

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

[2022] SGIPOS 15

Trade Mark No. 40201821182U

IN THE MATTER OF A TRADE MARK APPLICATION BY

TATA'S NATURAL ALCHEMY, LLC

... Applicant

AND OPPOSITION THERETO BY

TATA SONS PRIVATE LIMITED

... Opponent

GROUNDS OF DECISION

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Tata Sons Private Limited
v
Tata's Natural Alchemy, LLC

[2022] SGIPOS 15

Trade Mark No. 40201821182U
IP Adjudicator Burton Ong
26 July 2022

26 October 2022

IP Adjudicator Burton Ong :

Introduction

1 The parties to these proceedings are (i) a trade mark registration applicant in the cosmetics, toiletries and skincare business, and (ii) the proprietor of several earlier registered trade marks in various different commercial sectors, as part of a vast multi-national conglomerate, but not encompassing the business activities of the applicant. The latter party has opposed the registration of a trade mark that the former has used for several years, in Singapore and in foreign markets, on the basis that the latter's earlier registered trade marks are "well known in Singapore" and are entitled to protection from conflicting trade mark applications under Sections 8(4) and 8(7)(a) of the Trade Marks Act 1998 ("TMA").

2 In the process of determining whether or not these grounds of opposition ought to be available to the opponent, several interesting and challenging legal issues were encountered along the way. Firstly, there were broader questions relating to how the statutory requirements of Section 8(4) ought to be interpreted and to what extent this provision correlated to Section 8(7)(a). Secondly, there was the practical issue of whether the opponent's evidence was enough to

establish the “well known” status of its trade mark(s) for the purposes of the TMA. Thirdly, there was a dispute between the parties as to whether the competing trade marks were “similar” in the eyes of trade mark Law; this necessitated an analysis of the distinctiveness of the opponent’s trade mark to determine if the other features of the applicant’s trade mark were adequate to differentiate the competing marks despite them sharing a common denominator. This marks-similarity analysis also required a somewhat technical legal issue to be confronted: whether the acquired or factual distinctiveness enjoyed by a well known trade mark ought to be factored into this comparison stage of the legal analysis and, if so, whether and how to take into account the fact that such distinctiveness – through the actual use of the earlier registered trade mark in the opponent-proprietor’s business activities – was achieved in markets for goods and services that were *different* from those claimed by the applicant. Finally, it was necessary to examine the meaning of “damage” under these two grounds of opposition when assessing the opponent’s allegations of harm arising from the registration of the applicant’s mark.

3 This is an opposition to the following trade mark application:

Trade Mark No.	Mark	Class	Specification
40201821182U	 TATA HARPER (“the Application Mark”)	3	Cosmetics, natural organic cosmetics; skin, body and bath creams, lotions, sprays, soaps, powders, gels, oils, cleansers; non-medicated skin care preparations; body and foot scrubs; soaps for personal use; skin moisturizers; eye creams; skin care products, namely, non-medicated skin serums; non-

			medicated exfoliating preparations for skin; non-medicated skin toners; non-medicated balms for use on skin, feet, lips; beauty serums; skin masks; aromatherapy lotions, oils, creams and sprays, namely, non-medicated skin lotions, oils, creams and sprays with essential oils for use in aromatherapy; aromatherapy lotions, oils, creams and sprays, namely, aromatic oils, creams and sprays; cheek colors; lip stains; make-up sets.
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Background facts

4 Tata's Natural Alchemy LLC (the "Applicant") is a privately-owned company, incorporated in the state of Delaware, United States of America, which is in the business of making and selling premium skincare products and cosmetics, including the Class 3 goods identified above (collectively, the "Applicant's Goods"). The Applicant was co-founded by Graciela Harper nee Guzman, who is also known by her nickname – "Tata Harper". The Applicant's Goods are sold under the banner of a composite mark that comprises this nickname as a word element and a graphical device consisting of flowers and botanical elements. Since 2009, the Applicant has used its trade mark in relation to the Applicant's Goods in the United States and, subsequently, in many other countries including Singapore. The Applicant's Goods have been sold in Singapore since at least 2013, with revenue from wholesale sales of such goods

to retailers amounting to USD\$83,038 in 2017 and USD\$239,360 in 2018. The Application Mark has been used in various print and online media publications to advertise the Applicant's Goods since 2014.

5 Tata Sons Private Limited (the "Opponent") is part of an international industrial conglomerate (commonly known as the "TATA Group") headquartered in India, with operations in more than 100 countries across six continents, with a combined revenue in excess of US\$100 billion in 2017-2018. The TATA Group has over 12 companies incorporated in Singapore since 1971. Using details extracted from the Opponent's evidence¹, Table 1 summarises some of the fields of commerce in which the members of the TATA Group have conducted their business activities:

Table 1: TATA Group of Companies in Singapore (selected members)

Name of Company	Year Set Up	Main Activities	Revenue (Financial Year)
Tata International Singapore Pte Ltd	2011	Minerals, Metal, Agro Business trading and distribution, etc.	USD\$1,672,368,751 (2017) USD\$2,055,856,390 (2018)
Tata Capital Pte Ltd	2008	International headquarters of Tata Capital Limited (India)	USD\$14,288,026 (2017) USD\$11,508,344 (2018)

¹ [13] below

Tata Communications International Pte Ltd	2004	Telecommunications	USD\$145,759,383 (2017) USD\$155,272,942 (2018)
Tata Technologies Pte Ltd	1981	Complete Vehicle Programs and Development, Systems Engineering and Design, etc.	USD\$5,376,877 (2017) USD\$6,699,344 (2018)

6 Table 2 sets out some of the Singapore registered trade marks that the members of the TATA Group have used in the course of their respective business activities. Several of the exhibits in the Opponent's evidence include images from different publications and publicity material showing the use of these registered trade marks by various members of the TATA Group.

Table 2: Trade marks registered by the Opponent in Singapore (selection)

1.	 TM No. T9906888Z	<u>Class 9</u> Electrical and electronic equipment and components thereof; computers; computer softwares; all included in Class 9. Application Date: 05/07/1999 Status: Registered
2.		<u>Class 12</u>

	TM No. T0105038C	All kinds of land vehicles and parts thereof; all included in class 12. Application Date: 15/03/1996 Status: Registered
3.	TATA TM No. T1409723E	<u>Classes 1, 4, 5, 6, 7, 8, 9, 11, 12, 14, 16, 35, 36, 37, 38, 39, 42</u> Application Date: 23/06/2014 Status: Registered
<u>Class 1</u> Agricultural acids, agricultural chemicals, except fungicides, herbicides, insecticides and parasiticides, bacterial preparations for use in agriculture, bacteriological preparations for use in agriculture, Calcium peroxide for use in agriculture, Chemical adjuvants for use in agriculture, Chemical preparations for agricultural purposes (other than fungicides, herbicides, insecticides and parasiticides), Chemical products for use in agriculture (other than fungicides, herbicides, insecticides, parasiticides), Chemically treated peat for use in agriculture, Chemicals for use in coating agricultural seeds (other than fungicides, herbicides, insecticides, parasiticides), Chemicals used in agriculture, Gas mixtures for use in agriculture, Gases for use in agriculture, Genes of seeds for agricultural production, Lime for use in agriculture, Manure for agriculture, Plastic alloys for use in agriculture, Protective coatings for agriculture (not fungicides, weedkillers, herbicides, insecticides or parasiticides), Radioactive products for use in agriculture, Rock fibres for use in agriculture, Soot for industrial or agricultural purposes, Substrates for soil-free growing (agriculture), Trace elements for use in agriculture, soda ash, industrial salts, sodium bicarbonate, Fillers derived from white minerals, Filtering materials (mineral substances), Filtering media (mineral substances), Industrial minerals, Mineral acids, Mineral extenders, Mineral fertilizers, Mineral fillers for use in industry, Mineral fillers for use in manufacture, Mineral preparations for		

use as nutritional foodstuffs for plants, Mineral preparations for use in manufacturing, Mineral products for use in growing plants, Mineral sands, Mineral substances for use in filtering, Minerals in powder form for industrial use, Olivine [silicate mineral], Processed minerals, Raw mineral substances, Spinel [oxide mineral], Alkaline metals, Alkaline-earth metals, Earth metals, Metal elements, Metal etchants, Metal exchange resins, Metal oxides, Metal salts, Metallic oxides, Rare earth metals, Salts for coloring (colouring) metal, Salts from rare earth metals, Salts of alkaline metals, Salts of metals, Salts of precious metals for industrial purposes.

Class 4

Mineral coal, Mineral fuel, Mineral oils.

Class 5

Agricultural disinfectants, Fungicides for agricultural use, Herbicides for agricultural crops, Herbicides for agricultural use, Insect repellents for use in agriculture, Insecticides for agricultural use on crops, Organic products for agricultural use in killing insects, Organic products for agricultural use in killing weeds, Organic products for agricultural use in repelling insects, Pesticides for agricultural use, Preparations for use in agricultural cultivation for destroying vermin, Udder creams for agricultural use.

Class 6

Binding thread of metal for agricultural purposes, Building structures of metal for agricultural use, Permanent buildings of metal for agricultural purposes, Structures of metal for agricultural use, Stainless steel reinforcing rods for concrete building works, Steel reinforcement for use in the construction of concrete floors, hot rolled steel sheets, cold rolled steel sheets, galvanized steel wire, high carbon steel wire, barbed wire, stainless steel bars, steel ropes, steel rods, billets, nails, pipes, plates, screws.

Class 7

Agricultural apparatus (other than tractors), Agricultural elevators, Agricultural implements being trailer mounted, Agricultural implements other than hand-operated, Agricultural machine tools, Agricultural machines, Agricultural machines for animal management, Agricultural machines for cultivating, Agricultural machines for fertilizing, Agricultural machines for grass collecting, Agricultural machines for grass cutting, Agricultural machines for ground cultivation, Agricultural machines for harvesting, Agricultural machines for ploughing, Agricultural machines for soil working, Agricultural machines for sowing, Agricultural spraying apparatus (other than hand operated), Agricultural spraying machines, Apparatus for agricultural use (machines), Apparatus for killing weeds by means of heat (agricultural machine), Apparatus for use in agriculture, Atomisers being parts for agricultural crop spraying machines, Cog wheels for agricultural machinery, Couplings for agricultural implements, Cultivators for use in agriculture, Drive pulleys for power transmission belts of agricultural machines, Electric tools for use in agriculture, Elevators for agricultural use, Fluid valves for agricultural use (parts of machines), Hydraulic control apparatus for agricultural machines, Loaders for agricultural machines, Machine tools for agricultural use, Machines for agricultural use, Machines for shredding agricultural waste, Machines for use in agriculture, Mechanically driven agricultural appliances, Mechanically powered apparatus for agriculture, Ploughs being agricultural machines, Pneumatic control apparatus for agricultural machines, Portable steam engines for agricultural (other than transport) use, Power operated tools for use in agriculture, Power transmission belts for agricultural machines, Pumps for use in agriculture (machines), Spray lances being agricultural implements, Spray rollers being agricultural implements, Sprayers (machines) for agricultural use in spraying fungicide, Sprayers (machines) for agricultural use in spraying herbicide, Sprayers (machines) for agricultural use in spraying insecticides, Sprayers (machines) for use in agriculture, Sprayers for use in agriculture (parts of machines), Tilling implements for agricultural use, Towable agricultural machines, Towable spraying apparatus for agricultural use.

Class 8

Agricultural hand implements, Agricultural implements (hand-operated), Agricultural sprayers (hand operated), Agricultural tools (hand operated), Apparatus for agricultural use (hand operated), Hand held (hand operated) apparatus for use in agriculture, Hand tools (hand operated) for use in agriculture, Hand-operated implements for use in agriculture, Pumps for use in agriculture (hand-operated tools), Sprayers (hand-operated tool) for agricultural use in spraying insecticides, Sprayers (hand-operated) for use in agriculture, Sprayers for use in agriculture (hand tool), Tools (hand-operated) for agricultural use.

Class 9

Antennas for wireless communication apparatus, Two-way wireless communication systems, Wireless communication apparatus, Aerials for telecommunications, Apparatus for automatically placing messages via telecommunications equipment, Apparatus for telecommunications engineering, Cable converters for television being telecommunications apparatus, Call barring devices for use with telecommunications apparatus, Call charging apparatus for use with telecommunications apparatus, Cellular telecommunications apparatus, Cellular telecommunications instruments, Computer controlled telecommunications exchange apparatus, Computer programs for the control of telecommunication apparatus, Computer programs for the control of telecommunication instruments, Computer programs for use in telecommunications, Converters being telecommunications apparatus for television signals, Digital telecommunications apparatus, Digital telecommunications instruments, Earth satellites for use in telecommunications, Electric apparatus relating to telecommunications, Electric cables for use with telecommunication apparatus, Electrical instruments for telecommunications purposes, Electronic components for telecommunications, Fibre optic connectors for telecommunications apparatus, Fibre optic telecommunications apparatus, High capacity broadband telecommunications switching apparatus, Insulated telecommunications cables, Memory apparatus for telecommunications network design, Memory apparatus for telecommunications network management, Mobile telecommunications apparatus, Optical fibre telecommunications apparatus, Portable telecommunications apparatus, Programmable telecommunication apparatus, Racks and mountings specifically adapted for use

with audio, visual, computer and telecommunications equipment, Strategic telecommunication apparatus for aircraft, Strategic telecommunication apparatus for land vehicles, Strategic telecommunication apparatus for ships, Telecommunications alarm apparatus, Telecommunications apparatus, Telecommunications apparatus for diagnostic purposes, Telecommunications apparatus for interfacing purposes, Telecommunications apparatus for measuring purposes, Telecommunications apparatus for transferring data to computers, Telecommunications apparatus for transmission purposes, Telecommunications apparatus for transmitting data for use with computers, Telecommunications apparatus for use in cellular radio networks, Telecommunications apparatus for use with analogue signals, Telecommunications apparatus for use with digital signals, Telecommunications cable, Telecommunications circuit board units, Telecommunications devices, Telecommunications digital exchange apparatus, Telecommunications equipment, Telecommunications ground station apparatus, Telecommunications installations, Telecommunications instruments, Telecommunications instruments for use in cellular radio networks, Telecommunications machines., Telecommunications multiplexers, Telecommunications network management installations, Telecommunications networks, Telecommunications security instruments, Telecommunications switchboards, Telecommunications switching apparatus, Telecommunications switching systems, Terminals (connectors) for telecommunication lines, Transmitters (telecommunication), Transmitting apparatus for telecommunications, Transmitting sets (telecommunication), Waveguides (telecommunications components), Computer programs for designing control systems, Computer systems designed for project management, Programs for the design of control information systems.

Class 11

Air conditioning apparatus for agricultural use, Air conditioning installations for agricultural use, Air drying apparatus for agricultural use, Air freezing apparatus for agricultural use, Air freezing installations for agricultural use, Air heating apparatus for agricultural use, Air heating installations for agricultural use, Automatic watering installations for use in agriculture, Irrigation machines

(watering machines for agricultural purposes), Sprinkler installations (automatic) for agricultural purposes, Water filters (installations) for agricultural purposes, Water filters (machines) for agricultural purposes, Watering machines for agricultural purposes

Class 12

Vans; station wagons; multi-utility vehicles, namely, utility terrain vehicles; sports utility vehicles; chassis for motor vehicles; engine for land vehicles; gears for land vehicles; clutches for land vehicles; brakes for vehicles; propeller shafts for land vehicles; axles for motor vehicles; wheels for vehicles; steering and suspension system for land vehicles; windshield glass for land vehicles; bodies for vehicles; chassis frames for motor vehicles.

Class 14

Alarm watches, Anchors (clock and watch-making), Bands for watches, Bracelets and watches combined, Bracelets for watches, Cases (fitted) for watches, Cases adapted to contain watches, Cases for watches (presentation), Cases of precious metals for watches, Chronographs (watches), Clocks and watches, electric, Containers especially adapted for presentation and display of jewellery or watches, Chronometric apparatus, Chronometric instruments, Dials for watches, Dials for horological articles, Digital watches with automatic timers, Divers' watches, Electric watches, Electrically operated movements for watches, electronic watches, Electronically operated movements for watches, Faces for watches, Faces for chronometric instruments, Faces for horological instruments, Hands for watches , Horological apparatus, Horological articles, Horological goods, Horological instruments, Horological instruments having quartz movements, Horological instruments made of gold, Horological products, Jewellery watches, Leather watch straps, Mechanical watches with automatic winding, Mechanical watches with manual winding, Metal expanding watch bracelets, Metal watch bands, Movements for clocks and watches, Non-leather watch straps, Ornaments of precious metals incorporating watches, Pendant watches, Pendants for watch chains, Pocket watches, Presentation boxes for watches, Presentation cases for watches, Quartz watches, Sports watches, Straps for watches, Table watches, Time keeping devices

(chronometric instruments), Time keeping devices (horological instruments), Wall clocks (horological), Watch bands, Watch bracelets, Watch cases, Watch casings, Watch chains, Watch crystals, Watch dials, Watch glasses, Watch movements, Watch springs, Watch straps, Watch straps of leather, Watch straps of nylon, Watch straps of plastic, Watch straps of polyvinyl chloride, Watch straps of synthetic material, Watches, Watches bearing insignia, Watches for nurses, Watches for sporting use, Watches incorporating a memory function, Watches incorporating automatic generating systems, Watches made of gold, Watches made of plated gold, Watches made of precious metals, Watches made of rolled gold, Wrist straps for watches, Wrist watch bands, Wrist watches, Wristlet watches, Quartz movements for watches.

Class 16

Printed matter, stationery, paper, cardboard and goods made from these materials, instructional and teaching material, Discrete input forms for telecommunications purposes, Discrete output forms for use in telecommunications, Newsletters relating to telecommunications matters.

Class 35

Arranging subscriptions to telecommunication services (for others), Business consultancy services relating to the supply of quality management systems, Business consultancy relating to the administration of information technology, Business management and organization consultancy, Business management consultancy, Business management organization consultancy, Commercial management consultancy, Consultancy relating to business document management, Consultancy relating to business management, Consultancy relating to personnel management, Consultancy relating to the management of personnel, Corporate management consultancy, Data management consultancy, Management consultancy in information analysis, Management consultations relating to business, Personnel management

Class 36

Administration of capital investment services, Capital fund investment, Capital fund management, Capital investment, Capital investment advisory services, Capital investment in real estate, Capital investments, Capitalization services, Corporate funds management, Financial fund management, Investment fund management, Investment management of funds, Management of funds, Management of pension funds, Mutual fund management, Pension fund financial management, Pension fund investment management, Pension fund management, Provident fund management, Provision of investment capital, Raising of capital, Valuation of capital stock, Venture capital financing, Venture capital fund management, Venture capital management, Corporate finance consultancy, Corporate finance services, Agency services for securities, Brokerage of securities, Brokerage services for securities., Brokerage services relating to the securities markets, Commodities, gold, mercantile, monetary and security exchanges, Comparison of performance of securities, Financial securities, Lending against securities, Lending against security, Loans against securities, Management of securities., Provision of financial securities, Provision of secured loans, Recording the transfer of securities, Registration of securities, Revolving credit securities, Secured loans, Securing of funds, Securities advisory services, Securities analysis, Securities brokerage, Securities broking, Securities exchange services, securities investment services, Securities management, Securities settlement, Securities trading services, Securities underwriting, Security brokerage, Trading in securities, Valuation of portfolios of securities.

Class 37

Installation and repair of telecommunication apparatus, Installation of telecommunications apparatus, Installing of telecommunications networks, Maintenance and repair of telecommunications apparatus, Information technology (IT) services (computer and computer peripherals installation and maintenance), Removal of marine growths from ship's hulls, Ship building, Ship maintenance, Ship repair, Civil engineering consultancy (construction), Advisory services relating to building construction materials, Advisory services relating to construction, Advisory services relating to property development (building and construction services), Advisory services relating to the construction of buildings, Advisory services relating to the construction of

civil engineering structures, Advisory services relating to the construction of mechanical engineering structures, Beneath ground construction work, Building (construction) supervision, Building and construction of real estate subdivisions and developments, Building and construction services, Building construction, Building construction advisory services, Building construction consultancy, Building construction supervision, Building project management (building construction supervision), Charitable services, namely construction, Civil construction services, Civil engineering (construction), Civil engineering construction, Civil engineering consultancy (construction), Construction, Construction consultation, Construction engineering, Construction information, Construction of buildings, Development of land (construction), Development of property (building and construction services), Electrical engineering services (construction), Hire of construction apparatus, Hire of construction equipment, Hire of construction machinery, Housing construction, Housing development (building and construction services), Landscaping (construction), Maintenance and repair of construction apparatus, Maintenance and repair of construction machines, Mechanical engineering (construction), On-site construction, Project preparation relating to civil engineering (construction), Project preparation relating to construction engineering, Property development (building and construction services), Providing information, including online, about building construction, and repair and installation services, Provision of construction advice, Provision of construction information, Provision of information in relation to building construction, Real estate development (building and construction services), Rental of apparatus for use in the construction of buildings, Rental of building construction machinery, Rental of construction apparatus, Rental of construction equipment, Rental of construction machinery, Rental of cranes (construction equipment), Rental of lifting apparatus (construction equipment), Rental of machinery for use in construction, Road construction, Sign construction, Structural engineering services (construction), Supervision of building construction, Supervision of construction, Supervision of construction projects, Underground civil engineering services (construction), Underground construction, Underwater construction, Underwater construction services, Warehouse construction and repair, Welding (construction, repair and installation services), Advisory services relating to the construction of mechanical engineering structures,

Advisory services relating to the repair of mechanical engineering structures, Installation of electronic apparatus, Installing of electronic communications networks, Maintenance and repair of electronic apparatus, Maintenance and repair of electronic installations, Maintenance of electronic measuring devices, Maintenance of electronic monitoring devices, Maintenance of electronic testing devices, Repair of electronic apparatus, Repair of electronic business equipment.

Class 38

Wireless communication services, Advisory services relating to telecommunications, Cellular telecommunications services, Charitable services, namely telecommunications, Chat room services (telecommunications services), Communication of data by means of telecommunications, Consultancy services relating to telecommunications, Data transmission services over telecommunications networks, Delivery of digital music by telecommunications, Digital network telecommunications services, Electronic bulletin board services (telecommunications services); Fibre optic telecommunications services, Hire of telecommunications apparatus, Hire of telecommunications installations, Hire of telecommunications instruments, Information about telecommunication, Information services relating to telecommunications, Internet cafe services being the provision of telecommunications access to the internet, Message storage and transmission (telecommunications), Operation of telecommunications apparatus, Operation of telecommunications systems, Operation of wide-band telecommunications networks, Optical fibre telecommunications services, Providing information, including online, about telecommunications, Providing of access to telecommunication warehousing services, Providing telecommunication channels for teleshopping services, Providing telecommunications connections to a global computer network, Provision of news [telecommunication services], Provision of telecommunication facilities, Radio telecommunications, Relaying rescue beacon signals (telecommunications), Remote transmission of data by means of telecommunications, Rental of telecommunication apparatus, Rental of telecommunication equipment, Satellite telecommunications services, Switching network services (telecommunications), Telecommunications, Telecommunications advisory services, Telecommunications consultancy,

Telecommunications routing and junction services, Telecommunications security (providing secure connections and access including to computers and the global computer network), Telecommunications services by satellite, Telecommunications services for the distribution of data, Telegraph telecommunications services, Video conference services (telecommunications services).

Class 39

Charter of ships, Chartering of ships, Freight (shipping of goods), Freight shipping , Loading of ships, Piloting of ships, Refloating of ships, Rental of ships, Rescue of ships in distress , Salvage of ships, Salvage of ships cargo, Ship brokerage, Ship chartering , Ship loading services, Ship transport services, Shipping agency services, Shipping of documents, Shipping of goods, Shipping port services (berthing, mooring, cargo and container handling, storage and transportation), Towage of ships, Transport by ship, Unloading and refloating of ships.

Class 42

Design of telecommunications apparatus, Design of telecommunications installations, Development, maintenance and updating of a telecommunication network search engine, Research relating to telecommunication, Information services relating to information technology, Information technology (IT) consultancy, Information technology (IT) services (computer hardware, software and peripherals design and technical consultancy), Providing information on computer technology and programming via a web site, Providing information, including online, about scientific and technological services and research and design relating thereto, Provision of information relating to information technology, Civil engineering (design), Civil engineering design services, Development of vehicles, Design engineering, Engineering, Engineering consultancy, Engineering design, Engineering drawing, Engineering feasibility studies, Engineering project management services, Engineering project studies, Engineering research, Engineering services relating to architecture, Engineering services relating to computer programming, Engineering services relating to computers, Engineering surveying, Engineering

surveys and inspections, Engineering testing, Industrial engineering design services, Mechanical engineering services (design), Operating search engines, Preparation of engineering drawings, Preparation of engineering reports, Providing search engines for the internet, Provision of engineering reports, Provision of search engine services, Research relating to engineering, Search engine feeder services, Structural engineering services (design), Vehicle engine design services, Consultancy in the field of energy-saving, Energy use and conservation consultancy, Engineering consultancy, Environmental consultancy services, Design of electronic systems, Mechanical engineering services (design), Mechanical research.
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7 These three earlier trade marks set out in Table 2 were identified by counsel for the Opponent at the start of the oral hearing as the most likely candidates to qualify as “well known” trade marks under the TMA. In particular, the oral submissions made by counsel for the Opponent focused on the plain word mark – “TATA” (T1409723E) – as the strongest contender for recognition as a “well known” trade mark for the purposes of these opposition proceedings. The remainder of this decision will focus on this “TATA” word mark.

8 In essence, the grounds of opposition to the registration of the Applicant’s trade mark rest on the likely economic harms that the Opponent alleges it will suffer from the Applicant’s registration and subsequent use of its mark.

Procedural history

9 The Applicant applied to register the Application Mark



TATA HARPER under Trade Mark No. 40201821182U on 17 October 2018 in Class 3.

10 The application was accepted and published on 8 February 2019 for opposition purposes. The Opponent filed its notice of opposition to oppose the application on 3 June 2019. The Applicant filed its counter-statement on 9 September 2019.

11 The Opponent filed its evidence in support of the opposition on 21 December 2020. The Applicant filed its evidence in support of the application on 18 August 2021. The Opponent filed its evidence in reply on 15 October 2021. Following the close of evidence, a pre-hearing review was held on 11 November 2021. The Opponent's written submissions ("OWS") were filed on 17 June 2022, while the Applicant's written submissions ("AWS") were filed on 20 June 2022. The matter was set down for an oral hearing on 26 July 2022.

Grounds of opposition

12 The Opponent relies on Section 8(4) and Section 8(7)(a) of the TMA in this opposition. It had earlier pleaded Section 7(6) TMA as well, but confirmed in its letter to the Registrar on 13 April 2022 that it would no longer pursue this ground of opposition.

Opponent's evidence

13 The Opponent's evidence comprises the following:

- (i) a Statutory Declaration made by Kottamasu Venkateswara Rao, Resident Director of the Opponent, on 18 December 2020 in Singapore ("Opponent's SD"); and
- (ii) a Statutory Declaration in Reply made by the same Kottamasu Venkateswara Rao on 15 October 2021 in Singapore.

Applicant's evidence

14 The Applicant's evidence comprises a Statutory Declaration made by Blake Perlman, Executive Vice-President of the Applicant, on 9 August 2021 in Whiting, Vermont, the United States of America ("Applicant's SD").

Applicable law and burden of proof

15 There is no overall onus on the Applicant before the Registrar during examination or in opposition proceedings. The undisputed burden of proof in the present case falls on the Opponent.

Ground of opposition under Section 8(4)

16 Section 8(4) of the TMA reads:

(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;
 - (ii) 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.

Section 2(7) to (9) of the TMA reads:

(7) Subject to subsection (8), in deciding, for the purposes of this Act, whether a trade mark is well known in Singapore, it is 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.

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

(9) 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.

17 There are two separate grounds of opposition to trade mark registration in Section 8(4) TMA which the Opponent has sought to invoke. The first is

found in Section 8(4)(b)(i), which requires use of the Application Mark to “*indicate a connection*” between the Applicant’s Goods and the Opponent and be likely “*to damage the interests*” of the Opponent, who must be the proprietor of an earlier trade mark that is “*well known in Singapore*”. The second is found in Section 8(4)(b)(ii), which requires use of the Application Mark to either “*cause dilution in an unfair manner of the distinctive character of the earlier trade mark*” or “*take unfair advantage of the distinctive character of the earlier trade mark*”, where the Opponent is the proprietor of the earlier trade mark that is “*well known to the public at large in Singapore*”. A significant difference exists between these two grounds of opposition: opposition under Section 8(4)(b)(i) TMA can succeed where the “well known” status of the earlier trade mark is shown on the basis that the mark is “*well known to any relevant sector of the public*” (as provided for in Section 2(8) TMA), whereas opposition under Section 8(4)(b)(ii) TMA requires a substantially higher reputational threshold to be crossed, making it available only to a much more limited class of earlier trade marks that are “well known” across the wider population (i.e. “*the public at large*”) in Singapore. The types of harm that trade marks which are “*well known in Singapore*” are protected against under Section 8(4)(b)(i) TMA are distinct from the additional layers of legal protection also conferred upon trade marks which are “*well known to the public at large in Singapore*” under Section 8(4)(b)(ii) TMA.

18 For the Opponent to successfully invoke Section 8(4)(b)(i) TMA, it must satisfy three elements. Firstly, the Opponent must show that it has a trade mark that is “*well known in Singapore*” where this trade mark is, at a minimum, “*well known to any relevant sector of the public in Singapore*”. My decision on this issue will focus on whether the Opponent’s “TATA” word mark (T1409723E) has acquired this level of recognition and reputational status in Singapore. Secondly, the Opponent must show that the Application Mark is similar to this

well known trade mark. My decision on this issue will focus on comparing the characteristics of the “TATA” word mark (T1409723E) with the Application Mark. Thirdly, the Opponent must show that the use of the Application Mark on the Applicant’s Goods “*would indicate a connection between those goods*” and the Opponent, and that such use is “*likely to damage the interests of the [Opponent]*.” My decision on this issue will address the likelihood of the average consumer in Singapore being confused into making a connection between the Application Mark and the Opponent and believing that the Applicant’s Goods are sold by a trader with economic links to the TATA Group. It will then consider whether any damage is caused to the Opponent because of the restriction on the Opponent’s freedom to expand its existing business operations into the Applicant’s field of commercial activity.

19 Before dealing with these individual elements, it is necessary to introduce the other statutory ground of opposition, Section 8(7)(a) TMA, raised by the Opponent – that use of the Application Mark is liable to be prevented by the common law tort of passing off. This is because counsel for both parties appeared to proceed on the basis that there was close nexus between these two grounds of opposition.

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

20 Section 8(7)(a) TMA reads:

(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...

21 The common law tort of passing off consists of a classical trinity of elements, as set out in *Singsung Pte Ltd v LG 26 Electronics Pte Ltd* [2016] 4

SLR 86 (“**SingSung**”). Firstly, the claimant (in this context, the Opponent) must establish that it has goodwill in its business and trading activities in Singapore. Secondly, the claimant must show that the defendant (in this context, the Applicant) – through use of the Application Mark – is likely to make a misrepresentation as to the source or origin of the Applicant’s Goods that misleads the public into thinking that those goods originated from the claimant or an associated entity. An actionable misrepresentation entails the defendant’s utilization of something (including trade names, logos, product packaging and any other vessel in which goodwill might reside) which is distinctive of the claimant’s goods or services, where such usage gives rise to a likelihood of confusion amongst the public about the origins of the goods or services supplied by the defendant. Thirdly, the claimant must show that it has suffered, or is likely to suffer, damage to its goodwill as a result of the defendant’s misrepresentation.

22 The Singapore Court of Appeal has taken the position that there are close parallels between the elements of the common law tort of passing off and the statutory protection available to proprietors of well known trade marks. In *Sarika Connoisseur Café Pte Ltd v Ferrero SpA* [2012] SGCA 56 (“*Ferrero*”), the Court made the following statements about the relationship between the passing off action and the requirements for establishing trade mark infringement under Section 55(3)(a) TMA (which enables proprietors of well known trade marks to *restrain infringing acts* by those who make use of identical or similar trade marks), a provision that mirrors the contents of Section 8(4)(1)(b)(i) TMA (which enables proprietors of well known trade marks to *oppose the registration* of identical or similar trade marks by applicants):

[76] As regard the “connection” and the “likely to damage the proprietor’s interests” requirements in s 55(3)(a) TMA, the [Trial] Judge adopted the holding by this court in *Amanresorts* ... that the tests for both these elements were “substantively the same”

as the tests relating to the misrepresentation and damage elements under the law of passing off; the only difference is that the tests in passing off concern the proprietor's "goodwill" while the tests under s 55(3)(a) TMA concern the "interests" of the well-known trade mark proprietor. It is an implicit requirement that the requisite "connection" must be a confusing one, viz, a likelihood of confusion must be shown in relation to the connection between the parties' products: *Amanresorts* at [218], [226] and [233]; *Hyundai Mobis (CA)* ([16] *supra*) at [36].

[77] The [Trial] Judge found that there was a confusing connection based on his finding of confusing misrepresentation in the passing off action ... which was in turn based on his finding of a likelihood of confusion under s 27(2)(b) TMA ... Given that the test for the "connection" requirement is similar in substance to the test for the misrepresentation requirement in passing off (the findings of which were in turn based on the findings made in relation to the likelihood of confusion element in s 27(2)(b) TMA), and the distinction between the tests (see [76] above) does not result in any effective difference on the present facts, we find no reason to disagree with the Judge that there is the requisite confusing connection under s 55(3)(a) TMA here.

[78] As regards the element of damage, the [Trial] Judge found that damage was likely to be caused to the Respondent's interests, basing this finding on his finding of damage under the claim in passing off ... He found that the head of damage under the passing off claim was made out because the Respondent's expansion into the drinks business in Singapore would be restricted as a result... The Respondent, while recognising that it had not suffered any loss in terms of sales, (and here we would observe that as the Appellant had in fact used genuine Nutella spread in producing its Nutello beverage, this would no doubt help increase the sales of the Respondent's product), nevertheless argues in support of the Judge's finding that a restriction of its expansion into the Singapore drinks business would constitute damage of its interests. We agree. In so far as this head of damage, viz, restriction on the expansion by the Respondent into the Singapore drinks business is concerned, not only is it a recognised head of damage under passing off, it similarly features as a head of damage under s 55(3)(a) TMA. The only difference, we reiterate, is that under s 55(3)(a) TMA, such damage must be shown to pertain to the interests of the proprietor of the well-known mark: *Amanresorts* at [234]. This head of damage is a recognised one for the purposes of s 55(3)(a) TMA as can be seen in Tan Tee Jim, *Law of Trade Marks and Passing Off in Singapore* (Sweet & Maxwell Asia, 2nd Ed, 2005) at para 6.54: while the foremost and most obvious damage to a proprietor's interests in the mark is that

of pecuniary interests as exemplified by loss of sales and loss of profits, other forms of damage to his interests may include a restriction on the expansion of the use of his well-known mark and an exposure to liability....²

23 Adopting such an interpretation of the statutory protection for well known trade marks which regards these legislative provisions as closely aligned to the common law tort of passing off means that satisfying the elements for Section 8(4)(b)(i) TMA (opposition to the registration of a trade mark because it conflicts with an earlier well known trade mark) would *simultaneously* satisfy the elements for Section 8(7)(a) TMA (opposition to the registration of a trade mark because its use was liable to be prevented by the law of passing off) in cases where the earlier well known mark has been used. I am skeptical of the logic behind drawing such a close nexus between these two branches of the trade mark protection framework. If the scope of the legal protection conferred upon the Opponent via the common law tort of passing off is so similar to the rights conferred upon proprietors of well known trade marks under Sections 55(3)(a) and 8(4)(b)(i) TMA, it seems practically anomalous for most proprietors of well known trade marks³ to seek enforcement of these latter statutory provisions when the same confusion-based protection can already be obtained without having to bear the additional burden of establishing the “well known” status of its trade mark.

24 However, since the parties in both their written and oral submissions have chosen to plead their cases on the basis of a perceived symmetry between these grounds of opposition, I will proceed on the basis that successfully

² Emphasis added.

³ The only proprietors of well known trade marks who would *not* have recourse to the action for passing off, and are only protected by these statutory provisions, are those who have not made use of their trade marks in Singapore and, consequently, have no goodwill that is protectable under this economic tort.

opposing the registration of a trade mark under Section 8(4)(b)(i) TMA requires the Opponent to establish two of the three elements that comprise the tort of passing off, which is also the premise of Section 8(7)(a) TMA – the Opponent must show that (i) there is a likelihood of confusion by the average consumer from the registration of the Application Mark and (ii) there is a “connection” between the allegedly conflicting marks that is “likely to damage the interests of the proprietor” in a manner that amounts to, in substance, the head of damage known as “restriction on expansion” that has been developed in the context of the tort of passing off. My personal views on the difficulties with interpreting Section 8(4)(b)(i) TMA in this way will be discussed in the post-script to this decision.

Analysis of the facts and law

25 I now proceed to analyse the parties’ submissions on the three main issues relating to the key elements of Section 8(4)(b)(i) and 8(7)(a) TMA:

- (I) Whether the “TATA” trade mark is “*well known in Singapore*”
- (II) Whether the Application Mark should be regarded as “*similar*” to the “TATA” trade mark
- (III) Whether use of the Application Mark in relation to the Applicant’s Goods would “*indicate a connection*” with the Opponent and “*damage the interests*” of the Opponent

(I) Whether the “TATA” trade mark is “well known in Singapore”

26 The “well known” status of a trade mark must be evaluated from the perspective of members of the Singapore public and the extent to which they are aware of the trade mark as an indicator of origin for goods and services. Under Section 2(8) TMA, a trade mark is deemed to be “*well known in*

Singapore” so long as it is, at least, “*well known to any relevant sector of the public in Singapore*”, with Section 2(9) TMA explaining that a “*relevant sector of the public*” can include “*all actual consumers and potential consumers in Singapore of the goods or services to which the trade mark is applied*”, “*all persons in Singapore involved in the distribution of the goods or services to which the trade mark is applied*” and “*all businesses and companies in Singapore dealing in the goods or services to which the trade mark is applied*”. It follows that, as a starting point, the most direct evidence that a trade mark proprietor can adduce to establish that its mark is “*well known in Singapore*” would be evidence of *public awareness* or *recognition* of the trade mark. This might include evidence from consumer perception surveys, sales figures for transactions involving goods or services supplied under the trade mark, social media engagement statistics and anything else that demonstrates the breadth of public audience who has been exposed to the trade mark. Apart from such direct evidence from which the public’s *knowledge* of the trade mark can be inferred, other secondary evidence that might support a finding that the mark is “*well known*” could include details of the advertising and marketing efforts of the trade mark proprietor that might indicate a sufficient degree of public *exposure* to the trade mark from which public awareness and recognition of the mark can be inferred. In other words, evidence of *widespread* trade mark *usage* can be relied upon to support an assertion that at least a relevant sector of the Singapore public knows of the trade mark to such an extent that it qualifies as “*well known in Singapore*”.

27 We should not conflate what has been described in the paragraph above with general public awareness of a business’ brand or general reputation. Such awareness may be relevant only to the extent that it is indicative of the public’s familiarity with a particular trade mark *if* that trade mark has been used to facilitate the business’ brand-building or reputation-building efforts. Opposition

to the trade mark application under Section 8(4)(b)(i) TMA is predicated entirely on the Opponent demonstrating that it is the proprietor of a well known *trade mark* (in the sense that Singapore consumers would identify it as a sign which indicates the origin of particular goods or services, regardless of whether it is registered under the TMA or whether it has been used in Singapore) rather than simply requiring the Opponent to have a strong business reputation.

Evidence tendered by the Opponent relating to the “TATA” trade mark

28 The Opponent’s SD contains an abundance of evidence relating to the reputation and activities of the TATA Group, not all of which are equally persuasive in supporting its contention that the “TATA” trade mark is “*well known in Singapore*”. Table 5 summarises some of the different types of evidence relied upon by the Opponent.

Table 5: Evidence relied upon by the Opponent to establish “TATA” as a “well known” trade mark

S/N	Type of Evidence	Opponent’s SD
I	Background facts about the TATA Group’s international business activities in multiple business sectors across the world, including its main website	Pg 2-8 Exhibit A
II	Brand valuation ranking results conducted by international brand consultancy firms	Exhibit B
III	A 2004 speech by the Minister of Education at the launch of TATA Indicom Cable	Exhibit C

IV	A 2006 article recounting the early investments made in Singapore by the TATA Group, including Tata Precision Industries (in 1972) and the (now-defunct) Tata Government Training Centre	Exhibit D
V	Description of business activities of Singapore companies in the TATA Group, with annual turnover figures of selected Singapore corporate entities	Pg 10-15 Exhibits E, F & G
VI	Description of Tata Consultancy Services' (set up in 2001) business and other public activities in Singapore, between 2011 and 2020, including collaborations with the Singapore Management University and other Singapore schools, the People's Association and the Info-Communications Media Development Authority	Exhibit I
VII	Description of Tata Communications Singapore's (set up in 2004) business and other public activities in Singapore, including sponsorships and partnerships with different entities	Pg 23-25 Exhibits J & K
VIII	Description of Voltas Limited's (set up in 2001) engineering activities in Singapore	Exhibit L
IX	Description of Tata International Internship Programme (since 2006) and Tata Crucible Campus	Pg 26-27 Exhibits M & N

	Quiz (since 2007), including participation by students from Singapore's institutes of higher learning	
X	Description of business activities of Vistara airline, operated by a joint venture entity TATA SIA Airlines Limited (since 2015)	Exhibit O
XI	Description of Honorary Citizen Award given by the Singapore government to Mr Ratan N Tata in 2007, chairman of the TATA Group, for "outstanding contribution to the Country's growth and development"; Description of honorary doctorate degree awarded by Singapore Management University to Mr Ratan N Tata in 2014	Exhibits P & Q

29 The overall strategy pursued by the Opponent to show that its "TATA" trade mark is "*well known in Singapore*" was to demonstrate that "*the TATA Group has a significant and illustrious presence in Singapore, outside of India, with over 12 companies being incorporated in Singapore since 1971 featuring use of the TATA name and registered trade mark*" (OWS at [13]), along with the allegation that "*as a result of such long and extensive usage of the Opponent's TATA Marks in Singapore, the said marks have become distinctive of the Opponent's goods and services and none other*" (Opponent's SD at [61]).

30 The Applicant submits that the evidence tendered by the Opponent is not enough to show that the "TATA" trade mark has crossed the legal threshold to be regarded as "*well known in Singapore*". The Applicant is willing to concede that the business activities of the TATA Group have allowed it to acquire "*some goodwill in their business as a whole (and not in its "TATA" or*

“TATA”-formative marks)” but argues that “the Opponent has not clearly established a link between this goodwill and the Opponent’s marks in Singapore” (AWS at [23]-[24]).

31 I see some merit in the criticisms made by the Applicant about the quality and sufficiency of the evidence tendered by the Opponent to establish that “TATA” is a trade mark that qualifies as “*well known in Singapore*”. A significant portion of the evidence tendered by the Opponent relates to the international reputation of the TATA Group without any obvious attempt to show how that reputation is known to, or appreciated by, members of the Singapore public. Moreover, the evidence tendered by the Opponent appears to focus on public recognition of the general branding and reputation associated with the TATA Group and its business units, rather than the level of public recognition associated with specific *trade marks*. The awards, accolades and sponsorships described in the exhibits of the Opponent’s SD do not directly disclose the “*extent of use or promotion of the Opponent’s Marks in Singapore*” (Applicant’s SD at [54]). Apart from the annual turnover figures (S/N V in Table 2) of the TATA Group’s business activities in Singapore, which do not distinguish between revenue generated from local or overseas transactions, the Opponent has not offered any evidence of the size of its market shares in each business sector, the breadth of its customer base or the scale of its usage of the “TATA” trade mark in its business, advertising or other trade-related activities in Singapore. Counsel for the Applicant has also correctly pointed out that none of these turnover figures has been explicitly tied to the usage of any of the Opponent’s specific trade marks in relation to any particular goods or services.

32 On the other hand, even in the absence of the kinds of direct evidence of public awareness or knowledge of the “TATA” trade mark described above, there are several reasons why the Opponent’s evidence – when taken in totality

– may be just enough to support the inference that this trade mark is “*well known in Singapore*”. Firstly, the relevant trade mark is a plain word mark that corresponds exactly to the primary business name of the Opponent’s corporate group, while also featuring clearly in the business names of its constituent entities next to words that are descriptive of their respective trading activities. Therefore, that there are members of the public who are aware of the existence of businesses trading under a business name that includes “TATA” can also be regarded as having knowledge of the “TATA” trade mark.

33 This coincidence between a trader’s business name and its trade mark was what led the Principal Assistant Registrar to conclude in another case, on the issue of whether a trade mark has acquired distinctiveness through the use of the trade mark proprietor’s business or corporate name, that where a “*company has been trading under its corporate name for a material length of time and the overall effect of the manner of use on consumers is that they would regard the business or company name as a badge of origin, it must logically follow that the company or business name would count as trade mark use.*”⁴ To be clear, I am drawing an *inference* that the Singapore customers of the TATA Group have been subjected, over the many years in which they have had business dealings with the members of that business group in Singapore, to a level of exposure to the Opponent’s trade marks that is sufficient to make the “TATA” trade mark “*well known in Singapore*”.

34 Secondly, it is clear from the evidence that the Opponent belongs to a corporate group which has fingers in many pies in Singapore. The members of the TATA Group have a long history operating in Singapore in multiple business or industry sectors – engineering, manufacturing, infrastructure,

⁴ *In the matter of a trade mark application by Floor Xpert Pte Ltd*, [2022] SGIPOS 9 at [30].

services and so forth – and have engaged in many high-profile partnerships with both public sector and private sector entities over a span of decades. The fact that the Singapore government has, on multiple occasions, explicitly recognised the significance of the contributions made by the TATA Group to Singapore's development indicates that the "TATA" trade mark is well known to national trade and industry policymakers who have a direct hand in managing the different market sectors that comprise Singapore's economic landscape. That these economic planners, who wield tremendous influence over all trade-related aspects of economic activity taking place within the country, would recognise the "TATA" trade mark supports an inference that the "TATA" trade mark is at least well known amongst the upper echelons of the business community in Singapore, a "*relevant sector of the public in Singapore*" comprising the leaders of industry titans whose trading operations constitute the major pillars of the Singapore economy.

35 Thirdly, it seems to me that there are at least two approaches towards demonstrating that a trade mark is "*well known in Singapore*" given the statutory language of Section 2(9) TMA. One, more direct, approach would be to consider whether the regular man-on-the-street in Singapore would have some familiarity with the trade mark; if it can be shown that a *majority* of Singapore consumers would recognise the trade mark, then perhaps it should qualify as a "well known" trade mark even if the level of recognition falls short of the "*well known to the public at large*" threshold (which might, arguably, require recognition by all, or close-to-all, of the population). This approach might be suitable, for instance, where the trade mark is applied to fast moving consumer goods or everyday services that cater to the general public. Another, more targeted, approach would be to first carve out a segment of the population that can be reasonably regarded as a "*relevant sector of the public*" and ask if the "average consumer" belonging to *this* class would recognise the trade mark

in question. One might, for instance, define these classes along industry lines or relevant markets in which the trade mark proprietor competes. A highly successful competitor that uses a particular trade mark in one of these markets may well qualify as the proprietor of a mark that is “well known” in that industry or market.

36 While the evidence tendered by the Opponent falls short, in my opinion, of demonstrating the “well known” status of the “TATA” trade mark according to the first approach, I am prepared to accept that it is enough to do the job using the second approach outlined above. Traders and customers from the heavy industry markets in which the TATA Group has been an established market player within Singapore, such as those identified in [5] above, can be regarded as “*relevant sector[s] of the public*” to whom the “TATA” trade mark is well known. In light of the extent of the economic contributions made by the TATA Group to the various industry sectors of the Singapore economy it has operated within over the years, which the Singapore government has celebrated on more than one occasion, I would infer that the “average consumer” in each of these markets (including both corporate entities and individuals) is very likely to recognise the “TATA” trade mark.

Conclusion on status of the “TATA” trade mark

37 Despite the deficiencies of the evidence tendered by the Opponent in this case, I am drawn to the conclusion that the “TATA” trade mark is one that can be regarded as “*well known in Singapore*” on the basis that it is “well known to” a “*relevant sector of the public*”. I draw some support for this conclusion from the observations made by the Court of Appeal in *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 (“*Amanresorts*”) at [229]:

Finally, it will be recalled that it is not too difficult for a trade mark to be regarded as “well known in Singapore” – essentially, the trade mark in question need only be recognised or known by “*any* relevant sector of the public in Singapore” [emphasis added] (see s 2(7)(a) of the current TMA), which sector could in certain cases be miniscule.⁵

38 For completeness, in light of the other ground of opposition that the Opponent has invoked in these proceedings, two other related conclusions I have reached need to be made explicit at this stage. Firstly, the Opponent *does* enjoy the requisite goodwill in the “TATA” word mark to sustain an action in passing off, which is the premise of Section 8(7)(a) TMA, subject to it establishing an operative misrepresentation and damage to its goodwill. Secondly, the evidence furnished by the Opponent does *not* support a finding that the “TATA” word mark is “*well known to the public at large in Singapore*”.

(II) Whether the Application Mark should be regarded as “similar” to the “TATA” trade mark

39 The next stage of the inquiry requires the Application Mark to be compared with the “TATA” trade mark to determine if the former should fall within the scope of the exclusive rights conferred by the TMA on the latter by virtue of their similarity. The comparison to be made, through the eyes of the average consumer with imperfect recollection, is between the Applicant’s composite mark (consisting of a word element and a botanical graphic device) and the Opponent’s plain word mark.

⁵ This observation by the Court of Appeal should be read together with its subsequent elaboration in *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] SGCA 30 at [101]-[102], where it was pointed out that “this comment should not be taken to mean that the hurdle that trade mark owners had to cross was minimal... [and] 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 Singapore public, and this sector need not be large in size. Beyond this, it should not be read as suggesting (more generally) that the threshold of a trade mark to be regarded as well known in Singapore is a low one.”

Application Mark	Opponent's Trade Mark
	

40 The marks-similarity analysis plays a particularly important role in defining the scope of the Opponent's trade mark monopoly in this case because Section 8(4) TMA has been invoked, where it is unnecessary to look at the similarity or dissimilarity between the goods or services of the Opponent and the Applicant (a limitation which must be evaluated in every other situation where the Opponent's trade mark is *not* "well known in Singapore"). The crux of the Opponent's objection, in this context, is that the Application Mark should be denied registration *regardless of* the similarity or dissimilarity between their goods or services *because* the Opponent's interests are harmed by the *similarity* between these marks and how such similarity is likely to influence consumer perceptions of their respective goods or services to which these marks are applied, in light of the well known status of the Opponent's trade mark.

General legal principles applicable to the marks-similarity analysis

41 The general framework for conducting the marks-similarity analysis has been set out by the Court of Appeal in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 ("*Hai Tong*") and *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another and another appeal* [2014] 1 SLR 911 ("*Staywell*").

42 I would summarise the guiding principles for conducting the marks-similarity, as articulated by the Court of Appeal, in the following manner:

(i) **Three signposts.** Assessing the substantive similarity between the marks requires an examination of the extent to which they are visually, aurally and conceptually similar. The law does *not* require *all* three types of similarity to be established before the marks are regarded as similar for the purposes of Section 8(2)(b). Neither is the fact that *one* type of similarity is established sufficient to mandate a finding that the marks must be regarded as substantively similar. Each aspect of similarity merely provides a signpost that may or may not point in the direction of a conclusion on whether the marks, when observed in their totality, are similar or dissimilar. Trade-offs can occur between the three types of similarity, where a tribunal has some latitude to reach an overall conclusion based on one or more types of similarity offsetting the differences between the marks, or vice versa (*Hai Tong* at [40(a)], *Staywell* at [17]-[18]).

(ii) **Marks-similarity as a substantial threshold requirement.** The marks-similarity limb of Section 8(2)(b) should be applied in a sufficiently rigorous manner so that a meaningful conclusion is reached at the end of this stage of the inquiry. In concluding whether the marks are similar or dissimilar, the Singapore courts have rejected the “low threshold test” approach under which this limb is satisfied just because a minimal level of similarity between the marks has been shown (*Staywell* at [17]-[19]).

(iii) **“Mark-for-mark” comparison.** When assessing the similarity between the marks, the comparison must be made “mark for mark”, focusing the inquiry on the features of the mark without taking into

account any external added matter or circumstances (*Hai Tong* at [40(b)], *Staywell* at [20] and [80]).

(iv) **Marks taken as a whole.** When comparing trade marks at the marks-similarity stage of the inquiry, they should be assessed as a whole, based on the overall impression each gives, bearing in mind their respective distinctive and dominant components (*Hai Tong* at [40(b)] and [40(d)], *Staywell* at [26]-[29]). Whether the marks are similar or not is ultimately a matter of impression rather than a conclusion that can be resolved in a quantitative or mechanistic exercise (*Staywell* at [17]).

(v) **Distinctiveness is an integral factor in the marks-similarity inquiry.** The distinctiveness of the particular components of a mark, in both a technical sense (that which gives the mark the ability to perform its source-indicating functions, as opposed to merely describing the goods or services to which the mark is applied, which encompasses both **inherent** distinctiveness or **acquired** distinctiveness) and in a non-technical sense (that which is outstanding and draws the consumer's attention), is a factor *integrated into* the visual, aural and conceptual analysis as to whether the competing marks are similar (*Staywell* at [23]-[25] and [30]). A mark which has greater technical distinctiveness enjoys a "*high threshold before a competing sign will be considered dissimilar to it.*" Distinctiveness may lie in the individual components of the mark, or may arise from the combination of the sum of its parts (*Staywell* at [25]).

(vi) **Attention should be paid to dominant components of the marks.** An element or component of a trade mark which has a high degree of technical distinctiveness can, as a result of such technical distinctiveness, be regarded as the dominant and distinctive element of

the mark in a non-technical sense. (*Staywell* at [28]). When the other components of a complex mark or sign is of negligible significance, it is permissible to make the comparison solely on the basis of any dominant element(s). Competing marks with common dominant components may be regarded as similar if the components which distinguish them are ineffective to obscure the similarity between the marks (*Staywell* at [27], *Hai Tong* at [62(b)]).

(vii) **Average consumer viewpoint.** When assessing marks-similarity, the viewpoint taken should be that of an average consumer who would exercise some care and a measure of good sense when making purchases, and not that of an unthinking person in a hurry. Given that the average consumer has imperfect recollection, the two contesting marks should not be compared side by side and examined in detail for the sake of isolating particular points of difference. Instead, the court should consider the general impression that will be likely left by the essential or dominant features of the marks on the average consumer (*Hai Tong* at [40(c)] and [40(d)], *Staywell* at [23]).

43 Counsel for both parties expended considerable effort in scrutinizing the technical distinctiveness of the “TATA” trade mark, with the Opponent arguing that the word mark should be regarded as having such a high level of technical distinctiveness that the average consumer would regard the word as a dominant component of the Application Mark upon which special focus should be given, leading him or her to regard both marks as similar to each other. On the other hand, the Applicant argued that the “TATA” trade mark has a low level of technical distinctiveness such that the word itself should not be regarded as a dominant component of the Application Mark which, when viewed as a whole

including the botanical graphic device, would *not* be regarded by the average consumer as similar to the Opponent's trade mark.

Technical distinctiveness and the marks-similarity analysis: Acquired distinctiveness and the impact of the senior mark being "well known in Singapore"

44 This case introduces an additional layer of complexity to the marks-similarity analysis because the Opponent's mark may be regarded, if my earlier conclusion is correct, as "*well known in Singapore*". At this juncture, it may be helpful to distinguish between (i) the recognisability amongst a sector of the public, or the public at large, of a trade mark that is "well known" and (ii) the *acquired technical distinctiveness* of a trade mark. These are separate, albeit closely related, concepts. Whether or not a trade mark is "well known" depends on the degree of awareness that the public has of the mark in question. This involves assessing the strength of a trade mark's fame or reputation, in terms of the extent to which the public is familiar with the existence of such a mark, perhaps because they have seen or heard of the mark. Thus, a trade mark that has acquired the status of being "well known" is recognisable to such an extent that it may be regarded as part of the collective consciousness or general knowledge of at least a segment of the consuming public. The focus of the inquiry is from the perspective of consumers from the relevant sectors of the public, or the public at large, with evidence of public *familiarity* with, or *recognition* and awareness of, the mark being most directly relevant.

45 The acquired distinctiveness of a trade mark, in a technical sense, is concerned with the demonstrated ability of the mark – which has been put to use and applied to particular goods or services in the market – to distinguish the offerings of the mark's proprietor from the goods or services of rival traders. Acquired technical distinctiveness extends beyond mere consumer recognition

of the mark or an awareness that the trade mark exists – it also requires an appreciation of the nexus between the mark and the supplier of particular goods or services to which the mark has been applied. Acquired technical distinctiveness can be achieved even with relatively limited factual use of the trade mark. However, the broader the scale of the proprietor's usage of the trade mark on its goods or services, the stronger the ability of the mark to function as a badge of origin that identifies those goods or services as being supplied by a particular trade source. Such conduct by the trade mark proprietor enables the mark to acquire an elevated level of technical distinctiveness that *could also* generate a corresponding degree of public recognition or awareness of the mark that pushes it into the category of “well known” trade marks. In terms of evidence, establishing acquired technical distinctiveness is most directly established from the commercial *usage* of the mark by its proprietor.

46 In the present case, if the opposition to the registration of the Application Mark is premised on the Opponent's mark being “well known”, one might infer that once this threshold criterion is established, the Opponent's mark must have necessarily acquired a relatively high degree of technical distinctiveness after being put to use as a trade mark that identifies the Opponent as the origin of the goods or services to which that mark had been applied. This raises at least two closely related trade mark law questions which the courts in Singapore have yet to definitively resolve.

47 Firstly, whether or not an evaluation of the “technical distinctiveness” of the Opponent's mark and the Application Mark (at the markets-similarity stage of analysis) *should* take into account “external” evidence of *acquired distinctiveness*, particularly where such evidence has *already* been used at an earlier stage to draw inferences that the trade mark enjoys such a level of public recognition that it qualifies as “*well known in Singapore*”. Factoring evidence

of acquired or factual distinctiveness at this stage of the marks-similarity analysis may conflict with the “mark for mark comparison” principle set out above at [42](iii), though such evidence appears to be relevant in light of the “distinctiveness” and “dominant component” principles set out at [42](v) and [42](vi).

48 Secondly, given that a “well known” trade mark may have achieved its status by virtue of being well known *only* to members of *particular* sectors of the public, how should the acquired technical distinctiveness of the mark (that was achieved through the proprietor’s use of the mark in these *particular* markets) be factored (if at all) in the marks-similarity analysis? One needs to bear in mind that the marks-similarity analysis is conducted through the eyes of the “average” consumer in Singapore as a whole, and the question here is whether this “average consumer” should have the same knowledge of the consumer in those particular markets or sectors of the public in which the Opponent’s trade mark is well known, especially in a case (such as the one before us) where the allegedly conflicting mark is to be used on *dissimilar* goods in markets that are *different* from those in which the Opponent has been operating.

Acquired technical distinctiveness of the Opponent’s trade mark

49 On the first question, the Opponent recognises that this is an unsettled issue at the Registry of Trade Marks,⁶ but submits that evidence of acquired technical distinctiveness should be taken into account to support its position that the “TATA” trade mark has a high level of technical distinctiveness. The source

⁶ See *GCIH Trademarks Limited v Hardwood Private Limited* [2021] SGIPOS 6 at [33]-[40] and [103]-[113].

of this uncertainty may be traced back to the following statements made by the Singapore Court of Appeal in **Staywell** at [20]:

...we reiterate that the assessment of marks similarity is mark-for-mark without consideration of any external matter... This means that at the marks similarity stage this even extends to not considering the relative weight and importance of each aspect of similarity having regard to the goods. This does not mean that the court ignores the reality that the relative importance of each aspect of similarity might vary from case to case and will in fact depend on all the circumstances including the nature of the goods and the types of marks... Rather, such considerations are properly reserved for the confusion stage of the inquiry, because that is when the court is called upon to assess the effect of objective similarity between the marks, on the perception of consumers... We think that this is conceptually clearer because it recognises that the issue of *resemblance* between the competing marks is distinct from the question of the *effect* of such resemblance.

50 More specifically, at [36], the Court of Appeal in **Staywell** held that the judge in the High Court had “erred” in taking into account a graphical device, that was not part of the opponent’s trade mark in that case, when evaluating the conceptual similarity between the allegedly conflicting marks, “*as a reinforcement of the concept of royalty*”; this was inconsistent with prior caselaw “*that marks-similarity must be assessed without regard to ‘external added matter or circumstances’ (Hai Tong... at [40(b)])*”.

51 Elsewhere in **Staywell**, the crux of the court’s discussion on “external factors” or “extraneous material” was to explain why such considerations should be excluded from the marks-similarity stage of analysis, while also showing the limited extent to which it was permissible to use them at the likelihood-of-confusion stage of analysis.⁷ As a matter of policy, the court took

⁷ **Staywell** at [86] explains that “if competing marks and goods are found to be sufficiently similar such that, having regard to the characteristics of the likely consumer, the court concludes there would be a likelihood of confusion, then it would not be permissible to have regard to yet

the position that the statutory protection conferred on registered trade marks should not be too easily circumvented by a third party who relies on “*superficial trading choices... [to differentiate] his goods in some way from those of the owner of the incumbent mark*” despite the similarity between the marks and goods to which they are applied; otherwise, the proprietary rights of the trade mark owner would be weakened if he could “*avoid liability by means of an express disclaimer, or by using cheaper materials and selling his goods at a much lower price and saying that because of these steps, there is no likelihood of confusion notwithstanding the high degree of similarity or even of identity having been found at the antecedent stages of inquiry*”.⁸

52 However, those “external factors” which affect how a consumer would be motivated or enabled to exercise care in “*the forming of a judgment over the source of the product*” – such as the price of the item, whether or not it is purchased on impulse, as well as the nature of the typical purchasing process (“*the inherent characteristics and nature of the goods, the marks and how the purchaser is likely to approach the purchasing decision*”)⁹ – were recognised by the Court of Appeal as entirely appropriate issues that *should* be taken into account when determining whether there was a likelihood of confusion arising from the third party’s use of a similar mark on similar goods:

The permissible factors are those which (a) are intrinsic to the very nature of the goods and/or (b) affect the impact that the similarity of marks and goods has on the consumer. The impermissible factors are those differences between the

further extraneous considerations that might have the effect of diminishing the likelihood of confusion. In the same way that confusion stemming from sources other than the similarity of marks and goods is outside the reach of trade mark protection... so too must such factors be irrelevant to displace a finding of likely confusion if the property rights represented in the trade mark are to be meaningfully upheld.”

⁸ *Staywell* at [89]-[90].

⁹ *Staywell* at [94].

competing marks and goods which are created by a trader's differentiating steps. In other words, factors which are not inherent in the goods, but are susceptible to changes that can be made by a trader from time to time, should not be permissible considerations. In particular, we are satisfied that it is unnecessary, unworkable and impermissible for the court to have regard to such issues as pricing differentials, packaging and other superficial marketing choices which could possibly be made by the trader. In contrast, extraneous factors that relate to the purchasing practices and degree of care paid by the consumer when acquiring goods of the sort in question, can be considered and assessed without descending into the details of particular differentiating steps which the trader might choose to take in relation to the goods and services falling within the specification.¹⁰

53 A close reading of the *Staywell* decision *does not* reveal any indication that the Court of Appeal had specifically considered evidence of factual or acquired technical distinctiveness from the prior *use* of allegedly conflicting trade marks as “external matter” or “external material”, *either* in the context of *what was inadmissible* at the antecedent marks-similarity stage of the inquiry *or* in the context of *what could be admissible* at the subsequent likelihood-of-confusion stage of the inquiry. Instead, it appears that what the Court was *really* concerned about was to exclude matters relating to the deliberate attempts made by parties to manipulate the trading conditions surrounding the use of their respective trade marks, in order to reduce the likelihood of confusion amongst consumers by differentiating these marks and to *distance* themselves from each other. The judgment in *Staywell* does not, in my view, appear to convey any in-principle objection towards carrying out the marks-similarity assessment in a way which takes onboard evidence of use of these trade marks in the marketplace that demonstrates their ability to perform the origin-indicating functions of a trade mark and the extent to which this has taken place.

¹⁰ *Staywell* at [95].

54 The Opponent relies on the authority of the following post-**Staywell** High Court decisions which appear to “accept the position that evidence of acquired distinctiveness may be considered at the marks-similarity stage” (OWS at [39]).

(i) In **Monster Energy Company v Glamco Co, Ltd** [2021] 3 SLR 319, [50]–[51], Chan Seng Onn J appeared willing to consider the evidence adduced by the opponent to show usage of its earlier marks as part of the marks-similarity analysis and held that there was insufficient evidence to show that these marks had gained distinctiveness through long-standing or widespread use. The learned Judge then concluded at [52] that the Opponent’s marks did not possess a high level of technical distinctiveness that would have strengthened the scope of protection enjoyed by such marks with “a higher threshold to be crossed before the Application Mark will be considered dissimilar”.

(ii) In **Polo/Lauren Co LP v United States Polo Association** [2016] 2 SLR 667 at [28], Lee Seiu Kin J observed that it was unclear whether **Staywell** “contemplates that earlier trade marks which are already inherently distinctive can become more distinctive through use and that this enhanced distinctiveness can be taken into consideration at the marks-similarity stage”; the learned Judge indicated at [29] that “given this approach was not challenged by either of the parties, [he was] prepared to consider the plaintiff’s argument that the distinctiveness of an earlier trade mark can be enhanced and assessed on a sliding scale” and then proceeded to consider and evaluate the adduced evidence of acquired distinctiveness at [30]–[32].

(iii) In **Han’s (F & B) Pte Ltd v Gusttimo World Pte Ltd** [2015] 2 SLR 825 at [110], George Wei JC (as he then was) noted that “[t]he

Court of Appeal in Polo v Shop In at [23] was amenable to taking into account distinctiveness acquired through use (as well as inherent distinctiveness) in deciding whether the defendant's sign was similar to the mark" and stated that "[t]his makes sense as similarity is examined from the perspective of the average consumer".

55 In my view, these are eminently sensible approaches towards the relevance of acquired technical distinctiveness to the key question of what level of inherent distinctiveness is enjoyed by the Opponent's well known trade mark for the purposes of conducting the marks-similarity analysis. I completely appreciate the policy arguments, which emphasise the importance of structure and certainty in the analytical process, that underlie the "step-by-step" approach towards determining whether or not there is a likelihood of public confusion arising from the degree of similarity between allegedly conflicting marks (and additionally, in the case of ordinary trade marks, because of the degree of similarity between the parties' goods or services). However, a blanket exclusion of all "external" evidence at the marks-similarity analysis stage, which is willfully blind towards all evidence of acquired technical distinctiveness, would result in a highly artificial and unprincipled approach towards this comparison exercise.

56 It should be recalled that the marks-similarity analysis is carried out through the eyes of the average Singapore consumer with imperfect recollection. This "average consumer" is a legal fiction that is supposed to represent the ordinary person in Singapore society, which in itself raises many fundamental questions about the viability of constructing such a character given how diverse we are as a country. It is difficult to distill a single set of common denominators from the inhabitants of a multi-lingual and multi-cultural society, with a significant part of its population consisting of foreign long-term residents

and short-term immigrants, amalgamated together in a densely populated island with diverse physical and socio-economic landscapes. He or she is nevertheless a real person who needs to be fleshed out within the Singapore context. Might it be assumed that this average consumer has general knowledge based on what is taught in mainstream schools, what is available on the shelves of neighbourhood retail outlets, what is reported in local media outlets and advertised on local television channels or, in the digital era of the present, what is trending in cyberspace? Regardless of how the average consumer is constructed, he or she cannot be constructed as a navel-gazing drone devoid of knowledge of the outside world.

57 It is trite law that the marks-similarity analysis should be carried out through the eyes of the average consumer without this legal fiction simply subjecting these allegedly conflicting marks to side-by-side scrutiny. Instead, the average consumer is supposed to view each mark separately, having gazed at each of them for an appropriate length of time, before inquiring whether or not the later mark resembles the earlier mark,¹¹ and whether that resemblance is to such an extent that they can be regarded as identical or similar for the purposes of trade mark law, a substantive legal threshold that needs to be crossed before the proprietor of the latter can invoke the protection of the trade mark statute.

58 Determining whether the later trade mark *resembles* the earlier (senior) trade mark is a matter not just for the eyes of the average consumer; it must also unavoidably engage the mind of the average consumer. The marks-similarity inquiry depends not only on an objective comparison of their features (from visual, aural and conceptual perspectives), but also on the mental impression(s)

¹¹ As emphasised in *Staywell* at [20], reproduced above at [49].

that are etched in the average consumer's consciousness from his encounters with these marks. This is why the marks-similarity inquiry has to involve an assessment of whether there are any "distinctive or dominant" elements in either or both of these marks, since these characteristics are relevant to how the marks will be perceived in the mind of the average consumer. Once it is accepted that an evaluation of the distinctiveness of the senior trade mark (in order to determine the scope of legal protection it should enjoy) lies at the foundations of the marks-similarity assessment carried out by the average consumer, and that this necessitates an inquiry into the *inherent* technical distinctiveness of that mark, is it sensible to draw a sharp conceptual line which *always forbids* the average consumer from considering *any* external evidence of the *acquired* technical distinctiveness of that mark? In other words, should the distinctiveness inquiry that is carried out as part of the marks-similarity analysis be disassembled and compartmentalized to always *only* focus on inherent technical distinctiveness? The very nature of the distinctiveness inquiry through the eyes of the average consumer channels an awareness of real-world facts and real-life human perceptions beyond the elements of the trade mark being scrutinized by itself. What we see, and how we interpret or understand what we have seen, will depend on what we know of the world around us.¹² How else would the average consumer be able to tell whether or not a word used in a trade mark is a common name used by individuals or businesses, or whether it has a descriptive or adjectival meaning in the language(s) that this fictional character is fluent in? Even these facets of inherent technical distinctiveness require some appreciation of the wider socio-cultural context surrounding the average consumer in Singapore.

¹² This is the "contextual" approach I applied in *Monster Energy Company v NBA Properties, Inc.* [2018] SGIPOS 16 at [46].

59 By the same token, if trade mark law acknowledges that *acquired* technical distinctiveness is an inextricable part of the overall evaluation of the distinctiveness of a trade mark, for the purposes of determining the “strength” of that mark and how a high a “threshold” needs to be crossed before a later mark is regarded as dissimilar so as not to fall within the scope of the Opponent’s trade mark monopoly, then it seems sensible that evidence of actual use by that proprietor has made of the trade mark should at least be *potentially* relevant towards the assessment of its level of technical distinctiveness. The level of acquired or factual distinctiveness that a trade mark is imbued with can and should have a significant impact on how it is perceived by the average consumer, especially if that level of acquired distinctiveness has also generated a sufficient level of public recognition for the trade mark to be regarded as “*well known in Singapore*”. The stronger (i.e. more technically distinctive) the Opponent’s mark is as a result of the level of public exposure it has been given, the deeper the impression of that mark that will be left in the mind of the average consumer, and the more likely that the average consumer would regard it as a dominant component; and when the Opponent’s mark is incorporated along with other elements in a later composite mark, the more likely that the average consumer should regard the latter as “similar” to the former for trade mark law purposes.

60 On the other hand, the Applicant has, quite appropriately, urged me to be cautious on this issue because it has specific implications for the case at hand, where the Application Mark is alleged to enjoy a level of acquired technical distinctiveness of its own and the Opponent’s trade mark has not acquired its technical distinctiveness from the same field of commerce as the Application Mark (i.e. Class 3 goods relating to skincare products and cosmetics); instead, the Opponent’s trade mark has earned its status of a “well known” trade mark

from being used in relation to goods and services which are dissimilar and unconnected to the Applicant's Goods.

61 This leads us to the legal question of *whether* and *when*, if the Opponent's trade mark is "well known" to a particular "*relevant sector of the public in Singapore*" that is *different* from the sector of the public who are consumers of the Applicant's Goods, the marks-similarity analysis that is conducted from the perspective of the average consumer in Singapore *should take into account* the acquired technical distinctiveness of the "well known" trade mark. Put another way, is the acquired technical distinctiveness associated with the Opponent's trade mark, which arises from its usage in, and recognition by, a *particular sector of the public* in relation to *particular goods or services* that allows it to qualify as "*well known in Singapore*", relevant when looking at the components of the Application Mark and assessing its similarity to the Opponent's trade mark, when each mark has been used in relation to entirely different types of goods or services?¹³

Opponent's trade mark is "well known in Singapore", but has acquired distinctiveness from use in a different field of commerce from the goods or services to which the Application Mark is applied

62 The facts of the present case fall squarely within the parameters described in the preceding paragraph. How much, if any, weight, should be given to the acquired technical distinctiveness of the "TATA" word mark, when assessing its similarity to the Application Mark (a composite mark which shares a common denominator with the Opponent's trade mark), given that the "TATA" word mark is "well known" in markets for goods and services that are different from the Applicant's Goods?

¹³ See *Twitter Inc v VV Technology Pte Ltd* [2022] SGIPOS 4 at [61]-[62].

63 Counsel for the Opponent argues that even if the Opponent's trade mark has not been used (and does not enjoy acquired technical distinctiveness from such use) in respect of goods that are in the same field of trading activity as the Applicant, the acquired technical distinctiveness that the Opponent's "well known" trade mark has garnered through use of that mark in other markets should still be relevant to the marks-similarity analysis in this case because the average consumer is a member of the general public, looking at the Application Mark which has been used in relation to general Class 3 consumer goods, which would also encompass that segment of the public that is familiar with the Opponent's marks. He referred to a hypothetical situation involving the "IKEA" trade mark, which has acquired technical distinctiveness from its use in the field of furniture, and the use of this word as part of an Application Mark that will be applied to cosmetics. In this scenario, he argues, average consumers of cosmetics products would recognise "IKEA" as a distinctive mark in the context of furniture and this consumer perception of its distinctiveness should remain even if the word is used in the context of cosmetics products.

64 This analogy which the Opponent has drawn is illustrative but not, in my view, ultimately helpful to the Opponent in the present case. The persistence of a trade mark's acquired technical distinctiveness *outside the field of commerce where that mark has been used* certainly occurs where that trade mark has achieved the status of a mark that is "well known to the public at large in Singapore", a high level of recognition amongst the general public which has not been demonstrated as far as the Opponent's trade mark is concerned. Where such a wide degree of general public awareness and recognition of the Opponent's trade mark is present, then it is clearly appropriate to imbue the "average consumer" with this knowledge (i.e. the acquired technical distinctiveness of the Opponent's mark) such that it operates in the background when he or she is engaged in a marks-similarity analysis between the

Application Mark and the Opponent's trade mark. However, where a "well known" trade mark falls short of this extremely elevated threshold of fame, and if the "well known" status of the trade mark was achieved simply on the basis that the mark was highly recognisable amongst members of a particular "*relevant sector of the public*", then there is no reason to assume that the knowledge of persons in this "relevant sector of the public" (or the acquired technical distinctiveness enjoyed by the trade mark from its use amongst such persons) should be transposed to the "average consumer" in Singapore. In other words, there is no automatic coincidence between the imputed knowledge of members of the class of persons who make up the "*relevant sector of the public*" and the "average consumer" who is expected to determine if the allegedly conflicting marks are similar or not.

65 In this case, the fields of commerce in Singapore which the Opponent conducts its trading activities – such as metals, chemicals, engineering, infrastructure and consultancy services – are all very specialized fields of commerce and the Opponent has not specifically defined the size or scope of any particular "*relevant sector of the public*" in which the "TATA" trade mark is well known. While the members of one or more of these sectors of the public *could* include consumers of Class 3 goods which include the Applicant's Goods, it does not follow that the average consumer in the general public viewing the Application Mark on the Applicant's Goods *ought* to have the *same* knowledge of those members of the "relevant sector of the public" to whom the Opponent's trade mark is well known. Put another way, while *some* consumers of the Applicant's Goods or Class 3 goods may have knowledge of the Opponent's trade mark, there is no basis for extrapolating this knowledge into the legal fiction of the "average consumer" of the Applicant's Goods.

66 Instead, the presumed knowledge and perspective of the “average consumer” should be constructed using the following first principles. Firstly, given that the focus of the task performed by the “average consumer” at the marks-similarity stage of the analysis is to determine if *the Application Mark* is similar to the Opponent’s trade mark, the starting point for constructing the “average consumer” should have regard to *those particular goods or services claimed under the Application Mark* or to which the Application Mark has been applied. In this particular context, rather than being an abstract random member of the Singapore public, the “average consumer” should be identified as someone who is *a customer from the market* for the goods or services in which the proprietor of the Application Mark competes (‘the relevant market’). Secondly, this *average consumer in the relevant market* should be imputed with the *common general knowledge of real-world customers in the relevant market*. These are the members of the public who have been, or are likely to be, exposed to the Application Mark. This means that the “average consumer” should have some awareness of the existence of reputable brands, and the trade marks under which they are marketed, that real-life customers in the relevant market would recognise. Thirdly, this “average consumer” – as an avatar of the national trade mark system – should *also* have the *common general knowledge that is possessed by the general population across Singapore*, including an awareness of all marks that enjoy such strong reputations that they are “*well known to the public at large in Singapore*”.

67 In my view, any acquired technical distinctiveness of the Opponent’s trade mark (from which that mark has become “*well known in Singapore*”) should only factor into the marks-similarity analysis when the *average consumer in the relevant market* ought to be aware of the Opponent’s trade mark – either as part of the common general knowledge of real-life customers in the relevant market or the general population across Singapore. The marks-

similarity analysis should thus require the features of the Application Mark (including any elements that are alleged to constitute a common denominator with the Opponent's trade mark) to be viewed through the eyes of the *average consumer in the relevant market*, taking into account any acquired technical distinctiveness of the Opponent's earlier mark only where (i) the Opponent's earlier trade mark has achieved this acquired distinctiveness in the same, or sufficiently proximate, field of commerce as the relevant market in which the Application Mark has been or is likely to be used, such that it would be reasonable to infer that real-life customers in this market would have some pre-existing familiarity with the Opponent's earlier mark; or (ii) the Opponent's earlier mark has achieved such a level of widespread recognition amongst the Singapore public such that it qualifies as "*well known to the public at large*", making it entirely appropriate to impute this into the common general knowledge of the "average consumer" in Singapore. Where the Opponent's earlier mark and the Applicant's Mark have been applied to *dissimilar* goods or services, meaning that the sector of the public or market in which the Opponent's earlier trade mark is "well known" is *different* from the sector or market in which the Application Mark has been or is likely to be used, and in the absence of any basis for presuming that real-life customers from the latter group ought to share the same level of trade mark recognition as their counterparts from the former group, the acquired technical distinctiveness of the Opponent's earlier trade mark should *not* be relevant to the marks-similarity analysis carried out by the *average consumer in the relevant market* if this earlier trade mark was not "*well known to the public at large*".

68 What is sauce for the goose is sauce for the gander. Any acquired technical distinctiveness enjoyed by the Application Mark should likewise only be considered in the marks-similarity analysis when either criterion referred to above is satisfied.

Distinctiveness of the “TATA” word mark

69 The Opponent made various submissions as to why the word “TATA” – which appears in many forms in its various registered trade marks – should be regarded as technically distinctive, both in terms of its inherent distinctiveness as well as its acquired or factual distinctiveness. This relates to the trade mark’s ability to perform its source-indicating functions as a badge of origin, as opposed to simply describing the type or nature of the goods or services to which the mark has been applied. These arguments about the technical distinctiveness of “TATA” are also intended to bolster the Opponent’s position that the word also possesses a degree of non-technical distinctiveness that it should be regarded as an outstanding element – making it a “dominant” component – of the Application Mark for the purposes of the marks-similarity analysis. The nexus between these two facets of distinctiveness and dominance in the marks-similarity comparison exercise that the “average consumer” must make between the Opponent’s “TATA” word mark and the Application Mark has already been explained above at [42](v) and (vi). The Opponent submits that the “TATA” word mark *“in light of the high level of technical distinctiveness, will enjoy a high threshold before a competing sign will be considered dissimilar to it”* (OWS at [59]).

70 Having found that the Opponent’s “TATA” word mark is “*well known in Singapore*” – in the limited sense that it is only well known to very specific sectors of the public in Singapore but not “*well known to the public at large in Singapore*” – it follows that the “TATA” has a significant degree of acquired technical distinctiveness in those sectors; however, as I have tried to explain in [62]-[65] above, because those sectors (e.g. chemicals, engineering, infrastructure and consultancy services) are *different* from the relevant market in which the Application Mark has been or is likely to be used (i.e. Class 3 goods

relating to skincare and cosmetics), this acquired technical distinctiveness of the Opponent's word mark should *not* be taken into account by the average consumer of Class 3 products (who would be exposed to the Application Mark) for the purposes of the marks-similarity analysis. As such, in this case, it is only appropriate for me to assess the distinctiveness of the Opponent's "TATA" word mark in terms of its *inherent* technical distinctiveness.

71 The Opponent submits that the word "TATA" enjoys a high level of inherent technical distinctiveness because it has "*no obvious or immediate descriptive nexus to the claimed goods and services*" of the different businesses in the TATA Group which use this word as part of their respective trade marks. It also submits that the word "TATA" is a distinctive prefix to identify the Opponent's goods and services when it is used in conjunction with descriptive words like "Nano" or "Tea" in some of its registered trade marks.

72 Neither of these arguments appear particularly persuasive to me. Just because a word is non-descriptive of the goods or services of the trade mark proprietor does not automatically mean that it must have a high level of inherent technical distinctiveness. Other relevant factors to be taken into consideration include the simplicity of the word, whether or not it is entirely made up or if it has any meaning in the real world, as well as the surrounding commercial context in which the word is used. Furthermore, just because a word is *relatively* less descriptive than other words which have been paired with it does not automatically make the word "distinctive".

73 Both the Opponent and the Applicant appear to agree that the word "Tata" may be viewed by the average consumer as having different possible meanings, including the possibility that it may be construed as a name or surname, or perhaps an acronym. Both parties also acknowledge that the

“TATA” word mark is derived from the surname of the past chairmen of the Opponent’s TATA Group.

74 During the oral hearing, however, the Opponent argued that “Tata” was an “exceedingly uncommon” name in the Singapore context and both parties agreed that there was no evidence that any of local business used the word as part of its trading name, unlike a situation where a commonly used personal name was regarded as having “low distinctiveness” because “it was used as the trading name of a number of live businesses in Singapore”.¹⁴

75 In contrast, the Applicant submitted that “Tata” should be regarded as having a low level of distinctiveness because it has been used by third parties in diverse contexts. These include the use of the word as a name or nickname of world leaders (such as former South African President Nelson Mandela and Chilean dictator Augusto Pinochet), a Thai singer (Tata Young), the names of various geographical locations (such as the Tata Islands off the coast of New Zealand or the Tata province in Morocco) and as a word with varied meanings in different languages (such as Malay, Bengali and Spanish). The Applicant also pointed to a “Slang Dictionary” published in 2009 which defined “tata” as an “affectionate and respectful title for an old man” in many African languages, and “ta-ta” as an English language phrase meaning “to say goodbye”. In addition, the Applicant cited a Malay-English dictionary that defined “tata” as meaning “arrangement, order, system, regulation” in the Malay language, while a Spanish-English dictionary defined “tata” as the Spanish equivalent of “dad” or “daddy” (AWS at [53]). The Opponent pushed back against these different associations with the word as factors that diminish the distinctiveness of the

¹⁴ See *TMRG Pte Ltd v Caerus Holding Pte Ltd* [2021] SGHC 163 at [37], where the name “Luke” appeared in the registered trading names of more than 20 business entities in Singapore and featured in a number of different registered trade marks owned by different proprietors.

“TATA” word mark by arguing that they were too obscure and unlikely to be within the contemplation of average Singapore consumer or that the foreign language translations were not found in sufficiently reputable dictionaries.

76 I do not think it is productive or necessary to determine exactly what “Tata” might mean to, or the different meanings and connotations it might have in the minds of, the average consumer in Singapore. That would require some degree of speculation as to this legal construct’s awareness of international politics and interest in celebrities in the entertainment industry, or how well-travelled or fluent in non-English languages he or she might be. We are concerned with a short word that is not part of the formal vocabulary of the English language; how it is understood depends entirely on the context in which it is encountered. To the extent that the word “Tata” is not an invented word and has different possible meanings in different contexts, it is unlikely to possess any substantial degree of inherent distinctiveness.¹⁵

77 From a policy perspective, a sensible approach towards assessing the level of inherent distinctiveness of words that have potentially one or more actual meaning(s) in the real world would be to consider whether honest traders would have any legitimate reasons for wanting to use these words on their own goods or services. That is the essence of the trade mark policy of hostility towards a finding of inherent distinctiveness when highly descriptive or laudatory terms are incorporated into a trade mark. This policy is also similarly reflected in the context of surnames and geographical names, as articulated by George Wei JC (as he then was) in *Han’s (F&B) Pte Ltd v Gusttimo World Pte Ltd* [2015] SGHC 39, [84]:

¹⁵ See *Monster Energy Company v Glamco Co.* [2018] SGHC 238 at [48]-[49].

The concern over registration of surnames involves a broad question of policy: what is the role of trade mark law and to what extent is there a risk that the trader who registers first gains an unfair advantage? This is not a policy concern that can be easily addressed in the courts...

78 In that case, where the senior mark comprised a “relatively common surname”, the perspicacious judge reasoned, at [90], that “[i]f [he was] right in thinking that one guide in assessing distinctiveness is the question of whether the sign is one which other honest traders may wish to use on goods and services, the consequence is that the level of inherent distinctiveness falls towards the lower end of the spectrum”.

79 This same policy impulse should, in my view, apply equally to the word mark in the present case, which comprises a short four-letter word that has a relatively broad range of possible meanings (including that of a name or nickname) to honest traders in different fields of commerce; recognizing that other traders may have their own legitimate reasons for wanting to incorporate this word into their respective trade marks leads me to the conclusion that the “TATA” word mark should be regarded as having an average level of inherent technical distinctiveness such that its proprietor cannot seek to rely on this word, alone, to erect a broad zone of exclusivity which repels other traders from making use of it in the course of the latter’s trading activities.

Distinctiveness and dominance of “TATA” in the Application Mark

80 Turning to the Application Mark, the Opponent submits that the textual component of the Application Mark (particularly the word “TATA” in “TATA HARPER”) is distinctive and should therefore be regarded as a *dominant* component in the eyes of the average consumer when making comparisons with the Opponent’s earlier trade mark. In my view, a component within a composite mark should be regarded as dominant when it possesses a sufficiently high

degree of technical or non-technical distinctiveness – or perhaps a combination of both – such that the average consumer would pay more attention to this component over other devices that surround it.

81 Firstly, the Opponent argues that the graphic component of the Application Mark is subordinate to the textual components because the image of flowers and botanical elements (the ‘botanical device’) is descriptive of the natural ingredients used to make the Applicant’s goods. In addition, the Opponent relied on the Singapore Court of Appeal’s decision in *Hai Tong* (at [66]-[67]), where it was observed that “*flower devices were common to the cosmetics trade*” and that such “decorative” devices in a composite mark should be viewed as “*not distinctive or significant*” or of “*relative insignificance*”; this led the court to conclude that the textual component of the composite mark in that case was dominant.

82 I am unpersuaded by these arguments because the botanical device found in the Application Mark has a much greater visual significance to the composite mark as a whole, in contrast to the flower device found in the composite mark in the *Hai Tong* case. The botanical device found in the Application Mark is a relatively detailed and intricate symmetrical composition of flowers and leaves, occupying a central position in the composite mark. In contrast, the floral device in *Hai Tong* is a simple drawing of a flower that is juxtaposed next to a textual component with an eye-catching font. These composite trade marks are reproduced in Table 6 below.

Table 6: Graphic components of the composite marks in the present case and in *Hai Tong*

The Application Mark (with botanical device)	The Composite Mark in <i>Hai Tong</i> (with floral device)
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83 Secondly, the Opponent submits that within the textual component of the Applicant's composite mark, the word "Tata" should stand out, as a distinctive and dominant element, to the average consumer since, as *"read from left to right, the word 'TATA' would occupy the attention of an average consumer ... [because] the 'HARPER' word is placed in a subsidiary location"* (OWS at [29]). More significantly, the Opponent argues that the average consumer would place emphasis on the first word because of the well known status of the "TATA" word mark in Singapore. These submissions are, however, premised on the assumption that the well known status and acquired inherent distinctiveness of the "TATA" trade mark should be factored into the marks-similarity analysis; but as I have already taken the view that the well known status and *acquired* technical distinctiveness of this trade mark should *not* be taken into consideration in this case when analyzing the similarity of the marks from the perspective of the average consumer of Class 3 products, I cannot agree that any special attention ought to be given to the "Tata" word component of the Application Mark. Furthermore, given my conclusion above at [79], that the word "Tata" only has an average level of *inherent* technical distinctiveness, and in the absence of any evidence of non-technical distinctiveness associated with this component, I cannot agree with the Opponent's assertion that this word should be regarded as the dominant component of the Application Mark.

Visual similarity between marks

84 When comparing the Opponent's "TATA" word mark against the Application Mark for visual similarity, it is worth reiterating the general principle articulated by the Singapore Court of Appeal, discussed above at [42] (iv), which requires trade marks to be assessed as a whole when carrying out the marks-similarity assessment exercise. Furthermore, I would agree with the Applicant's submission that as far as the textual component of the Application Mark is concerned, "TATA HARPER" should be viewed in its entirety, as the name of the founder of the business, without any particular emphasis placed on the word "TATA".

85 As a starting point, it is clear that both the Opponent's trade mark and the Application Mark share a common denominator – the word "TATA". That alone is certainly *not* enough to establish that these marks are visually "similar" for trade marks law purposes in the context of opposition proceedings under Section 8(4)(b)(i) TMA. In ***Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd*** [2017] SGCA 30 ("***Ceramiche***") at [32], the Singapore Court of Appeal endorsed the approach taken by Lai Kew Chai J in ***The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd*** [2005] 4 SLR(R) 816 at [26]:

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.

86 In ***Ceramiche***, the Court of Appeal reversed the decision of the lower court and held that the respondent's "CAESARSTONE" mark was visually similar to the appellant's "CAESAR" mark for two reasons. Firstly, the Court of Appeal found that the graphic device which the respondent had integrated into its "CAESARSTONE" mark was "*a somewhat insignificant component*" of the mark given its relatively small size and prominence, as well as the

simplicity of its design. Secondly, at [41]-[42] of the judgment, the Court of Appeal found that the inclusion of the word “stone” in the respondent’s mark did not “[serve] to sufficiently and substantially distinguish the respondent’s CAESARSTONE mark from the appellant’s CAESAR mark... because the word “stone” is merely descriptive of the goods” to which the mark had been applied.

87 Looking at the visually perceptible components of the Application Mark, this trade mark differs from the Opponent’s “TATA” word mark in two obvious ways. Firstly, it includes an additional word “Harper” immediately after “Tata”. Secondly it includes a botanical device that occupies a visual space at least equal to, if not greater than, the textual component of the same mark.

88 The Opponent argues that the Application Mark “is unable to distinguish itself from any of the Opponent’s Earlier Marks as it adopts the Distinctive Features of the Opponent’s Mark by incorporating the “TATA” word as a dominant prefix” and that these other components are “negligible” (OWS at [61]). In other words, the crux of the Opponent’s submission is that “the ‘TATA’ component... will be the dominant and distinctive component in the Application Mark as compared to ‘HARPER’ ... [because of] the technical distinctiveness [of] the ‘TATA’ component... [and] [i]n terms of non-technical distinctiveness, the [appearance of] ... the ‘TATA’ textual component as the first word... will be accorded central prominence by the average consumer as the more outstanding and memorable component”. According to the Opponent, “the overall impression conveyed by the competing marks to the average consumer with imperfect recollection would be dominated by the term ‘TATA’ ... [such that] there would be a good degree of visual similarity” (OWS at [62]-[63]).

89 On the other hand, the Applicant submits that the Application Mark is visually dissimilar to the Opponent's trade marks because of the "visual space" occupied by the word "Harper" and the botanical device, which "resembles a crown of flowers with intricately designed and arranged foliage and floral elements" that is "*large, visually prominent and equally significant, if not dominant, vis-à-vis the textual elements of the Application Mark*" (AWS at [68]-[69]). The Applicant also referred me to precedents in which the assessment of visual similarity between marks emphasised the importance of viewing composite marks "*as a whole... [when] the device element contributes to the overall visual impression to a material degree*"¹⁶ and that, when "[e]ach element occupies weight in the whole... [one] cannot simply focus on any one element to the exclusion of the others."¹⁷

90 Given my earlier conclusions – that the word "Tata" enjoys an average level of *inherent* technical distinctiveness (at [79]), and that any *acquired* technical distinctiveness enjoyed by the "TATA" word mark should not be considered as part of marks-similarity stage of analysis in this case because the parties have applied their respective trade marks to dissimilar goods and services (at [67]) and that this word would not be regarded by the average consumer as a dominant component of the Application Mark (at [83]) – I have to agree with the Applicant that these competing trade marks are more dissimilar than similar. In my view, the overall visual impression of the Application Mark, when viewed by the average consumer of Class 3 products to which that trade mark is applied, is that of a composite mark whose differences from the "TATA" word mark are indeed sufficient and substantial enough to distinguish the former from the latter.

¹⁶ *Valentino S.p.A. v Matsuda & Co* [2020] SGIPOS 8 at [25]-[26].

¹⁷ *Clarins Fragrance Group v BenQ Materials Corp* [2018] SGIPOS 2 at [67] ("*Clarins*").

Aural similarity between marks

91 When assessing the aural similarity between the Application Mark and the Opponent's "TATA" word mark, only the textual components are compared against each other while the botanical device, a graphical element, is ignored. The issue here is whether "Tata Harper" is aurally similar to "Tata" for trade mark law purposes when they are spoken or read aloud.

92 Both parties agree that the applicable law here has been articulated by the Court of Appeal in ***Ceramiche*** at [45], where the aural similarity between marks can be assessed either by focusing on their respective dominant components (the "dominant component approach") or by undertaking a quantitative assessment of their respective syllables (the "quantitative approach").

93 Given my analysis, above (at [83]), that the "Tata" word component should not be regarded as a dominant component of the Application Mark, I am drawn to the conclusion that these competing marks are aurally dissimilar. Where each textual component "*has about the same aural weight in the sense that neither would stand out more to the ear*" and there is "*no aural dominant component in the Application Mark*",¹⁸ the aural comparison to be made is simply between the sound of a one-word and a two-word textual component when they are read aloud. In this case, the comparison made between "Tata" and "Tata Harper" would lead to the conclusion that these marks are not similar from an aural perspective.

¹⁸ ***Clarins*** at [71] where the "irresistible conclusion" reached by the Assistant Registrar was that "DERMA ANGEL", as a whole, was aurally dissimilar to "ANGEL".

94 Even if the dominant component approach towards aural similarity is not applied in this case, a comparison between “Tata” and “Tata Harper” under the quantitative approach would lead to the same conclusion. These words are aurally dissimilar because the latter has twice as many syllables as the former; moreover, even though the first two syllables are phonetically identical, the combination of words in “Tata Harper” must be read as a whole such it is likely to leave a different phonetic impression in the ears of the average consumer. These competing marks are not aurally similar.

Conceptual similarity between marks

95 Assessing the conceptual similarity between the marks involves analyzing the ideas that lie behind and inform the average consumer’s understanding of the mark as a whole (*Staywell* at [35]). As I have reached the conclusion that the word “Tata” has an average level of inherent distinctiveness and should not be regarded as a dominant component of the Application Mark (at [79] and [83] above), I am unpersuaded by the Opponent’s submission that the overall impression conveyed by the competing marks should “*be centred on the word ‘TATA’*” (OWS at [71]) or that the “same idea” would be conveyed to the average consumer looking at the word “Tata” in both the Application Mark and the Opponent’s “TATA” word mark.

96 In my view, the word “Tata” is conceptually amorphous and has different meanings to consumers depending on the surrounding context in which it is used. “Tata” could be understood as a name, a nickname, an acronym, or a word in a non-English language. We can distinguish this from the Court of Appeal’s analysis of the word “Caesar” in *Ceramiche* (at [53]), which held that the Appellant’s CAESAR mark “*conveyed the same idea that would be*

conveyed by the Respondent's CAESARSTONE Mark... the same idea of supremacy, power and authority".

97 In contrast, the Application Mark as a whole – including the botanical device of “*an intricately designed arrangement of foliage and floral elements resembling a crown of flowers*” (AWS at [97]) – does conjure up connotations of the natural world and the beauty of nature. If my views on the relevance of a trade mark's acquired technical distinctiveness in the relevant market are accepted (at [58]-[59] above), other imagery or brand values could also be triggered in the mind of the average consumer of Class 3 products if we factor this aspect of the distinctiveness of the Application Mark into the conceptual similarity analysis.

98 I am unable to accept the Opponent's submission that there is a conceptual similarity between the marks because of the “*enhanced technical distinctiveness of the Opponent's 'TATA' marks and the descriptive nature, if any, of the suffixes*” used by competing marks, where “*the average consumer will come to associate any 'TATA'-formative sign to be a subsidiary, branch or extension of the main 'TATA' brand*” (OWS at [72]). First of all, as I have explained (above at [63]-[67]), the “well known” status and any associated acquired technical distinctiveness of the Opponent's “TATA” word mark should not be taken into consideration at the marks-similarity stage *in this case* because the assessment is carried out through the eyes of the average consumer in the relevant market for Class 3 goods – he or she who is likely to be exposed to the Application Mark – who would not be imputed with knowledge of the Opponent's use of the word mark in completely unrelated markets for industrial goods and services unless the word mark is “well known to the public at large in Singapore” (which it is not, in my view). Secondly, the inherent technical distinctiveness of the Opponent's “TATA” word mark is average (see above at

[79]). Thirdly, this submission conflates the “conceptual similarity” question with an issue that arises only a later stage – whether the use of the Application Mark would “indicate a connection” with the Opponent and damage the latter’s interests.

99 Given that the Application Mark and the Opponent’s “TATA” word mark would not convey the same ideas or concepts to the average consumer, it follows that I would regard these competing marks as not conceptually similar.

Conclusion on similarity between marks

100 My conclusions above on each of the three dimensions of similarity are premised on the Court of Appeal’s declaration in *Staywell* (at [16]-[19]) that the marks-similarity inquiry should *not* entail a “minimal threshold approach” or “low threshold test” under which the legal analysis could proceed to the next stage (of assessing likelihood confusion) once a “minimal level of similarity” or a “modicum of similarity” has been established. Instead, the comparisons between the competing marks made above at the visual, aural and conceptual levels perform a gatekeeping function which gives effect to the “step-by-step approach” envisaged by the Court of Appeal. Achieving a “productive and appropriate application” of the marks-similarity stage of the legal analysis requires, in my view, a sensible conceptualisation of the average consumer through whose eyes the competing marks must be assessed for similarity. It is thus appropriate to frame the perspective of this average consumer with reference to the relevant market and ensure that his or her perceptions of these trade marks are nourished by a realistic and reasonably constructed aquifer of common general knowledge.

101 In light of the lack of visual, aural or conceptual similarity between the Application Mark and the Opponent’s “TATA” word mark, my overall

conclusion at the end of marks-similarity stage is that the statutory requirement of similarity between the marks has not been established by the Opponent.

(III) Whether use of the Application Mark in relation to the Applicant's Goods would "indicate a connection" with the Opponent and "damage the interests" of the Opponent

102 Given that the threshold requirement of similarity between the competing marks has not been crossed, it is strictly unnecessary for me to consider whether or not the other elements of the ground of opposition in Section 8(4)(b)(i) have been met. However, as the Opponent has also invoked another ground of opposition (under Section 8(7)(a) TMA), that the Application Mark should not be registered because its use in relation to the Applicant's Goods is liable to be prevented by the law of passing off, I will consider whether any of the other elements of Section 8(4)(b)(i) have been proven to the extent that they overlap with the elements of the tort of passing off, since both parties appear to have proceeded with the oral hearing on the basis that there was a substantial overlap between these grounds of opposition. Furthermore, the Opponent clearly enjoys goodwill in the "TATA" word mark from the many years it has used that mark in its business operations, as explained above at [38] and conceded by the applicant (AWS at [23]), which establishes the existence of the core subject matter protected by the tort of passing off.

"Indicate a connection" - Likelihood of confusion and misrepresentation?

103 The Opponent contends that the use of the Application Mark in relation to the Applicant's goods would "indicate a connection" with the Opponent because *"there is a serious risk that the relevant public will confuse the Application Mark, which incorporates the Distinctive Features of the Opponent's 'TATA' marks, to be part of the same family such that they will perceive goods and services under the Application Mark to originate from the*

Opponent or from sources that are economically linked. This would lead to an outcome in which average consumers would perceive the Applicant's 'TATA HARPER' mark to originate or be economically linked to the TATA Group" (OWS at [80]). This alleged likelihood of confusion from the use of the Application Mark is relied upon by the Opponent to satisfy the "connection" requirement of Section 8(4)(b)(i) TMA, based on the observations of the Singapore Court of Appeal in **Staywell** at [120], with the Opponent submitting that *"the use of the Application Mark will result in a confusing connection between the Applicant's goods and the Opponent's"* (OWS at [91]).

104 Furthermore, relying on the observations of the Singapore Court of Appeal in **Ferrero** at [76] (reproduced above at [22]), the Opponent submits that establishing this "confusing connection" requirement under the trade mark statute was "substantively the same" as what was needed to show an actionable misrepresentation for the purposes of the tort of passing off (OWS at [133]).

105 I am of the view that the Opponent has not discharged its burden of showing that the use of the Application Mark would "indicate a connection" between the Applicant's goods and the Opponent, much less a "confusing connection". Absolutely no evidence has been tendered to show how consumers would react to the Application Mark or if they would even think of the Opponent when they encountered the Application Mark. Neither has the Opponent met the even more demanding threshold of showing consumer confusion – that they would think that the goods to which this mark was applied originated from a source connected to the Opponent – of the sort typically required under the tort of passing off.

106 Instead, the Opponent has asked me to infer that consumers of Class 3 products bearing the Application Mark would make a "confusing connection"

with the Opponent because of (i) the well known status of the Opponent's TATA Marks; (ii) the "high degree of similarity between the competing marks" and; (iii) the applicability of the "family of marks" doctrine – where "*the public may assume that a later mark originates from the same undertaking as an addition to the family of marks and may be confused or deceived if that is not the case*".¹⁹

107 I am reluctant to draw such an inference of consumer confusion. While I am prepared to acknowledge the Opponent's word mark as a well known trade mark, it is my view that it is "well known" only in a limited sense – to very specific sectors of the public where the Opponent has engaged in specialised areas of commerce within Singapore. Moreover, I have found the competing marks to be more dissimilar than similar. Finally, it seems to me that the Opponent has not done enough to show the subsistence of a "family of marks" in Singapore so as to strengthen its contention that consumer confusion is likely. No evidence has been tendered to show the duration, frequency or prominence of the use of any of the possible members of this "family" – such as "TATA TEA", "TATA NANO" or any of the unregistered marks – making it difficult to conclude that Singapore consumers would have recognised the existence of this collective grouping. As the Principal Assistant Registrar in ***Bridgestone Corporation and Bridgestone Licensing Services, Inc. v Deestone Limited*** [2018] SGIPOS 5 at [41] put it, "*in order for the existence of a 'family' of ... marks to affect the relevant consumer's reaction to the Application Mark, that 'family' must have been evident to Singapore consumers.*" There is nothing in the evidence to show how or why Singapore consumers would necessarily perceive the different TATA marks as part of a "family of marks".

¹⁹ Chapter 7, "Relative Grounds for Refusal of Registration", *IPOS Trade Mark Registry's Trade Mark Work Manual*, Version 6 (2018) at p42-43.

“Damage the interests of the proprietor” – Restriction on expansion opportunities?

108 The Opponent submits that, based on the observations of the Singapore Court of Appeal in **Ferrero** at [76] (reproduced above at [22]), “*the element of damage [for the purposes of the tort of passing off] was ‘substantially the same’ as the ‘likely to damage the proprietor’s interests’ requirement under s 55(3)(a) of the TMA, the infringement equivalent of s 8(4)(b)(i) of the TMA*” (OWS at [134]).

109 As the Opponent and the Applicant engage in different fields of business in Singapore, there is no allegation of damage to the Opponent’s business interests in the form of a diversion of sales or any other adverse impact on the ability of the Opponent to exploit its trade mark in any of its existing business operations. Instead, the Opponent alleges that the damage to its interests lies in the Application Mark being “*likely to cause damage via a restriction of the Opponent’s expansion*” (OWS at [92]) into markets for Class 3 products.

110 It is clear that this is a head of damage that originated from the law of passing off. The following observations have been made in the caselaw about what must be proven in order to establish “damage by restriction on expansion”.

111 The Singapore Court of Appeal also noted in **Ferrero** at [108] that:

The restriction of expansion into another field of commercial activity which *naturally* extends from the original activity has been recognised by this court as a head of damage under passing off in **Amanresorts** ([70] supra at [117]). It was emphasised in **Amanresorts** (at [118]) that there needs to be a *close connection* between the established activity and the extended activity (ie, commercial activity which is a natural expansion of the first activity in which the claimant already has established goodwill in).²⁰

²⁰ Emphasis added

112 Similarly, the Singapore Court of Appeal in **Staywell** at [125] declared that:

Where the field in which the defendant or applicant operates is in *close proximity* to, or is a *natural* extension of, the incumbent's business damage in the form of a restriction of business expansion opportunities will more readily be inferred. Christopher Wadlow in *The Law of Passing-off* (Sweet & Maxwell, 2011) at para 4-043 states that:

"If the defendant's chosen field of business is a natural extension of that in which the claimant trades then, as a practical matter, damage is likely to be inferred even if the claimant has no present intention of expanding into that field."²¹

113 More recently, the Assistant Registrar in **Monster Energy Company v Mixi, Inc.** [2017] SGIPOS 12 at [168] observed that:

A party that enjoys goodwill in one form of commercial activity may be entitled to protection from passing off in respect of another form of commercial activity which is a *natural* expansion (or extension) of the first. However, the two fields of activity *must share a close connection* for there to form a foundation for this head of damage (See **Amanresorts** at [117] – [118].)²²

114 It seems to me that deliberate care was taken in all of these previous decisions to limit the scope of the “damage by restriction on expansion” head of damage to situations where the Applicant or Defendant is operating in an adjacent market or there must be a close nexus to the goods or services offered by the Opponent or Plaintiff. What the Opponent has tried to argue is that its scope of application should be broadened in this case, particularly in the context of Section 8(4)(b)(i) TMA, where the goods and services in question of the parties are *not* similar and the competing marks have been registered in completely different classes.

²¹ Emphasis added.

²² Emphasis added

115 Essentially, the damage which the Opponent alleges in this case is that the registration of the Application Mark *could possibly* limit its future opportunities to expand its business activities to the sale of Class 3 goods in Singapore, where its existing business operations are in dissimilar and unrelated fields of commerce, under the “TATA” banner. Without tendering any evidence of its future plans for actually entering into any of the markets for Class 3 goods in Singapore, the Opponent is ultimately seeking to assert control over the use of the word “Tata” by the Applicant in markets which the Opponent currently does not operate within. However, I think there are at least three reasons why such a potentially expansive interpretation of the “damage by restriction on expansion” concept should *not* be adopted.

Principle – Damage must have nexus to the goodwill and confusion-by-misrepresentation elements of the tort of passing off

116 Firstly, as a matter of principle, the “damage” element is part of the classical trinity of closely connected elements that comprise the tort of passing off and must be analysed accordingly, bearing in mind that the basic objective of this tort is to protect the claimant’s right of property in his *goodwill* from the defendant’s confusion-inducing *misrepresentation*. If the goodwill enjoyed by the claimant is generated by trading activities in one or more specific markets, then any damage allegedly suffered must be in relation to the attractive force of *that* goodwill in order for an action in the tort of passing off to succeed; a defendant that “misrepresents” itself as being connected to the claimant in other *different* or *unrelated* markets does not necessarily cause damage to the claimant’s goodwill, particularly in the absence of actual or likely consumer confusion arising from the defendant’s conduct.

117 As explained in the leading treatise on the law of passing off, *Wadlow on the Law of Passing Off 6th Edition* (Sweet & Maxwell, 2021) (“Wadlow”) at

[4-7], the “damage” to the property either takes the form of “destruction” or “deprivation” – either when the goodwill is destroyed or depreciated (such as where inferior goods are sold under the claimant’s name) such that its attractive power is diminished, or when the claimant has been deprived of the benefit of the goodwill in situations where its attractive force is used to draw custom to the defendant and not the claimant. As a head of damage, the “damage by restriction of expansion” relied upon by the Opponent in this case falls into the second category.

118 The Opponent submitted that I should adopt the views of Sir Michael Kerr, the dissenting judge in the UK Court of Appeal case of **Harrods v Harroddian School** [1996] RPC 697 (“**Harrods**”) at pages 718-727, a case where passing off had been alleged by a plaintiff which operated a famous department store and a defendant which had set up a school under a similar name. The majority of the UK court of Appeal expressed the view that:

*The risk of significant damage to the appellant’s goodwill and reputation from the activities of the defendant depends not only on the nature and strength of the connection made by the public who perceive a link in the name notwithstanding the different spheres of activity, but also on how many of those persons would in consequence regard shortcomings in the running of the school as reflecting adversely on the quality of the goods and services offered in the department store and on its reputation as a supplier of such goods and services and so whether any customer or potential customer is likely to withhold, withdraw or reduce his custom or consider the appellant’s reputation for excellence to be diminished.*²³

119 Sir Michael Kerr would have allowed the plaintiff’s appeal in the **Harrods** case because, in his view, the defendant’s use of a similar name caused “damage to the plaintiff’s reputation and goodwill which is ultimately liable to lead indirectly to a reduction in trade” because of a “[l]oss of distinctiveness...

²³ Per Beldam L.J. at p731 (Emphasis added).

[since] the plaintiff has... lost control of his reputation and... has therefore suffered damage to his goodwill by a potentially injurious association with the defendant...”. Even while recognizing that the defendant in the **Harrods** case had not engaged in any disreputable conduct that might diminish the plaintiff’s reputation, he emphasised that:

The crucial point... is the plaintiff’s inevitable *loss of control of his reputation* and the consequent risk of damage to it.²⁴

120 The problem with adopting such an interpretation of the “damage” element for the purposes of establishing the tort of passing off is that it is completely decoupled from the notion of *damage to the goodwill* of the plaintiff. There is neither a weakening of the attractive force of the plaintiff’s goodwill nor a deprivation of the benefit of the plaintiff’s goodwill *arising from* a misrepresentation by the defendant that has caused confusion. There is also an intractable circularity with the argument that “loss of control” of one’s reputation is enough to show the requisite “damage” for establishing an action under the tort of passing off, because it assumes *ipso facto* that that the plaintiff already has an exclusive right in the name or other vessel which generates its goodwill, when the very purpose of the legal analysis is to establish if a cause of action should be available to the claimant in the first place.

Policy – Damage must serve a meaningful purpose in defining the scope of the tort of passing off

121 Secondly, as a matter of policy, if we believe that damage is an independent and essential element in the classical trinity of elements that comprise the tort of passing off, then its existence should neither be too readily presumed nor automatically established from just any act of misrepresentation

²⁴ Per Sir Michael Kerr at p725 (Emphasis added).

by the defendant. Otherwise, the damage element would be rendered otiose instead of serving as a meaningful legal limitation on the scope of the tort of passing off.

122 As Wadlow points out, the aftermath of *Erven Warnink v Townend* [1979] A.C. 731; [1980] R.P.C. 697 (commonly referred to as the *Advocaat* case) has thrown “wide open the question of what categories of misrepresentations were to be actionable as passing-off” and that it was “no longer possible to define the tort as one of misrepresenting one’s goods or business as those of the claimant, with a few extensions of precise and limited scope”, meaning that it became necessary to engage in a “rigorous investigation into whether damage to the claimant is really likely to result from the misrepresentation in issue” and that “likelihood of damage provides one acid test to distinguish those misrepresentations which amount to passing-off from those which the claimant cannot complain”.²⁵

123 Wadlow’s analysis of the various possible heads of damage that the courts have recognised under the tort of passing off separates them into two broad categories.²⁶ In first category are “fully established” heads of damage – encompassing direct loss of sales, inferiority of the defendant’s goods or services, “injurious association” with the claimant, exposure to liability or risk of litigation or damage to reputation within the trade.

124 In the second category are heads of damage that “need to be treated with varying degrees of caution” because “if damage under one of these were sufficient to support an action for passing off, then there would be no genuine

²⁵ Wadlow at [4-11].

²⁶ Wadlow at [4-48].

need to prove damage as an essential element of the tort in its own right: it could be assumed almost regardless of the facts of the case. This would deprive damage of its value as the acid test for distinguishing actionable misrepresentations from those outside the scope of the law". The "damage by restriction of expansion" head of damage falls into this second category which Wadlow labels as a "*category of recoverable parasitic damages*". Heads of damage in this category cannot stand on their own and "*may be taken into account in some circumstances, but only if the damage under one of the heads in the first category can be proven or presumed*". I respectfully agree with this analysis.

Precedent – Singapore Court of Appeal decisions have applied "damage by restriction of expansion" only where there is a close connection between the business activities of the parties

125 Thirdly, as a matter of precedent, it appears that the Singapore Court of Appeal has unequivocally taken onboard the need to be circumspect when approaching this species of "damage by restriction of expansion". In *Amanresorts* at [118], the cautionary note sounded in the following passage from an American case was cited and described as "representative of the position in Singapore":

It is true that a merchant who has sold one kind of goods ... sometimes finds himself driven to add other 'lines' in order to hold or develop his existing market; in such cases he has a legitimate present interest in preserving his identity in the ancillary market, which he cannot do ... if others make his name equivocal there. But *if the new goods have no such relation to the old*, and if the first user's interest in maintaining the significance of his name when applied to the new goods is nothing more than the *desire to post the new market as a possible preserve which he may later choose to exploit*, it is hard to see any basis for its protection [*ie*, for the protection of the merchant's name in the new market]. The public may be deceived, but [the merchant] has no claim to be its vicarious

champion; *his remedy must be limited to his injury and by hypothesis he has none.*²⁷

126 This passage was recited again by the Court of Appeal in ***The Audience Motivation Company Asia Pte Ltd v AMC Live Group China (S) Pte Ltd*** [2016] SGCA 25 (“**AMC**”) at [96].

127 In ***Amanresorts***, the Court recognised a “close connection” between the claimant’s high-end hotels and resorts business and the defendant’s residential accommodation business as both fields concerned accommodation, such that the latter’s misrepresentation prevented the former from expanding into the residential accommodation business in Singapore, noting that the claimant had also expanded into the residential accommodation business overseas.

128 In ***AMC***, the Court was satisfied that the respective businesses of the claimant (event management services for corporate promotional events) and defendant (concert management services) were “sufficiently close” to establish “the requisite prospect of damage”. The “*damage element had been established by virtue of the restriction from natural expansion that would be suffered by the [claimant] on account of the [defendant’s] misrepresentation*” because “*both parties [were] in the business of events management, save that they currently manage different types of events. It would be artificial to assume that the [claimant] would never venture into managing other types of events.*”²⁸ Of particular importance to the Court’s decision in favour of the claimant was its conclusion that the defendant’s use of a similar identifier “*would cause the relevant segment of the public to believe that [the parties] were either the same*

²⁷ ***S C Johnson & Son, Inc v Johnson*** 116 F 2d 427 (2nd Cir, 1940) at 429 (per Hand J) (Emphasis added).

²⁸ ***AMC*** at [98].

*company or closely related companies”, which was “corroborated by evidence of actual confusion on the part of the clients and suppliers of the [claimant]”.*²⁹

Conclusion on “connection” and “damage” elements

129 Invoking Section 8(4)(b)(i) TMA, the Opponent has argued that the Applicant’s use of the Application Mark on Class 3 goods, specifically skincare and cosmetic products, would “indicate a connection” between those goods and the Opponent and “damage the interests” of the Opponent. In addition, the Opponent’s case is that parallels should be drawn between these elements and those necessary to establish the tort of passing off – that there is a confusion-inducing misrepresentation and damage to the goodwill of the Opponent – for the purposes of invoking Section 8(7)(a) TMA.

130 If proof of consumer confusion is indeed necessary to satisfy the “connection” element of Section 8(4)(b)(i) TMA, then my conclusion above, at [107], means that this statutory requirement has not been met. In the absence of a likelihood of consumer confusion arising from the use of the Application Mark, and given that the competing marks should be regarded as more dissimilar than similar, it must also follow that the Applicant does *not* make an operative misrepresentation that is actionable under the tort of passing off simply by making use of the Application Mark on the Applicant’s Goods.

131 On the element of “damage”, which the Opponent has framed as “damage by restriction of expansion” for both the grounds of opposition under Section 8(4)(b)(i) TMA and the tort of passing off under Section 8(7)(a) TMA, the argument made is that registration of the Application Mark would “*prevent the Opponent from diversifying and expanding into related fields*” (OWS at

²⁹ **AMC** at [93].

[95]). While the Opponent's current business activities are in a vast array of business sectors, from heavy industry to high technology, financial services to telecoms and media, the Opponent maintains that its commercial interests in the "consumer fashion products" market "of 'alarm watches, anchors, bands for watches' as claimed in Class 14 of the Opponent's 'TATA' mark" are "similar" to "The Class 3 goods claimed by Applicant" (OWS at [95]). However, that timepieces and their accessories are *not* similar to skincare and cosmetic products should be as clear as day.

132 Furthermore, the Opponent relies on evidence from the Opponent's SD, at pages 5-6, to argue that it has trading activities in other business field involving "consumer and retail products", bringing them closer to business activities of the Applicant:

Over the years, various Tata companies have established leading brands ranging from consumer durables to tea to packaged water. The journey from 1917 to date has seen the group's footprint in the Consumer Goods segment multiply several times.

The group started its Retail foray with the launch of Westside, by Trent in 1998. Other specialty stores include Croma, by Infiniti Retail and Star Bazaar by Trent.

Tata Chemicals started its journey in Mithapur, Gujarat in 1939 and is today the world's third largest producers of soda ash with manufacturing facilities in North America, Europe, Asia and Africa.

Tata Chemicals' Consumer Products business reaches over 148 million households through its salt, pulses and spices portfolio in India and its Specialty Products business covers approximately 80% of India's districts, impacting over 9 million farmers.

Tata Group company Titan Company Limited is a leading player in the Jewellery, Watches and Eyewear categories with several successful brands. It is the fifth largest integrated own brand watch manufacturer in the world.

The company's Tanishq brand of jewellery is today one of the most trusted and respected lifestyle brands in India. Titan also operates its eyewear business through its Titan eye plus stores.

Titan's other popular brands include Fastrack, Sonata and Raaga. It recently entered the perfume business with Skinn and launched Taneira, a destination for fine silk sarees....

133 Unfortunately, none of the above is helpful to the Opponent in demonstrating how the registration of the Application Mark will cause “damage by restriction of expansion” in the relevant sense discussed above. Firstly, none of these trading activities involving “consumer and retail products” take place within Singapore, and there is no evidence to show that the average consumer in Singapore is aware of their existence. Secondly, all of these “consumer and retail products” are branded using other trade names instead of the “TATA” word mark – “Taneira” for silk sarees, “Skinn” for perfume, “Tanishq” for jewellery and “Titan” for eyewear. Thirdly, and most crucially, there is nothing in the evidence to support a finding that these product markets have a close connection with the skincare and cosmetic business that that the Applicant has engaged in using the Application Mark.

134 In short, there is nothing to show how the Applicant's use of the Application Mark on cosmetics products sold in Singapore could really damage the goodwill of the Opponent. At the end of the day, the real crux of the Opponent's opposition to the Application Mark lies in the “loss of control of his reputation” when the Applicant uses a mark which incorporates the word “Tata” and, for the reasons I have given above at [120] – [124], this alone is simply not enough qualify as “damage by restriction of expansion”. A decision otherwise would end up giving the Opponent a *de facto* monopoly on the word “Tata”, which neither the law of registered trade marks nor the tort of passing off would countenance.

135 On a side note, I should point out my skepticism as to whether it is actually appropriate to tether the “damage the interests” element of Section 8(4)(b)(i) TMA to the concept of “damage by restriction of expansion” developed in the context of the tort of passing off, which is relevant when Section 8(7)(a) TMA is invoked as a ground of opposition to the registration of the trade mark. Such an interpretation of the “damage” element of Section 8(4)(b)(i) TMA is, in my view, unduly restrictive in light of the wider range of goals of trade mark law in conferring extra layers of protection upon well known trade marks, as compared to the focus on the protection of goodwill that preoccupies the law of passing off. Moreover, given the clear judicial emphasis on confining the “damage by restriction of expansion” concept in the tort of passing off to situations where there is a “close connection” between the business activities of the claimant and the defendant, or where the latter’s business is a “natural extension” of the former’s business, such a head of damage sits very uncomfortably in the context of Section 8(4)(b)(i) TMA as this statutory provision is likely to be invoked in towards situations where the goods or services of the parties are *not* similar to each other.

Conclusion on opposition under Section 8(4) TMA

136 While the Opponent’s “TATA” word mark may be regarded to be “well known in Singapore”, its opposition to the registration of the Application Mark under Section 8(4) TMA cannot be sustained because these competing marks are more dissimilar than similar. In addition, the Opponent has not satisfactorily established the “connection” and “damage” elements of Section 8(4)(b)(i) TMA, based on its interpretation of the requirements of this statutory provision, relying on the evidence tendered in these opposition proceedings.

Conclusion on opposition under Section 8(7)(a) TMA

137 While the Opponent clearly has goodwill in its various trade marks, including the “TATA” word mark, its opposition to the registration of the Application Mark under Section 8(7)(a) TMA cannot be sustained because the remaining two elements of the tort of passing off – misrepresentation and damage – have not been satisfactorily established in these opposition proceedings.

Overall conclusion

138 Having considered the submissions, pleadings and evidence tendered by the parties, both in writing and orally, I find that these opposition proceedings to the registration of the Application Mark must fail on the grounds considered above. The application should proceed to registration. The Applicant is entitled to costs to be taxed, if not agreed.

139 I would like to acknowledge the commendable efforts of counsel for both parties in preparing their written submissions and delivering their oral submissions, as well as to thank them for their indulgence in addressing my questions relating to the unsettled legal issues encountered in these proceedings.

140 While proprietors of well known trade marks are certainly entitled to challenge attempts to register trade marks that might jeopardise their commercial interests, the pursuit of trade mark opposition proceedings in circumstances where the applicant operates in a different sphere of trading activities from these proprietors should be bridled by a keen awareness of the limitations of the legal protection afforded under Singapore trade mark law. Well known trade marks are certainly entitled to a wider scope of legal

protection than ordinary trade marks, but this does not extend to a legal monopoly over the mark itself as a unit of intellectual property *simpliciter*.

141 With two “tiers” of well known trade marks in Singapore, the level of protection corresponds to the degree of familiarity that these marks have amongst the Singapore public; however, both categories of well known marks enjoy additional rights over and above those conferred upon ordinary registered trade marks *only* to the extent specifically prescribed by the relevant legislative provisions of the Trade Marks Act. What this case has illustrated are the complexities of navigating the relationship between the statutory provisions of the Act that are perceived to overlap with each other, as well as the unsettled legal principles underlying the manner in which these provisions should be interpreted and applied.

142 One hopes that the Singapore courts will have, in the near future, the opportunity to further clarify the scope of these statutory provisions in a coherent manner and explain exactly how, and to what extent, they expand the scope of the legal rights conferred on proprietors who have succeeded in achieving a “well known” status for their respective trade marks.

Post-Script: Intersection and overlaps between statutory grounds of opposition to trade mark registration?

143 In this section, I set out my reasons for why I believe further thought needs to be given to the interpretation and scope of Section 8(4)(b)(i) TMA in light of the manner in which the Singapore courts have chosen to link it to other provisions in the TMA. As a starting point, Table 3 maps out the apparent commonalities between the legal elements of Section 8(4)(b)(i) TMA and the common law tort of passing off referred to in Section 8(7)(a) TMA.

Table 3: “Parallels” between legal elements of grounds of opposition

Earlier well known trade mark Section 8(4)(b)(i) TMA	Tort of Passing Off Section 8(7)(a) TMA
<i>Well known trade mark</i> Opponent's earlier mark is “well known in Singapore”	<i>Goodwill</i> [Claimant]-Opponent enjoys “goodwill” that is protected by the tort of passing off
<i>Marks Similarity</i> Application Mark is identical or similar to the Opponent's earlier well known trade mark	<i>Misrepresentation</i> [Defendant]-Applicant's registration and use of the Application Mark amounts to an actionable “misrepresentation” to the public
<i>Connection and Damage (to “Interests” of Proprietor)</i> Use of the Application Mark would indicate a “connection” between the Applicant's Goods and the Opponent, which would be likely to “damage the interests” of the Opponent	<i>Damage (to Goodwill)</i> [Claimant]-Opponent suffers “damage” as a result of the actual or likely confusion to the public which flows from the misrepresentation



Ferrero, SGCA, [76]-[77]

144 The nexus between these two grounds of opposition is premised primarily on an interpretation of Section 8(4)(b)(i) TMA that introduced an implied requirement that there must be a likelihood of confusion experienced by the average customer in order to successfully invoke this ground of

opposition. In other words, the Opponent must show that the average consumer would make a confusing connection between the Applicant's Goods and the Opponent before this ground of opposition can succeed. This was the position taken by the Singapore Court of Appeal in **Amanresorts**:

[226] ... The “damaging connection” condition in s 8(4)(b)(i) and s 55(3)(a) of the current TMA will be satisfied only where there is a confusing connection between the plaintiff and the defendant's goods or services (*ie*, only where there is confusion) because non-confusing connection is covered by the “unfair dilution” condition in s 8(4)(b)(ii)(A) and s 55(3)(b)(i).

145 Several reasons were given by the Court of Appeal for interpreting the “connection” element as requiring the Opponent to show additional proof of consumer confusion *despite* the *absence* of explicit statutory language referring to this element, unlike the wording of the provisions of Section 27(3) TMA, which existed before the subsequent introduction of Sections 8(4)(b)(i) and 55(3)(a) TMA:

27(3) A person infringes a registered trade mark which is well known in Singapore if —

(a) without the consent of the proprietor of the trade mark, the person uses in the course of trade a sign which is identical with or similar to the trade mark in relation to goods or services which are not similar to those for which the trade mark is registered;

(b) the use of the trade mark in relation to those goods or services would indicate a connection between those goods or services and the proprietor;

(c) there exists a likelihood of confusion on the part of the public because of such use; and

(d) the interests of the proprietor are likely to be damaged by such use.

146 One reason given in **Amanresorts**, at [228], was that the introduction of Sections 8(4)(b)(i) TMA and 55(3)(a) TMA should be read and understood in light of the pre-existing legislative provisions found in Section 27(3) TMA:

The conditions under which infringement is made out, as stated in s 27(3) of the current TMA, remain substantially the same as the conditions which previously applied under s 27(3) of the 1998 TMA, *ie*, there has to be a “connection” (see s 27(3)(b) of the current TMA) between the plaintiff and the defendant’s goods or services arising from the use of the defendant’s trade mark, “*a likelihood of confusion*” (see s 27(3)(c) of the current TMA) on the part of the public because of such use and damage to the plaintiff’s interests as a result of such use (see s 27(3)(d) of the current TMA). It might be argued that the express mention of the confusion requirement in s 27(3)(c) of the current TMA makes the lack of such mention in s 8(4)(b)(i) and s 55(3)(a) thereof all the more significant, but, for practical reasons, we think the converse is true. Specifically, if the confusion requirement were not read into s 8(4)(b)(i) and s 55(3)(a) of the current TMA, the following situation would pertain: The plaintiff which relies on s 27(3) of the current TMA to sue for infringement of its well-known trade mark must show a likelihood of confusion on the part of the public due to the use of the defendant’s trade mark on dissimilar goods or services, but, if the plaintiff seeks to stop the registration of the defendant’s trade mark based on s 8(4)(b)(i) or to restrain (by way of injunction) the use of the defendant’s trade mark under s 55(3)(a), it need not show a likelihood of confusion. This situation is anomalous. There is no reason why the confusion requirement should not apply across the board to all these sections.

147 It is submitted, with respect, that there is no real anomaly if proof of a likelihood confusion is required when Section 27(3) TMA is used in trade mark infringement proceedings, but not when Sections 8(4)(b)(i) TMA or 55(3)(a) TMA are invoked to oppose a registration, or restrain a defendant’s use, of a mark that is identical or similar to a well known mark. The former statutory provision pre-dated Singapore’s trade agreement obligations with the United States to grant extra protection to well known trade marks, while the latter provisions were subsequently introduced with the objective of enhancing the scope of protection given to such trade marks, which could include both confusion-based and non-confusion based forms of harm. The former applies to situations involving dissimilar goods or services, while the latter is applicable to situations involving *any* goods or services – identical, similar or dissimilar.

The former applies only to well known trade marks that have been registered in Singapore, while the latter is applicable to all trade marks that qualify as “well known in Singapore”, regardless of whether they have been registered in Singapore or whether their proprietors have carried on any business, or have any goodwill, in Singapore.

148 Another reason given by the Court in *Amanresorts*, at [229], was that the availability of trade mark protection, independent of proof of consumer confusion, should not be available to trade marks that were *merely* “well known in Singapore”, but *only* available to trade marks that were “well known to the public at large in Singapore”:

In recognition of the fact that many trade marks are potentially “well known in Singapore”, Parliament has granted such trade marks only one advantage over ordinary trade marks, namely, the former are protected from the registration and/or the use of identical or similar trade marks on dissimilar goods or services – such protection takes the form of the protection covered by the “damaging connection” condition in s 8(4)(b)(i) and s 55(3)(a) of the current TMA. The protection covered by the “unfair dilution” condition in s 8(4)(b)(ii)(A) and s 55(3)(b)(i) and that covered by the “unfair advantage” condition in s 8(4)(b)(ii)(B) and s 55(3)(b)(ii) are reserved for trade marks which are “well known to the public at large in Singapore” (*per* s 8(4)(b)(ii) and s 55(3)(b)). The policy question in issue is the extent of the protection which we wish to give to trade marks which are merely “well known in Singapore” as opposed to “well known to the public at large in Singapore”. In the absence of a clear legislative intent, we do not think that trade marks which are merely “well known in Singapore” should be given protection against the use of a similar or an identical mark on dissimilar goods or services where such use does not give rise to confusion. Such protection (ie, protection despite the absence of confusion) should, for now, properly be the preserve of a rare and privileged few.

149 These reasons were used to justify a judicial “copying-and-pasting” of parts of the legislative language from Section 27(3)(c) TMA (“*there exists a likelihood of confusion on the part of the public because of such use*”) into

Sections 8(4)(b)(i) and 55(3)(a) TMA.³⁰ However, with respect, they do not seem to adequately take into account the full context surrounding the introduction of Sections 8(4)(b)(i) and 55(3)(a) into the TMA.

150 Firstly, these new provisions were accompanied by a legislative intention to confer *additional* legal protection on proprietors of well known trade marks (beyond the pre-existing protections found in Section 27(3) TMA) in implementing the standard-elevating objectives of the US-Singapore Free Trade Agreement. It is not inconceivable that these enhancements, which include protection against non-confusion-based forms of harm, were meant to be distributed across two “tiers” of well known trade marks. Sections 55(3)(a) TMA and 8(4)(b)(i) TMA could be sensibly interpreted to apply to a basic tier of trade marks that are “*well known in Singapore*” which receive greater protection (from both confusion-based and non-confusion based harms) than ordinary registered trade marks (which only receive protection from confusion-based harms). Section 55(3)(b) TMA and 8(4)(b)(ii) TMA would then apply to a higher tier of even more privileged trade marks that are “*well known to the public at large*” so as to enjoy additional rights against dilution by blurring and unauthorised acts which take unfair advantage of the distinctive character of these extremely well known trade marks.

151 Secondly, even if there were many trade marks that qualified as “*well known in Singapore*”, their proprietors may well have been regarded by Parliament as deserving of some extra legal protection (as compared to ordinary registered trade marks) against the “use [or registration] of a similar or an identical mark on dissimilar goods or services where such use [or registration]

³⁰ See B Ong, *Interpreting Intellectual Property Statutes in Singapore – What are the Limits of Judicial Creativity?* (2012) 24 Singapore Academy of Law Journal (Special Issue – Intellectual Property Law) 1020 at 1032-1052.

does not give rise to confusion”. Perhaps these trade mark proprietors, having expended the effort and resources to successfully develop their trade marks to make them well known to at least a segment of the Singapore public, *deserve* to be rewarded with a broader scope of legal protection *beyond* the confusion-based protection conferred on all trade marks in Sections 8(1)-(3) TMA and 27(1)-(3) TMA? Perhaps it was intended that such well known trade marks receive additional protection against unauthorised acts that are injurious to the brand reputations of such trade marks in the minds of their consumers without any accompanying confusion?

152 One must assume that Parliament did not legislate in vain. The fact is that our legislative draftspersons *chose* to *omit* the language found in the pre-existing Section 27(3)(c) TMA from Sections 8(4)(b)(i) TMA and 55(3)(b) TMA – the “new” provisions that were introduced to implement the US-Singapore Free Trade Agreement. Therefore, it is entirely plausible that this was Parliament’s way of communicating its intention to give proprietors of well known trade marks (that were *merely* “*well known in Singapore*” without having reached the level of being “*well known to the public at large in Singapore*”) the privilege of having *more than* “only one advantage over ordinary trade marks”.

153 For instance, all well known trade marks, even if they fall short of being well known to the public at large in Singapore, can and should benefit from protection against unauthorised usage of identical or similar marks that tarnish the reputations of the well known mark, even in the absence of consumer confusion.³¹ More strikingly, the judicial implication of the “likelihood of

³¹ Recent empirical studies by contemporary trade mark scholars actually suggest that extremely well known marks are, in fact, immune to some extent to tarnishment-type reputational harms (not based on consumer confusion) because of the sheer strength of the brands they embody. This suggests that legal protection against tarnishment might, actually, only be practically useful to

confusion” requirement into Section 8(4)(b)(i) TMA results in this provision substantively mimicking its immediate neighbor, Section 8(3) TMA, despite the readily apparent differences between the statutory language used in each provision. If this was truly in the intention of Parliament, then there would have been no need to draft *separate* statutory provisions covering trade marks registered “before 1 July 2004” (protected by Section 8(3) TMA) and trade marks registered “on or after 1 July 2004” (protected by Section 8(4) TMA). The statutorily prescribed elements of both provisions set out below side-by-side in Table 4.

Table 4: Side-by-side comparison of Sections 8(3) and 8(4)(1)(b) TMA

Section 8(3) TMA	Section 8(4)(1)(b) TMA
Applies to application for trade mark registration made before 1 July 2004	Applies to application for trade mark registration made on or after 1 July 2004
(i) Application mark is identical with or similar to earlier trade mark (ii) Application mark is registered for use in respect of dissimilar goods or services	• Application mark is identical with or similar to earlier well known trade mark • Application mark is registered for use in respect of <i>any</i> goods or services

well known trade marks *with some reputation amongst niche audiences* and is less likely to be necessary for trade marks that are well known to the public at large. See C Boshoff, *The lady doth protest too much: A neurophysiological perspective on brand tarnishment*, 25 Journal of Product & Brand Management 2 (2016) 196-207.

(iii) Earlier trade mark is “well known in Singapore” (iv) Use of the application mark in relation to the goods or services for which registration is sought “would indicate a connection between those goods or services and the proprietor of the earlier trade mark”	• Earlier trade mark is “well known in Singapore” • Use of the application mark in relation to the goods or services for which registration is sought “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”
(v) “there exists a likelihood of confusion on the part of the public because of such use”; and	(Judicially implied requirement of likelihood of confusion)
(vi) “the interests of the proprietor of the earlier trade mark are likely to be damaged by such use”	

154 The chain of jurisprudence set off by *Amanresorts*, including the later *Ferrero* decision, has led us to the present case, where the implication of a requirement of consumer confusion into Section 8(4)(b)(i) TMA has transformed this ground of opposition into one that overlaps almost entirely with Section 8(3) TMA and very substantially with the common law of passing off that is referenced in Section 8(7)(a) TMA. Between this interpretation of Section 8(4)(b)(i) TMA and Section 8(7)(a) TMA, the main difference is that

the latter requires goodwill (which requires business activities to be conducted within Singapore) to be established, whereas the former simply requires the opponent to have a trade mark that is “well known” in Singapore (without having any business activities within this jurisdiction).

155 These binding authorities from the Singapore courts have circumscribed the scope of Section 8(4)(b)(i) TMA very substantially and, in my view, unjustifiably. The clear legislative intention behind its introduction, along with Section 55(3)(a) TMA, was to meaningfully strengthen the scope of legal protection enjoyed by trade mark proprietors whose trade marks have achieved the status of being “*well known in Singapore*”. This should mean that these provisions should protect such trade mark proprietors from both confusion-based and non-confusion-based forms of harm, since protection from confusion-based harms was already offered in the pre-existing provisions of the Act prior to the introduction of Sections 8(4)(b)(i) TMA and 55(3)(a) TMA.

156 When juxtaposed against Section 8(7)(a) TMA, was the introduction of Section 8(4)(b)(i) TMA meant to merely widen scope of the grounds of opposition, based on the tort of passing off, to include unregistered trade marks that are well known in Singapore or well known trade marks whose proprietors do not enjoy goodwill in Singapore? If this had been Parliament’s true intention, it could have simply amended Section 8(7)(a) TMA directly rather than introduce an entirely new section – Section 8(4)(b)(i) TMA – whose purpose must have been to implement a *new* regime of *additional* rights for well known trade marks pursuant to Singapore’s free trade agreement obligations.

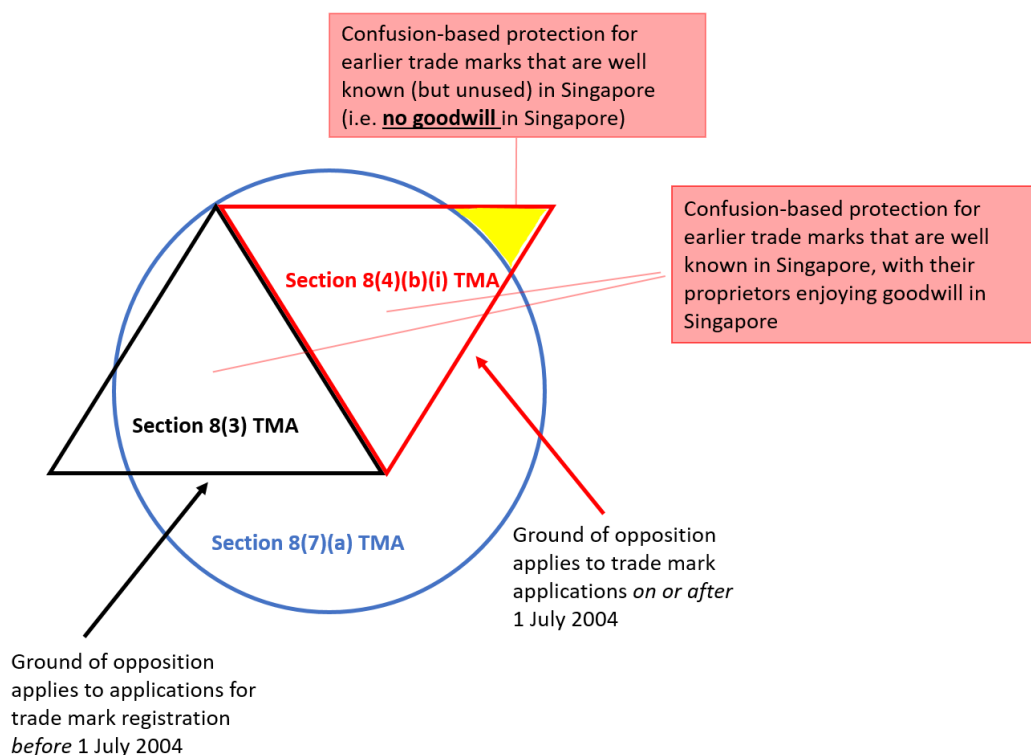
157 Where, as on the particular facts of this case, the proprietor of an allegedly well known mark actually conducts business activities within Singapore, thereby necessarily satisfying the goodwill requirement for the tort

of passing off, why would or should he invoke Section 8(4)(b)(i) TMA as a ground of opposition (which imposes upon him the *additional* burden of showing that its trade mark is has reached the requisite status of qualifying as “*well known in Singapore*”) when that proprietor can simply rely on the “easier” route under Section 8(7)(a) TMA instead? Put another way, if a trade mark proprietor is able to demonstrate that its mark has acquired the status of a “well known” trade mark, shouldn’t Section 8(4)(b)(i) TMA confer a wider scope of legal protection to that “well known” trade mark *beyond* the confusion-based protection which is already available to ordinary trade marks via the common law tort of passing off?

158 In summary, my difficulties with the entanglement between these provisions of the Act can be reduced to the following observations and questions. These statutory grounds of opposition to trade mark registration have been interpreted by the courts to overlap with each other to such an extent (see Figure 1 below) that renders Section 8(4)(b)(i) TMA of extremely limited practical value to proprietors of trade marks that are well known in Singapore. The caselaw as it currently stands, with respect, obfuscates the scope of legal protection conferred upon proprietors of well known trade marks under (I) Section 8(3) TMA, (II) Section 8(4)(b)(i) TMA and (III) Section 8(7)(a) TMA. Do (I) and (II) *only* protect well known trade marks from confusion-based harms, despite the obvious differences in the statutory language used in each provision, such that the main difference between them is that (I) applies to trade marks registered before 1 July 2004 while (II) applies to trade marks registered on or after 1 July 2004? If Parliament had merely intended for a very modest expansion of the scope eligible trade marks (i.e. for the benefit of unregistered well known trade marks) to receive exactly the same confusion-based protection as what was already available under the TMA, would it not have been more straightforward to amend the existing legislative provisions dealing with

confusion-based harm in situations involving goods or services that are identical or similar (Section 8(2) TMA) or dissimilar (Section 8(3) TMA), instead of inserting a whole new statutory provision (Section 8(4)(b)(i) TMA)? Do (II) and (III) overlap to such an extent that they are both limited to *only* confusion-based conduct prohibited by the tort of passing off, with the sole difference being that (II) extends the scope of protection to foreign well known trade marks whose proprietors do not enjoy any goodwill in Singapore, which is required for (III)?

Figure 1: Overlaps between Sections 8(3) TMA, 8(4)(b)(i) TMA and 8(7)(a) TMA based on current judicial interpretations given to these statutory provisions



Burton Ong
IP Adjudicator

Ms Ruby Tham and Mr Teo Xuan Lang (Drew & Napier LLC) for
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Mr Sukumar Karuppiah and Mr Jon Chan Wenqiang (Ravindran
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