

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

[2024] SGIPOS 6

Trade Mark No. 40202129653W

**IN THE MATTER OF A TRADE MARK APPLICATION
IN THE NAME OF**

SURVIVALVERSE PTE LTD

... Applicant

AND

AN OPPOSITION BY

AMAZON TECHNOLOGIES INC

... Opponent

GROUND OF DECISION

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Amazon Technologies Inc
v
Survivalverse Pte Ltd

[2024] SGIPOS 6

Trade Mark No. 40202129653W
Principal Assistant Registrar Ong Sheng Li, Gabriel
5 June 2024

8 August 2024

Principal Assistant Registrar Ong Sheng Li, Gabriel:

Introduction

1 This case concerns an opposition filed by Amazon Technologies Inc (the “Opponent”) against a trade mark application by Survivalverse Pte Ltd (the



“Applicant”) to register “ ” (Trade Mark No. 40202129653W) in Class 09 for “software” and Class 41 for “providing online computer games” (the “Application Mark”).

Background

The Opponent

2 The Opponent is an affiliate of the Amazon.com Inc group of companies (collectively, “Amazon”). Amazon is a multi-national electronic commerce and technology company founded in 1994. It is publicly listed on the NASDAQ stock exchange and is considered one of the largest companies in the world by various reputable business publications such as Forbes Magazine and Fortune Magazine. Amazon is part of various major indices such as the S&P 500 Index

and the NASDAQ 100. It is public knowledge that Amazon is — and has been for some time — one of the largest companies in the world by market capitalisation.

3 Amazon’s businesses consist of a wide variety of product categories, service offerings, and delivery channels. Since 1994, Amazon has operated an e-commerce website (www.amazon.com) which is accessible to consumers worldwide, including Singapore. Some of Amazon’s other main offerings include products and services in respect of information technology, computing, and software. Over time, Amazon has expanded into industries beyond its initial core business, including fields such as food and beverage, apparel and accessories, beauty and health products, brick-and-mortar stores, content publishing and distribution, consumer electronics, video gaming, media, and digital entertainment.

4 Around 1998, Amazon ventured into the computer games industry first by selling (on its e-commerce website) video games for consoles such as Sega Dreamcast, Nintendo 65, and Neo Geo. In 2012, Amazon founded Amazon Game Studios to develop and publish video games. Today, such video games are offered under the “Amazon Games” mark and brand. These games are made available for download/purchase on the Apple App Store, Google Play store, and the Amazon app store, and playable on major gaming platforms such as PlayStation, Xbox One, and PC.


The Applicant

5 The Applicant is a games software publisher that develops blockchain-based videogames and software. It was incorporated in April 2022. On 8 December 2021, AMC Asia (SG) Pte Ltd applied to register the Application Mark. Ownership of the Application Mark was subsequently transferred to the


Applicant. (The change of ownership has no impact whatsoever on this case.)

6 According to the Applicant, the Application Mark was meant to be used in connection with an Amazon rainforest-themed videogame world; one of a series of game world locations set within a fictional “SURVIVAL VERSE”. For each of these locations, the Applicant applied to register (and with the exception of the present Application Mark, has now obtained registration for) a corresponding trade mark for “software” in Class 09 and “providing online computer games” in Class 41. Examples of these registrations (and their associated environments) include the following.




(a) “  ” (TM No. 40202129658T) which corresponds to an African savanna-themed world setting,




(b) “  ” (TM No. 40202129655Y) which corresponds to an Atlantis-themed world setting,



(c) “  ” (TM No. 40202129654U) which corresponds to an Antarctica-themed world setting, and



(d) “  ” (TM No. 40202129656X) which relates to the entire SURVIVAL VERSE series of games.

7 It appears that the Amazon rainforest-themed game location is not yet live. To date, only the African savanna-themed game location is active and can be accessed through the following website: <http://www.savannasurvival.io/>

Grounds of opposition

8 Four grounds of opposition were raised by the Opponent under the Trade Marks Act 1998 (“TMA”) against the Application Mark: ss 8(2)(b), 8(4)(b)(i), 8(4)(b)(ii), and 8(7)(a) TMA.

9 The cornerstone of the Opponent’s case in respect of all four grounds is that the Application Mark should not be registered because it conflicts with the Opponent’s numerous earlier trade mark registrations comprising or containing the word “AMAZON”, chief among them the plain word mark “AMAZON” (Trade Mark No. T1416619I), registered on 16 October 2014 for various goods and services including “computer software” in Class 09 and “providing on-line computer and educational games and on-line interactive children's stories” in Class 41 (the “Plain AMAZON Mark”).

Statutory declarations

10 Each side gave evidence via the usual way: through statutory declarations (“SD(s)”). Aimee Mahan, an Assistant Secretary in the Trademarks department of the Opponent, gave evidence on its behalf (“Opponent’s SD”). Tan Jit Leng, the Chief Financial Officer of the Applicant, gave evidence on its behalf (“Applicant’s SD”). Aimee Mahan also gave evidence-in-reply (“Opponent’s Reply SD”). Since there was no cross-examination, these SDs formed the entirety of the evidence before this tribunal.

Outcome in brief

11 The hearing took place on 5 June 2024. After due consideration of the materials before me and the parties’ written and oral submissions, I allow the opposition under s 8(2)(b) TMA and accordingly refuse registration to the Application Mark.

12 Why? Well, in simple layperson terms, I think that “**AMAZON**” is what stands out in the Application Mark. The “**SURVIVAL**” element is presented in a manner that is much smaller in comparison. When viewed through the lenses of imperfect recollection, average consumers of the goods and services in question would likely focus on the dominant “**AMAZON**” element. The Opponent’s Plain AMAZON Mark is simply: “AMAZON”. It logically follows that the marks are similar to a high degree. Furthermore, the goods and services are identical. In this regard, it is important to bear in mind that the assessment is not limited to how the parties are using their marks in practice. It also concerns the full spectrum of possible uses under the specification of goods and services on both sides. Given all of the relevant circumstances, I think that a likelihood of confusion would result.

13 Might the outcome have been different had the mark applied for featured “**SURVIVAL**” in a larger size? Perhaps. But it is pointless to speculate on hypotheticals. Ultimately the bottom line is this: I see no reason to doubt that the Applicant was honestly seeking to use “**AMAZON**” as a geographical reference in connection with a rainforest-themed videogame world. But on these facts, due to the way the elements of the Application Mark are presented, together with various other factors, the mark that was chosen was simply too close to the Plain AMAZON Mark.

Section 8(2)(b) TMA

14 Section 8(2)(b) TMA provides that:

8. (2) A trade mark shall not be registered if because —
 - (a) [omitted]

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

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

15 Here, the primary earlier trade mark relied on is the Plain AMAZON Mark registered in various classes including Class 09 for “computer software” and Class 41 for “providing on-line computer and educational games and on-line interactive children's stories”.

16 In *Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide* [2014] 1 SLR 911 (“*Staywell*”), the Court of Appeal held that s 8(2)(b) TMA entails the following test. First, are the competing marks similar? Second, are the goods identical or similar? Third, is there a likelihood of confusion arising from the foregoing? All three steps must be established for the opposition under this ground to succeed.

Whether the marks are similar?

17 The law relating to marks-similarity has been set out in a number of decisions of the Court of Appeal including *Sarika Connoisseur Café Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 (“*Sarika*”), *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 (“*Hai Tong*”), *Staywell*, and *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 (“*Caesarstone*”), all of which I have given due consideration to. The applicable principles of law, which are not in dispute in this case, have also been restated in numerous decisions of this tribunal, including an earlier decision of mine: *GCIH Trademarks Limited v Hardwood Pte Ltd* [2021] SGIPOS 6.

18 Although there was previously some uncertainty concerning the role of distinctiveness in the marks-similarity comparison, the law has since been

clarified by the High Court in *V V Technology Pte Ltd v Twitter, Inc* [2023] 5 SLR 513 (“*Twitter*”). The following key points emerge (see *Twitter* at [119]).

(a) First, distinctiveness should not be treated as a threshold enquiry; rather, it should be integrated within the *Staywell* step-by-step approach.

(b) Second, courts and tribunals should be careful to make consistent use of the right terms when referring to distinctiveness. In particular, we should be careful to delineate whether “distinctiveness” refers to: (i) inherent technical distinctiveness (which refers to the inherent capacity of a mark to function as a badge of origin without taking use into account); (ii) acquired technical distinctiveness (wherein the capacity of a mark to function as a badge of origin has been acquired as a result of long and extensive usage); or (iii) non-technical distinctiveness (which is assessed by reference to the dominant component(s) of a mark).

(c) Third, acquired technical distinctiveness should not be considered at the marks-similarity inquiry. Instead, it should be considered at the likelihood of confusion stage. This is based on precedent, principle, and policy. It also preserves conceptual clarity.

Visual similarity

19 I begin with visual similarity.

20 The law mandates that the assessment for marks-similarity should not be undertaken via a side-by-side comparison. Be that as it may, I reproduce them alongside each other below for the sake of illustration.


Plain AMAZON MarkApplication Mark

AMAZON



21 The Opponent’s case is that the marks are visually similar to a high degree. Its central argument is that “**AMAZON**” is the dominant and distinctive component in the Application Mark. The Opponent acknowledges that there are some differences between the marks when they are examined closely; however, it contends that with imperfect recollection, “AMAZON” is what will stand out in the mind’s eye of the consumer. It argues that the stylisation (including the paw print device) and green colour in the Application Mark is decorative, would not make a significant visual impact, and would in any event not communicate trade origin. As regards the difference in colour, the Opponent points to the well-established principle that a plain word mark registration confers protection in respect of all colours and fonts (see *Twitter* at [122]). As for the second word “**SURVIVAL**”, the Opponent’s submission is that this element is visually a great deal smaller such that it would be overshadowed by the much larger “**AMAZON**” component.

22 In advancing its case that the Application Mark is sufficiently and substantially distinguishable from — and hence dissimilar to — the Plain AMAZON Mark, the Applicant puts forward three primary arguments. First, it contends that the Plain AMAZON Mark does not possess a high level of inherent technical distinctiveness because it is an ordinary English word and not an invented word. Second, it submits that “**AMAZON**” cannot be considered

to be the sole distinctive component of the Application Mark. Third, the Applicant points out that there are various differences between the competing marks including the word “SURVIVAL”, the green colour, and the other stylistic features present in the Application Mark such as the image of a pawprint in the middle of the second “A” in “”.

23 I begin with discussing the inherent technical distinctiveness of the Plain AMAZON Mark and how it plays into the visual-similarity analysis. In so doing, I do not treat inherent distinctiveness as a threshold or stand-alone issue. I also disregard any significance that may have been acquired through use, for that is a matter to be left for the likelihood of confusion analysis. (See *Twitter* at [119].) In my view, “AMAZON” is clearly inherently distinctive since it does not describe the goods or any of their characteristics. Although it is part of the English language, it is not a commonly encountered word. Be that as it may, I do not think that “AMAZON” possesses a greater level of inherent distinctiveness as compared to, say, an invented term. This is relevant in that no high(er) threshold applies before a competing sign will be considered similar to it (see *Staywell* at [25]; *Sarika* at [36]).

24 Still on the topic of inherent distinctiveness, it is relevant that “SURVIVAL” in the Application Mark is a common word in the English language. The Opponent raises an interesting argument: that “survival” would be understood as a reference to a particular (sub)genre of video games and should be regarded as descriptive to that extent. While I accept that there is evidence to suggest that there some are members of the public who might take this view,¹ it seems doubtful that they would be any more than a slim minority. Moreover, the specification in Class 09 covers “software” and is not confined


¹ Opponent’s SD at OSD-13

to video games. The niche reference to “survival” videogames does not apply to software in general. In the premises, I prefer the view that “SURVIVAL” is inherently distinctive in relation to the relevant goods and services. But, since it is an ordinary word in common use, I would say that the strength of its distinctiveness would be slightly less as compared to “AMAZON”.

25 I now turn to what I consider to be the crux of the matter: the significant size difference between “**AMAZON**” on the one hand and “**SURVIVAL**” on the other. Although the marks must always be compared as wholes, it is plain to see that “**AMAZON**” visually stands out in the Application Mark. It appears first and is much larger in size as compared to “**SURVIVAL**” beneath. Given imperfect recollection, “AMAZON” would be the distinctive and dominant element. Although “SURVIVAL” is not so small as to be negligible, visually, it plays a lesser role.

26 Of course, if one were to enlarge the Application Mark, the “**SURVIVAL**” element becomes a great deal more impactful. Indeed, that was what counsel for the Applicant did in written submissions: providing an enlarged image of approximately the same size as what is depicted below.






27 To be clear, I do not think that there is anything wrong or inappropriate about presenting an enlarged image of the subject trade mark in written submissions. This way, one is better able to view the pawprint device in the second “A” in “AMAZON”, the word “SURVIVAL”, and the encircled TM at the end of the “” element.

28 However, there are at least two reasons why the enlarged image should be treated with caution. First, this is not how average consumers of the goods and services would ordinarily encounter the mark. The relevant specifications are “software” in Class 09 and “providing online computer games” in Class 41 respectively. It stands to reason that these goods and services would be accessed via screens of all sorts (whether computer screens, televisions, or cell phones). It seems doubtful that the Application Mark would ordinarily be perceived at this scale. Second, lest it be forgotten, the viewpoint is that of an average consumer with imperfect recollection. Resizing the Application Mark does not alter the fact that the visually dominant component is still “AMAZON”.

29 All in all, I take the view that the marks have a moderately high degree of visual similarity. There is some stylisation in the Application Mark. But it is slight and would not change the analysis in any material way. The protection accorded to a plain word mark is wide enough to cover differences in stylisation and font sizes.

30 Before concluding this part, I briefly discuss the Applicant’s reliance on *Monster Energy Company v Tencent Holdings Limited* [2018] SGIPOS 9

(“*Tencent*”). There, the application mark “” was found to be visually dissimilar to the earlier “MONSTER” plain word mark. While one can readily see the parallels between that case and this, each dispute must

necessarily turn on its own facts. In my assessment, the critical difference is as follows. In *Tencent* it was found that “MONSTER” in “MONSTER CASTLE” does not stand alone. Instead, it visually overlaps with “CASTLE”. This tribunal found, based on the layout, that it is the whole of the mark that would leave an impression on the average consumer’s memory, not “MONSTER” alone (see *Tencent* at [54(c)]). But this case is different: “” is not visually integrated with “” in the same way. Therefore, I take the view that *Tencent* is distinguishable on the facts.

Aural similarity


31 Next, I turn to aural similarity.

32 There are two accepted approaches to the assessment (see *Staywell* at [31]-[32]). The first is to consider the dominant and distinctive component of the marks (“Dominant Component Approach”) and the second is to undertake a quantitative assessment as to whether the competing marks have more syllables in common than not (“Quantitative Approach”).

33 The Applicant submits that the Dominant Component Approach is not applicable because the Application Mark does not contain any dominant and distinctive component. This argument is premised on the fact that there are two words: “AMAZON” and “SURVIVAL”, both of which are ordinary English words. Since there is no distinctive and dominant component, or so the argument goes, the Quantitative Approach should be applied instead. And under the Quantitative Approach, the competing marks are said to be aurally dissimilar since only 3 out of 6 syllables are common and the Application Mark contains the additional “SURVIVAL” word.

34 With respect, I think it makes sense to prefer the Dominant Component Approach over the Quantitative Approach in this case. Common experience tells us that the way a sign is read aloud depends on a number of factors including how it is visually represented. A sign that is presented as



“ ” would not ordinarily be read the same way as “AMAZON SURVIVAL”. Due to the size differential, average readers would likely place verbal emphasis on “AMAZON”. Earlier, I found “” to be the visually distinctive and dominant component of the Application Mark. For similar reasons, “AMAZON” should be regarded as the aurally distinctive and dominant component. This is not to say that “SURVIVAL” would not be pronounced. It would. But as the second word that is presented in much smaller font, it would only be natural for it to be accorded a lesser oral/aural role. Since the Plain AMAZON Mark is also “AMAZON”, I am led to the conclusion that the marks are aurally similar to a material degree.

35 There was a suggestion by the Opponent that even if one uses the Quantitative Approach, half the words / syllables are similar (“AM-A-ZON” versus “AM-A-ZON SUR-VI-VAL”). As such, the marks should be considered similar to that extent. I agree. The point is that the marks have three syllables in common: “AM-A-ZON”. The additional three syllables in the Application Mark are not likely to displace that identical first word. Even if the degree of similarity might be slightly less as compared to the Dominant Component Approach, the marks would be more similar than dissimilar.

36 In conclusion, I would prefer the Dominant Component Approach and take the view that the marks are aurally similar to a material degree. Even under the Quantitative Approach, I would say that the marks are at least aurally more similar than dissimilar.

37 For completeness, I briefly mention the Applicant’s reliance on *Clarins Fragrance Group f.k.a. Thierry Mugler Parfums S.A.S. v BenQ Materials Corp.* [2018] SGIPOS 2 (“*Clarins*”). There, the competing marks were “ANGEL” and *derma* “*Angel*”. This tribunal rejected the argument that the stylised “*Angel*,” should be regarded as the dominant component. Instead, it found that there is no aurally dominant component. Accordingly, the comparison was between “DERMA ANGEL” and “ANGEL”. The conclusion reached was that the marks were aurally dissimilar. This case, however, involves a different situation: the aural commonality coincides in the first identical word, “AMAZON”.

Moreover, the layout of the *derma* “*Angel*” mark ensures that both elements would be pronounced with equal weight whereas it is likely that the word “AMAZON”



in “ ” would be emphasised orally. Thus, I do not think that *Clarins* assists the Applicant.

Conceptual similarity

38 I now move to the third facet: conceptual similarity.

39 It is well established that conceptual similarity seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole: *Staywell*

at [35].

40 The Applicant argues that the Application Mark conveys a very different impression than the Plain AMAZON Mark. In so doing, the Applicant points to various stylistic features in the Application Mark as support for the contention that the underlying idea is about surviving in a dangerous and hostile environment such as the Amazon rainforest.

41 Responding to this, the Opponent argues that if “AMAZON SURVIVAL” indeed conveys such an impression, then the Plain AMAZON Mark must necessarily do the same; after all, “SURVIVAL” does not alter the “AMAZON” concept in any meaningful way since the Amazon rainforest would be understood as a harsh or difficult environment to survive in.

42 In my assessment, “AMAZON” would likely be understood by the general public as a reference to a geographical location: the largest rainforest in the world located in South America and/or the river that runs through it. If so, the addition of “SURVIVAL” and the stylistic elements such as the pawprint and colour green would only serve to reinforce the rainforest/river concept. It is well understood that the Amazonian environment is harsh and unforgiving. Survival would not be easy for those without proper training or experience. For these reasons, “SURVIVAL” would enhance, not displace, the strong level of conceptual similarity between the marks.

43 Now, I acknowledge the Applicant’s argument that “AMAZON” could also refer to a nation/group of female warriors. However, I take the view that this reference, which is historical and/or founded in certain Greco-Roman myths, is somewhat dated and would not be in common use except in the popular culture context (e.g. the superhero Wonder Woman). (The same goes

for the related use of “AMAZON” as a descriptor — oftentimes a backhanded compliment or outright derogatory — for women possessing warrior-like traits.) However, I am not sure that this changes anything. What is sauce for the goose must be sauce for the gander: both marks are equally capable of encapsulating the female warrior concept. Moreover, war and survival are closely intertwined concepts. In war, survival is never certain. The presence of “**SURVIVAL**” would not displace the common concept.

Conclusion on marks-similarity

44 In summary, I have found the marks to have a moderately high level of visual similarity. Aurally, they are at least more similar than dissimilar (based on the syllable counting approach) and, if the Dominant Component Approach is to be preferred, must be regarded as similar to a material degree. Conceptually, the marks share a strong level of similarity. As a whole, I would say that the marks are similar to a significant degree.

Identical goods and services

45 The Applicant forthrightly accepts — and in my view, correctly so — that the goods and services for which registration is sought (“software” in Class 09 and “providing online computer games” in Class 41) are identical to those covered under T1416619I (“computer software” in Class 09 and “providing on-line computer and educational games and on-line interactive children's stories” in Class 41). This satisfies the second step of the test.

Likelihood of confusion

46 I come now to the third and final step: likelihood of confusion. It requires consideration of: (a) how similar the marks are; (b) how similar the

goods/services are; and (c) given the similarities, how likely the relevant public will be confused (see *Staywell* at [55]).

47 There are at least two aspects to likelihood of confusion: the first is mistaking one mark for another, whilst the second is where the relevant segment of the public may well perceive that the contesting marks are different but yet remained confused as to the origin which each mark signifies; they may believe that the goods/services bearing the two marks come from the same trade source or that there is some economic link or association between them (see *Caesarstone* at [57]; *Hai Tong* at [74]).

48 Above, I have found that the marks are similar to a significant degree. It is also undisputed that the goods and services are identical. Given this, even if average consumers of software and videogames might perceive that the competing marks are different, they may yet be confused into thinking that the goods/services under the Application Mark are from the Opponent or from an economically linked trade source. The logical conclusion on the facts is that there would be a likelihood of confusion. As such, I would allow the opposition under s 8(2)(b) TMA and refuse to register the Application Mark.

49 Technically speaking, this brings the analysis under s 8(2)(b) TMA to a close. No other findings are necessary to dispose of this ground of opposition. However, since the parties have advanced extensive arguments on various factors under the third step of the step-by-step test, I will offer some comments in case they are of assistance elsewhere. All that needs to be said at this point is that they do not alter my view that there would be a likelihood of confusion.

Additional comments

Videogame industry practice

50 There is some evidence to suggest that within the videogame industry, it is not uncommon for game studios and developers to display their house mark (that is: the main trade mark) in a style which is different from how it is conventionally portrayed. These design choices are ostensibly meant to fit the theme or setting of the underlying game. For instance, consider the following ways in which Electronic Arts, Inc., a well-established game studio, has used its “EA” mark in launch trailers.²

- (a) Screen capture from the Harry Potter and the Deathly Hallows (Part 2) videogame launch trailer in 2011:



- (b) Screen capture from the Battlefield Bad Company TV advertisement in 2008:

² Opponent’s Reply SD at OSD-14, pp 56 to 60



(c) Screen capture from a Warhammer Online cinematic trailer in 2008:



51 This approach is also adopted by other game developers. Below, I provide some examples of the ways in which another well-established developer, Blizzard Entertainment, has used its stylised “BLIZZARD” trade mark in videogame launch trailers.

(a) Diablo III: Reaper of Souls cinematic (2013)



(b) Starcraft II: Legacy of the Void cinematic (2015)



(c) Hearthstone: Heroes of Warcraft cinematic (2013)





There are other examples in evidence from other game developers/studios which show essentially the same thing.³

52 In written submissions, the Applicant argues that even if the relevant public is accustomed to the industry practice described above, they would not expect there to be a significant departure from the original stylisation of the marks in question. (To illustrate: even if the “EA” mark is used in connection with different backgrounds, decorative features and/or in different colours, consumers would still expect to see the essential features of the stylised “EA”.)

53 While I agree, respectfully, this misses the larger point. And the point is this: here, the earlier mark in question is a plain word mark: “AMAZON”. The stylistic features in the Application Mark are minor. Hence, it is quite conceivable that average consumers of software and online video games would perceive the Application Mark as a variant or iteration of the Plain AMAZON Mark. This supports a finding of likelihood of confusion.

Significance of TM symbol

54 The parties discussed the significance of the “” symbol at the top right of the “” (see enlarged Application Mark at [26] above). In my view, it is a very a minor feature that would likely not be noticed given the context (see discussion at [28] above). However, to the extent that it is perceived by the relevant public, it would heighten (rather than lessen) the likelihood of confusion because its placement reinforces the impression that “AMAZON” (and not “SURVIVAL” or “AMAZON SURVIVAL”) is the primary badge of origin.

³ Opponent’s Reply SD at OSD-14, pp 64 to 67





Reputation and acquired distinctiveness


55 I now turn to the related topics of reputation and acquired distinctiveness through use. To be clear, these are separate and distinct concepts. However, what is common is that both reputation and acquired distinctiveness can be increased through use and advertising. And both may in the right conditions increase the likelihood of confusion.

56 First, reputation. There are many things to unpack here, but the gist of it is that a strong reputation may increase or decrease the likelihood of confusion. The rationale is tied to fame: the more average consumers are familiar with a mark, the better their recollection of that mark would be, and they would therefore be more aware as to the differences in another mark. (See *Twitter* at [190]-[191].)

57 As for acquired distinctiveness, the argument typically is that a sign may through sufficient use and/or advertising acquire a secondary meaning as denoting the goods and services of a particular trader. So, in this case, the argument would be that although consumers would ordinarily perceive “Amazon” as a descriptive reference to the Amazon rainforest or the river that runs through it, as a result of the Opponent’s activities, when the term is applied to certain goods and services, they would regard it as a badge of origin for products and services supplied by the Opponent.

58 One difficulty with evaluating the impact of reputation and acquired distinctiveness lies in the fact that the Opponent does not solely market its goods and services by reference to the Plain AMAZON Mark. In this connection, the Applicant tendered evidence relating to Amazon’s brand and logo usage guidelines. It reveals that the Opponent typically uses “amazon” in lower case and in a particular font, together with a distinctive curved right-pointing arrow

“” which points from “a” to “z”.⁴ Indeed, the Opponent’s own evidence shows that in Singapore, the primary marks used are “”, “”, and “”, each of which cohere to the brand/logo usage guidelines mentioned.⁵

59 Since there is no need for me to make any concrete findings in respect of reputation and/or acquired distinctiveness, I do not propose to do so. All I will say is the following. I think that a persuasive case can be made that as a result of the Opponent’s trading activities and advertisements, average consumers would regard the plain word “AMAZON” — even though it may not carry the “” device — as being distinctive of the Opponent in relation to a wide range of goods and services including software and online computer games. If so, this factor would point towards an increased likelihood of confusion. The same could also be said of reputation.

A family of “AMAZON” marks?

60 In the course of its submissions, the Opponent brought up the “family-of-marks” argument. In brief, this doctrine, if it may be called that, provides that where a number of similar marks owned by the same entity (or group of entities) incorporates an identical element (here: said to be “AMAZON”) within the family of marks and another party also applies to register a mark incorporating that element, the public may assume that the junior mark is from the same trade source (see IPOS Trade Marks Work Manual Version 9.1 (November 2022), Chapter 7: Relative Grounds for Refusal of Registration, at pp 44-45). It is well

⁴ Applicant’s SD at Exhibit TJL-1, pp 92-138

⁵ Opponent’s SD at Exhibit OSD-7

established that the party seeking to establish a family of marks has to provide sufficient evidence to show the use of a sufficient number of “members” of the family (see *Monster Energy Company v Glamco Co, Ltd* [2021] 3 SLR 319 at [76]).

61 To my mind, on these facts, the “family-of-marks” analysis is unlikely to differ much from the evaluation concerning reputation and acquired distinctiveness through use. If the Opponent can succeed in showing that “AMAZON” *per se* enjoys good reputation and enhanced distinctiveness through use, it is likely to also succeed in this argument as well.

Other grounds of opposition


62 The Opponent only needs to succeed on one ground of opposition for the Application Mark to be refused registration. Above, I have allowed the opposition under s (8)(2)(b) TMA. Therefore, analysing the other grounds of opposition is nothing more than an academic exercise. This is especially since the Plain AMAZON Mark clearly represents the Opponent’s strongest and most straightforward case against the Application Mark.

63 For each of the other pleaded grounds, the Opponent also needs to clear various other evidentiary hurdles and legal elements. Both s 8(7)(a) TMA (which relate to passing off) and s (8)(4)(b)(i) TMA (which protects earlier trade marks that are well known in Singapore) require the Opponent to establish a likelihood of confusion. In the former, likelihood of confusion is intertwined with a finding of misrepresentation: the second element of the tort of passing off (see *Novelty Pte Ltd v Amanresorts Ltd and anor* [2009] 3 SLR(R) 216 (“*Amanresorts*”) at [77]). As for s 8(4)(b)(i) TMA, case law is clear: the requirement of likelihood of confusion is embedded within the word “connection” (see *Staywell* at [120]). But even before it proves likelihood of

confusion, under s 8(7)(a) TMA the Opponent needs to establish that it enjoys goodwill in Singapore. Similarly for s 8(4)(b)(i) TMA: before reaching the issue of confusing “connection”, it must be first shown that the earlier mark(s) relied on are well known to the relevant sector of the public in Singapore.

64 What then of s 8(4)(b)(ii) TMA? Well, this ground protects trade marks that are well known to the public at large: a rare and exclusive class (see *Amanresorts* at [233]) that can only be recognised on the basis of proper evidence. Unlike the other pleaded grounds, there is no need to establish a likelihood of confusion. But there is still a need to show dilution or the taking of unfair advantage of the distinctive character of the earlier mark.

65 To be absolutely clear, I am by no means saying that the Opponent cannot establish the requirements of ss 8(7)(a), 8(4)(b)(i) and/or 8(4)(b)(ii) TMA. Rather, my point is that these other grounds of opposition do not fundamentally add anything to the strength of the Opponent’s case under s 8(2)(b) TMA. After all, the Plain AMAZON Mark is registered for goods and services that are identical to those for which registration is sought under the Application Mark. And the fact that “AMAZON” is a plain word mark means that the Opponent does not need to contend with how the Application Mark can

be distinguished from, say, the stylisation in “”. Put bluntly, if the Opponent cannot succeed under s 8(2)(b) TMA, I find it difficult to envisage a scenario in which it would be able to succeed under any of the other grounds of opposition.

Overall conclusion and costs

66 The Application Mark is refused registration. I would award the Opponent the costs of this action. I have considered the parties’ submissions on

costs and, having regard to all the circumstances, would summarily award the Opponent the sum of S\$ 8,651.19 (all in).

Ong Sheng Li, Gabriel
Principal Assistant Registrar

Mr Zachery Tan and Mr Melvin Pang (Amica Law LLC) for the
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Mr Jon Chan Wenqiang and Mr Harren Yip Shuen Kai (Ravindran
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