

The Polo/Lauren Co, LP v Shop-In Department Store Pte Ltd
[2006] SGCA 14

Case Number : CA 67/2005
Decision Date : 06 April 2006
Tribunal/Court : Court of Appeal
Coram : Chao Hick Tin JA; Tan Lee Meng J; Yong Pung How CJ
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Parties : The Polo/Lauren Co, LP — Shop-In Department Store Pte Ltd

Trade Marks and Trade Names – Infringement – Appellant alleging respondent's sign infringing appellant's registered word mark – Applicable test for infringement under s 27(2)(b) Trade Marks Act – Whether respondent's sign similar to appellant's word mark – Whether goods to which defendant's sign and plaintiff's mark applying similar – Whether likelihood of confusion on the part of the public existing – Section 27(2)(b) Trade Marks Act (Cap 332, 1999 Rev Ed)

6 April 2006

Chao Hick Tin JA (delivering the judgment of the court):

1 This was an appeal against the decision of Lai Kew Chai J (“Lai J” or “the trial judge”) where he dismissed the action instituted by The Polo/Lauren Company, LP (“the appellant”) against Shop In Department Store Pte Ltd (“the respondent”) for an alleged infringement of the appellant’s trade mark under s 27(2)(b) of the Trade Marks Act (Cap 332, 1999 Rev Ed) (“the Act”). We heard the appeal on 21 February 2006 and dismissed it. Our reasons are now set out.

The facts

2 The appellant is an entity constituted under the laws of the State of New York, USA. It is the proprietor of six trade marks registered under the Act under class 25 of the International Classification of Goods and Services (“ICGS”), namely, “POLO” (word mark), “POLO BY RALPH LAUREN” (word mark), “RALPH LAUREN & polo player device”, “POLO RALPH LAUREN & polo player device”, “LAUREN RALPH LAUREN” and “RALPH LAUREN”. The respondent is a private limited company incorporated in Singapore. Unlike the appellant’s goods, which are sold at upmarket boutiques located in prime shopping areas and are accordingly pricey, the respondent operates five suburban stores, selling things such as clothing, bags, handbags, shoes, watches and household stuff at prices affordable to the masses.

3 For the purposes of the action and the appeal, only the word mark “POLO” was in issue. Sometime in early 2004, the respondent imported clothing, handbags and shoes manufactured in China which bore the following sign:

□

It would be noted that this sign bears a different font, typeface and design. On 7 May 2004 the respondent, after consulting its solicitors, applied to the Registry of Trade Marks to have the sign “POLO PACIFIC” registered under classes 18 and 25 of ICGS which application was, on 2 December 2004, accepted by the Registry for publication. Soon thereafter, the appellant raised opposition to the registration of the sign. That opposition proceeding is pending.

4 In the meantime, the respondent started selling in its stores goods bearing the “POLO

PACIFIC” sign. This came to the attention of the appellant who sent agents to obtain evidence of the sales which sales it considered to be in breach of its rights under the trade mark “POLO”. On 6 September 2004, the appellant commenced the present action. We should add that, in the action, besides relying on s 27(2) of the Act, the appellant had also alleged that the respondent had breached an undertaking which it gave to the appellant on 25 April 2003, in relation to an earlier event in 2002 when the respondent was alleged to have infringed the appellant’s trade marks. In the undertaking, the respondent declared that it would not infringe the appellant’s marks in the future.

The approach to section 27(2) of the Act

5 Section 27(2) of the Act reads:

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

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

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

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

6 For the purposes of the action, para (a) of sub-s (2) was not in issue as it was not alleged that the infringing sign of the respondent was identical to the appellant’s registered mark. It was para (b) of that subsection that the appellant was relying on. The wording of s 27(2)(b) is clear. For it to apply, it must first be shown that the sign of the respondent is similar to that of the appellant’s mark and that they are both used in relation to identical or similar goods or services, and, on account of both these factors, there exists a likelihood of confusion on the part of the public.

7 The trial judge, applying the three-step approach enunciated in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 (“*British Sugar*”), held that the sign “POLO PACIFIC” was not similar to “POLO” and that there was no likelihood of confusion on the part of the public. Consequently, he held that the respondent had not infringed the appellant’s mark within the meaning of s 27(2)(b). We should add that the trial judge did not accept the respondent’s argument that the better approach should be the global assessment test enunciated by the European Court of Justice in cases such as *Sabel BV v Puma AG, Rudolf Dassler Sport* [1998] RPC 199 and *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 which focused on the ultimate question whether or not there was a likelihood of confusion. In that test, all the other matters mentioned in s 27(2)(b) would be just factors or circumstances to enable the court to come to the ultimate issue as to confusion.

8 In our opinion, having examined the express wording of s 27(2)(b), the step-by-step approach adopted in *British Sugar* is conceptually more appropriate and is in line with the structure of the provision. It seems to us that there will be infringement under that provision only if three conditions are present. First, the alleged offending sign must be shown to be similar to the registered mark. Second, both the sign and the mark must be used in relation to similar goods or services. Third, on account of the presence of the first two conditions, there exists a likelihood of confusion on the part of the public. As the judge rightly pointed out, s 27(2)(b) does not make it an infringement if the likelihood of confusion is caused by some other factor. While we can see some link and overlap between the first and the third conditions, it is clear that they are different. The fact that a sign is similar to a registered mark does not automatically mean that there will be a likelihood of confusion on

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

9 Having said that, we do not think that, in practice, the end result will be likely to be any different whether the court is to apply the *British Sugar* test or the global assessment test. It seems to us that in a given situation, whichever test the court is to apply, the final conclusion is likely to be the same. In other words, if either the first or second condition is not satisfied, applying the global assessment test would not be likely to bring about a different result. Here, we would agree with what Assoc Prof Ng-Loy Wee Loon said in her case note on the judgment below entitled "The Polo Match in Singapore: England vs Europe?, *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* " soon to be published in the European Intellectual Property Review:

Naturally, because the question of similarity between goods depends on the facts of each case, it is highly likely that this doctrinal difference in the two approaches will not have a material impact in practice. Two tribunals comparing the same two sets of goods may very well come to the same conclusion on the question of similarity between the goods, even though one tribunal is applying the English approach whilst the other tribunal is applying the European approach and has to be less strict on this issue.

Similarity between the mark and the sign

10 We now turn to consider the first question of whether there is similarity between the appellant's mark and the respondent's sign. The trial judge was of the opinion that the two are not visually, aurally or conceptually similar although the respondent has used the word "polo" as the first word of its composite sign. He said (at [2005] 4 SLR 816 at [26]–[28]):

The decided cases suggest that there are three aspects to similarity: visual, aural or phonetic, and conceptual. In terms of visual similarity, it is clear that the mark and the sign share one common denominator: the word "POLO". In cases where there is a common denominator, it is important to look at the differences between the mark and the sign in order to decide whether the challenged sign has been able to distinguish itself sufficiently and substantially ... In *Samsonite Corp v Montres Rolex SA* [1995] AIPR 244 ... it was held that just because the registered mark was wholly included in the challenged sign, it did not mean that it would necessarily cause confusion between the two.

...

In the present case, the differences are obvious: the addition of the word "PACIFIC" together with the sign's different font and design. The question, then, is whether these differences are enough so as not to capture the distinctiveness of the registered mark. In order to decide this, I first have to consider whether the [appellant's] mark can be considered to be so distinctive that the differences would not negative the similarity. This is an important issue because a more distinct mark generally receives greater protection. ...

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

11 In this regard, the trial judge noted pertinently, from the evidence adduced for the appellant, that it had never inserted any advertisement using only the word mark "POLO". Its products invariably carried the other composite marks of the appellant such as "POLO RALPH LAUREN", "POLO BY RALPH LAUREN" or "RALPH LAUREN & polo player device". This showed that the other composite marks were more distinctive and essential in distinguishing the appellant's goods. We would hasten to add that the appellant had also disclaimed any desire to monopolise the word "polo". After observing that the word "polo" is commonly understood to refer to a sport, or a particular style of T-shirts, the trial judge said (at [30]):

It is settled that the courts are wary of allowing companies to monopolise words that are either purely descriptive or used in everyday parlance[.]

12 Before this court, the appellant had submitted the following main points to contend that the trial judge was wrong to have held that the registered mark and the sign are not similar:

- (a) The judge was wrong to hold that the mark "POLO" is not distinctive.
- (b) In any event, it is not relevant whether the mark is or is not "strikingly distinctive".
- (c) The fact that the sign includes the word "pacific" does not necessarily mean that the mark and the sign are dissimilar.

13 These arguments are inter-related and we shall consider them together. The appellant relied on the Australian case of *Polo Textile Industries Pty Ltd v Domestic Textile Corporation Pty Ltd* [1993] 26 IPR 246 ("*Polo Textile*") to substantiate its assertion that the word "polo" is distinctive. The appellant also seemed to be saying that upon registration of a mark, it automatically became distinctive.

14 We will start with the case of *Polo Textile* where the applicant there was the owner of the trade mark "POLO". The respondent there sold bed linen under the mark "POLO CLUB". The applicant sued for infringement. Burchett J of the Federal Court of Australia held that the word "polo" was distinctive and that its use by the respondent in the mark "POLO CLUB" would cause confusion and that the addition of the word "club" to the word "polo" would not remove the confusion created. In coming to this view, Burchett J had relied upon the case of *de Cordova v Vick Chemical Coy* (1951) 68 RPC 103, where it was held that the mark "Vicks VapoRub Salve" was infringed by the mark "Karsote Vapour Rub", and especially the following opinion of Lord Radcliffe (at 105–106):

They have not used the mark itself on the goods that they have sold, but a mark is infringed by another trader if, even without using the whole of it upon or in connection with his goods, he

uses one or more of its essential features. The identification of an essential feature depends partly on the Court's own judgment and partly on the burden of the evidence that is placed before it. A trade mark is undoubtedly a visual device; but it is well-established law that the ascertainment of an essential feature is not to be by ocular test alone. Since words can form part, or indeed the whole, of a mark, it is impossible to exclude consideration of the sound or significance of those words. Thus it has long been accepted that, *if a word forming part of a mark has come in trade to be used to identify the goods of the owner of the mark*, it is an infringement of the mark itself to use that word as the mark or part of the mark of another trader, for confusion is likely to result. ...

... [T]heir Lordships think that "VapoRub" must be treated as an essential feature, or, to use an alternative phrase, a material or substantial element, of Trade Mark 1852, and that the Appellants have infringed the mark by selling their ointment under the designation "Karsote Vapour Rub"; for the word "Karsote" prefaced to "Vapour Rub" is quite insufficient in itself to dissolve the confusion that is bound to arise from associating the Appellants' goods with a word so distinctive as "Vapour Rub".

[emphasis added]

We note that Burchett J did not elaborate why he thought "polo" was distinctive other than saying that the additional word, "club", to the respondent's sign was "bland".

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

A trade mark shall not be registered if because —

...

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

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

16 The Appointed Person (Geoffrey Hobbs QC) in *Royal Berkshire* found the mark "POLO" to be distinctive. But it is important to note the basis for this finding. Hobbs QC said at [27]:

The evidence indicates that the opponent's earlier trade marks enjoyed a high degree of recognition and popularity among purchasers of toiletries at the date of the application for registration (August 4, 1995). The evidence also suggests that the opponent was at that date unique among suppliers of toiletries in marketing its products under and by reference to the word POLO. It had a long history of using the word POLO with graphics linking it to the game of the same name. I think it is clear that in August 1995 the average consumer would naturally have expected POLO brand toiletries to come directly or indirectly from one and the same undertaking (*i.e.* the opponent).

However, Hobbs QC also went on to find that even though the word "polo" was incorporated into the applicant's mark, the two were nevertheless not similar (see [30]–[31]):

[T]he real task is to determine what impression the use of that mark would make upon people in the ordinary course of trade in goods of the kind specified in the application for registration: see *Marengo v Daily Sketch and Sunday Graphic Ltd* (1948) 65 R.P.C. 242, HL, at page 250 *per* Lord Simonds.

Approaching the matter in that way, I am satisfied that the use of the word POLO as part of the applicant's mark does not capture the distinctiveness of the opponent's earlier trade marks. I do not think that people exposed to the use of the applicant's mark would notice that it contained the word POLO without also noticing that it contained the words ROYAL BERKSHIRE and CLUB. The message of the mark comes from the words in combination and that is not something that I would expect people to overlook or ignore in the ordinary way of things.

17 When we compare the position here with what was done by the proprietor to promote the mark "POLO" in *Royal Berkshire*, the difference is worlds apart. The appellant here had not done anything either to promote or use the mark "POLO" on its own. The mark "POLO" has always been used and linked with Ralph Lauren. Thus, we cannot see how the appellant could claim that the word mark "POLO" has acquired distinctiveness. It also follows that the argument based on a family of trade marks with the prefix "POLO" cannot carry much weight. Of course, where a mark is not used the court is entitled to assume that the proprietor will use it in a normal and fair manner. The fact of the matter is that the word "polo" *per se* is not distinctive since it is an ordinary English word.

18 Another interesting case cited by the appellant to contrast is *Aktiebolaget Volvo v Heritage (Leicester) Limited* [2000] FSR 253 where the claimant alleged infringement of its registered mark "Volvo" in respect of class 37 relating to the maintenance and repair of vehicles and where the court found that the sign was not only similar but identical. There the defendant ceased to be an authorised Volvo dealer by end 1996 and yet continued to use the word "Volvo" in a similar style (though not identical), accompanied by the words "independent" and "specialist" appearing in much smaller lettering so that the entire sign read "Independent Volvo Specialist". It was argued by the defendant that in view of the other words, the sign was not identical to the claimant's mark. Rattee J, in rejecting this contention, said (at 259):

In my judgment, in a case of a word trade mark such as that in the present case, all that is necessary to constitute *prima facie* infringement under section 10(1) is use of the identical word in the course of trade as a distinct word, whether with or without other words or material added to it.

19 It would be noted that Rattee J found that the defendant's infringing sign was not only similar, but identical, to the claimant's mark. There is perhaps a simple explanation for this. First, the word "Volvo" is not an ordinary English word. It is an inventive word, and is thus distinctive. Second,

it had been used on the claimant's automobiles for a long time and had acquired a reputation and goodwill in it. Third, the emphasis in the entire sign was the word "Volvo". The other two words, "independent" and "specialist", which were in much smaller print, were quite clearly of marginal significance.

20 In *Pan-West (Pte) Ltd v Grand Bigwin Pte Ltd* [2003] 4 SLR 755, ("*Pan-West*"), where the contest was between "Katana Golf" and "Katana", the court held the two marks were identical as the main thing in the registered mark "Katana Golf" was really "Katana". Relying on the case, the appellant argued that if in that situation the court could hold that the two marks were identical, even though they were not really so, then the court should, in the present case, hold that the appellant's mark and the respondent's sign were at least similar. We recognise that there could be a difference of views as to whether "Katana" could really be said to be identical to "Katana Golf".

21 On the other hand, in *Origins Natural Resources Inc v Origin Clothing Ltd* [1995] FSR 280, the court held that "Origin" was not identical to the registered mark "Origins" because of the omission of the letter "s". This case shows a stricter approach to the question of what is "identical". And this was further elucidated by the European Court of Justice in the case of *SA Société LTJ Diffusion v Sadas Vertbaudet SA* [2003] FSR 34, where it said (at [50]):

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

22 Of course we are not here concerned with the question of whether the sign of the respondent is identical to that of the mark of the appellant. A good illustration of two marks being similar is the case of *Jordache Enterprises Inc v Millennium Pte Ltd* [1984-1985] SLR 566 where the word "Jordane" was found to be closely resembling that of "Jordache". Thus they were held to be similar.

23 In the present case, as stated before, the appellant had never used the word mark "POLO" *simpliciter*, on its products. Instead, the appellant's products bore its other registered trade marks *eg*, "POLO BY RALPH LAUREN" and "POLO RALPH LAUREN & polo player device". There was simply no evidence before the court to show that the word "polo" *per se* is distinctive. Indeed, the word "polo" is an ordinary English word meaning a game played on horseback. It is also used to describe a type of T-shirt with a collar. Moreover, there is no rigid principle that the first syllable of a word mark is more important. We recognise that some marks are inherently distinctive because they consist of inventive words without any notional or allusive quality. An example would be "Volvo". "Polo" is certainly not an inventive word and could claim no inherent distinctiveness. Where common words are included in a registered mark, the courts should be wary of granting a monopoly in their use: see *The European Limited v The Economist Newspaper Limited* [1998] FSR 283 at 289-290 and "FRIGIKING" Trade Mark [1973] RPC 739 at 753. Any alleged distinctiveness must be acquired through use. Thus, the question of distinctiveness must be determined in the light of all the circumstances of the case. No authority has been cited to substantiate the assertion that the fact of registration is conclusive as to the distinctiveness of a mark. Neither does it follow that the incorporation of an entire registered word mark would automatically lead to infringement. The appellant even boldly contended that "POLO" should stand on the same footing with marks such as "Rolex" or "Cartier". This is an overstatement of monumental proportion, a bare assertion without foundation. While "Rolex" and "Cartier" are established distinctive names, the appellant had yet to begin to show that "POLO" has acquired a similar distinction. Even the appellant's witness in cross-examination said that the appellant's most distinctive marks are the "polo player device" and "Polo Ralph Lauren" name.

24 Bearing in mind that "polo" is a common English word, we are unable to see how it could be

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

Confusion

25 As we have earlier indicated, there was common ground that the goods on which the sign of the respondent is applied are similar to the class of goods against which the appellant's mark is registered. This leaves us with the last issue relating to the question of confusion. Indeed, in the light of our finding above that the sign and the mark are not similar, the question of confusion does not arise. However, for the purpose of discussion, we shall assume that the sign and the mark could be regarded in a sense similar. It is clear from the term of s 27(2)(b) that it does not necessarily follow that, just because the registered mark and the sign, as well as the goods, are similar, confusion will automatically arise. If that were intended, s 27(2)(b) would have provided that where the mark and sign, as well as the goods, are similar, there shall be deemed to be confusion. We therefore endorse the broader approach taken by the trial judge to determine confusion.

26 One of the main planks of the appellant's case is that if the sign includes the entire mark of the proprietor, there is *ipso facto* infringement relying on *Saville Perfumery Ld v June Perfect Ld and F W Woolworth & Co Ld* (1941) 58 RPC 147 ("*June Perfect*"). In *June Perfect* the plaintiff sold articles of perfumery and toiletry under labels bearing the word "June" in conjunction with other words. The Court of Appeal, in reversing the decision of the trial judge, held (at 162) that there was no doubt that the word "June" was the distinguishing or essential feature of the plaintiff's mark. It also held that it was by this word "that traders and members of the public who see the mark on the goods which they purchase describe the [plaintiff's] goods". It further observed that the question of likelihood of deception was to be considered by reference not only to the whole mark but also its distinguishing or essential features. But the court also opined that regard would be had to extraneous factors such as trade practices in determining whether a mark had an essential feature. The appellant here has failed to show that "POLO" is an essential feature in all their marks or that "POLO" had become distinctive of their goods. All that the appellant could show was that "POLO" is a registered mark. But registration *per se* does not equal to distinctiveness.

27 In *Pianotist*, a case cited by the trial judge which related to refusal of registration on a similar ground as that set out in our s 27(2)(b), Parker J, in dealing with the question as to how the issue of confusion should be approached, said (at 777):

You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. *In fact, you must consider all the surrounding circumstances*; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion – that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will

lead to confusion in the goods – then you may refuse the registration or rather you must refuse the registration in that case. [emphasis added]

In *Pianotist*, the owner of a registered mark “Pianola” unsuccessfully opposed an application for registration of the sign “Neola” in respect of musical instruments. The appellant contended that Lai J misapplied *Pianotist*, as he took into account matters other than those relating to “the nature and kind of customer” who was likely to buy the goods. We do not think there is any merit in this argument. First, it ignores the words of Parker J underscored above. Second, it fails to take into account the following conclusion reached by Parker J (at 778):

[H]aving regard to the nature of the customer, the article in question, and the price at which it is likely to be sold, and all the surrounding circumstances, no man of ordinary intelligence is likely to be deceived.

28 The question of likelihood of confusion has to be looked at globally taking into account all the circumstances including the closeness of the goods, the impression given by the marks, the possibility of imperfect recollection and the risk that the public might believe that the goods come from the same source or economically-linked sources: see *Associated Newspapers Ltd v Express Newspapers* [2003] FSR 51 (“*Associated News*”). But that is not all. Steps taken by the defendant to differentiate his goods from those of the registered proprietor are also pertinent. As the trial judge observed ([10] *supra* at [21]):

The only thing that the statute calls for is that the likelihood of confusion arises from the similarity. But where the user of a potentially infringing sign has taken pains to distinguish his products from the registered proprietor’s good and services, the effect may be that the likelihood of confusion, if any, is merely hypothetical or speculative. This is significant because unlike s 27(1) TMA, s 27(2)(b) does not presume that there is a likelihood of confusion. If there is no likelihood of confusion, there can be no infringement ... Section 27(2)(b) TMA also does not forbid the court taking into account various factors in deciding the degree of similarity required in order to find that there exists a likelihood of confusion.

So also is the kind of customer who would be likely to buy the goods of the appellant and the respondent: see *Cooper* ([24] *supra*) at 539; *Celine SA’s Trade Mark Applications* [1985] RPC 381 at 400–401 and *Pianotist* ([24] *supra*) at 777.

29 The appellant had sought to argue that English cases relating to objection proceedings (equivalent to s 8(2) of the Act), where the courts had taken into account extraneous factors in determining whether there would be confusion, should not be adopted in relation to infringement proceedings under our s 27(2)(b). This contention was not accepted in *Royal Berkshire* where the Appointed Person (Hobbs QC) said ([15] *supra* at [17]) that both provisions “serve to ensure that trade marks whose use could successfully be challenged before the courts are not registered”. We agree.

30 In *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767, the comparison was between “TY.PHOO” and “TYPHOON”. The plaintiff who was the registered owner of the first mark made three claims, one of which was that the respondent’s use of the mark “TYPHOON” on its goods infringed the rights of the plaintiff under a provision which is substantially similar to our s 27(2)(b). It was not strongly disputed that “TYPHOON” was similar to “TY.PHOO” and indeed Neuberger J so held. The main question there was whether there would be confusion. After examining the following factors, and here we quote Neuberger J (at 780):

- (1) The visual aural and conceptual similarity between the TYPHOON sign and the TY.PHOO mark;
- (2) The inherent distinctiveness of the TY.PHOO mark, and, for reasons I have just been discussing, Premier does not rely in relation to this part of its case, on any acquired distinctiveness;
- (3) The degree of similarity between the goods for which the defensive marks are registered and the goods in relation to which the TYPHOON sign has been used;
- (4) The nature of the average consumer to the type of goods concerned.

he came to the conclusion that there would be no real possibility of the average consumer of kitchenware, mistaking the TYPHOON sign for the TY.PHOO mark.

31 In *Polo/Lauren Co LP v United States Polo Association* [2002] 1 SLR 326, proceedings were instituted to set aside the registration of the applicant's marks on the ground that those marks, which depicted a polo player on horseback were similar to the opponent's registered trade mark of a polo player. However, there were two main differences between both marks. The polo player on the opponent's mark had his polo club on the upswing whereas the polo player in the applicant's mark had his polo club on the low swing. Second, the applicant's mark had the alphabets "USPA" beneath the logo while the opponent's had just a motif without any lettering. Choo Han Teck JC (as he then was) opined at 322, that one should not determine likelihood of confusion based on a man in a hurry and that the test should be "the ordinary, sensible members of the public". In the circumstances there, Choo JC nevertheless found there could not be confusion.

32 Therefore, we agree with the rationale offered by the trial judge as to why extraneous factors, beyond matters relating to similarity of marks and products, may be looked at to determine whether there is infringement, when he said at [19]:

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

33 We also agree with his reasoning (at [23]) that admitting such extraneous factors to determine confusion under s 27(2)(b) would not blur the distinction between a passing-off action and an action for infringement under s 27(2)(b):

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

34 We would reiterate that what is of particular significance to the present case is the fact that none of the articles produced by the appellant bears just the mark "POLO" without other additional words. It stands to reason that the greater the exposure and use of a particular registered mark, the greater its reputation is likely to be, and therefore the greater the protection likely to be afforded to it. But where, as in this case, the mark "POLO" had, up to the date of the trial, never been used by the appellant as the only word mark on its products, we doubt that any average consumer will be confused. The average consumer is not an unthinking person in a hurry but, as the court emphasised in *McDonald's Corp v Future Enterprises Pte Ltd*, would be someone who would exercise some care and good sense in making his purchases. The trial judge also rightly pointed out that unlike the respondent's goods which are sold in their stores located in modest suburban shopping centres, the appellant's retail outlets are found in prime shopping centres. Moreover, there is a great disparity in prices between the appellant's goods and those of the respondent, not counting the fact that the appellant's goods come in nice packaging. The appellant's target consumers, who are likely to be more sophisticated and discerning, are clearly of a different class from those of the respondent.

35 In the light of all the foregoing, there could hardly be any basis for this court to disagree with the trial judge's finding that there was no likelihood of confusion in this case. It is important to bear in mind that the question whether there has been trade mark infringement is more "a matter of feel than science": *per* Laddie J in *Wagamama Ltd v City Centre Restaurants Plc* [1995] FSR 713 at 732. On this note we return to the case of *Associated News* where the court held that "Evening Mail" could be confused with "Daily Mail" or "The Mail on Sunday", but it was not persuaded that there would be confusion if the title to be used was "London Evening Mail". Laddie J said ([28] *supra* at 936) that the distinctive words "London" and "Evening" made up the majority of the title and that "the differences [were] so noticeable and important to the title". This illustrates all the more vividly that the whole question of confusion is one of perception.