

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

Trade Mark No. T1417856A
28 November 2018

IN THE MATTER OF A TRADE MARK APPLICATION BY

JEN, CHI

AND

OPPOSITION THERETO BY

GUESS?, INC

Hearing Officer: Ms Sandy Widjaja
Principal Assistant Registrar of Trade Marks

Representation:¹

Ms Jaswin Khosa (Drew & Napier LLC) for the Opponents

Henry Goh (S) Pte Ltd² for the Applicant

GROUND OF DECISION

1 Guess what is in contention in this opposition action?

¹ There was no oral hearing. The decision is made on the basis of the Opponent's written submissions only (see below).

² The Applicant did not file any written submissions (more below).

2 In the instant dispute, the subject mark, T1417856A:



was sought to be registered by Jen Chi, (the “Applicant”) for the following goods in Class 25:

Shirts; T-shirts; clothing; skirts; pants; raincoats; boots; shoes; bandanas (neckerchiefs); ties (for wear); hats; socks; gloves (clothing); belts (clothing); coats; aprons (clothing); sleep mask.

("Application Mark")

3 The Application Mark was accepted and published on 17 April 2015 for opposition purposes. The Opponent filed its Notice of Opposition to oppose the registration of the Application Mark on 17 August 2015. The Applicant³ filed her Counter-Statement on 1 October 2015. On 28 December 2016, the Opponent requested for specific information which would be included in its evidence, to be kept confidential due to its obligations to its distributors. On 6 January 2017, the Registrar allowed the request, such that the specific information will be redacted from his decision⁴. The Opponent filed evidence in support of the opposition on 8 February 2017. The Applicant filed evidence in support of the application on 8 February 2018. The Opponent filed its evidence in reply on 2 August 2018. A Pre-Hearing Review⁵ was conducted on 15 August 2018, whereupon the Applicant informed the Registrar that neither she nor her agents will be attending any hearing or filing any written submissions in order to minimise costs. The matter was set down for a “hearing” on 29 November 2018.⁶ On 12 November 2018, the Opponent informed that it wished to rely solely on written submissions.

³ The was filed by the previous owner, Wun Ton Li Activity Design Co., Ltd. Form CM8 to register a transfer of ownership was filed on 30 June 2017.

⁴ The specific items of information are:

- (i) Worldwide and local sales figures;
- (ii) Sales invoices;
- (iii) Worldwide and local advertising expenses; and
- (iv) Advertising invoices.

⁵ Via letter only.

⁶ This was re-scheduled from the original “hearing” date of 27 November 2018.

Grounds of Opposition

4 The Opponent relies on Sections 8(2)(b), 8(4) and 8(7)(a) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (the “Act”) in this opposition⁷.

Opponent’s Evidence

5 The Opponent’s evidence comprises the following:

- (i) statutory declaration of Douglas Benjamin, Chief Operating Officer of F J Benjamin Holdings Ltd,⁸ dated 27 January 2017 (“Opponent’s 1st DB SD”);
- (ii) statutory declaration of Theresa Becerril, Director and Senior Counsel, Business Transactions and Intellectual Property for the Opponent, dated 2 February 2017 (“Opponent’s 2nd TB SD”); and
- (iii) statutory declaration of Anne Deedwania, Director of Litigation and Chief Compliance Officer for the Opponent, dated 24 July 2018 (“Opponent’s 3rd AD SD”).

6 One comment on the evidence before I proceed further. The onus is on parties to provide quality⁹ evidence to support their case. Otherwise, they will have to be prepared to bear the consequences of such evidence being disregarded.

Applicant’s Evidence

7 The Applicant’s evidence comprises the statutory declaration of Jen Chi, the Applicant, dated 7 February 2018 (“the Applicant’s SD”).

Applicable Law and Burden of Proof

8 As the applicable law is the Act, there is no overall onus on the Applicant either before the Registrar or in opposition proceedings. The undisputed burden of proof in the present case falls on the Opponent.

Background

9 The Opponent deposed that it is established in California by the Marciano brothers in 1981. It is a publicly traded Delaware Corporation, listed on the New York Stock Exchange since 1996. The Opponent specializes in, among others, fashion-forward apparel, handbags, watches, eyewear, fragrance, shoes and other fashion accessories ([4] of the Opponent’s 2nd TB SD). The Opponent has approximately 4,600 pending trademark applications / registrations and over 500 copyright applications / registrations in approximately 184 countries worldwide ([5] of the Opponent’s 2nd TB SD).

⁷ Confirmation via letter of 3 September 2018.



⁸ They are the Opponent’s main distributor in Singapore, more below.

⁹ Some of the marks in the Opponent’s 2nd TB SD are not visible at all.

10 The Opponent currently has 15 domestic and international licensees offering a wide range of products as well as licensees for the manufacture of the Opponent's branded products in various markets ([6] of the Opponent's 2nd TB SD). The Opponent's retail network is made up of both directly operated and licenced operation stores ([9] of the Opponent's 2nd TB SD).

11 The **Opponent's Earlier Marks**¹⁰ have been used by the Opponent in relation to a variety of goods¹¹ in Singapore since 1 May 1991 ([32] of the Opponent's 2nd TB SD). The Opponent and its related companies have a partnership with a local developer of retail and distribution networks for international luxury and lifestyle brands, FJ Benjamin Holdings Ltd, its wholly owned subsidiary, FJ Benjamin (Singapore) Pte Ltd and its other subsidiaries ("the **Singapore Distributors**") to bring the Opponent's products into the local market. This partnership first started 25 years ago. The Singapore Distributors and other distributors have licenses from the Opponent to use the **Opponent's Earlier Marks** in Singapore ([33] of the Opponent's 2nd TB SD).

12 The Opponent relies on its following earlier registered marks (collectively, **Opponent's Earlier Registered Marks**)¹² ([9] of the Opponent's written submissions ("OWS")):

S/N	Opponent's Earlier Registered Marks	Class
Opponent's Earlier Registered Marks		
Opponent's Earlier Registered Device Mark		
1	 T8603580E	<u>Class 25</u> Articles of outer-clothing; vests; underpants and footwear being articles of clothing
Opponent's Earlier Registered GUESS Mark		
2	 T8302664C	<u>Class 25</u> Men's, women's and children's outerwear and underwear, jeans, shirts, jackets, vests, pants, sweaters, jumpsuits, shorts, hats, overalls, dresses, skirts, sweatshirts, t-shirts, sweatpants, neckties, brassieres, camisoles, bathing suits, sport coats, suits, robes, pyjamas, belts, briefs, coats,

¹⁰ As defined at [62] below; see also [12] of the Opponent's 2nd TB SD.

¹¹ This includes clothes, eyewear, watches, handbags etc (see [6] of the Opponent's 2nd TB SD).

¹² In addition, although the Opponent also sought to rely on its unregistered mark (see below at [62], defined as the **Opponent's Earlier Unregistered Mark**) for the purposes of section 8(2) in its pleadings ([10] of the Notice of Opposition), it did not do so in the OWS (see [9] OWS). In this regard, they only sought to rely on the same for section 8(4) in its submissions (see [54] of the OWS). In any event, even if the **Opponent's Earlier Unregistered Mark** was relied on for the purposes of section 8(2), it would not have assisted the Opponent since the **Opponent's Earlier Unregistered Mark** does not qualify as "an earlier mark". This is because it is not found to be "well-known in Singapore" (see [69] below).

		leotards, hosiery, gloves, pantyhose, scarves, ponchos, slips, sun visors, tights and footwear.
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13 The Applicant deposed that the previous applicant, Wun Ton Li Activity Design Co., Ltd had assigned the Application Mark to her ([2] of the Applicant’s SD). The Applicant deposed that use of the Application Mark was made in Taiwan by the previous applicant in 2012¹³. Within 6 months of its launch, products were featured in a leading online platform for men’s contemporary fashion and street wear based in Hong Kong. Since then the products have been distributed worldwide to exclusive retailers ([4] of the Applicant’s SD). In Singapore, the goods are offered for sale online^{14 15} as well as via retail stores which specialise in men’s contemporary fashion. Outlets can be found in Far East Plaza and Cineleisure etc ([7] of the Applicant’s SD).

Summary

14 For convenience, I set out my principal holdings as follows:

- (i) Under the ground of objection under section 8(2)(b), there is no mark similarity as the Application Mark is visually and conceptually more dissimilar than similar¹⁶ to the ***Opponent’s Earlier Registered Device Mark***.
- (ii) Under the ground of objection under section 8(2)(b), there is no mark similarity as the Application Mark is visually, aurally and conceptually more dissimilar than similar to the ***Opponent’s Earlier Registered GUESS Mark***. In coming to the above conclusion, the main distinctive component of the ***Opponent’s Earlier Registered GUESS Mark*** is the word “GUESS”.
- (iii) In light of the above, and the fact that ***Opponent’s Earlier Unregistered Mark*** does not qualify as “an earlier mark” as it is not found to be well known in Singapore, the ground of objection under section 8(4) fails although the Registrar is prepared to hold that the ***Opponent’s Earlier Registered GUESS Mark*** is well known in Singapore under section 8(4)(b)(i).
- (iv) The ground under section 8(7)(a) fails as there is no misrepresentation.

¹³ It would appear that the Applicant also hails from Taiwan (see Applicant’s SD).

¹⁴ At [5] of the Applicant’s SD.

¹⁵ Via hatersnapback.com; see exhibit JC-2, for example, at the top left hand corner of page 20 of the Applicant’s SD.

¹⁶ There is no aural concept as a basis for comparison since the ***Opponent’s Earlier Registered Device Mark*** is a device mark.

MAIN DECISION

Ground of Opposition under Section 8(2)(b)

15 Section 8(2)(b) provides as follows:

8(2) A trade mark shall not be registered if because...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public.

Decision on Section 8(2)(b)

Step-by-step approach

16 In *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 (“*Staywell*”), the Court of Appeal re-affirmed the 3-step test approach in relation to an objection under Section 8(2)(b) (see [15] and [55]):

- (i) The first two elements - namely similarity or identity of the marks and similarity or identity of the goods / services - are assessed individually before the final element which is assessed in the round.
- (ii) Once the two threshold requirements have been met, the issue of the likelihood of confusion arises and the tribunal / court is directed to look at (a) *how* similar the marks are, (b) *how* similar the goods / services are, and (c) given this, how likely the relevant segment of the public will be confused.

Similarity of Marks

17 The law in relation to this issue is as follows (*Staywell* at [15] to [30]):

- (i) The three aspects of similarity (i.e. visual, aural and conceptual similarities) are meant to guide the court’s inquiry. Trade-offs can occur among the three aspects of similarity.
- (ii) Technical distinctiveness is an integral factor in the marks-similarity inquiry. A mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it.
- (iii) While the components of a mark may be inherently technically distinctive, ultimately the ability of the mark to function as a strong badge of origin must be assessed by looking at the mark as a whole. Conversely, the components of a mark may not be inherently distinctive, but the sum of its parts may have sufficient technical distinctiveness.

- (iv) When speaking of the assessment of a mark as a whole, the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.
- (v) The similarity of marks is ultimately and inevitably a matter of impression rather than one that can be resolved as a quantitative or mechanistic exercise. The court must ultimately conclude whether the marks, when observed in their totality, are similar or dissimilar.
- (vi) The assessment of marks similarity is mark-for-mark without consideration of any external matter.

18 Further, the Court of Appeal provided in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941 at [40(c)] and [40(d)] ("*Hai Tong*"):

[40(c)] The relevant viewpoint is that of the average consumer who would exercise some care and a measure of good sense in making his or her purchases, not that of an unthinking person in a hurry.


[40(d)] It is assumed that the average consumer has "imperfect recollection" such that the two contesting marks are not to be compared or assessed side by side (and examined in detail). Instead, the court will consider the general impression that will likely be left by the essential or dominant features of the marks on the average consumer.


Distinctiveness

19 I am mindful of the Court of Appeal's guidance in *Staywell* (above) that distinctiveness is a factor integrated into the visual, aural and conceptual analysis as to whether the competing marks are similar and it is not a separate step within the marks-similarity inquiry. However, for ease of analysis, I will summarise my findings first, before applying them within the context of the mark-similarity analysis (see *Hai Tong* at [26]).

Opponent's Earlier Registered Marks

20 For ease of reference, the marks are:

S/N	<i>Opponent's Earlier Registered Marks</i>	Class
<i>Opponent's Earlier Registered Device Mark</i>		
1	 T8603580E	<u>Class 25</u> Articles of outer-clothing; vests; underpants and footwear being articles of clothing
<i>Opponent's Earlier Registered GUESS Mark</i>		

2	 <p>T8302664C</p>	<p><u>Class 25</u></p> <p>Men's, women's and children's outerwear and underwear, jeans, shirts, jackets, vests, pants, sweaters, jumpsuits, shorts, hats, overalls, dresses, skirts, sweatshirts, t-shirts, sweatpants, neckties, brassieres, camisoles, bathing suits, sport coats, suits, robes, pyjamas, belts, briefs, coats, leotards, hosiery, gloves, pantyhose, scarves, ponchos, slippers, sun visors, tights and footwear.</p>
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21 The Opponent argued that the dominant and distinctive feature in the *Opponent's Earlier Registered Marks* is the “the inverted triangle device, known as a “*nabla*”¹⁷ or “*del*”¹⁸ ([15] OWS).

22 The Opponent submitted at [13], [14], [19] – [22] OWS:

[13] ...In *Staywell*, the Court of Appeal commented as follows at [23] to [26]:-

...

Distinctiveness in the ordinary and non-technical sense simply refers to what is outstanding and memorable about the mark. Such components tend to draw the consumer's attention, bearing in mind the imperfect recollection of the average customer... That is why the court is entitled to have special regard to the distinctive or dominant components of a mark, even while it assesses the similarity of the two marks as composite wholes.

Distinctiveness in the technical sense on the other hand, usually stands in contradistinction to descriptiveness ... Distinctiveness can be inherent, usually where the words comprising the mark are meaningless and can say nothing about the goods or services...

[14] In the High Court decision of *Han's (F & B) Pte Ltd v Gusttimo World Pte Ltd* [2015] SGHC 39, Judicial Commissioner Wei (as he then was) gave examples to illustrate the varying distinctiveness of a trade mark at [61] to [63]:-

Returning to the meaning of distinctiveness, the trade mark must necessarily, either inherently or as a result of use, perform the most basic function of distinguishing the goods of the trader from those of his competitors in the marketplace. Some trade marks carry a high level of “inherent distinctiveness” in the sense that these marks will be understood by the public as bearing a trade mark meaning, even if they have not yet been used or promoted to the public. Invented words are classic examples of such trade marks...

¹⁷ It is not apparent from the Opponent's written submissions how the Opponent reached the conclusion that an inverted triangle is known as “*nabla*”. The Opponent further submitted that “*nabla*” means “*del*” in Mathematics ([17] OWS).

¹⁸ In turn, “*del*” means “An operator used in vector analysis” in Mathematics ([18] OWS).

Another example is a manufacturer who decides to use the mark “*Slow Coach*” for a range of running shoes that he is about to launch. **Even though the words and phrase are not newly coined, the meaning has little bearing on the product to which it is to be applied.** Nonsensical phrases may also bear a relatively high level of inherent distinctiveness in the sense that, even without extended advertising or marketing, consumers are likely to view the phrase as a trade mark. Even if there is a possibility that some persons may view the nonsensical phrase as part of the product design such as a visual embellishment or decoration, it may not take much use and marketing to develop the trade mark message. Much of course will depend on how the nonsensical phrase is used on or in relation to the product...

[19] Given the above significance of the inverted triangle device, known as a “nabla” or “del”, the said device by itself “says nothing about” the goods for which it is registered for in Class 25 (apparel).

[20] Even if the inverted triangle device...is a simple geometric device as averred by the Applicant, which is not admitted, the device has absolutely no reference to the Opponent’s goods. In short, the inverted triangle device...is unusual, novel and highly distinctive of the Opponent’s goods.

[21] Furthermore, the *Opponent’s Earlier Registered Marks*¹⁹ are marks that have “come to acquire the capacity to act as a badge of origin through long-standing or widespread use”. Women’s apparel bearing the *Opponent’s Earlier Registered Marks* represent approximately 18% of the women apparel offered for sale by the Opponent. Denim products bearing the *Opponent’s Earlier Registered Marks* represent at least 45% of the denim products offered for sale by the Opponent, which equated to over SGD93,000,000 worth of products sold in 2013 alone.

[22] It is therefore submitted that each of the *Opponent’s Earlier Registered Marks* has a high level of “technical distinctiveness”, and each therefore “enjoys a high threshold before a competing sign will be considered dissimilar to it.”

[Emphasis as underlined the Opponent’s and in bold mine]

23 First of all, it is to be recalled that in the mark similarity analysis, I am to assume the viewpoint of the average consumer. Thus, regardless of any technical meaning of the inverted triangle device,²⁰ I am of the view that an average consumer is likely to view the device simply as an “inverted triangle device”.

24 The Opponent argued that “the inverted triangle device...by itself “says nothing about” the goods” and that “the device has absolutely no reference to the Opponent’s


¹⁹ See [9] OWS.

²⁰ Whether it is known as a “nabla” or “del”.

goods...[i]n short, the inverted triangle device is unusual, novel and highly distinctive of the Opponent's goods ([19] and [20] OWS).

25 There is a need to apply *Staywell* and *Han's (F & B) Pte Ltd v Gusttimo World Pte Ltd* [2015] SGHC 39 with care. It is not directly applicable here as the mark in contention, the **Opponent's Earlier Registered Device Mark**, is a *device* mark. For clarity, there may be instances where a device which says nothing about the goods is distinctive of the goods. However, I am of the view that this is not the case here. On the other hand, I am of the view that (having regard to the goods), it would simply be viewed as a decorative element (more below).²¹

26 The Opponent also sought to support its argument on the basis that “[while] IPOS

raised objections to TM No. T1114027Z “” on the basis of Section 7(1)(b) of the Act, no formal decision was issued by...IPOS that TM No. T1114027Z is not distinctive. The Opponent was given an opportunity to respond to the objections but chose to abandon the application due to a commercial decision” ([48] of the Opponent's 2nd TB SD). My short response is that the above matter does not affect the current opposition case.²²

27 Further, the Opponent deposed at [21] of the Opponent's 3rd AD SD that it has successfully registered T1301009H which is essentially an inverted triangle in Class 25 amongst others. However, a closer look at the entry of the said mark in the Register²³ will reveal that it is more than just an inverted triangle:



In fact, the mark index on the Register reads: “Device Description: *gems pattern* triangle.”^{24 25} Thus this mark also does not assist the Opponent's stance.

28 Taking the **Opponent's Earlier Registered Marks** as *wholes* respectively, I am of the view that while the **Opponent's Earlier Registered GUESS Mark**, which incorporates the Opponent's company name, is distinctive, the same cannot be said of the **Opponent's Earlier Registered Device Mark**. In light of the above, the issue of acquired distinctiveness is only relevant for the **Opponent's Earlier Registered Device Mark**.

²¹ And this is so even taking the question mark device into account.

²² The fact that no formal decision has been issued by IPOS that TM No. T1114027Z is not distinctive does not imply that the mark is distinctive. On the contrary, the fact that section 7(1)(b) was raised (and not waived) suggests that the said mark is not a strong mark.

²³ See Exhibit AD-4 of the Opponent's 3rd AD SD.

²⁴ See page 54 of the Opponent's 3rd AD SD.

²⁵ Even if the the **Opponent's Earlier Registered Device Mark** includes a question mark device, the two still cannot be equated such that the registration of T1301009H does not assist.

29 The issue of whether any evidence can be admitted at this stage of the mark-similarity analysis was considered by the IP Adjudicator in *Monster Energy Company v NBA Properties, Inc* [2018] SGIPOS 16, albeit *obiter*:

[41] One interesting question that arose from this dispute is to what extent the knowledge of the average consumer, which may include awareness of facts that are widely known to the public or common general knowledge, is relevant to the mark-similarity analysis in trade mark opposition proceedings. **More specifically, is it permissible for the parties to adduce evidence of public activities which may have shaped consumer knowledge of, and familiarity with, a word mark?** This question arises because of the emphasis that the Court of Appeal has placed on how “the assessment of marks similarity is mark-for-mark without consideration of any external matter” (*Staywell* at [20]) and is related to the unresolved question of whether the acquired distinctiveness of a mark ought to be relevant to mark-similarity (Step 1) analysis.



...

[46] In my view, how the average consumer *understands* what he *sees* (which is the essence of the mark-similarity analysis) must necessarily depend on *what he knows*. As such, the knowledge of the average consumer, and *how* he is likely to *understand* or *interpret* the word device element of a composite mark, must be relevant to mark-similarity assessment. What words (or images, for that matter) *mean* to the average consumer must be evaluated contextually. **It follows that the parties should be permitted to adduce evidence of those surrounding circumstances that are relevant towards establishing the general knowledge possessed by the average consumer...**

[Emphasis in bold mine, emphasis in italics in the original]

I am inclined to agree with the IP Adjudicator. In any event, it will become apparent that even if the evidence can be taken into account at this stage, it does not advance the Opponent’s cause.²⁶

30 Before I begin, in addition to the *Opponent’s Earlier Registered Marks*, it is useful to define the marks which appear in the Opponent’s evidence:

S/N	Opponent’s marks used in its evidence	Depiction
1	<i>Opponent’s Earlier Composite GUESS Mark</i>	
2	<i>Opponent’s Earlier GUESS Word Mark</i>	

31 The Opponent deposed at [17] – [25] of the Opponent’s 2nd TB SD:

²⁶ That the *Opponent’s Earlier Registered Device Mark* has acquired distinctiveness.

[17] The Opponent does not track its worldwide product sales or purchases by trade mark. The Opponent's estimated annual worldwide net revenue for its products, including the Opponent's Goods²⁷ bearing the *Opponent's Earlier Marks*²⁸, from 1982 to 2014 are:^{29 30}

[redacted]

[18] Though the Opponent does not track its worldwide product sales or purchases by trade mark, the Opponent's records show that in approximately 18% of the Opponent's full line of women's apparel that have been offered for sale on its online website at www.guess.com³¹ are women's apparel bearing the *Opponent's Earlier Marks*. As a similar range of the Opponent's products are being sold worldwide, the proportion of women's apparel bearing the *Opponent's Earlier Marks* that have been sold worldwide is also approximately 18% of the Opponent's full line of women's apparel products.³²

[19] Additionally, the Opponent's records at April 2014³³ showed that based on the denim products bearing the *Opponent's Earlier Marks* available at April 2014 on its online website at www.guess.com,³⁴ as a percentage of all its denim products that were available on the website at such time, the Opponent reasonably estimated and believes that more than 50% of the Opponent's denim products sold each year in the United States through its retail stores, e-commerce site and to its wholesale accounts³⁵ contain one of the *Opponent's Earlier Marks* or a variation thereof. Therefore, for 2013, by way of example, based on the sales data reflected in the chart below, the Opponent had approximately [redacted] of sales of products, bearing the *Opponent's Earlier Marks* or a variation thereof in the United States.

[20] The chart below represents Opponent's total denim sales for the period 2009 – 2014 (partial year) in the United States, Europe and Asia only (excluding Korea):

[redacted]

²⁷ See [6] of the Opponent's 2nd TB SD.

²⁸ As above.

²⁹ The figure for 2015 is excluded as the *Relevant Date* is 6 November 2014.

³⁰ In this regard, it is not necessary to look into exhibit TB-6 which contains relevant extracts from the Opponent's annual reports disclosing the Opponent's annual worldwide net revenues and advertising expenditures relating to the *Opponent's Earlier Marks* from 1999 – 2015 ([26] of the of the Opponent's 2nd TB SD). The Opponent's worldwide advertising figures are provided below.

³¹ See [11] of the Opponent's 2nd TB SD where the Opponent deposed that "As of 30 January 2016, GUESS operates retail websites e.g. www.guess.com...in the U.S". It is to be recalled that the *Relevant Date* is 6 November 2014. If so, any figures from the website www.guess.com would be after the *Relevant Date*. Nonetheless, I am mindful that the Opponent is merely using the figures from the website as an approximation and in any event, it will become apparent that this point is inconsequential.

³² See below Exhibit TB-5 of the Opponent's 2nd TB SD.

³³ The *Relevant Date* is 6 November 2014.

³⁴ As above.

³⁵ Query whether this should be taken into account as it can potentially result in double counting since such items would in all likelihood be ultimately sold via the retail outlets.

[21] Based on the Opponent's products available in April 2014 on the Opponent's European e-commerce website, www.guess.eu, the Opponent reasonably estimated and believes that more than 40% of the Opponent's denim products sold each year in Europe through its retail stores, e-commerce site and to its wholesale accounts³⁶ contain one of the ***Opponent's Earlier Marks*** or a variation thereof. Therefore, for example, in 2013, the Opponent had approximately [redacted] of sales of denim products bearing the ***Opponent's Earlier Marks*** or a variation thereof in Europe based on the sales data reflected in the chart above.

[22] Product lines offered in the United States and Europe are also available worldwide, including in Singapore and therefore the Opponent reasonably believes that 45% of its global denim sales through its retail stores, e-commerce site and to its wholesale accounts, including its sales in Singapore, feature products bearing the ***Opponent's Earlier Marks*** or a variation thereof. For 2013 alone, this equates to [redacted] of product sold worldwide bearing the ***Opponent's Earlier Marks*** or a variation thereof, based on the sales data reflected in the chart above.

[23] Now shown to me and marked TB-5³⁷ is a report showing the estimated sales figures for the Opponent's women apparel bearing the ***Opponent's Earlier Marks*** that are sold via the Opponent's website at <http://shop.guess.com>³⁸...

[redacted]

[24] The Opponent does not track its advertising expenses by trade mark. The Opponent's estimated annual worldwide advertising expenses for promoting its products, including the Opponent's Goods bearing the ***Opponent's Earlier Marks***, from 1993 – 2014³⁹ ⁴⁰are:

[redacted]

[25] The Opponent's company records relating to its advertising expenses prior to 1993 have either been lost or destroyed, though extensive advertising for the period of 1982 to 1992 did occur.

32 The Opponent also adduced evidence as to the figures pertaining to the Singapore Distributor at [36] – [39] of the Opponent's 2nd TB SD:

³⁶ As above.

³⁷ For convenience, the table in TB-5 of the Opponent's 2nd TB SD is presented.

³⁸ It is unclear if the website should be www.guess.com instead; see above [18] of the Opponent's 2nd TB SD.

³⁹ The figure for 2015 is excluded as it is after the ***Relevant Date***.

⁴⁰ In this regard, it is not necessary to look into exhibit TB-6 which contains relevant extracts from the Opponent's annual reports disclosing the Opponent's annual worldwide net revenues and advertising expenditures relating to the ***Opponent's Earlier Marks*** from 1999 – 2015 ([26] of the of the Opponent's 2nd TB SD).

[36] GUESS does not track its product sales or purchases by trade mark. GUESS annual sales figures from its wholesale sales of apparel products, including the Opponent's Goods bearing the **Opponent's Earlier Marks** from 2010 to 2014⁴¹ to the Singapore Distributors are:

[redacted]

[37]...Additionally, the sales figures above reflect the sales figures for apparel products only. The sales figures for the accessory products sold by Singapore Distributors (purchased from the Opponent's accessory licensees) are not included, nor are the sales figures of the Opponent's accessory products sold by its other distributors in Singapore (purchased from the Opponent's accessory licensees), though the Opponent's full line of accessory products, including those bearing the **Opponent's Earlier Marks**, are sold in Singapore.⁴²

[39] The Opponent's estimated annual local advertising expenses for promoting its goods under the **Opponent's Earlier Marks** through the Singapore Distributors and other various distributors in Singapore from 2010 – 2014⁴³ are:

[redacted]

33 The exhibits tendered by the Opponent in support are as follows⁴⁴:

S/N	Description	Comments
TB-2⁴⁵		
1	Photographs of examples of the Opponent's Goods and packaging bearing the Opponent's Earlier Marks ⁴⁶	The mark which is commonly reflected is the Opponent's Earlier Composite GUESS Mark . The Opponent's Earlier Registered Device Mark usually does not appear alone.
TB-3		
2	Summary of editorials promoting the Opponent's Goods bearing the Opponent's Earlier Marks around the world from 2008 to 2011 and	It is unclear if the publications listed were circulated in Singapore, and if so, to what extent. Further, the mark which is commonly reflected is the Opponent's Earlier Composite GUESS Mark and the Opponent's Earlier GUESS Word Mark .

⁴¹ The figure for 2015 is excluded.

⁴² These cannot be taken into account as there are no figures to substantiate them.

⁴³ The figure for 2015 is excluded as it is after the **Relevant Date**.

⁴⁴ Reference to Exhibit TB-4 (see [16] of the Opponent's 2nd TB SD) is excluded. This is because the main relevant website for Singapore is <http://www.zalora.sg> and at [11] of the Opponent's 2nd TB SD, the Opponent deposed that goods were "launched online in Singapore on October 1, 2016, through the website www.zalora.sg". This is after the **Relevant Date**.

⁴⁵ These are exhibits included in the Opponent's 2nd TB SD.

⁴⁶ See [14] of the Opponent's 2nd TB SD.

	sample copies of these editorials as well as those from 2012 to 2014 ^{47 48}	
<i>TB-10</i>		
3	Sample copies of the Opponent's product catalogues for the period 1992 – 2014 ⁴⁹ showing use of the <i>Opponent's Earlier Marks</i> which were circulated in Singapore. ⁵⁰	The catalogues are international in nature and the extent to which they were circulated in Singapore is unclear. Importantly, the marks which are more commonly reflected are the <i>Opponent's Earlier Composite GUESS Mark</i> and <i>Opponent's Earlier GUESS Word Mark</i> .
<i>TB-11</i>		
5	Sample copies of random sales invoices issued by the Opponent's subsidiary [redacted] in relation to the sale of the Opponent's apparel products bearing the <i>Opponent's Earlier Marks</i> to the Singapore Distributors ⁵¹ from 2010 – 2014. ^{52 53}	The main mark which appears on the invoices is the <i>Opponent's Earlier Composite GUESS Mark</i> .

34 Apart from the issue of segregating the figures which arose from sales in the local market, crucially, it is observed that the more commonly reflected marks in the evidence are the ***Opponent's Earlier Composite GUESS Mark*** and the ***Opponent's Earlier GUESS Word Mark***. On the other hand, while there are a handful of references to the ***Opponent's Earlier Registered Device Mark***, they *hardly* appear on their own.

35 The Opponent also tendered evidence made by its ***Singapore Distributors*** ([5] – [8] of the Opponent's 1st DB SD):⁵⁴

[5] The Singapore Distributors have been using and promoting the ***Opponent's Earlier Marks***⁵⁵ in respect of a variety of the Opponent's products, including clothes, watches, handbags, footwear...in Singapore since 1 May 1991.

⁴⁷ Those dated after the ***Relevant Date*** are excluded.

⁴⁸ See [15] of the Opponent's 2nd TB SD.

⁴⁹ Those dated after the ***Relevant Date*** are excluded.

⁵⁰ See [35] of the Opponent's 2nd TB SD.

⁵¹ The issue remains that these products may not reach the final consumer (see below).

⁵² The year 2014 is included as the ***Relevant Date*** falls in November. Those dated after the ***Relevant Date*** are excluded.

⁵³ See [38] of the Opponent's 2nd TB SD.

⁵⁴ Although the Opponent referred to [5] - [10] of the Opponent's 1st DB SD at [58] OWS, [9] and [10] simply refer to exhibits DB-2 and DB-3 of the Opponent's 1st DB SD while [7] simply refers to DB-1. They are thus not replicated here.

⁵⁵ See [4] of the Opponent's 1st DB SD.

[6] The Opponent's Goods⁵⁶ bearing the ***Opponent's Earlier Marks*** are readily available to the general public at large in Singapore...the Singapore Distributors now have 8 stores that offer and distribute the Opponent's product, including the Opponent's Goods bearing the ***Opponent's Earlier Marks***, in prime shopping megamalls with dense human traffic in Singapore. Their locations are Ngee Ann City, Paragon, ION Orchard, Marina Bay Sands, Vivo City, Bugis Junction and Takashimaya...

[8] The Singapore Distributors have also expended significant efforts in advertising and promoting the Opponent's Goods under the ***Opponent's Earlier Marks***, on behalf of the Opponent, through a variety of means and media including, but not limited to, print advertisements, editorials, billboard installations, fashion shows, online advertisements, social media etc in Singapore.

36 The following exhibits are tendered in support:

S/N	Description	Comments
<i>DB-1</i> ⁵⁷		
1	List of Singapore Distributor's retail stores in Singapore. ⁵⁸	List of stores in prime malls ⁵⁹ with the opening period spanning 1993 – 2012.
<i>DB-2</i> ⁶⁰		
2	Sample copies of advertising invoices and corresponding print advertisements, editorials, photographs of billboard installations etc. ^{61 62}	Again the marks which are commonly reflected are the <i>Opponent's Earlier Composite GUESS Mark</i> and the <i>Opponent's Earlier GUESS Word Mark</i> .
<i>DB-3</i>		
3	Straits Time article entitled <i>Guess what? FJ Benjamin stays upbeat amid global retail slump</i> dated 6 May 2008. ⁶³	Again the marks which are reflected are the <i>Opponent's Earlier Composite GUESS Mark</i> and the <i>Opponent's Earlier GUESS Word Mark</i> .

37 One issue with the wholesale sales figures from the Opponent to the Singapore Distributors is that not all of the products may reach the ultimate consumer. Nonetheless, I am prepared to accept them as an approximate of the sales generated from the Singapore market.

⁵⁶ See [5] of the Opponent's 1st DB SD.

⁵⁷ These are exhibits included in of the Opponent's 1st DB SD.

⁵⁸ See [7] of the Opponent's 1st DB SD.

⁵⁹ See [6] of the Opponent's 1st DB SD.

⁶⁰ Those which are dated after the ***Relevant Date*** are disregarded.

⁶¹ Those which are dated after the ***Relevant Date*** are disregarded.

⁶² See [9] of the Opponent's 1st DB SD.

⁶³ See [10] of the Opponent's 1st DB SD.




38 Importantly, it is observed that the more commonly reflected marks in the evidence above are, once again, the **Opponent’s Earlier Composite GUESS Mark** and the **Opponent’s Earlier GUESS Word Mark** (above).

39 Returning to the issue of distinctiveness, in light of the above, the evidence does nothing to advance the Opponent’s argument that the **Opponent’s Earlier Registered Device Mark** has acquired any distinctiveness. When viewed on its own, any distinctiveness emanates from the **Opponent’s Earlier Registered Device Mark** as a whole, that is, the inverted triangular device together with the question mark device. I am of the view that the **Opponent’s Earlier Registered Device Mark** is at the low end of the spectrum of distinctiveness as “the device component is more likely to be perceived as a *decorative* element rather than as an element indicating commercial origin” ([40] **Hai Tong** below). This is borne out by the evidence in that when the **Opponent’s Earlier Registered Device Mark** does appear, it *hardly* appears on its own.

40 For completeness, the Application Mark is distinctive as a whole, with the peculiar triangle device as well as the word “Hater” in a specific font right in the middle of the inverted triangle.

Visual Similarity

41 For ease of comparison only, the marks are:

<i>Application Mark</i>	<i>Opponent’s Earlier Registered Marks</i>
	Opponent’s Earlier Registered Device Mark
	
	Opponent’s Earlier Registered GUESS Mark
	

42 The Opponent argued at [25] OWS:

[25] The Application Mark is a composite mark consisting of an inverted triangle device...and the word “Hater”. It is useful to refer to the principles in relation to the visual similarity of composite marks set out by the Court of Appeal in [62] of **Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd** [2013] 2 SLR 941 (“**Hai Tong**”)...
 ...

[40(c)] The overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components.

[40(d)] The textual component of a composite mark or sign *could* (but will not necessarily or always) be the dominant component of the mark or sign. Some instances where this might be the case include where:

- (i) The two marks or signs in question each contain a **similar device**. The overall resemblance between them may then be diminished if they bear words which are entirely different from each other.
- (ii) **The textual component is large, and is in a prominent location** in relation to the other components or stands out from the background of the mark or sign.
- (iii) The textual component is *in itself* already widely known.
- (iv) The composite mark or sign is applied to goods or services marketed or sold primarily through *online* trade channels.

[40(e)] The device component has been found to be an equally significant, if not the dominant, component of a composite mark or sign where:

- (i) the device is significant and large;
- (ii) the accompanying word(s) are devoid of any distinctive character, or are purely descriptive of the device component; or
- (iii) the device component is of a complicated nature.

[40(f)] But usually not where:

- (i) the device is simple and will not evoke any particular concept for the average consumer;
- (ii) the device component does not attract the attention of the average consumer of the goods in question because such a consumer is regularly confronted with similar images in relation to those goods; or
- (iii) the device component is more likely to be perceived as a **decorative** element rather than as an element indicating commercial origin.

[26] As mentioned above, the Application Mark contains an inverted triangle device...Although the Application Mark also contains additional features, namely, the word “Hater”, this feature does not serve to adequately distinguish the

Application Mark from the Opponent’s “” mark for the following reasons:-

- (a) The dominant and distinctive feature of the Application Mark is the inverted triangle device...[which] does not convey any descriptive meaning and has no notional or allusive quality insofar as the Applicant’s goods and services are concerned having regard to the meaning of the inverted triangle device...
- (b) The word “Hater” only serves to reference the Applicant’s goods of hats. The Applicant’s evidence shows that the Applicant’s use of the word “Hater” is an amalgamation of the word “hat” and the suffix “-er” to designate persons who wear hats.
- (c) The device component in the Application Mark is prominently displayed in comparison to the textual component which lacks clarity.

[27] Similar to the case at hand, in *Converse v Southern Rubber Works* [2015]



SGIPOS 11, the adjudicator, in assessing the visual similarity between “



”, held at [34] to [38]:-

[34] The star device which is the **centre** of both competing marks is a lot more **prominent** than the words. Visually, the star is the prominent feature in both competing marks due to the relative size of the star device vis-à-vis the words and **the size of the star in relation to the whole mark**. Thus, I find the star device to be a distinctive component (distinctive in the non-technical sense) in that it is an outstanding and memorable feature in both marks.

...


[36] Broadly speaking, visually, both marks contain a star which is a distinctive component within a concentric circular outline and some words. **The placement of the star in the middle of the circular device is the same in both marks**. The sizes of the stars and their placement relative to the other elements such as the words and relative to the circular outline in both marks are the same. The placement of the words and the star device within the concentric circular outline is the same except that the Opponents’ mark contains the additional words, “Chuck Taylor” across the star device in the Opponents’ mark.


[37] In my view, visually, both marks bear some similarity in that both competing marks consist of **a prominent star device in the centre** within a concentric circular outline; and that both competing marks contain words that are placed in the same places within the concentric circular outline and relative to the prominent star device. **On the prominent feature, the star device itself**, there is also similarity in the two competing marks notwithstanding slight differences in the star device in that the Application Mark contains a two-tone

star.

[38] On the whole, given that **the star device is distinctive** (distinctive in the non- technical sense) in both marks and given that there is similarity between the star devices within similar circular outlines, and the words in both marks are placed in the same locations in the two marks, I conclude that the two marks are visually similar.

[28] It is therefore submitted that the Application Mark is visually similar to the

Opponent's “  ” mark⁶⁴.

[29] The Application Mark and the Opponent's “  ” mark are conceptually similar as both utilise an inverted triangle device...



[30] With regards to visual similarity, we repeat our submissions in paragraphs [25] to 28 above.

[31] With regards to conceptual similarity, we repeat our submission in paragraph 29 above.

[Emphasis in bold mine]

43 It is not in dispute that the principles in *Hai Tong* are applicable. The issue is *how* the principles are applied to the instant case. Applying the principles in *Hai Tong*, “[t]he textual component of [the Application Mark is]...the dominant component of the mark...[as]...[t]he textual component is large, and is in a prominent location in relation to the other components or stands out from the background of the mark or sign” and “the device component is more likely to be perceived as a decorative element rather than as an element indicating commercial origin” ([40(d) and (f)] *Hai Tong*, above).

44 In this regard, I disagree that “[t]he dominant and distinctive feature of the Application Mark is the inverted triangle device” and I simply fail to see how “[t]he device component in the Application Mark is prominently displayed in comparison to the textual component which lacks clarity” ([26(a) and (c)] OWS, above).

45 Further, I also disagree that [t]he word “Hater” only serves to reference the Applicant’s goods of hats” ([26(c)] OWS above). The dictionary meaning of “hater” is “a

⁶⁴ With regards to the *Opponent’s Earlier Registered GUESS Mark*, the Opponent refers to its submissions at [25] – [29] OWS above (see [30] and [31] OWS).

person who has intense dislike for another person”.⁶⁵ Thus, the most that can be said is that it is a play of words which may be allusive of hats, since “hatter” (spelt with 2 “t”s), refers to “a maker or seller of hats”.⁶⁶ Given the centrality and prominence of the placement of “hater”, if there is one component which dominates, it would be the word “hater”, rather than the inverted triangle device.

46 The Opponent relied on *Converse v Southern Rubber Works* [2015] SGIPOS 11 (“*Converse*”) to support its contention that the marks are visually similar ([28] OWS above). On the contrary, I am of the view that *Converse* supports my conclusion that the marks are visually more dissimilar than similar.

47 The IP adjudicator found visual similarity on the basis of the *prominence and centrality of the positioning* of the star device:

- (i) “The star device which is the *centre* of both competing marks is a lot more *prominent* than the words...” ([34] *Converse*, above).
- (ii) “...The *placement* of the star in the *middle* of the circular device is the same in both marks...” ([36] *Converse*, above).
- (iii) “...visually, both marks bear some similarity in that both competing marks consist of a *prominent star device in the centre* within a concentric circular outline...” ([37] *Converse*, above).

48 Similarly, in the instant case, my basis for finding visual dissimilarity between the Application Mark and the *Opponent’s Earlier Registered Marks* is:

- (i) in relation to the *Opponent’s Earlier Registered Device Mark*, the prominence and centrality of the textual component of the Application Mark which is clearly missing in the *Opponent’s Earlier Registered Device Mark*.
- (ii) in relation to the *Opponent’s Earlier Registered GUESS Mark*, the prominence and centrality of the positioning of the differing textual components in the marks.

Conclusion

49 In conclusion, I agree with the Applicant that, taken as wholes, the marks are visually more dissimilar than similar.

Aural Similarity

50 With regard to aural similarity, the Court of Appeal in *Staywell* stated at [31] and [32] that there are two approaches. One approach is to consider the dominant component

⁶⁵ Dictionary.com.

⁶⁶ The goods sought to be registered for the Application Mark includes “hats” (see above).

of the mark (“Dominant Component Approach”) and the other is to undertake a quantitative assessment as to whether the competing marks have more syllables in common than not (“Quantitative Assessment Approach”).

51 In relation to the *Opponent’s Earlier Registered Device Mark* there is no aural component to speak of. On the other hand, the *Opponent’s Earlier Registered GUESS Mark* would be known as a “GUESS” mark, while the Application Mark will be known as the “HATER” mark.

Conclusion

52 In light of the above, the Application Mark is aurally dissimilar in comparison to the *Opponent’s Earlier Registered GUESS Mark*.

Conceptual Similarity

53 The Court of Appeal in *Staywell* expounded at [35] as follows:

[35] ...Unlike the aural analysis, which involves the utterance of the syllables without exploring the composite meaning embodied by the words, the conceptual analysis seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole...*Greater care* is therefore needed in considering what the conceptually dominant component of a composite mark is, because the idea connoted by each component might be very different from the sum of its parts...

[Emphasis in italics mine]

54 As indicated above, any distinctiveness with regard to the *Opponent’s Earlier Registered Device Mark* emanates from the mark as a whole, that is, the inverted triangular device together with the question mark device. On the other hand, when viewed as a whole, the *Opponent’s Earlier Registered GUESS Mark* is distinctive, in particular, having regard to the word “GUESS” prominently and centrally placed right in the middle of the mark.

55 To complete the analysis, the distinctiveness of the Application Mark resides in the mark as a whole, that is, with the peculiar inverted triangle design and a possible play on the word “hater” prominently placed right in the middle of the inverted triangle device in a specific font.

56 Taking all of the above into consideration, I am of the view that the Application Mark is conceptually more dissimilar than similar to the *Opponent’s Registered Earlier Marks* respectively.

Conclusion on the similarity of marks

57 It is to be recalled that:

- (i) The court must ultimately conclude whether the marks, when observed in their totality, are similar rather than dissimilar. In this regard, trade-offs can occur between the three aspects of similarity.
- (ii) The average consumer:
 - (a) has an “imperfect recollection” and there is a need to consider the general impression that will likely be left by the dominant features of the marks.
 - (b) is one who would exercise some care and a measure of good sense in making his or her purchases, not that of an unthinking person in a hurry.

58 I have concluded that the Application Mark is visually and conceptually more dissimilar than similar to the ***Opponent’s Earlier Registered Device Mark***.⁶⁷ In the same vein, the Application Mark is visually, aurally and conceptually more dissimilar than similar to the ***Opponent’s Earlier Registered GUESS Mark***.

59 Having regard to the 3-step test, my conclusion above ends the inquiry with regard to the objection under Section 8(2)(b).

Conclusion on Section 8(2)(b)

60 The ground of opposition under Section 8(2)(b) therefore fails.

Ground of Opposition under Section 8(4)(b)(i)

61 Section 8(4) of the Act reads:

8(4) Subject to subsection (5), where an application for registration of a trade mark is made on or after 1st July 2004, if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark, the later trade mark shall not be registered if —

- (a) the earlier trade mark is well known in Singapore; and
- (b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —





(i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark...

⁶⁷ There is no aural concept as a basis for comparison since the ***Opponent’s Earlier Registered Device Mark*** is a device mark.

Decision on Section 8(4)(b)(i)

Similarity of marks

62 In relation to this ground, the Opponent relies on the following earlier marks:

<i>Application Mark</i>	<i>Opponent’s Earlier Marks</i>
	<p><i>Opponent’s Earlier Registered Device Mark</i></p>
	
	<p><i>Opponent’s Earlier Registered GUESS Mark</i></p>
	
	<p><i>Opponent’s Earlier Unregistered Mark⁶⁸</i></p>
	

63 It would appear that the Opponent is relying on the ***Opponent’s Earlier Unregistered Mark*** as an earlier mark on the basis that it is an *unregistered trade mark that is well known in Singapore*.⁶⁹

64 The definition of an earlier mark is provided in section 2 of the Act:

2.—(1) In this Act, unless the context otherwise requires —

“earlier trade mark” means —

(a) a registered trade mark or an international trade mark (Singapore), the application for registration of which was made earlier than the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks; or

(b) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was a *well known trade mark*,

⁶⁸ See [54] OWS.

⁶⁹ See above.

and includes a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph (a) subject to its being so registered;

“well known trade mark” means —

(a) any registered trade mark that is well known in Singapore; or
(b) any *unregistered trade mark that is well known in Singapore* and that belongs to a person who —

(i) is a national of a Convention country; or
(ii) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country, whether or not that person carries on business, or has any goodwill, in Singapore;

65 Further, Section 2(7), (8) and (9) of the Act are relevant for the concepts of “well known in Singapore” and “well known in Singapore at large”. Section 2(7) of the Act states:

Subject to subsection (8), in deciding, for the purposes of this Act, whether a trade mark is well known in Singapore, it shall be relevant to take into account any matter from which it may be inferred that the trade mark is well known, including such of the following matters as may be relevant:

(a) the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;

(b) the duration, extent and geographical area of —

(i) any use of the trade mark; or
(ii) any promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied;

(c) any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application;

(d) any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory;

(e) any value associated with the trade mark.

Section 2(8) of the Act reads:

Where it is determined that a trade mark is well known to *any relevant sector of the public in Singapore*, the trade mark shall be *deemed* to be well known in Singapore.

Section 2(9) states:

In subsections (7) and (8), “relevant sector of the public in Singapore” includes any of the following:

- (a) all actual consumers and potential consumers in Singapore of the goods or services to which the trade mark is applied;
- (b) all persons in Singapore involved in the distribution of the goods or services to which the trade mark is applied;
- (c) all businesses and companies in Singapore dealing in the goods or services to which the trade mark is applied.

66 These provisions have been the subject of further exposition by the Courts:

- (i) Section 2(7)(a) is arguably the most crucial factor when determining whether a trade mark is well known in Singapore. This because Section 2(8) of the Act *deems* a trade mark to be well known in Singapore where it is determined to be well known to *any* relevant sector of the public in Singapore (see [139] of *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] SGCA 13 (“*Amanresorts*”).
- (ii) Aside from Section 2(7)(a) of the Act, the court is ordinarily free to disregard any or all of the factors listed in Section 2(7) as the case requires and to take additional factors into consideration (*Amanresorts* at [137]).
- (iii) In relation to Section 2(8) of the Act, the Court of Appeal in *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 clarified that:
[101] ...we said in *Amanresorts* that it is “not too difficult” for a trade mark to be regarded as well known in Singapore⁷⁰...

[102] We do not think that this comment in *Amanresorts* was made to lay down a general principle...the context of this comment was the desire to clarify that, in order for a mark to be well known in Singapore, the relevant sector to which a mark must be shown to be well known can be *any* relevant sector of the Singaporean public, and this sector need not be large in size. *Beyond this, it should not be read as suggesting (more generally) that the threshold for a trade mark to be regarded as well known in Singapore is a low one.*

⁷⁰ The Court of Appeal in *Amanresorts* commented that it is *not too difficult* for a trade mark to be regarded as “well known in Singapore” since the trade mark in question need only be recognised or known by “*any* relevant sector of the public in Singapore” which could in certain cases be *miniscule* ([229] *Amanresorts*).



[Emphasis in italics mine]

- (iv) Last but not least, with regard to the ambit of Section 2(9)(a), the inquiry is into the specific goods or services to which the Opponent’s trade mark has been applied ([152] *Amanresorts*).

67 The Opponent made extensive submissions⁷¹ as to how the *Opponent’s Earlier Marks* are “not only well known to the relevant public in Singapore, but also well known to the public at large”.⁷² I do not propose to analyse them in detail. As indicated above, aside from Section 2(7)(a) of the Act, this Tribunal is free to disregard any or all of the factors listed in Section 2(7) as the case requires and to take additional factors into consideration.⁷³ The relevant considerations and evidence have been considered above in relation to the issue of acquired distinctiveness.

68 As alluded to above, I am prepared to accept that there is retail activity in Singapore. In fact, on the basis of the evidence,⁷⁴ I am prepared to hold that the *Opponent’s Earlier Composite GUESS Mark* is well known in Singapore as at the *Relevant Date*.

69 Having regard to the extent of similarity between the *Opponent’s Earlier Composite GUESS Mark* and the *Opponent’s Earlier Registered GUESS Mark*:

<i>Opponent’s Earlier Composite GUESS Mark</i>	<i>Opponent’s Earlier Registered GUESS Mark</i>
	

I am prepared to conclude that the *Opponent’s Earlier Registered GUESS Mark* is well known in Singapore as at the *Relevant Date*.

70 For clarity, in light of the above:

- (i) the *Opponent’s Earlier Registered Device Mark* is *not* well known in Singapore; and
- (ii) the *Opponent’s Earlier Unregistered Mark* does *not* qualify as an earlier mark (as it is *not* well known in Singapore as well) and can be disregarded for the purposes of the objection under section 8(4).⁷⁵

⁷¹ See [57] – [68] OWS.

⁷² See [57] OWS.

⁷³ *Amanresorts* at [137].

⁷⁴ See [36] and [39] of the Opponent’s 2nd TB SD and Exhibits DB-1 to DB-3 of the Opponent’s 1st DB SD, above.

⁷⁵ It would thus not qualify as an earlier mark for the purposes of section 8(2)(b) as well, above.

Similarity of marks

71 In relation to this ground, it is clear that the first element that must be satisfied is that "the whole or essential part of the trade mark must be identical or similar to an earlier mark".

72 This element is essentially the same as the similar element under Section 8(2)(b).⁷⁶ In this regard, I have already found that the Opponent has not satisfied this element in relation to the ***Opponent's Earlier Registered GUESS Mark***⁷⁷ under the section 8(2)(b).

Conclusion on Section 8(4)(b)(i)

73 In light of the above, there is no need for me to consider the other elements of this objection and the ground of opposition under Section 8(4)(b)(i) fails.

Ground of Opposition under Section 8(4)(b)(ii)

74 The relevant provisions of the Act read:

8(4) Subject to subsection (5), where *an application for registration of a trade mark* is made on or after 1st July 2004, if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark, the later trade mark shall not be registered if —

(b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —

(i) if the earlier trade mark is well known to the public at large in Singapore;

(A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or

(B) would take unfair advantage of the distinctive character of the earlier trade mark.

[Emphasis in italics mine]

Decision on Section 8(4)(b)(ii)

75 The critical question is whether the ***Opponent's Earlier Registered GUESS Mark***⁷⁸ is well known to the public at large (in Singapore) as at the ***Relevant Date***.

⁷⁶ See *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 (at [70] and [71]).

⁷⁷ Only the ***Opponent's Earlier Registered GUESS Mark*** is well known in Singapore (above).

⁷⁸ Only the ***Opponent's Earlier Registered GUESS Mark*** is well known in Singapore (above).

Well-known to the public at large

76 It is clear that the relevant provisions and case law which relate to the limb “well known in Singapore” (above) apply. Further, the following are pertinent:

- (i) The test “well known to the public at large in Singapore” has to mean *more than just* “well known in Singapore”. The mark has to necessarily enjoy a much *higher* degree of recognition. It has to be recognised by *most* sectors of the public though not so far as to all sectors of the public (*City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 at [13]).
- (ii) A much more *extensive* level of protection is granted to trade marks which have attained the *coveted* status of being “well known to the public at large in Singapore”. These form *a rare and exclusive class*, and are entitled to protection from use of a trade mark⁷⁹ on dissimilar goods or services even in the absence of a likelihood of confusion (*Amanresorts* at [233]).

[Emphasis in italics mine]

77 The Opponent tendered extensive worldwide net revenue in the range of millions⁸⁰ for an extensive period of 30 years.⁸¹ In particular, the Opponent deposed:

- (i) that the Opponent’s records show that approximately 18% of the Opponent’s full line of women’s apparel that have been offered for sale on its online website at www.guess.com are women’s apparel bearing the ***Opponent’s Earlier Marks***. As a similar range of the Opponent’s products are being sold worldwide, the proportion of women’s apparel bearing the ***Opponent’s Earlier Marks*** that have been sold worldwide is also approximately 18% of the Opponent’s full line of women’s apparel;⁸² and
- (ii) that the Opponent reasonably estimated and believes that:
 - (a) more than 50% of the Opponent’s denim products sold each year in the United States; and
 - (b) more than 40% of the Opponent’s denim products sold each year in Europe

through its retail stores, e-commerce site and to its wholesale accounts contain one of the ***Opponent’s Earlier Marks*** or a variation thereof.⁸³

⁷⁹ Similar.

⁸⁰ In USD; see [17] of the Opponent’s 2nd TB SD above.

⁸¹ See [17] of the Opponent’s 2nd TB SD above.

⁸² See [18] of the Opponent’s 2nd TB SD above.

⁸³ See [19] and [21] of the Opponent’s 2nd TB SD above.

Product lines offered in the United States and Europe are also available worldwide, including in Singapore and therefore the Opponent reasonably believes that 45% of its global denim sales through the above modes of sale,⁸⁴ including its sales in Singapore, feature products bearing the **Opponent's Earlier Marks** or a variation thereof.⁸⁵

78 The above do not assist as:

- (i) The two approximates overlap. Surely, there will be denims intended for women and thus can be categorised as “women’s apparel”. In this regard, there is *nothing* in the evidence to suggest that the two approximates do not overlap. As such, the common interpretation that there is an overlap between the two categories, stands.
- (ii) Even if there is no overlap, there is a need for the extent of sales arising from the *local* market to be determined for each category, that is, women’s apparel and denim respectively.
- (iii) Having regard to “the *coveted* status of being “well known to the public at large in Singapore””⁸⁶ unequivocal evidence must be tendered. *Approximates* simply do not justify the “extensive level of protection”⁸⁷ granted.

79 In any event, to complete the analysis, a comparison of the Opponent’s figures with cases where the element was made out is as follows (for the avoidance of doubt, the table is a guide only):

All figures pertain to activities in Singapore					
S/N		Expenditure on marketing	Exposure via physical sales outlets	Sales figures	Survey, if any
1	"Seiko" ⁸⁸	More than \$4 million <i>each year</i> for 5 years	100 optical shops	\$14 million <i>per annum</i> for 5 years	70% of consumer awareness
2	"Clinique" ⁸⁹	\$3 million <i>each year</i> for 4 years	13 stores and counters	\$10 million <i>per annum</i> for 4 years	

⁸⁴ That is, its retail stores, e-commerce site and to its wholesale accounts.

⁸⁵ See [22] of the Opponent’s 2nd TB SD above.

⁸⁶ See *Amanresorts* at [233], above.

⁸⁷ See *Amanresorts* at [233], above.

⁸⁸ *Seiko Holdings Kabushiki Kaisha (trading as Seiko Holdings Corporation) v Choice Fortune Holdings Limited* [2014] SGIPOS 8

⁸⁹ *Clinique Laboratories, LLC v Clinique Suisse Pte Ltd and another* [2010] 4 SLR 510 (“*Clinique*”).

3	"Nutella" ⁹⁰	NA	94-98% of stores in Singapore that sell food items	2 million units of "Nutella" bread spread sold <i>every year</i>	70% of consumer awareness
4	Intel ⁹¹	US\$600 million per annum for 4 years		US\$1 billion per annum for 7 years	85% of consumer awareness
5	Gucci ⁹²	<p>- “[I]n the region of hundreds of thousands of euros”... “for many years, including in Singapore”⁹³</p> <p>- Exposure via approximately 30 publications.</p> <p>- Exposure via social media (Facebook with 15.9 million likes; Instagram – 17.8 followers; Twitter – 4.97 followers; Youtube – 136,000 subscribers)</p>	<p>- Changi Airport, the Paragon shopping mall in Orchard Road, the Takashimaya department store in Orchard Road and at The Shoppes retail complex in Marina Bay Sands</p>	“[M]ore than tens of millions SGD” for 5 years ⁹⁴	


⁹⁰ *Ferrero SPA v Sarika Connoisseur Cafe Pte Ltd* [2011] SGHC 176

⁹¹ *Intel Corporation v Intelsteer Pte Ltd* [2015] SGIPOS 2

⁹² *Guccio Gucci S.P.A v Guccitech Industries (Private Ltd)* [2018] SGIPOS 1 (“*Guccitech*”).

⁹³ See [14] of *Guccitech*.

⁹⁴ See [13] of *Guccitech*.

6		<i>An average of [redacted] promotional expenditure per annum for a period of 5 years.</i> ⁹⁷	8 stores including, Ngee Ann City, Paragon, ION Orchard, Marina Bay Sands, Vivo City, Bugis Junction and Takashimaya ⁹⁸	<i>An average of [redacted] per annum for 5 years.</i> ¹⁰⁰	NA
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80 From the above table, while it is no mean feat to attain the above figures, they appear to fall short in comparison to the other cases.¹⁰¹

81 As this element has not been made out (in addition to the conclusion that the marks are not similar), there is no need for me to look at the other elements of the objection.

Conclusion on Section 8(4)(b)(ii)

82 The ground of objection under Section 8(4)(b)(ii) therefore fails.

83 However, before I proceed to consider the ground under Section 8(7)(a), two comments with regards to submissions made by the Opponent under the element of “dilution”¹⁰²:

- (i) The fact that a *variant* of the Application Mark “bears uncanny resemblance” to the Opponents’ marks does not assist the Opponent for the purposes of this objection. This is because section 8(4)(b)(ii) only relates to the Application Mark *as sought to be registered*.¹⁰³

⁹⁵ As indicated above.

⁹⁶ Approximately [redacted] at the exchange rate 1.354154 as at the *Relevant Date* accessed from x-rates.com on 17 January 2019.

⁹⁷ See [36] of the Opponent’s 2nd TB SD above. Although the *Relevant Date* is 6 November 2014, the figure for 2014 has been averaged out.

⁹⁸ See [6] and exhibit DB-1 of the Opponent’s 1st DB SD.

⁹⁹ Approximately [redacted] at the exchange rate 1.354154 as at the *Relevant Date* accessed from x-rates.com on 17 January 2019.

¹⁰⁰ See [39] of the Opponent’s 2nd TB SD above. Although the *Relevant Date* is 6 November 2014, the figure for 2014 has been averaged out.

¹⁰¹ The closest example is *Clinique*. It is observed that there was a survey conducted although it pertained to the element “well known in Singapore” ([40] *Clinique*).

¹⁰² At [87] and [88] OWS.

¹⁰³ See as highlighted above.

- (ii) Similarly, the Applicant’s alleged “modus operandi to adopt marks belonging to other entities and to use designs / marks derived from other proprietors”¹⁰⁴ is irrelevant for the purposes of the objection under section 8(4)(b)(ii).

For the avoidance of doubt, in coming to these conclusions, I make no comments as to the Applicant’s conduct

Ground of Opposition under Section 8(7)(a)

84 Section 8(7)(a) of the Act reads:

8(7) 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.

Decision on Section 8(7)(a)

85 In relation to this ground, there are three elements to be established:

- (i) Goodwill;
- (ii) Misrepresentation; and
- (iii) Damage.

86 Some further elaboration as to the law in relation to passing off:

- (i) The Opponent must establish that they have acquired goodwill as at the *relevant date*, that is, the date on which the defendant's conduct complained of started. Applying this principle, it is the ***Relevant Date*** in this instance (***Law of Intellectual Property of Singapore*** at [17.2.5]).
- (ii) Goodwill, in the context of passing off, is concerned with goodwill in the *business as a whole*, and not specifically in its constituent elements. The issue of *whether a mark or get-up is distinctive* of a plaintiff’s products or services is a question best dealt with in the context of the inquiry as to whether the defendant has made a misrepresentation (*Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading* [2016] 4 SLR 86 (“***Singsung***”)). Evidence of sales and income of the business are a “proxy for the attractive force of the business” (***Singsung*** at [58]). The “get up” can include various aspects of the business, *including* a mark (***Law of Intellectual Property of Singapore*** at [17.2.10] – [17.2.11]).
- (iii) Section 8(7)(a) of the Act at the very least requires an opponent to adduce sufficient evidence to establish a *prima facie* case on goodwill,

¹⁰⁴ At [88] OWS.

misrepresentation, and damage (*Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] SGHC 216 at [164]).

87 It is not in dispute that the Opponent has the relevant goodwill.¹⁰⁵

Misrepresentation

88 As alluded to above, in an action in passing off, it is permissible for the Opponent to rely on their *get-up* (which includes the ***Opponent's Earlier Marks***). I have already commented on the Opponent's evidence above. In essence, the bulk of the evidence tendered by the Opponent pertains to the ***Opponent's Earlier Composite GUESS Mark***



89 Taking into account the extent of dissimilarity in the marks, I am of the view that, on a balance of probabilities, there is no likelihood of misrepresentation that the Applicant and the Opponent are one and the same or that they are economically linked.

Damage

90 As I have found that the element of misrepresentation has not been made out, there is no need for me to look into the element of damage.

Conclusion

91 The ground of opposition under Section 8(7)(b) therefore fails.

Conclusion

92 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition fails on all grounds. Accordingly, the Application Mark shall proceed to registration. The Applicant is also entitled to costs to be taxed, if not agreed.

Date of Issue: 20 February 2019

¹⁰⁵ I have concluded above that the ***Opponent's Earlier Registered GUESS Mark*** is well known in Singapore on the basis of the Opponent's retail activity in the local market.