside from the Survey, the plaintiffs also point to some emails and a social media post, as evidence of *actual* confusion.[40]

89 In particular, the plaintiffs say that the statements of two interviewees (citing verbatim comments no 14 and 22)[41] show that they had, <u>while confused</u>, eaten at the defendants' Luke's Lobster shack <u>first</u> before realising that it was not run by the plaintiffs.[42]

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39 PCS at para 115.

40 PCS at para 112(d).

41 Affidavit of Evidence-in-Chief of Gregory Ian Coops ("Mr Coops' AEIC") at pp 124–125.

42 PCS at para 118.

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90 This use of a survey is questionable. The Survey is not being relied upon as survey evidence. Instead, it is being used to get out-of-court statements from persons – who are not called as witnesses – whose statements are then put forward as evidence. Ironically, this is precisely what counsel for the plaintiffs had said he would not do, after the evidence had concluded. He had then said:[43]

> I'm not saying look at what this so-and-so guy said about this and therefore this must be his opinion, that would be hearsay. We are saying look at what Mr Greg Coops and his team and all the data analysts have done, this is the data and this is the proportion and that is admissible. So that is what we are going to rely on …
>
> [emphasis added]

91 To rely on the unsworn statements of two of 266 interviewees, without calling them as witnesses, is indeed hearsay as the plaintiffs' counsel had correctly recognised; it is not survey evidence. The plaintiffs' evidence of actual confusion is open to the same criticisms levelled against similar evidence in *Subway* ([81] above) (at [48] and [52]):

> 48 The plaintiff identified some isolated instances of actual confusion by members of the public, though some of these instances constituted hearsay and consequently must be disregarded …
>
> …
>
> 52 The evidence relied on by the plaintiff was deficient. The testimony given was vague and did not demonstrate that 'not an insubstantial number' of the public would be confused. The evidence described isolated incidents of individuals who were misled – no elaboration on the cause of the confusion or the extent of it or whether the individuals fit the archetypical 'moron in a hurry' mould was provided.

92 In contrast, in *Wagamama* ([55] above), eight customers actually gave evidence (at 715). Here, none did.

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[43] Transcript, 11 Mar, p 115 lines 19–25.

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93 In any event, I do not accept that the verbatim comments the plaintiffs rely on show that those two interviewees had purchased food from the defendants' Luke's Lobster shack thinking that it was associated with the Luke's Oyster Bar & Chop House restaurants in some way.

94 Comment 14 states (among other things) "*when I went there, the service was so bad that I realised it wasn't Lukes* … [it was] like a fast-food place not a restaurant" [emphasis added].[44] That does not show that the interviewee was confused *when the purchase was made* from the defendants' Luke's Lobster shack. The interviewee appears to have appreciated that the Luke's Lobster shacks have a fast-food model, and what the service was like (and indeed, that it was distinct from the plaintiffs' restaurants), before making a purchase.

95 Comment 22 states, "I saw the sign [Opening Soon]. I thought 'is this related to Luke's?' I thought I'd try it. When I ate there and saw the flyer which said it was from New York I realised it's not related [to Luke's]."[45] That too does not show that a purchase was made *before* the interviewee saw the flyer and realised that the defendants' Luke's Lobster shack was not related to Luke's Oyster Bar & Chop House. At best, it is ambivalent on the point, but the burden is on the plaintiffs to establish otherwise, and they never called that interviewee as a witness to testify to the incident.

96 In so far as these two comments might show initial interest confusion, that is not sufficient for the plaintiffs' purposes (see [72] above). If I were inclined to rely on those comments at all, they only show that from the visits to the defendants' Luke's Lobster shack, the interviewees had realised that Luke

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44 Mr Coops' AEIC at p 125.

45 Mr Coops' AEIC at p 125.

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Lobster and the plaintiffs were unconnected; they did not only find this out when they participated in the Survey.

97 I turn now to the five emails and one Facebook post which the plaintiffs rely on. Again, none of the persons were called as witnesses, and their unsworn out-of-court statements are hearsay. In any event, the contents of the emails and Facebook post do not assist the plaintiffs.

98 There is first a 4 August 2020 email from one Aaron of Ink Global to the plaintiffs asking for photographs for an article on the upcoming opening of Luke's Lobster at Isetan.[46] Mr Masiero conceded that it was unclear whether Aaron had intended to contact the plaintiffs or the defendants.[47] The email does not indicate that Aaron thought Luke's Oyster Bar & Chop House was opening a new outlet at Isetan; it does not even indicate that Aaron knew of the Luke's Oyster Bar & Chop House restaurants. Moreover, the email does not show any confusion at the point of purchase, it was sent before Luke's Lobster had even opened in Singapore on 23 September 2020 (see [8] above).

99 There are then emails from four individuals (whose names/emails I have anonymised).[48] None of them show confusion at point of purchase; the first three were sent before Luke's Lobster opened in Singapore:

(a) The 17 September 2020 email from one "H" says, "I saw that you guys will open a restaurant at Shaw Centre … When are you

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46 Mr Masiero's AEIC at para 28.

47 Transcript 9 Mar, p 146 lines 10–25; p 147 lines 1–18.

48 Mr Masiero's AEIC at para 33.

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opening?"[49] That was in advance of any patronage of the defendants' Luke's Lobster shack.

(b) The 19 September 2020 email from one "W" says, "I will like to find out if your restaurant and Luke's Lobster are affiliated under same parent. [*sic*] Is there a reservation hotline or online reservation for Luke's Lobster dining in?"[50] That too was in advance of any patronage of the defendants' Luke's Lobster shack. Moreover, it does not show that the sender was confused between Luke's Lobster and Luke's Oyster Bar & Chop House – she *asks* if there is a link.

(c) The 19 September 2020 email from one "M" says, "I'm so excited to see you're opening a new Luke's in Orchard! How can I make a reservation for your new outlet?"[51] That was likewise in advance of any patronage of the defendants' Luke's Lobster shack.

(d) The 23 October 2020 email from one "S" was the only one of the four sent after Luke's Lobster had opened in Singapore. It says, "I see you have opened a lobster roll outlet at Isetan. I am assuming it is you anyway. I love your lobster rolls. Congratulations and *hope to try it soon*! [emphasis added]"[52] That too shows that the sender had yet to make a purchase at the defendants' Luke's Lobster shack.

100 There is then a Facebook post from one "J" on 29 September 2020 with a photograph of a lobster roll and other food, on a table at the Luke's Lobster

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49 Mr Masiero's AEIC at p 1052.

50 Mr Masiero's AEIC at p 1054.

51 Mr Masiero's AEIC at p 1055.

52 Mr Masiero's AEIC at p 1056.

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shack at Isetan.[53] The location tag she had applied to that photo was that of "Luke's Oyster Bar & Chop House", and the suggestion was that she had thought she was dining at Luke's Oyster Bar & Chop House. However, her other Facebook posts the same day had location tags for "ION Orchard (Singapore, Singapore)" and "Marina Bay Singapore" applied to photos taken at Luke's Lobster, Isetan.[54] On the plaintiffs' reasoning, whilst at Isetan, Shaw House, J was confused in thinking that she was in multiple places at the same time: she was actually at Luke's Lobster, Isetan, but thought she was (a) across the road at ION Orchard; (b) further away at Marina Bay; and (c) at one of the Luke's Oyster Bar & Chop House restaurants. On social media, one can even location tag a photograph of Marina Bay Sands as "Downtown Chattanooga, Tennessee" – but what would that mean?

101 J's Facebook post is not good evidence of confusion at point of purchase, between Luke's Oyster Bar & Chop House, and Luke's Lobster. The plaintiffs did not call J as a witness; nor did they lead evidence to show that she was a customer of the plaintiffs' restaurants, or that she even knew of Luke's Oyster Bar & Chop House (other than as a location tag which she applied to one of her photos taken at Luke's Lobster at Isetan that day). One possible explanation is that she could simply have typed, "Luke" (or "Luke's") and picked "Luke's Oyster Bar & Chop House" from various alternatives suggested by Facebook.

102 Neither the survey evidence, nor the alleged evidence of actual confusion, is of much assistance to the plaintiffs on the issue of confusion. My decision is that the element of likelihood of confusion is not made out.

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53 Mr Masiero's AEIC at p 1057.

54 DBOD Vol I at pp 147 and 154; Transcript, 9 Mar, p 153 lines 3–25; p 154 lines 1–8; p 155 lines 13–25; p 156 lines 1–5.

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The "Own Name" Defence under s 28(1)(a) of the TMA

103 Even if the plaintiffs had made out that the marks are similar, and that there is a likelihood of confusion, the "own name" defence under s 28(1)(*a*) of the TMA stands to be considered.

104 Section 28(1) of the TMA reads:

> Notwithstanding section 27, a person does not infringe a registered trade mark when —
>
> (*a*) he uses —
>
> (i) his name or the name of his place of business; or
>
> (ii) the name of his predecessor in business or the name of his predecessor's place of business;
>
> (*b*) he uses a sign to indicate —
>
> (i) the kind, quality, quantity, intended purpose, value, geographical origin or other characteristic of goods or services; or
>
> (ii) the time of production of goods or of the rendering of services; or
>
> (*c*) he uses the trade mark to indicate the intended purpose of goods (in particular as accessories or spare parts) or services,
>
> and such use is in accordance with honest practices in industrial or commercial matters.

105 In *The Audience Motivation Company Asia Pte Ltd v AMC Live Group China (S) Pte Ltd* [2016] 3 SLR 617 ("*AMC*"), the Court of Appeal summarised the relevant principles to be applied when considering the applicability of the "own name" defence (at [65]–[66]) which included recognition that "[t]he defence is available in relation to the use of corporate names and this includes the use of the full company name as well as the defendant's trading name" (at [65(b)]). I thus cannot accept the plaintiffs' submission (citing *Premier Luggage*

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and Bags Ltd v Premier Co (UK) Ltd [2003] FSR 5 ("*Premier Luggage*") and *Asprey & Garrard Ltd v WRA (Guns) Ltd* [2002] FSR 31 ("*Asprey*")) that the defence is not available in relation to trading names.[55] Moreover, in *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2010] RPC 16 ("*Cipriani*"), the English Court of Appeal, which accepted that the "own name" defence is available in relation to trading names (at [72]), had stated that *Premier Luggage* was not authority for the proposition that the defence was unavailable for trading names (at [65]) and that the decision in *Asprey* had recognised that an established trading name might allow for successful use of the defence (at [67]). In that case, the defendant-company's name was Cipriani (Grosvenor Street) Ltd (at [59]) but the court considered that it could rely on the defence in relation to its trading name, "Cipriani London" if it established that such use was justified (at [73]).

106 "Luke's Lobster" is a trading name which the second defendant, Lukes Seafood LLC, has used since 2009, two years prior to the opening of the first of the plaintiffs' Luke's Oyster Bar & Chop House restaurants in 2011 (see [4] and [8] above). In this regard, I would treat the Luke's Lobster logo where "Lobster" is conveyed by way of a lobster device rather than a word, as no different from the "Luke's Lobster" word mark (where "Lobster" is conveyed by words).

107 I further accept that the second defendant's use of "Luke's Lobster" for its Singapore lobster shacks is in accordance with the "honest practices" proviso to s 28 of the TMA. Not only did the use of the trade name "Luke's Lobster" pre-date the opening of the plaintiffs' Luke's Oyster Bar & Chop House restaurants, "Luke's Lobster" is named after its co-founder and CEO Luke Holden ("Mr Holden") (in this regard, nothing turns on the use of the English

[55] PCS at paras 189(a)–(b).

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"Luke" rather the Latin "Lucas" which is formally Mr Holden's first name (see [10] above),[56] especially since it was another Lucas – Mr Masiero's son – that the Luke's Oyster Bar & Chop House restaurants were named after (see [7] above)). In *AMC*, the Court of Appeal cited *Cipriani* (at [66]), which recognised that in principle an individual can use the defence "in relation to an adopted name by which he or she is known for business purposes or generally, for example an actor's stage name or a writer's *nom de plume*", and that a corporate entity should be able to do likewise (at [47]).

108 Moreover, the Luke's Lobster trade marks were successfully registered in 2018 (see [12] above): the plaintiffs did not oppose that registration,[57] nor did the Registry of Trade Marks cite the plaintiffs' trade mark against the applications.[58]

109 In contrast, the Korean Intellectual Property Office had issued a provisional refusal against registration of the Luke's Lobster logo, citing the plaintiffs' registration for their Luke's Oyster Bar & Chop House trade mark;[59] the second defendant had filed a non-use cancellation action in Korea.[60]

110 In Hong Kong, the second defendant also filed a non-use revocation action against the plaintiffs' Luke's Oyster Bar & Chop House trade mark – that was resolved on the basis of the plaintiffs' proposal for co-existence and

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56 PCS at para 188.

57 Defendants' Closing Submissions ("DCS") at para 131(a)(ii).

58 DCS at para 131(a)(i).

59 Plaintiffs' Supplementary Bundle Volume III at pp 2154–2156; Transcript, 11 Mar, p 24 lines 21–25; p 25; p 26 lines 1–10.

60 DCS at para 131(a)(ii).

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withdrawal of the revocation action.[61] Notably, the plaintiffs' solicitors wrote, "[o]ur client is of the view that your client's [*ie*, the second defendant] target customers base is likely to be very different from our client's target customer base".[62]

111 Given the Singapore registrations, which were unopposed, and how the position in Hong Kong had been resolved, it was reasonable for the second defendant to think that it could open lobster shacks in Singapore under the name "Luke's Lobster" (as all its other shacks were named), and that the plaintiffs would likely not object.

112 I thus find that the second defendant is entitled to rely on the "own name" defence.

113 The first defendant too is entitled to rely on the "own name" defence. The first defendant is the exclusive licensee of the second defendant,[63] and under the Franchise Agreement between them, the first defendant has been given the same rights and remedies as the second defendant in respect of defending against or initiating any litigation in Singapore related to or in connection with the "Licensed Marks", save as expressly excluded under that agreement.[64] Section 45(1) of the TMA recognises that: "[a]n exclusive licence may provide that the licensee shall have, to such extent as may be provided by the licence, the same rights and remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment."

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61 Mr Holden's AEIC at para 21(b).

62 Mr Holden's AEIC at p 724.

63 Mr Pillai's AEIC at para 8.

64 Mr Pillai's AEIC at pp 66–67.

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114 The plaintiffs submitted that even if the second defendant could rely on the "own name" defence, the first defendant could not – because of matters that related particularly to the first defendant:[65]

(a) the first defendant's CEO, Vijay Kumar s/o Sreekumar Pillai ("Mr Pillai") had, for at least 10 years, known the plaintiffs' directors Mr Masiero and Jeremy Muller ("Mr Muller") (whose company, Peccavi Wines Pte Ltd, was also a shareholder of the plaintiffs);

(b) in 2011 Mr Pillai had proposed to Mr Masiero to cooperate in a restaurant business;

(c) Mr Pillai had over the years visited the Luke's Oyster Bar & Chop House restaurants at least 10 times, and must know that they serve seafood including lobsters;

(d) Mr Pillai had referred to the plaintiffs' restaurants as "Luke's" in a WhatsApp message to Mr Muller;

(e) the first defendant would have done all the necessary due diligence before bringing in a new brand – like Luke's Lobster; and

(f) Mr Pillai had intimate knowledge of the plaintiffs' business and goodwill, and so it would be unfair of the first defendant as franchisee to be able to rely on the "own name" defence, even if the second defendant could do so.

115 I do not agree with the plaintiffs' contentions on this. The successful, and unopposed, registrations of the Luke's Lobster trade marks in Singapore

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65 PCS at para 191.

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would have indicated not only to the second defendant, but also to the first defendant and Mr Pillai, that Luke's Lobster could likely open in Singapore without issue. Moreover, I do not believe Mr Pillai thought there was a likelihood of confusion between Luke's Lobster, and Luke's Oyster Bar & Chop House.

The "Registered Mark" defence under s 28(3) of the TMA

116 Section 28(3) of the TMA reads:

> Notwithstanding section 27, a registered trade mark is not infringed by the use of another registered trade mark in relation to goods or services for which the latter is registered.

117 Unless the registration of the Luke's Lobster trade marks is declared invalid, the second defendant as the owner of the marks is entitled to use them, without that use being an infringement of the plaintiffs' Luke Oyster Bar & Chop House trade mark; and the first defendant as the second defendant's exclusive licensee is likewise entitled to the defence (as discussed at [113] above).

118 I consider the plaintiffs' claim for invalidity at [179] below.

119 Even without the "Registered Mark" defence, the plaintiffs' trade mark infringement claim would fail for the reasons I have stated above, and I dismiss that claim.

Are the defendants liable for passing off?

120 The tort of passing off requires proof of goodwill, misrepresentation, and damage: *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 ("*Novelty*") at [36].

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Goodwill

121 I accept that the plaintiffs had goodwill in their Luke's Oyster Bar & Chop House restaurant business: there is an "attractive force that brings in custom", *ie* customers to the restaurants (see *Novelty* at [39], citing Lord Macnaghten in *The Commissioners of Inland Revenue v Muller & Co's Margarine Limited* [1901] AC 217 at 223–224).

122 What is the get-up that is distinctive of the plaintiffs' business? Is it the name of the restaurants ("Luke's Oyster Bar & Chop House"), the plaintiffs' registered trade mark and unregistered logo, the plaintiffs' food and beverage offerings, or some combination of these and perhaps other factors besides? The plaintiffs contend that "Luke's" by itself is distinctive of their business, but in my analysis of their trade mark infringement claim, I have already rejected that (see [43]–[46] above). The plaintiffs' goodwill is not associated with "Luke's" *simpliciter*. Rather, the plaintiffs' restaurants are known as oyster bars and chop houses. "Oyster Bar" and "Chop House" are not only in the name of the restaurants – "Luke's Oyster Bar & Chop House" – but also in both the Luke's Oyster Bar & Chop House trade mark and the unregistered Luke's Oyster Bar & Chop House logo. The plaintiffs' goodwill is also associated with the Travis Masiero Restaurant Group (which is part of their trade mark), and restaurateur Mr Masiero (whose name is part of their logo).

Misrepresentation

123 Whether there is misrepresentation must be tested against what the plaintiffs' restaurants' goodwill is associated with, *ie*, not "Luke's", but "Luke's Oyster Bar & Chop House", as part of the Travis Masiero Restaurant Group.

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124 As I have found in analysing the trade mark infringement claim, a personal name like "Luke" (or its possessive form, "Luke's") is of low distinctiveness, and the average consumer will be sensitive to additional words and/or features that accompany (and qualify) "Luke's" (see [43] above): they would distinguish between the Luke's Oyster Bar & Chop House trade mark and the Luke's Lobster trade marks.

125 As the court in *Han's* ([3] above) noted, in a passing off claim (at [199]):

> The court is entitled to take a broader view of the context within which the respective marks are employed in ascertaining whether a likelihood of confusion exists for the passing off tort. … The court is entitled to consider factors extraneous to the marks that would be impermissible in an action for infringement of a registered mark.

126 In the present case, the less mark-centric the approach, the lower the likelihood of any misrepresentation or confusion, for there are many differences between the two sides.

127 In assessing misrepresentation and confusion, I accept the defendants' submission that initial interest confusion is insufficient for passing off, just as it is insufficient for the purposes of trade mark infringement.[66] In *Law of Intellectual Property of Singapore* (Sweet & Maxwell, 2nd Ed, 2014), the learned author Professor Ng-Loy Wee Loon, SC (who had been the *amicus curiae* in *Staywell (CA)* ([23] above)) stated that (at para 18.3.7):

> There can be no doubt that the appellate court intended this aspect of its decision [that the doctrine of initial interest confusion is not part of the law] to apply to the confusion inquiry arising under the Trade Marks Act, as well as the confusion inquiry arising in the common law action for passing off. Thus, to satisfy the second element in passing off, the

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66 DCS at paras 161–164.

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> material time at which confusion or likelihood of confusion must exist is the point of purchase.

128 Indeed, it would not make sense if Starwood should fail in opposing the registration of Staywell's "Park Regis" marks because initial interest confusion does not suffice for trade mark purposes, but could then successfully sue Staywell in passing off for using those registered marks.

129 In England too, the doctrine of initial interest confusion does not apply in a passing off claim: see *Moroccanoil Israel Ltd v Aldi Stores Ltd* [2015] ECC 6 (at [25]).

130 The plaintiffs contend that initial interest confusion can suffice in the passing off context.[67] They rely on a commentary in Christopher Wadlow, *The Law of Passing Off: Unfair Competition by Misrepresentation* (Sweet & Maxwell, 5th Ed, 2016) ("*The Law of Passing Off*") at para 5-181 on *Knight v Beyond Properties Pty Ltd and others* [2007] EWHC 1251 (Ch) ("*Knight v Beyond Properties*"), which suggests that – in the context of a television programme – if initial confusion would cause damage to the claimant's goodwill, that should be sufficient. However, in *Knight v Beyond Properties*, the court drew a distinction between the viewing of a television programme and cases concerning the sale of goods in a shop; and accepted that in the latter, confusion must persist until the point of sale, which is the "critical time" before damage may result (at [81]). Indeed, that provides the relevant comparison in our case, which concerns restaurants with food products that are bought, not television programmes that are viewed. Furthermore, in *The Law of Passing Off*, Professor Christopher Wadlow ("Prof Wadlow") commented that *Knight v Beyond Properties* should not be taken as standing for the proposition that initial

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67 PCS at paras 110–111.

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interest confusion is sufficient for establishing passing off (at para 5-182). I proceed on the basis that even for their passing off claim, the plaintiffs must establish confusion at point of purchase, not initial interest confusion.

131 In the present case, the defendants did not use the name "Luke's Lobster" for their lobster shacks because they wanted to capitalise on the goodwill of Luke's Oyster Bar & Chop House. To the contrary, the name "Luke's Lobster" was in use some two years before the first Luke's Oyster Bar & Chop House restaurant was opened (see [8] above); and all of the second defendant's lobster shacks (*ie*, including those outside of Singapore) are called "Luke's Lobster". The fact that the name was chosen *bona fide* makes a finding of deception less likely (*AMC* ([105] above) at [105]; *Han's* ([3] above) at [201]).

132 There are also many significant differences in style, price, range and type of food and services, between the two sides. For example, in *Han's*, the court noted the stark difference in the market segments targeted by the parties, respectively. The Han's restaurants were known for being "value for money", and "affordable and good", with the most expensive item on its menu being the $16.80 NZ Prime Sirloin Steak with Black Pepper Sauce (at [203]). The Han Cuisine of Naniwa restaurant on the other hand served omakase- and kaiseki-style sets, the Japanese equivalents of western fine dining; and it had a substantial wine and alcohol menu (at [203]).

133 The same comparisons may be made in the present case, save that the plaintiffs' restaurants are the fine dining ones, and the defendants' Luke Lobster shacks the simpler and relatively cheaper ones.

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134 The plaintiffs describe their Luke's Oyster Bar & Chop House restaurants as fine dining restaurants with an "elegant yet personable and comfortable" dining atmosphere.[68] The contrast with the defendants' Luke's Lobster shacks was well put by Mr Masiero himself in his Affidavit of Evidence-in-Chief ("AEIC"):[69]

> 38 … the Plaintiffs have taken great care to build tremendous goodwill by offering a personable, high quality dining experience where the customer can build a rapport with the chef, staff, and enjoy fine dining in a modern classic bistro interior décor.
>
> 39 On the other hand, I understand the 2nd Defendant's lobster shacks to be more akin to fast food chains or restaurants offering 'quick bites' where its lobster rolls are priced around S$25.50 in Singapore … the launch by the 1st Defendant of a restaurant using a confusingly similar name offering a fast-food type of experience is likely to dilute and tarnish the value of the Plaintiffs' brand and reputation as a restaurant offering fine dining services.

135 Indeed, as the photographs I have set out above show, the plaintiffs' restaurants are spacious fine dining establishments (see [79] above), whereas the defendants' Luke's Lobster shacks are small, casual, grab-and-go outlets with limited seating (see [76] above).

136 Mr Masiero further noted that HungryGoWhere assesses the average price of a trip to the Luke's Oyster Bar & Chop House restaurant at The Heeren at $108, and a trip to the one at Gemmill Lane at $153; he says this is "unsurprising".[70]

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68 Mr Masiero's AEIC at paras 7 and 20.

69 Mr Masiero's AEIC at paras 38–39.

70 Mr Masiero's AEIC at para 38.

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137 From the plaintiffs' menu,[71] the cheapest item in the "chops and a burger" section is a burger at $36 (without cheese, bacon, or egg, which are available at extra cost); the other items in that section range from $78 (Kurobuta pork chop) to $99 (USDA prime rib). There are also Chop House classics including "signature fish of the day" at market price, whole steamed lobster (available on weekends only) also at market price, and three other items ranging from $55 (Georges Bank scallops) to $115 (Luke's lobster pot pie). One can also order table snacks, items from the Oyster Bar, starters, sides, desserts & cheese, and caviar – ranging from $30 for a 5g spoon, to $200 for 30g of Osciètre caviar.

138 In contrast, the mains at the defendants' Luke's Lobster shacks are: lobster roll ($25.50), crab roll ($23.50), shrimp roll ($21.50), and the Luke's Trio – halves of each of the above three rolls ($33.50).[72]

139 Besides a two-page food menu (which also covers beer and some cocktails), the plaintiffs' restaurants have a 20-page wine and drinks list with a number of wines above $1,000, all the way up to $10,380 for the 1995 Screaming Eagle red wine from Napa Valley.[73]

140 The defendants' Luke's Lobster shacks, on the other hand, only have a one-page menu for all the food and drink items on offer:[74] the most expensive drink being the Little Creatures IPA Pint at $17.50. Ordering that together with the most expensive food item (the Luke's Trio at $33.50) would only cost $51.

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71 ABOD Vol I at pp 36–40.

72 Agreed Bundle of Documents Volume II ("ABOD Vol II") at p 1172.

73 Mr Pillai's AEIC at pp 848–886.

74 ABOD Vol II at p 1172.

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An average trip to the plaintiffs' restaurants costs some two to three times of that.

141 In an obvious attempt to play up similarities between Luke's Oyster Bar & Chop House, and the defendants' Luke's Lobster shacks, the plaintiffs claimed that amongst their best known and best-selling dishes are "Luke's Lobster Roll(s); lobster pot pie; whole steamed lobster; Jumbo Lump Crab Cakes; oysters and Signature Foley 'George Bank Scallops'" [emphasis in original].[75]

142 I find the plaintiffs' claim to fame in relation to lobster dishes to be somewhat exaggerated. First, as I noted above (at [137]), their menu states that the whole steamed lobster is only available on weekends. As for the lobster roll, that is not on their main menu, and it is only available at lunch (see [15] above). Mr Masiero says the lobster roll has always been an "off menu" lunch special, and that he expects "many" of the plaintiffs' customers to know about their lobster rolls because lobster rolls would "often" be recommended to customers by the plaintiffs' staff.[76] The lobster rolls are featured on the plaintiffs' "lunch plates" menu at $48.[77] That costs significantly more than the lobster roll at the defendants' Luke's Lobster shacks, which costs just over half of that, at $25.50.

143 The plaintiffs' own evidence is that lobster-related dishes have contributed only around 5% of their restaurants' total revenue (see [15] above).[78]

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75 Mr Masiero's AEIC at para 15.

76 Mr Masiero's AEIC at para 16.

77 ABOD Vol I at p 38.

78 Mr Masiero's AEIC at paras 17–18.

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The defendants' Luke's Lobster restaurants, on the other hand, are overwhelmingly lobster shacks.

144 I do accept that the plaintiffs' restaurants have some reputation for, and goodwill in, lobster dishes, including lobster rolls. The plaintiffs' restaurants have been named in media articles as being among the places in Singapore selling lobster rolls[79] – see, *eg* Rebecca Lynne Tan, "8 places for lobster rolls in Singapore", *The Straits Times* (12 May 2017).[80] But it is as an Oyster Bar, and Chop House, that the plaintiffs' restaurants are better known for.

145 The plaintiffs contend that the second defendant's outlet in Portland Pier, Maine, USA is a "flagship full service restaurant",[81] and so that Luke's Lobster outlet has more similarities with the plaintiffs' restaurants.[82] The Luke's Lobster shacks in Singapore, however, do not offer as many menu items, or wait service, unlike the Portland Pier one. Nor is there any evidence that the defendants intend to open a Luke's Lobster outlet in Singapore that is like the Portland Pier one. The evidence of Mr Holden was that the Portland Pier outlet was not a full service restaurant as one would understand that concept: one could have wait service, but one could also order direct; and most of the sales were over the phone or through an online application.[83] Moreover, the time from ordering to food service was almost the same time as in any other Luke's Lobster shack, it was very much an in-and-out concept, and the outlet turned

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79 Mr Masiero's AEIC at para 20.

80 Mr Masiero's AEIC at p 844.

81 ABOD Vol II at pp 1061–1079; Transcript, 11 Mar, p 7 lines 18–25; pp 8–11; p 12 lines 1–11.

82 PCS at para 34.

83 Transcript, 11 Mar, p 11 lines 13–24.

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tables probably three times faster than any other wait-staff model within Portland.[84]

146 Ultimately, the plaintiffs get nowhere seeking to focus on the Luke's Lobster outlet in Portland Pier– it is more relevant to compare the plaintiffs' restaurants with the Luke's Lobster shacks in Singapore, and the differences are stark (see [134]–[143] above).

147 The plaintiffs also point to their "Lobster Shack" takeaway event, which ran for two weekends in June 2020,[85] to argue that they and the defendants were not in dissimilar market segments.[86]

148 That Lobster Shack event was, however, only run for those two weekends, during the near ten-week period in 2020 when dining-in was not allowed (from the start of the "circuit breaker" on 7 April 2020 until dining-in resumed with Phase 2 of re-opening on 19 June 2020). During that event, Luke's Oyster Bar & Chop House sold lobster rolls at $30 (admittedly, a price closer to the defendants' $25.50), but since then, the lobster roll has gone back to being a $48 lunch item at the plaintiffs' restaurants. Indeed, Mr Masiero testified that that the takeaway market "is not a sustainable business model for any restaurant",[87] whilst also saying that he was keeping his options open.[88]

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84 Transcript, 11 Mar, p 8 lines 22–25; p 9 lines 1–6.

85 Mr Masiero's AEIC at para 43; Transcript, 9 Mar, p 74 lines 10–25; p 75 lines 1–4; p 163 lines 19–25; p 164 line 1.

86 PCS at para 125.

87 Transcript, 9 Mar, p 174 lines 22–24.

88 Transcript, 9 Mar, p 175 line 10.

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149 It is quite clear, though, that if the plaintiffs do expand into the takeaway market, they do not intend to use the name "Luke's Oyster Bar & Chop House". For their Lobster Shack event in June 2020, they used the following mark (the "Lobster Shack mark"):[89]



150 That mark did not bear the name "Luke's Oyster Bar & Chop House", or indeed, "Luke's".

151 On 10 September 2020, however, the plaintiffs applied to register the following as a trade mark in Class 43 of the ICGS (the "Lobster Shack by Luke's mark"):[90]



89 Mr Masiero's AEIC at p 77.

90 Mr Masiero's AEIC at para 43 and pp 1075–1077.

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152 That was some three months after the plaintiffs' Lobster Shack event in June 2020. Moreover, the plaintiffs' application for an injunction against Luke's Lobster opening in Singapore was pending, headed for a hearing on 16 September 2020.[91] The words, "An Ode to the New England Summer" as used in the Lobster Shack mark were replaced by the words, "by Luke's", at a time when the plaintiffs were asserting that "Luke's" *per se* is distinctive of them.

153 The Registry of Trade Marks declined to allow registration of the Lobster Shack by Luke's mark on the basis that it conflicted with the registered Luke's Lobster trade marks.[92] Indeed, the plaintiffs' proposed new mark is confusingly similar to the Luke's Lobster trade marks, because it uses "Lobster" in conjunction with "Luke's". That does not, however, mean that the Luke's Lobster trade marks are confusingly similar to the plaintiffs' existing Luke's Oyster Bar & Chop House trade mark and unregistered Luke's Oyster Bar & Chop House logo – they are not.

154 The plaintiffs' failed attempt to register the Lobster Shack by Luke's mark as a trade mark, does not show that the plaintiffs genuinely wish to expand into the takeaway/grab and go/lobster shack market under that name. Rather, they simply wished to stop Luke's Lobster from using its own name in Singapore.

155 There was also evidence of very long queues at the Luke's Lobster shack at Isetan.[93] On the other hand, the plaintiffs' customers were described by Mr

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91 DCS at para 109(c).

92 Mr Masiero's AEIC at pp 1078–1080.

93 Mr Pillai's AEIC para 9(g).

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Coops as busy people, the sort that go to fine dining restaurants.[94].The plaintiffs' customers would likely not be the kind to queue up at the defendants' Luke's Lobster shacks (although 6%, *ie*, some 16 out of 266 interviewees who responded to the Survey (see [84] above), said they had been there,[95] and, in particular, two of them – whose verbatim comments were relied on by the plaintiffs as evidence of confusion (see [94]–[95] above) – had eaten there).

156 The many differences between the plaintiffs' restaurants, and the defendants' Luke's Lobster shacks in Singapore, reinforce my conclusion that there was no misrepresentation by the defendants' use of the name "Luke's Lobster", and hence no likelihood of confusion. My analysis of the issue of confusion in relation to the trade mark infringement claim (see [76]–[82] above), the plaintiffs' survey evidence (see [84]–[87] above), and the plaintiffs' evidence of actual confusion (see [98]–[102] above), is also relevant to the passing off claim – indeed, with a wider range of extraneous factors in play, the plaintiffs' case for passing off is weaker than their claim for trade mark infringement, which I have already found to be without merit.

Damage

157 Given the absence of misrepresentation and confusion, the element of damage is also not made out.

158 Even if there had been some likelihood of confusion, the plaintiffs have a poor case on damage. I glean the following main contentions on the issue:

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94 Transcript, 10 Mar, p 114 lines 9–25; p 115 lines 1–22.

95 Mr Coops' AEIC at p 117.

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(a) confusion would lead to some of the plaintiffs' customers patronising the defendants' Luke's Lobster shacks instead of the plaintiffs' restaurants (direct loss of sales, or blurring);[96]

(b) confusion would lead to some of the plaintiffs' customers being disappointed with the plaintiffs, because of the lower level of service or standards at the defendants' restaurants (tarnishment);[97]

(c) the plaintiffs have been restricted from expanding into the takeaway/grab and go/lobster shack market (restriction on expansion);[98]

(d) the plaintiffs would have lost the "exclusivity" in their trade name "Luke's";[99]

(e) there is damage arising from the plaintiffs' customers being confused into thinking that there is an economic association between the plaintiffs and the defendants, exacerbated by both sides running restaurants and thus being competitors.[100]

Direct loss of sales

159 The plaintiffs cite *The Law of Passing Off* ([130] above) (at para 4-27) for the proposition that direct loss of sales is the major head of damage in most cases in which the parties are in actual competition.[101] However, the plaintiffs

96 PCS at paras 123(a) and 131.

97 PCS at paras 123(b) and 126–130.

98 PCS at paras 124–125.

99 PCS at para 123(c).

100 PCS at para 123(d).

101 PCS at para 131.

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adduce no evidence of direct loss of sales. They do not, for instance, provide sales figures before and after Luke's Lobster opened in Singapore, to show that that they had lost customers to the defendants. Instead, they simply rely on the Survey to say it showed that confusion was likely; and so it was likely that they had lost, and would lose, business to the defendants. As I have stated above (at [84]–[87] above), I do not consider the plaintiffs' survey evidence reliable. What is more, none of the 266 participants interviewed for the Survey said that they had eaten at the defendants' restaurants *instead* of the plaintiffs' restaurants. Even the two who provided comments about eating at the defendants' restaurant (see [94]–[95] above) did not say that if they had not eaten there on those occasions, they would have gone to the plaintiffs' restaurants instead.

Blurring/tarnishment

160 Citing *Novelty* ([120] above) and *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR (R) 975, the plaintiffs contend that confusion would result in:

(a) blurring, *ie*, loss of the plaintiffs' business to the defendants; and

(b) tarnishment, *ie*, the plaintiffs' customers will think less well of the plaintiffs, because the defendants' restaurant is not a fine dining establishment like the plaintiffs' restaurants, but one with lower levels of service and standards.

161 I have addressed the "blurring" argument in the previous section – the plaintiffs have not shown that they had lost and/or would lose business to the defendants' restaurants (see [159] above). As for tarnishment, the different dining experiences offered by the plaintiffs and defendants go against the

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plaintiffs at the misrepresentation/confusion stage of the analysis (see [132]–[146] above).

162 The plaintiffs' argument is that the value of their "brand and reputation as a restaurant offering *fine dining* services" may suffer if it is confused with the defendants' restaurants, which offers a "*fast-food type* experience" [emphasis in original].[102] There is some inconsistency between the plaintiffs' arguments that, on the one hand, they wish to expand into the takeaway / grab and go / lobster shack market; but on the other hand, they say their brand and reputation would be tarnished to be associated with a fast-food type experience like that.

163 The evidence shows that the plaintiffs' brand and reputation is indeed that of restaurants offering fine dining services (see [133]–[140] above). However, the plaintiffs did not think the name "Luke's" would suffer by being associated with a "lobster shack" when the plaintiffs sought to register the Lobster Shack by Luke's mark as a trade mark (see [151] above). I do not accept that if a customer of Luke's Lobster perceived some association between the defendants' and the plaintiffs' restaurants, the plaintiffs' reputation and brand would suffer thereby just because Luke's Lobster does not offer a fine dining experience.

Restriction on expansion

164 The plaintiffs cite *Novelty* ([120] above) (at [117]), which in turn cited *Alfred Dunhill Limited v Sunoptic SA* [1979] FSR 337, where the English Court of Appeal prevented the defendant from marketing sunglasses under the name

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102 PCS at para 130.

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"Dunhill" (which the plaintiff used to sell tobacco products). In that case, there was evidence that the plaintiff was planning to produce sunglasses.[103]

165 The plaintiffs say that they have been restricted from expanding into the takeaway / grab and go / lobster shack market. That is not so.

166 There is nothing to stop the plaintiffs from expanding into the takeaway / grab and go / lobster shack market. They are free to do so under the name of their restaurants, Luke's Oyster Bar & Chop House. In that regard, they can use the registered Luke's Oyster Bar & Chop House trade mark, the unregistered Luke's Oyster Bar & Chop House logo, and perhaps even the Lobster Shack mark which they used for the Lobster Shack event during the period in between April–June 2020 when dining-in was not allowed. However, from the evidence, including the fact that the Lobster Shack event only lasted two weekends in June 2020 (see [147] above), it does not however appear that the plaintiffs seriously intend to expand into the takeaway / grab and go / lobster shack market – in this vein, as I noted earlier, the plaintiffs' failed attempt to register the Lobster Shack by Luke's mark does not show its genuine intention to expand into that market (see [154] above).

Loss of exclusivity in the trade name "Luke's"

167 As I have decided in relation to the trade mark infringement claim, the plaintiffs' trade name is "Luke's Oyster Bar & Chop House" rather than "Luke's", and in any event they have no monopoly or exclusivity over "Luke's" as a trade name (see [43], [46] and [49] above).

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103 PCS at paras 124–125.

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Confusion per se *as damage*

168 The plaintiffs argue that confusion in terms of its customers perceiving an economic association between themselves and the defendants is damage, exacerbated by both sides running restaurants and thus being competitors.[104]

169 I do not accept that confusion *per se* is equivalent to damage. If damage were presumed once misrepresentation and confusion were proved, that would make it meaningless to regard damage as an element of a passing off claim. I have already stated that in a passing off claim, as in a trade mark infringement claim, initial interest confusion is not sufficient if confusion is not established at the point of purchase (see [72] and [130] above).

170 In *Novelty* ([120] above), the Court of Appeal (at [123]) considered *Taylor Bros Ltd v Taylors Group Ltd* [1988] 2 NZLR 1. In that case, the Wellington Court of Appeal thought that damage had been caused to the plaintiff (which ran a dry-cleaning business under the style "Taylors", "Taylors Drycleaners" and "Taylors Drycleaning") by the defendant (which likewise operated a dry-cleaning business in Wellington) trading under the name "Taylors", because "Taylors" was distinctive of the plaintiff in the field of businesses associated with textile cleaning in the region and there will be a "natural tendency to treat the parties as associated". However, the Court of Appeal in *Novelty* commented (at [124]):

> it is hard to see how this constitutes damage as opposed to mere proof that there has been a misrepresentation by the defendant which has led to confusion between the business, goods or services of the plaintiff and those of the defendant.

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104 PCS at para 123(d).

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171 In *The Law of Passing Off* ([130] above), Prof Wadlow suggests that (at para 4-41):

> The better way of putting the question is to ask whether confusion as such is so inherently likely to cause damage to the claimant, that further proof of damage will not be required. This must depend on the facts of each case …

172 In other words, confusion *per se* is not damage, but if confusion in a particular case is inherently likely to cause damage, the plaintiff would then not need to go further in proving damage. In the present case, I am not satisfied as to confusion in the first place, and even if there were initial interest confusion, that would not persist to point of purchase and is not inherently likely to cause damage.

173 In view of the above, I dismiss the plaintiffs' passing off claim.

Defences

174 In the circumstances, strictly speaking I do not need to decide on the defences raised to the passing off claim, *viz*, the defence of prior or concurrent user, and the "own name" defence. I will only make the following brief remarks.

The defence of prior or concurrent user

175 I accept that the plaintiffs would have established goodwill in "Luke's Oyster Bar & Chop House" by 2013, some two years after the first of the plaintiffs' restaurants was opened in 2011, by which time it had achieved revenues of about $4.7m and won an international accolade for the Gemmill Lane restaurant.[105] Luke's Lobster, on the other hand, only opened in Singapore in September 2020, with pre-launch publicity earlier that year.

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105 PCS at para 145.

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176 In *Staywell (CA)* ([23] above), the Court of Appeal accepted that goodwill can be generated by pre-trading or pre-business activities (at [140]) which, although need not be revenue-generating, should unequivocally evince the intention of the party to enter into the Singapore market (at [142]). In relation to Luke's Lobster in the present case, that would not have been until 2020. Luke's Lobster did have a reputation amongst Singaporeans even earlier than that, but that *alone* would not amount to Luke's Lobster having goodwill in Singapore prior to 2020. The defendants argue that the substantial reputation of Luke's Lobster suffices to negate the reputation of the plaintiffs[106] (and they argue that allows them to rely on the defence of prior or concurrent user even if Luke's Lobster had no goodwill in Singapore at the material time),[107] but the evidence does not support such an extreme position. Instead, the plaintiffs had their own reputation (and goodwill) in Luke's Oyster Bar & Chop House, and Luke's Lobster had its own reputation. As such, I would not have been inclined to accept the defence of prior or concurrent user.

The "own name" defence

177 The defendants advance the "own name" defence despite *AMC* ([105] above) where the Court of Appeal expressed the *obiter* view that the "own name" defence is not a defence to a claim in passing off (at [103]) (see also *Taco Company of Australia Inc and another v Taco Bell Pty Ltd and others* (1982) 42 ALR 177).

178 I would not add to the observations in *AMC*. The point can be decided on another occasion.

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106 DCS at para 221.

107 DCS at paras 213–217.

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Are the Luke's Lobster trade marks invalid?

179 The plaintiffs seek a declaration that the Luke's Lobster trade marks are invalid pursuant to s 23 of the TMA as they were registered in breach of ss 8(2)(*b*) and/or 8(7) of the TMA.[108] Specifically, the plaintiffs invoke s 8(7) against the defendants for "passing off the [plaintiffs'] distinctive tradename 'LUKES' [*sic*]".[109]

180 Section 23(3) of the TMA states:

> The registration of a trade mark may be declared invalid on the ground —
>
> (a) that there is an earlier trade mark in relation to which —
>
> (i) the conditions set out in section 8(1) or (2) apply;
>
> (ii) where the trade mark has been registered pursuant to an application for registration of the trade mark made before 1st July 2004, the conditions set out in section 8(3) apply; or
>
> (iii) where the trade mark has been registered pursuant to an application for registration of the trade mark made on or after 1st July 2004, the conditions set out in section 8(4) apply; or
>
> (b) that there is an earlier right in relation to which the condition set out in section 8(7) is satisfied,
>
> unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

181 Section 8(2)(*b*) of the TMA states:

> A trade mark shall not be registered if because —

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108 SOC, Prayer (c).

109 SOC, Prayer (c).

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> …
>
> (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.

182 Section 8(7) of the TMA states:

> 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 [sections 8(1)–(3) of the TMA] or paragraph (*a*), in particular by virtue of the law of copyright or any law with regard to the protection of designs.

Whether the Luke's Lobster trade marks offend against s 8(2)

183 The plaintiffs submit that the principles relating to infringement under s 27 of the TMA equally apply to s 8(2), and that cases which considered the issue of similarity of marks, similarity of goods/services, and confusion under ss 8(2) and 27(2) of the TMA are applied as authorities interchangeably.[110]

184 If that were the case, then it would follow from my dismissal of the plaintiffs' trade mark infringement claim (see [119] above), that the plaintiffs' claim for invalidity of the Luke's Lobster trade marks would also fail.

185 However, the defendants point out that in *Staywell (CA)* ([23] above), the Court of Appeal had – while noting that the text of the relevant sections of

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110 PCS at paras 153–154.

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the TMA was essentially the same – recognised a distinction between opposition and infringement proceedings in the analysis of likelihood of confusion (at [55]–[56]).[111] It was very fair of the defendants to point this out, for the distinction could work to their disadvantage.

186 The Court of Appeal explained the distinction as follows (*Staywell (CA)* at [56], [60] and [61]):

> 56 … On reflection we are satisfied there is a difference between the approach to the confusion inquiry in opposition and infringement proceedings, although there are considerable overlaps as well. If it seems surprising that different outcomes may ensue from the interpretation of essentially the same text, it is because of the context in which each provision is to be applied.
>
> …
>
> 60 … in opposition proceedings the inquiry must take into account the full range of the competing monopoly rights that are already enjoyed on the one hand, namely the actual and notional fair uses to which the incumbent proprietor has or might fairly put his registered trade mark, and compare this against the full range of such rights sought by the applicant by reference to any actual use by the applicant (assuming there has been prior use) as well as notional fair uses to which the applicant may put his mark should registration be granted. This is the setting in which the question of whether there is likelihood of confusion is assessed …
>
> 61 In infringement proceedings on the other hand, there is no question of the alleged infringer seeking to establish any monopoly rights. The only question is whether the actual use of a similar or identical sign by the infringer encroaches on the registered proprietor's monopoly rights under s 26 of [the TMA], to use the mark in relation to goods and services for which he is already using it as well as the penumbra of fair uses for which he might want to use it. There is therefore no need to examine any notional fair use by the alleged infringer because he is not seeking to acquire or assert any rights in respect of such penumbral uses.

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111 DCS at para 236.

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187 What I decided on marks-similarity and goods/services-similarly in the context of trade mark infringement applies equally to the invalidity claim. As for the confusion analysis, broadening that to include notional fair uses to which the Luke's Lobster trade marks may be put, does not lead to any difference in the outcome. I find that the marks are not confusingly similar, whether in relation to the actual or notional fair uses of the Luke's Lobster trade marks.

Whether the Luke's Lobster trade marks offend against s 8(7)

188 In view of my decision to dismiss the plaintiffs' passing off claim (see [173] above), it follows that the Luke's Lobster trade marks do not offend against s 8(7) of the TMA. The use of the Luke's Lobster trade marks is not liable to be prevented by the law of passing off.

189 I thus dismiss the plaintiffs' claim that the Luke's Lobster trade marks are invalid.

190 Harking back to the trade mark infringement claim, my decision against the plaintiffs on their invalidity claim also means that the defendants have the benefit of the "registered mark" defence under s 28(3) of the TMA (see [116]–[117] above).

The plaintiffs' survey evidence

191 These are my comments on the plaintiffs' survey evidence (see [84] above), which they had put forward to support a finding of confusion for both its trade mark and passing off claims.

192 First and foremost, the Survey used the Luke's Oyster Bar & Chop House logo (which is not a registered trade mark) rather than the registered

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Luke's Oyster Bar & Chop House trade mark. This was ironic when the plaintiffs were claiming for infringement of a registered trade mark. It was also unhelpful for the court to have to extrapolate, from the Survey which used the plaintiffs' unregistered logo, how the interviewees might have responded had the plaintiffs' registered trade mark instead been used for the Survey.

193 The plaintiffs suggest that there is no real difference between their registered trade mark and unregistered logo,[112] but I do not agree.



The Luke's Oyster Bar & Chop House trade mark



The Luke's Oyster Bar & Chop House logo

194 Most notably, the Luke's Oyster Bar & Chop House logo omits the words "Restaurant Group". Whilst "Travis Masiero" is retained, the logo does not expressly refer to the Luke's Oyster Bar & Chop House restaurants being part of the Travis Masiero Restaurant Group. While there is still a stated association with Mr Masiero, interviewees might well be unaware of the Travis Masiero Restaurant Group. If the Luke's Oyster Bar & Chop House trade mark had been used instead, the interviewees would have seen "Travis Masiero Restaurant Group" in the registered trade mark itself. I cannot conclude that the results of the Survey would have been the same had the registered trade mark been used instead of the unregistered logo.

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112 PCS at para 60.

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195 In *Han's* ([3] above), one deficiency of the survey was that its questions did not include an apostrophe in the spelling of "Han's"; the respondents were simply asked whether "H-A-N-S" sounded similar to "H-A-N" (at [166]). Another deficiency was that the survey was conducted over the telephone and so the Han's marks and the HAN sign (see [34(c)] above) were not shown to the respondents (at [165]). A third deficiency was that there was no reference to the phrase "Cuisine of Naniwa" or the *Kushikatsu* device in the HAN sign (at [167]).

196 The phrase "Travis Masiero Restaurant Group" is a significant part of the Luke's Oyster Bar & Chop House trade mark (see [46] and [60] above) that was not shown as part of the Survey. It was a deficiency for the Survey not to use the plaintiffs' registered trade mark (but instead the unregistered Luke's Oyster Bar & Chop House logo) for comparison with the Luke's Lobster trade marks.

197 Second, the interviewees did not represent the relevant cross-section of the public, contrary to the Whitford Guidelines (see [86] above). There were 266 participants interviewed for the Survey. They were drawn from the plaintiffs' mailing list of 18,000 persons. From that mailing list, names were randomly generated, emails were sent to invite their participation (12,000 of such emails were sent), and ultimately 266 participated in the Survey.[113]

198 The 266 participants were all customers of the plaintiffs: 80% had visited both of the plaintiffs' restaurants, the remaining 20% had visited one.[114]

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113 Mr Masiero's AEIC at paras 35–36.

114 Mr Coops' AEIC at pp 101–103; PCS at paras 56–58.

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199 The plaintiffs acknowledge that the relevant cross-section of the public comprises the plaintiffs' actual and potential customers.[115] But the interviewees for the Survey included no *potential* customers – all of them were *actual* customers. I cannot conclude that the plaintiffs' potential customers would have responded in the same way as their actual customers; nor can I postulate how the results of the Survey would have turned out, if potential customers had been included in the sample group.

200 Third, the survey evidence should directly ascertain the cause of any confusion, and this was not done. In *Sarika (HC)* ([86] above), this was noted as a shortcoming of the surveys used in that case (at [136]). As the court explained, confusion for the purposes of s 27(2) of the TMA must arise from marks-similarity and goods/services-similarity (at [136]). The survey evidence would be unhelpful if the interviewees had applied a different test in concluding that they were confused.

201 In *Han's* ([3] above), the court found the survey question that was the most relevant to establishing actual confusion to be deficient as a result of how it was phrased – it was leading and would "lead the interviewee into a field of speculation upon which he would not otherwise have embarked" (at [169]–[171]). With that and the other deficiencies (discussed at [195] above), the court placed no weight on the survey findings in so far as they were said to show actual confusion or the likelihood of confusion (at [172]).

202 Here, the interviewees were not asked any question to ascertain the cause of any confusion.

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115 PCS at paras 112 and 116(a)(i).

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203 Moreover, the questions in the Survey were not limited to marks-similarity and goods/services-similarity. As I noted at the outset, the registered Luke's Oyster Bar & Chop House trade mark was not even shown to the interviewees, instead it was the unregistered Luke's Oyster Bar & Chop House logo that was shown to them. As all the interviewees were customers of the plaintiffs, in answering the questions, they would likely have drawn on their experience of having dined at the plaintiffs' restaurants. However, some 36% of them – more than a third – had not heard of Luke's Lobster in Singapore,[116] and of those who had heard of Luke's Lobster, only a fraction would have actually been there (the Survey records 6% of interviewees commenting that they had been there[117] including two interviewees who had eaten there: see [155] above). Since the interviewees were much more familiar with Luke's Oyster Bar & Chop House than with Luke's Lobster, the responses obtained may thus have taken into account extraneous considerations other than those relating to marks-similarity and goods/services-similarity, which the Court of Appeal in *Staywell (CA)* ([23] above) had said should not feature in the confusion analysis in a trade mark claim. That would be exacerbated by some interviewees having never heard of Luke's Lobster or been to the defendants' restaurants before.

204 Fourth, I do not consider the Survey to be fair; it was leading or otherwise problematic in various ways. This too was contrary to the Whitford Guidelines.

205 One of the key objectives of the Survey was to establish "whether LUKE's [*ie*, the plaintiffs] customers routinely and commonly refer to

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116 Mr Coops' AEIC at p 118.

117 Mr Coops' AEIC at p 117.

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'LUKE's' or by reference to any other trade names such as 'LUKE's Oyster Bar' or 'Luke's Oyster Bar & Chop House'".[118]

206 Emails were sent to by Mr Masiero to persons on the plaintiffs' mailing list to invite them to participate in the Survey (see [197] above) ("the Email").[119] An example of the Email appears below:[120]



Dear Ashish,

This is Travis from Luke's. I hope you are well. I understand your time and privacy are very important. As a valued guest I wanted to invite you to participate in a short 4 to 5 minute survey to obtain your views on restaurants.

We have appointed a research firm, ASIAN STRATEGIES (www.asianstrategies.com) to chat with some of our most valued clients to assist us in this endeavor.

In return for your kind participation, we will be making a donation to the charity Love, Nils (www.lovenils.org), who give hope and support to children with cancer based here in Singapore.

Please click on I CONSENT if you consent to be contacted by ASIAN STRATEGIES for our survey. I thank you in advance for your time.

Best Regards,

118 Mr Coops' AEIC at para 14 and p 93.

119 Transcript, 9 Mar, p 106 lines 13–25; p 107; p 108 lines 1–21.

120 Plaintiffs' Supplementary Bundle of Documents Vol I at p 1.

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207 The Email bore the unregistered Luke's Oyster Bar & Chop House logo, rather than the plaintiffs' registered Luke's Oyster Bar & Chop House trade mark which carried the phrase "Travis Masiero Restaurant Group". The first sentence of the Email read, "[t]his is Travis from Luke's".

208 This was unhelpful. One of the key objectives of the Survey was to find out if the participants referred to the plaintiffs' restaurants as "Luke's", and here was restaurateur Mr Masiero doing just that in his initial email inviting participants for the Survey. In effect, Mr Masiero was saying to them, "I refer to my restaurants as 'Luke's'", before they were then asked in the Survey, "what do you refer to the restaurants as?" This was leading. The fact that the Survey may have been conducted a couple of weeks after the Email,[121] does not render the Email insignificant.

209 When the Survey was conducted (in the period of 11 December 2020 to 5 January 2021),[122] the defendants had already opened their first Luke's Lobster shack in Singapore – the one at Isetan, Shaw House, opened in September 2020 (see [8] above).

210 The interviewees were first asked some introductory questions, including Question 3 which showed four restaurant logos including the unregistered Luke's Oyster Bar & Chop House logo (but not those of Luke's Lobster's yet).[123]

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121 PCS at para 80(c).

122 Mr Coops' AEIC at p 97.

123 Mr Coops' AEIC at p 132.

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211 Then, interviewees were asked Question 6 (with reference to the restaurants identified by the logos shown in Question 3 – including the Luke's Oyster Bar & Chop House logo): "If you were … going to meet friends or colleagues for lunch or dinner at each of these … how would you refer to the restaurant to them in your conversation or text message?"[124] 76% responded "Luke's", 19% responded "Luke's" together with either Gemmill Lane or The Heeren (where the plaintiffs' restaurants were respectively located), and only 6% responded with a fuller name, "Luke's Oyster Bar & Chop House", "Luke's Oyster Bar", or "Luke's Chop House".[125]

212 By its nature, Question 6 would tend to elicit responses with more casual references to the plaintiffs' restaurants, as compared to, *eg*, "what is the name of this restaurant?" While one objective of the Survey was to find out if the plaintiffs' customers referred to the plaintiffs' restaurants as "Luke's", other objectives were to establish "the reaction of customers to [the Luke's Lobster trade marks] (i.e. whether they perceive a link between these marks and [the plaintiffs])", and "whether or not consumers perceive an association between Luke's Lobster and [the plaintiffs] and if so, the likely nature of this relationship",[126] *ie*, to obtain evidence for the plaintiffs' claims. By eliciting from the interviewees responses which were either just "Luke's" or would start with "Luke's", as a precursor to showing them the Luke's Lobster trade marks (which also included the word "Luke's"), Question 6 would tend to shape the interviewees' thinking.

213 That shaping process continued through Questions 7 and 8.

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124 Mr Coops' AEIC at p 133.

125 Mr Coops' AEIC at p 104.

126 Mr Coops' AEIC at para 14 and p 93.

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214 Question 7 sought to understand what types of foods were most strongly associated with the plaintiffs' restaurants. The restaurant name which the participant identified with the Luke's Lobster & Chop House logo and mentioned in response to Question 6, was used for Questions 7 and 8A, *ie*, if a participant had said "Luke's" to Question 6, the interviewer would then refer to the plaintiffs' restaurants as "Luke's" for the purposes of Questions 7 and 8A.[127] Given that 76% had responded "Luke's" to Question 6, this would have reinforced the association of the plaintiffs' restaurants with the name "Luke's", before the Luke's Lobster trade marks were shown as part of Question 9.

215 Question 7 was not an open-ended question, four choices were suggested: seafood, meat, poultry, vegetarian; participants could pick more than one.[128] The responses were: 90% seafood; 88% meat; 2% vegetarian.[129] Food spontaneously mentioned was also noted: 25% steak; 14%, oysters; but only 2% lobster rolls / sliders / lobster, mac & cheese.[130]

216 Question 7 would have been fairer as an open-ended question. If that had been done, instead of offering "seafood" as one of four choices, less than 90% might have responded, "seafood". For instance, an interviewee who might have said "oysters" to an open-ended question, could have ended up picking "seafood" because that was one of four choices offered. A "seafood" response to Question 7 would then open the door to Question 8A about the types of seafood associated with the plaintiffs' restaurants, including lobsters.[131]

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127 Mr Coops' AEIC at p 134.

128 Mr Coops' AEIC at p 134.

129 Mr Coops' AEIC at p 105.

130 Mr Coops' AEIC at p 105.

131 Mr Coops' AEIC at p 134.

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217 If an interviewee had mentioned "seafood" in response to Question 7, he would be asked Question 8A: which types of seafood did he associate with the plaintiffs' restaurants? Again, this was not an open-ended question, the choices suggested were: fish, oysters, shrimp / prawns, lobster, clams, crab, scallops, caviar.[132] The responses were: 96% oyster; 78% lobster, 63% shrimp / prawns, 60% fish, *etc*.[133] As with Question 7, if Question 8A had been an open-ended one, less interviewees might have said "lobster".

218 All interviewees were then asked Question 8B, which asked them to describe the dining experience at the plaintiffs' restaurants (referred to as "Luke's Oyster Bar & Chop House at Orchard Road and/or Gemmill Lane").[134]

219 Question 9 about the Luke's Lobster trade marks came only after questions about how interviewees referred to the plaintiffs' restaurants (Question 6); the types of foods served there, including "seafood" as a choice (Question 7); the types of seafood, including "lobster" as a choice (Question 8A); and the dining experience at the plaintiffs' restaurants (Question 8B).

220 Question 9 involved showing interviewees the Luke's Lobster trade marks, and asking them what was the first thing that came to their minds.[135] The responses were then grouped into categories: awareness related; perceived connection or disconnection between Luke's Lobster and the plaintiffs'

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132 Mr Coops' AEIC at p 134.

133 Mr Coops' AEIC at p 107.

134 Mr Coops' AEIC at p 135.

135 Mr Coops' AEIC at p 135.

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restaurants; experience with Luke's Lobster; and opinions on the Luke's Lobster trade marks.[136]

221 Interviewees were then asked Question 10: whether they had previously heard of a restaurant called Luke's Lobster in Singapore.[137] Only 64% of the interviewees said they had.[138] Those who were aware of the Luke's Lobster restaurant in Singapore were then asked Question 11A: "When you first heard of or saw 'Luke's Lobster', what was your immediate reaction?"[139] Those who were unaware of the Luke's Lobster restaurant in Singapore were asked Question 11B: "If I told you that a new restaurant called 'Luke's Lobster' has just opened in Singapore, what would be your immediate reaction?"[140]

222 Questions 12A and 12B were the most directly relevant to the issue of confusion. Question 12A was:[141]

> I'm going to show you some statements. Please tell me which one, if any, you feel best described your view on LUKE's LOBSTER and LUKE'S [*ie*, the plaintiffs] when you first saw this logo or heard about LUKE'S LOBSTER opening in Singapore. If you don't know or are unsure about which statement to choose, that is an answer too.
>
> [emphasis in original]

223 The four statements were:[142]

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136 Mr Coops' AEIC at p 114.

137 Mr Coops' AEIC at p 136.

138 Mr Coops' AEIC at p 118.

139 Mr Coops' AEIC at p 137.

140 Mr Coops' AEIC at p 138.

141 Mr Coops' AEIC at p 139.

142 Mr Coops' AEIC at p 139.

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> 'LUKE'S LOBSTER' and 'LUKE'S' are part of the same group or business organisation.
>
> 'LUKE'S LOBSTER' and 'LUKE'S' are connected or affiliated in some way.
>
> 'LUKE'S LOBSTER' and 'LUKE'S' are not part of the same group or business organisation.
>
> I don't know / not sure [*sic*] [if they are related or not].

224 It is unfortunate that Question 12A referred to the Luke's Oyster Bar & Chop House restaurants as "Luke's". Even if an interviewee had not said "Luke's" in response to Question 6 when asked how he would refer to the plaintiffs' restaurants in a conversation or text message (see [211] above), here he was being told, the plaintiffs' restaurants are referred to as "Luke's", and then asked about the perceived association between "Luke's Lobster" and "Luke's". That was not a fair question, it would lead the interviewees to think of the plaintiffs' restaurants as "Luke's", even if they had not initially thought of them as such.

225 The phrasing of the four statements (set out in [223]) is also problematic. The statement "'LUKE'S LOBSTER' and 'LUKE'S' are part of the same group or business organisation" has a negative counterpart, *ie*, "'LUKE'S LOBSTER' and 'LUKE'S' are not part of the same group or business organisation". But there is no negative counterpart to "'LUKE'S LOBSTER' and 'LUKE'S' are connected or affiliated in some way" – the statement "'LUKE'S LOBSTER' and 'LUKE'S' are not connected or affiliated in some way" was not one of the choices offered. Interviewees were thus presented with two positive choices, and only one negative choice (the opposite of one of the positive choices). That could have skewed the results. It is much like asking interviewees whether they think "LUKE'S LOBSTER" and "LUKE'S" are part of the same group or

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business organisation; and then asking those who say, "no", whether they are nevertheless connected or affiliated in some way.

226 That is essentially what was done in *Sarika (HC)* ([86] above) where the survey respondents who thought it was unlikely that the manufacturer of "Nutella" produced "Nutello" were then asked whether it was likely that the manufacturer of "Nutella" had authorised the use of the name "Nutello" (at [120]). As the court commented, that may have planted in the minds of the survey respondents the possibility of a licensing arrangement between the manufacturer of Nutella and the defendants when they would not, of their own accord, have considered such a possibility (at [121]). In *Han's* ([3] above), where one of the survey questions had asked respondents if they thought "H-A-N-S" (referring to the plaintiff) and "H-A-N" (referring to the defendant) belonged to the same management (at [164]), the court similarly considered that question to be problematic for it bluntly introduced the possibility to the survey respondents that the plaintiff and defendant might be under the same management, when that might not have reasonably occurred to them in the first place (at [171]).

227 It would have been simpler and safer just to ask interviewees whether Luke's Lobster and the Luke's Oyster Bar & Chop House restaurants were associated or not.

228 As it was, the responses to Question 12A were as follows:[143]

(a) of all the interviewees, 59% said they perceived some association between Luke's Lobster and the plaintiffs' restaurants, 23%

[143] Mr Coops' AEIC at p 119.

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said they were not part of the same group or business organisation, and 17% were not sure if they were related or not;

(b) of those who were aware of the Luke's Lobster restaurant in Singapore, 54% perceived some association between Luke's Lobster and the plaintiffs' restaurants, 32% said they were not part of the same group or business organisation, and 14% were not sure if they were related or not;

(c) of those who unaware of the Luke's Lobster restaurant in Singapore, 72% perceived some association between Luke's Lobster and the plaintiffs' restaurants, 6% said they were not part of the same group or business organisation, and 23% were not sure if they were related or not.

229 The responses to Question 12A indicate that the plaintiffs' customers who were aware of the Luke's Lobster restaurant in Singapore were less likely to perceive some association between the plaintiffs' restaurants and Luke's Lobster.

230 Interviewees were then asked Question 12B:[144]

> Now please tell me which one, if any, you feel best described your view on LUKE'S LOBSTER and LUKE'S after you saw the new LUKE'S LOBSTER restaurant in Isetan or found out more information on it. If you don't know or are unsure about which statement to choose, that is an answer too.

231 Interviewees were asked to pick between the same four statements as for Question 12A (see [223] above), with the same problems I have discussed above (see [224]–[226]).

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144 Mr Coops' AEIC at p 139.

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232 The responses to Question 12B were as follows:[145]

(a) of all the interviewees, 36% said they perceived some association between Luke's Lobster and the plaintiffs' restaurants, 47% said they were not part of the same group or business organisation, and 17% were not sure if they were related or not;

(b) of those who were aware of the Luke's Lobster restaurant in Singapore, 25% perceived some association between Luke's Lobster and the plaintiffs' restaurants, 64% said they were not part of the same group or business organisation, and 11% were not sure if they were related or not;

(c) of those who unaware of the Luke's Lobster restaurant in Singapore, 59% perceived some association between Luke's Lobster and the plaintiffs' restaurants, 13% said they were not part of the same group or business organisation, and 27% were not sure if they were related or not.

233 Those who were unaware of the Luke's Lobster restaurant in Singapore could not sensibly have answered Question 12B which asks what they thought after they saw the new Luke's Lobster restaurant in Isetan or found out more information on it. By definition, those interviewees had *never* seen that Luke's Lobster restaurant nor found out more information on it – they had not heard about it until Question 10 was put to them (see [221] above). Yet responses were recorded from all 84 such interviewees.[146] Curiously, after having supposedly 'seen' or 'found out' more information about the Luke's Lobster restaurant in

145 Mr Coops' AEIC at pp 120–121.

146 Mr Coops' AEIC at p 121.

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Singapore, the proportion of them who perceived some association between Luke's Lobster and the plaintiffs' restaurants dropped from 72% to 59%, and the proportion who said they were not part of the same group or business organisation rose from 6% to 13% (see [228(c)] and [232(c)] above).

234 Turning to those who were aware of the Luke's Lobster restaurant in Singapore: after seeing that Luke's Lobster restaurant or finding out more information on it, the proportion of them who perceived some association between Luke's Lobster and the plaintiffs' restaurants fell from 54% to 25%, and the proportion who said they were not part of the same group or business organisation rose from 32% to 64% (see [228(b)] and [232(b)] above).

235 The Survey thus suggests that the more that a customer of the plaintiffs knows about Luke's Lobster, the less likely he is to think it is associated with the plaintiffs' restaurants.

236 As I noted above (at [200]–[203]), no questions were posed in the Survey to ascertain the cause of any perceived association between Luke's Lobster and the plaintiffs' restaurants. In *Sarika (HC)* ([86] above), neither party's survey there had ascertained the cause of confusion (at [136]). The court suggested that "why" questions could have been asked of those who perceived some association between the two sides (at [139]–[140]). That was also not done in the present case.

237 Instead, any interviewee who had not mentioned "lobster" in response to Question 8A (see [217] above) would be asked Question 13: "… does LUKE'S OYSTER BAR & CHOP HOUSE IN THE HEEREN AND/OR

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GEMMIL [*sic*] LANE serve lobster dishes or are you not sure?"[147] As the report of the Survey states, 186 had mentioned "lobster" in response to Question 8A, and another 55 "who didn't associate lobster with LUKE's initially did so when prompted in [Question 13]."[148] Questions 7, 8A and 13 only test whether interviewees associate lobster dishes with the plaintiffs' restaurants, or are aware that they serve lobster dishes. The responses do not mean that the plaintiffs' restaurants had a reputation for, or goodwill in, lobster dishes.[149] To illustrate the point bluntly, a person who did not like the lobster dishes at the plaintiffs' restaurants could still say that he associated the plaintiffs' restaurants with lobster (as a type of seafood) in response to Question 8A, or at least that he was aware that the plaintiffs' restaurants did serve lobster dishes in response to Question 13.

238 Fifth, there was late disclosure of the whole of the Survey. The Whitford Guidelines (see [86] above) require that the totality of the answers given be disclosed and made available to the defendants (*Sarika (HC)* at [134]; *Han's* ([3] above) at [31]). The 266 original questionnaires were, however, only provided on Friday, 5 March 2021, shortly before the trial commenced on Tuesday, 9 March 2021. Mr Coops acknowledged that at least a month would be needed to review all the questionnaires.[150] The defendants could not have done so and proceeded with the trial as scheduled.

239 In the event, the defendants proceeded with the cross-examination of Mr Coops without reference to the original questionnaires. At the close of the

147 Mr Coops' AEIC at p 139.

148 Mr Coops' AEIC at p 122.

149 DCS at para 272.

150 Transcript, 10 Mar, p 161 lines 15–17; p 167 lines 10–13; p 178 lines 11–13.

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evidence, counsel on both sides agreed that neither side would refer to the original questionnaires in their submissions.[151]

240 Sixth, the interviewees were not shown a photograph of the Luke's Lobster shack at Isetan, or the defendants' Luke's Lobster menu; but only the Luke's Lobster trade marks. On the other hand, all of the interviewees were customers of the plaintiffs, and would have seen the plaintiffs' restaurants and the plaintiffs' menus. The Survey did not facilitate a like-for-like comparison of the get-up of the plaintiffs' restaurants and that of the Luke's Lobster restaurant at Isetan; any comparison was not based on actual market conditions, which have a significant impact on how the marks are perceived and consequently, the likelihood of confusion (see *Han's* at [162] and [202]; *Subway* ([81] above) at [51]).

241 For the above reasons, I placed no weight on the plaintiffs' survey evidence.

Conclusion

242 What's in a name? The plaintiffs' restaurants are named "Luke's Oyster Bar & Chop House", a name that is reflected in their registered trade mark and unregistered logo. The defendants' lobster shacks are named "Luke's Lobster", a name for which the second defendant has registered trade marks. I have decided that the parties' respective marks and businesses can co-exist, without the relevant public being confused. The defendants may continue to use the name "Luke's Lobster" in Singapore.

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151 Transcript, 11 Mar, p 112 lines 16–25; p 113; p 114; p 115; p 116 lines 1–9.

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243 I dismiss the plaintiffs' claims for trade mark infringement, passing off, and invalidation of the Luke's Lobster trade marks. I will hear the parties on costs.

Andre Maniam
Judicial Commissioner

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for the plaintiffs;
Melvin Pang, Ong Eu Jin (Amica Law LLC) for the defendants.

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