

Mitac International Corp v Singapore Telecommunications Ltd and Another Action
[2009] SGHC 137

Case Number : Suit 519/2007, OS 1655/2007
Decision Date : 05 June 2009
Tribunal/Court : High Court
Coram : Lai Siu Chiu J
Counsel Name(s) : Tan Tee Jim SC, Christopher de Souza and Zheng Shaokai (Lee & Lee) for the plaintiff; Gill Dedar Singh, Paul Teo and Roe Yun Song (Drew & Napier LLC) for the defendant
Parties : Mitac International Corp — Singapore Telecommunications Ltd

Trade Marks and Trade Names – Infringement – Registered proprietor of trade marks for computer products suing registered proprietor of trade marks for telecommunications services for infringement – Whether there was identity or similarity in marks and goods – Whether there was likelihood of confusion between defendant's modems and plaintiff's products

5 June 2009

Lai Siu Chiu J:

1 These proceedings involved trade mark disputes in Suit No 519 of 2007 ("S519/2007"), Mitac International Corporation ("the Plaintiff") sought *inter alia* an injunction to restrain Singapore Telecommunications Ltd ("the Defendant") from infringing trade marks registered by the Plaintiff under TM No T0519317J ("the Mio Trade Mark") and TM No T0305450E ("the Mio Digi Walker Trade Mark") (collectively "the Plaintiff's Trade Marks"), an order for delivery up or destruction of all goods, materials and printed matter the use of which would be in breach of the foregoing injunction, as well as an inquiry as to damages or, at the Plaintiff's option, an account of profits. By way of Originating Summons No 1655 of 2007 ("OS1655/2007"), the Plaintiff applied for an order that certain trade marks of the Defendant be declared invalid on the ground that they were registered in breach of s 8(1) and/or s 8(2) of the Trade Marks Act (Cap 332, 2005 Rev Ed) ("the TMA").

2 By an order of court dated 1 August 2008, S519/2007 and OS1655/2007 were consolidated and they were heard together. At the conclusion of the trial, I dismissed the Plaintiff's claims in both actions. The Plaintiff is dissatisfied and has appealed against my decision in Civil Appeal No. 202 of 2008.

The facts

3 The Plaintiff is a company incorporated in Taiwan and has its corporate head office in Taipei. It is and was at all material times in the business of providing computer products, internet appliances, wireless communication products and photoelectric applications and had operations in, *inter alia*, Taiwan, China, North America, Europe and South East Asia.

4 The Plaintiff is and was at all material times the registered proprietor of the following trade marks in Singapore:

- (a) the Mio Trade Mark (**[Image 1*]**), registered under TM No T0519317J in Class 9 in respect of computers, MP3 players, personal digital assistants ("PDAs"), global positioning system ("GPS") devices, portable media players, video game machines for use with televisions, liquid crystal display ("LCD") television sets, mobile phones and cellular phones; and
- (b) the Mio Digi Walker Trade Mark (**[Image 2*]**), registered under TM No 0305450E in Class 9 in respect of cathode ray tubes, computer printers, disc drives, computer keyboards, computer mouses, add-on cards, printed circuit board modules, modems, power supplies, monitors, application specific integrated circuits, scanners, facsimile machines for use with computers, leather cases for cellular telephones, cases for cellular telephones, hands-free handsets for cellular telephones use in cars, holders for cellular telephones use in cars, computers, computer software, PDAs, telephones, telephone answering machines, mobile telephones and cellular telephones.

[*LawNet Admin Note: Images 1 and 2 are viewable only by [LawNet](#) subscribers via the PDF in the Case View Tools.]

The Plaintiff's Trade Marks are and have at all material times been valid and subsisting in Singapore.

5 The Defendant (commonly known as "SingTel") needs little introduction. It is the leading telecommunications group in Singapore. The Defendant was incorporated in Singapore in March 1992 and became a public company in October 1993. It was listed on the Singapore Exchange in November 1993. In October 2008, it was the largest company listed on the Singapore Exchange and was ranked the most valuable brand in the Singapore Brand Awards 2006.

6 On 20 November 2006, the Defendant had registered several trade marks in Classes 9 and 37, including the following trade marks: "Mio Box" in Class 9 under registration number T0625171I; "Mio TV" in Class 9 under registration number T0625165D; "Mio Voice" in Class 9 under registration no T0625189A; and "Mio Plan" in Class 9 under registration number T0625177H. Subsequently, the Defendant restricted the scope of the first two marks and cancelled the next two marks. Thus, by the time of trial, it was the registered proprietor of the following trade marks in Classes 9 and 37 in Singapore ("the Defendant's Trade Marks"):

[Image 3*]	T0625171I	9	Computer modems to enable connection to the Internet
[Image 4*]	T0625165D	9	Set-top boxes to enable connection to the Internet
[Image 5*]	T0625179D	37	Installing, maintaining and repairing apparatuses, instruments, units, devices and machines relating to the field of electronics, computing, on-line facilities, communications and telecommunications.

[Image 6*] T0625191C

[Image 7*] T0625185I

[Image 8*] T0625173E

[Image 9*] T0625167J

[*LawNet Admin Note: Images 3 to 9 are viewable only by [LawNet](#) subscribers via the PDF in the Case View Tools.]

7 The Defendant's ownership and use of the Defendant's Trade Marks in Singapore first came to the Plaintiff's attention in or around January 2007. (The exact nature and scope of this use was disputed by the parties.) It was this ownership and use which led to the Plaintiff's subsequent filing of S519/2007 and OS1655/2007.

The pleadings

8 In its final statement of claim filed on 21 May 2008 ("Statement of Claim (Amendment No 2)"), the Plaintiff claimed that the Defendant had infringed the Plaintiff's Trade Marks under s 27(1) of the TMA by using in the course of trade in Singapore signs which were identical with the Plaintiff's Trade Marks in relation to goods which were identical to goods for which the Plaintiff's Trade Marks are registered.

9 The Plaintiff further claimed that the Defendant had infringed the Plaintiff's Trade Marks under s 27(2) of the TMA by: using in the course of trade in Singapore signs which were identical with the Plaintiff's Trade Marks in relation to goods and services which were similar to goods for which the Plaintiff's Trade Marks are registered, and/or using in the course of trade in Singapore signs which were similar to the Plaintiff's Trade Marks in relation to goods and services which were identical with or similar to goods for which the Plaintiff's Trade Marks were registered, such that there existed a likelihood of confusion on the part of the public.

10 The Plaintiff also claimed that the Defendant had infringed the Plaintiff's Trade Marks under s 31(5) of the TMA by using, in relation to goods and/or services, counterfeit trade marks which were identical with or so nearly resembling the Plaintiff's Trade Marks as to be calculated to deceive.

11 The Plaintiff averred that, from a date unknown to it, the Defendant had been advertising, promoting and/or selling goods (namely computers; computer software; computer printers; computer keyboards; monitors; LCD televisions; televisions; computer software for use in delivering and receiving video-on-demand services, downloading an audio/video stream from a global computer network, work processing, organization of data, accessing the internet; cellular phones; mobile phones and telephones) under or by reference to the trade marks set out at [\[6\]](#) above as well as the marks "mio Mobile", "mio" and "Generation mio" (which were unregistered). I shall refer to the Defendant's Trade Marks and the unregistered SingTel mio marks collectively as "the marks complained of". It also averred that the Defendant had been advertising, promoting and/or selling services used with or in relation to these goods. According to the Plaintiff, despite its request to the Defendant to cease and desist the uses complained of, the Defendant threatened and intended to continue with the said acts.

12 In its most recent defence filed on 6 June 2008 ("Defence (Amendment No 1)"), the Defendant admitted that the Plaintiff was the registered proprietor of the Plaintiff's Trade Marks and that those trade marks were at all material times valid and subsisting in Singapore.

13 It admitted that it had registered the Defendant's Trade Marks but denied the particulars of infringement stated in the Statement of Claim (Amendment No 2) and set out at [\[9\]](#) above. In particular, the Defendant averred that the marks complained of were neither identical nor similar to the Plaintiff's Trade Marks. Further or alternatively, the goods or services in relation to which the Defendant used the marks complained of were neither identical nor similar to those in respect of which the Plaintiff's Trade Marks were registered.

14 Further or alternatively, the Defendant denied that there was any likelihood of confusion arising from the Defendant's use of the marks complained of, whether as alleged in the Statement of Claim (Amendment No 2) or at all, *inter alia* because:

- (a) the marks complained of were used in relation to the Defendant's integrated mobile, fixed line and broadband services only ("the Defendant's mio services");
- (b) the Defendant's mio services were always promoted in conjunction with the Defendant's "SingTel" trade mark;
- (c) the Defendant did not offer for sale any goods under the marks complained of; and
- (d) the Defendant's mio services could only be obtained by way of a subscription with the Defendant, the process of which would eliminate any likelihood of confusion.

15 The Defendant denied that it was in violation of s 31(5) of the TMA. It averred that the marks complained of did not constitute counterfeit trade marks, nor were they identical with or nearly resemble the Plaintiff's Trade Marks. Further or alternatively, the Defendant averred that its goods or services under the marks complained of were not falsely represented as being the goods of the Plaintiff.

16 The Defendant contended that, in addition to the Defendant's Trade Marks set out at [\[6\]](#) above, it was also the registered proprietor of mio trade marks in Classes 38, 41 and 42 (eg, "mio Box" in Class 38 under registration number T0625174C). Pursuant to s 28(3) of the TMA, use of its registered trade marks in relation to the goods and/or services for which those marks were registered did not amount to infringement.

17 The Defendant contended that the Plaintiff had not suffered nor would it in future suffer any loss or damage resulting from the Defendant's use of the marks complained off and concluded that the Plaintiff was not entitled to the relief sought or any relief.

18 In its reply ("Reply (Amendment No 1)"), the Plaintiff essentially denied all the Defendant's averments and contentions as detailed above. It maintained that the Defendant had not only used the marks complained of in relation to its integrated mobile, fixed line and broadband services but had also been offering for sale and/or selling goods including and not limited to, mobile phones in relation to or with reference to the marks complained of.

19 The Plaintiff further maintained that the Defendant had registered trade marks with the word "mio" in Class 9 for goods including software, electronic publications and telecommunications

apparatus (including modems). I note that by the time of trial, however, these goods were restricted to modems and set-top boxes (see [\[6\]](#) above).

20 The Plaintiff maintained that the Defendant had also used the marks complained of in respect of services which were confusingly similar to the goods and services offered by the Plaintiff under the Plaintiff's Trade Marks.

21 The Plaintiff contended that the likelihood of confusion arose from the way the Defendant had been using and/or promoting the marks complained of and was not affected or negated by any subscription process instituted by the Defendant.

22 The Plaintiff admitted that the Defendant was the registered proprietor of the marks referred to in [\[6\]](#) above but averred that the registration of each of the said marks was invalid pursuant to s 23 read with s 8 of the TMA. The Plaintiff averred that this was why it had taken out OS1655/2007 to invalidate nine of the Defendant's trade marks which had proceeded to registration (of which four were by the time of trial either restricted or cancelled: see [\[6\]](#) above).

The evidence

23 The Plaintiff called two witnesses to prove its case while the Defendant had four witnesses.

The Plaintiff's case

24 The first witness for the Plaintiff was James Yuan ("Yuan"), the Vice President and General Counsel of the Plaintiff's Legal Affairs Office.

25 Yuan (PW1) deposed that in addition to selling computer products, internet appliances as well as wireless communication products, the Plaintiff also provided technical support and services for the above.

26 Yuan deposed that, since in or about February 2003, the Plaintiff had offered to sell and sold goods in Singapore under the Plaintiff's Trade Marks. The sales turnover in Singapore for the goods amounted to about \$1.97m in 2006 and about \$4.65m in 2007 (until September). Yuan further averred that the Plaintiff had expended considerable money and effort in promoting, marketing and advertising in Singapore goods and services bearing the said trade marks. The expenditure amounted to about \$28.7m in 2006 and about \$34.5m in 2007 (until September).

27 Yuan exhibited in his second affidavit dated 19 September 2008 sample copies of the Defendant's newspaper advertisements ("the sample copies of the Defendant's newspaper advertisements") showing that the marks complained of were used (as part of the Defendant's efforts to promote its services) in relation to goods within the specifications of the Plaintiff's Trade Marks, in particular, mobile phones, cellular phones, telephones, LCD televisions, monitors, telecommunications apparatus (including modems), computers, computer keyboards and computer software.

28 In the same affidavit, Yuan also exhibited a CD of six of the Defendant's television commercials, entitled "Arrival", "Treadmill", "Flirt", "Piggy", "Mio TV Countdown" and "Mio TV Neighbours" respectively (collectively "the Defendant's TV commercials"). Yuan pointed out that the Defendant's TV commercials prominently featured goods covered by the Plaintiff's Trade Marks, in particular, the same goods referred to in [\[27\]](#) above.

29 Yuan contended that the Defendant must have been aware of the Plaintiff's Trade Marks and

use thereof in Singapore prior to the Defendant's applications to register or use of the marks complained of, because by November 2006 when the Defendant applied to register the Defendant's Trade Marks at the Intellectual Property Office of Singapore (IPOS), the Plaintiff's applications for registration of the Plaintiff's Trade Marks had already been advertised and were available for public inspection; the Plaintiff's websites www.mitac.com, www.mio.com and www.mio.com.sg had been operational and accessible for some years; the Plaintiff had used the Plaintiff's Trade Marks and other mio marks extensively in Singapore for some years (see [\[26\]](#) above); and the Plaintiff and its subsidiaries, Mio Technology Ltd and Mio Technology Corporation, were already well-known in the computing and mobile telecommunications fields.

30 On cross-examination, Yuan conceded that the documentary evidence of sales of the Plaintiff's mio products placed by the Plaintiff before the court only pertained to sales commencing in the year 2006, and only of GPS navigation systems and PDA phones.

31 Yuan was also unable to identify the services of the Defendant which allegedly infringed the Plaintiff's Trade Marks. Furthermore, he did not dispute that the Defendants did not sell any goods of the type covered by the Plaintiff's Trade Marks (*eg.* Television sets) (apart from the mio Box) and conceded that there could therefore never be any confusion in respect of such goods.

32 Yuan also conceded that, in respect of the mio Box, there could be no confusion because customers who wished to purchase the mio Box would know that it was a SingTel product since such customers had to buy the product from the SingTel shop and the box itself bore the SingTel mark. In respect of the mio TV set-top box, he agreed that there could be no confusion because the customers had to lease the mio TV set-top box from SingTel.

33 Yuan conceded that no survey had been commissioned by the Plaintiff to determine whether there was any confusion in the market in Singapore between the Plaintiff's products and the Defendant's products and services. However, he explained that this was because the Plaintiff's claim was that there was a likelihood of confusion and therefore evidence of actual confusion was unnecessary. He conceded that no evidence of any actual confusion in the marketplace had been adduced by the Plaintiff.

34 Yuan was shown a trade mark (**[Image 10*]** (Registration No T0801970H)), separately registered by the Plaintiff on 18 February 2008, of the stylised "M" in the Plaintiff's Trade Marks. He agreed that for the Plaintiff to secure registration of this particular element of the Plaintiff's Trade Marks, the Plaintiff would have considered that element distinctive enough as a trade mark.

[*LawNet Admin Note: Image 10 viewable only by [LawNet](#) subscribers via the PDF in the Case View Tools.]

35 The Plaintiff's second witness was I-Chun Liu ("Liu"), the Senior Manager of the Plaintiff's Brand Marketing Division. Liu (PW2) deposed that the Plaintiff's Trade Marks had been used in Singapore since 2002 in relation to the goods specified at [\[4\]](#) above. She gave sales figures of the Plaintiff's Singapore sales for the years 2002 to 2007. Invoices showing the sales of PDAs and GPS devices with reference to or under the Plaintiff's Trade Marks in 2006 and 2007 were exhibited. On cross-examination, Liu admitted that the goods in those invoices were shipped directly to Hong Kong albeit sold to companies in Singapore.

36 Liu averred that the Plaintiff had expended considerable money and effort in promoting, advertising and marketing its goods and services under the Plaintiff's Trade Marks and set out its advertising and marketing expenditure for the years 2002 to 2007. No documentary evidence of such

expenditure was exhibited and on cross-examination she revealed that the figures given were for the Plaintiff's worldwide advertising and marketing expenditure. She averred that the Plaintiff's advertising and promotional activities in Singapore included participation in an IT show at Suntec City and a IT trade show called "CommunicAsia". However, on cross-examination she admitted that the only documented promotional activities conducted by the Plaintiff were these two IT shows and some advertising for the sale of the products at Carrefour Hypermarket in 2006. She conceded that the Plaintiff did not advertise its products in Singapore under the Plaintiff's Trade Marks on the radio, on television, in newspapers or in Singapore magazines.

37 On cross-examination, Liu admitted that the Plaintiff provided technical and service support for its goods in Taiwan, not Singapore.

The Defendants' case

38 The first witness for the Defendant was Derrick Heng ("Heng"). Heng (DW1) first joined the Defendant in 1998. Prior to that he had worked for three years in Dentsu Young & Rubicam ("DYR"), the advertising agency that serviced the SingTel account. He became Director (Segment Marketing and Communications) of the Consumer Business Division of the Defendant in 2006. His responsibilities as such a director involved overseeing promotions targeted at various customer segments (eg, youths, the pre-paid market, value-seekers), marketing communications work, as well as overseeing how well the SingTel brand was received in Singapore.

39 Heng averred that the Defendant owned and operated its own retail outlets known as SingTel hello! stores. In October 2008 (the date of Heng's affidavit of evidence-in-chief [AEIC]), the Defendant had 10 hello! stores located at various parts of Singapore. It also had over 100 exclusive retailers which were owned and operated by third parties but which sold exclusively SingTel's services.

40 Heng revealed that, in August or September 2006, the Defendant was looking to offer some of its key services in an "all-in-one" (as it was internally referred to) package, to bring more value for its customers. The Defendant tasked him to come up with a name or sub-brand for this package.

41 According to Heng, DYR and a digital agency Crayon Digital were engaged to come up with a suitable name. After various options for names had been mooted, the Defendant then engaged a market research firm Synovate to solicit customer feedback on the various options. Synovate conducted market research between 4-5 September 2006 by testing six name options with focus groups comprising people selected by Synovate who were representative of the population. Its market research findings showed that the focus groups' response to "mio" was more positive than to other potential names.

42 Heng exhibited e-mail correspondence showing that on 27 September 2006, his assistant Sally Lee ("Lee") had contacted a member of SingTel's in-house legal team, Leslie Tham ("Tham"), and asked him to conduct a search for "mio" trade marks registered in respect of the services that SingTel intended to provide under the "mio" name. On cross-examination, Heng clarified that he left the details of the search to the legal team and did not instruct them to search for products using "mio" trade marks. On 28 September 2006, Tham replied as follows:

Hi Sally,

Please see the attached preliminary search report.

This search only covers telecommunications and related services.

It appears that there is no identical mio mark that has been previously registered.

If you plan to use the mio mark for other goods and services (eg, retail services or advertising services), please let me know as we will have to check each class of items individually.

43 On 29 September 2006, Lee replied:

Hi Leslie

Thanks for the prompt reply.

Just want to be more "kia-su", is IPTV [mio TV] considered as *telecommunications and related services*?

[emphasis added]

44 Tham's response on 29 September 2006 was as follows:

Hi Sally,

No problem. Yes I think IPTV is under this class.

45 According to Heng, subsequently (on 3 October 2006), his contact at DYR one Andrew Tu, informed him by e-mail of a GPS/PDA product marketed under the "mio Digi Walker" brand and a jewellery line marketed under the name "mio". The e-mail attachment stated that "Mio Technologies and Mio DigiWalker is [*sic*] of primary concern as it is in a related category of telco-communication products marketed since 2002."

46 Heng exhibited his e-mail response dated 3 October 2006, which read:

Hi,

FYI – our search showed that no identical mio mark has previously been registered based on *telco services*.

[emphasis added]

47 Heng averred that the name "mio" was selected in October or November 2006 by a group of key stakeholders taking into account the market research. He was part of this group, which also included various marketing directors, the Vice-President (Consumer Marketing) and CEO (Singapore). (These other members of the group were not called to testify.) He maintained that the group had gone on to choose "mio" despite its awareness of the Plaintiff's Trade Marks because the group was of the view

that SingTel was not in the business of manufacturing or selling GPS/PDA products or jewellery, and also because "mio" was to be used as a sub-brand offered under the primary SingTel brand. The Defendant's Trade Marks were subsequently filed on 20 November 2006 (as mentioned at [\[6\]](#) above).

48 Heng averred that "mio" was a sub-brand used by the Defendant to refer to a specific range of SingTel services focusing on a customer's experience at home and marketed under the umbrella term "Generation mio". He averred that there were no goods or services associated with the umbrella term "Generation mio". Instead, the Defendant provided its various services ("the Defendant's mio services") under various "mio" trade marks (*viz*, the marks complained of), namely:

- (a) "mio Plan": A service plan that bundled the "mio Voice", "mio Mobile" and a SingNet Broadband internet access plan.
- (b) "mio Voice": A service that allowed a customer to enjoy unlimited outgoing calls on a fixed line. This service required a modem device known as a "mio Box" to enable it.
- (c) "mio Mobile": A service that allowed a customer to enjoy free and unlimited outgoing calls on his mobile phone using the internet. While a supported handset was needed to enjoy the service, this handset was not bundled by default.
- (d) "mio TV": A pay TV service launched in July 2007. To enjoy the service, the customer must have a television set (which was not bundled with the service), a "mio TV set-top box" (which was leased to the customer and could not be purchased) and the mio Box (see (b) above).

49 Heng stated that the Defendant's advertisement and promotion expenditure for the services provided under the marks complained of focused mainly on the "mio Plan" bundle and the "mio TV" service. As of October 2008, the Defendant had spent over \$12m on advertising and promoting the "mio Plan" bundle and "mio TV" service alone. Heng tendered originals of the full-page coloured newspaper advertisements leading up to the launch of the Defendant's mio services ("the Defendant's full-page newspaper advertisements"). He explained that the first advertisements on 8 January 2007 did not contain the SingTel trade mark because it was a teaser campaign. The subsequent advertisements on 9 and 10 January 2007 explicitly carried the SingTel trade mark.

50 Heng stated that the Defendant's mio services could only be obtained via a subscription with the Defendant. About 70%–80% of walk-in customers who wished to subscribe to these services signed up at SingTel's hello! stores, while the rest signed up at its exclusive retailers (see [\[39\]](#) above). On cross-examination, he accepted that customers who subscribed to the services at Singtel's hello! stores or exclusive retailers could at the same time purchase cellular or mobile phones, albeit these handphones would be products of other companies, *eg*, Nokia, Ericsson.

51 Heng asserted that the Defendant did not use any of the marks complained of on cathode ray tubes, computer printers, disc drives, computer keyboards, computer mice, add-on cards, printed circuit board modules, power supplies, monitors, application specific integrated circuits, scanners, facsimile machines for use with computers, leather cases for cellular telephones, cases for cellular telephones, hands-free handsets for cellular telephones use in cars, holders for cellular telephones use in cars, computers, computer software, PDAs, telephones, or telephone answering machines. He acknowledged that the "mio" mark appears on the mio Box and the mio TV set-top box but pointed out that the "mio Box" and "mio TV" marks were always seen together with the SingTel logo. He averred that, apart from the mio Box, SingTel did not sell goods under any of the marks complained

of.

52 Heng testified that he was the key contact person for any customer complaints pertaining to marketing. From January 2007 (when the Defendant's mio services were launched) until the date of trial, he was not aware of any instances of complaints or confusion amongst the public in respect of the Defendant's mio services and the Plaintiff's mio Digiwalker PDA/GPS products.

53 Heng revealed that the Defendant had commissioned a company Millward Brown to conduct surveys on a six-monthly basis after the launch of its "mio" services in January 2007, to gauge the impact of SingTel's advertising of its "mio" services on consumers. He testified that the survey had fulfilled the Defendant's objective because the results showed that while the consumers were not very sure what exactly the "mio" services entailed, they were aware that "mio" is a bundled offering and hence should offer better value.

54 The Defendant's second witness was Andrew Sim ("Sim"). Sim (DW2) had been employed by the Defendant for almost nine years. At the time of trial he was a Director (Network Operations) of the Defendant, a position he had held for two and a half years. As part of his job, he oversaw field operations, which comprised the installation of broadband services, dial-up internet connections and the Defendant's fixed line services, as well as the maintenance of these services.

55 Sim testified that the mio Box was an integral product for Generation mio because it was used to enable and provide the services under Generation mio. He agreed that the mio Box was in essence a modem.

56 Sim testified that all installation and maintenance services in respect of the hardware (*viz*, the mio Box and mio TV set-top box) required for SingTel's mio services were carried out by the Defendant and that the Defendant did not provide these services under the marks complained of. Rather, after a customer signed up for any of the Defendant's mio services, a SingTel representative (either a SingTel engineer or a third-party contractor) who was required to wear attire bearing the SingTel trade mark, would go to the customer's premises to install and configure the hardware. Upon completion of a job, the representative would give the customer a Service Report and/or Confirmation of Job Done, both of which bore the SingTel trade mark. Similarly, if the customer subsequently experienced difficulties with his mio service(s), a SingTel representative would go on site to attempt to solve the problem and upon completion of the job, the customer would receive a Service Report and/or Confirmation of Job Done bearing the SingTel trade mark.

57 The Defendant's next witness was Arif Lukman ("Lukman"). Lukman (DW3) had been employed by the Defendant for over 11 years and at the time of trial had been its Business Manager (Retail Sales) for around two years. He managed three SingTel hello! shops and oversaw the standard operating procedures as well as monitored the sales targets and customer service levels at these shops.

58 Lukman elaborated on the various methods of signing up for the Defendant's mio services: namely, in person, by telephone or online (though some methods were not applicable to certain services). In essence, his evidence was that the sign-up processes made it clear that the services to which the customer was subscribing were offered by SingTel, whether because sign-up was done in a SingTel store, because the website featured the Singtel trade mark prominently or the hotline number for subscription was a SingTel hotline.

59 Lukman clarified that customers could obtain the mio Box for free by signing up for SingTel broadband, mio Voice or mio TV, while existing SingTel customers could purchase it for about \$350. A

mio Box could only be purchased from a SingTel hello! store.

60 Lukman averred that since January 2007, the Defendant had organized and/or participated in seven road shows to promote its mobile and broadband services (including the Defendant's mio services). Lukman had participated in four of them and did not encounter anyone asking about the Plaintiff's mio DigiWalker product at these roadshows. He also said that he had not been informed by or received any feedback from, the managers of the SingTel hello! shops under his charge regarding any customer being confused between the Plaintiff's mio DigiWalker product and the Defendant's mio services.

61 During cross-examination Lukman explained that the mio Box was in fact bundled in most of the Defendant's mio services, namely, mio Plan, mio TV and mio Mobile. Like Sim, he agreed that it was an integral device for the purposes of mio Plan and mio Voice. However, he maintained that it was a device to facilitate the provision of the Defendant's mio Services and not a product in itself.

62 The last witness for the Defendant was Gonzalo Fuentes ("Fuentes"). By the time of trial he had been the Manager of Millward Brown South East Asia ("Millward Brown") for around two years. Millward Brown was a market research consultancy that had been in business since 1973. Its business involved gathering information on customers' perception of brands. Fuentes personally led and managed the Defendant's account with Millward Brown. He helped design the research for, analyzed and presented the results of market surveys conducted for the Defendant, including the surveys commissioned by the Defendant beginning in 2007 (see [\[53\]](#) above) ("the Millward Brown surveys").

63 Fuentes explained that the purpose of the Millward Brown surveys was to find out the public's perception of the Defendant's mio services in order to assess the success of their launch in January 2007. There were three such surveys. Each time a survey was completed, Fuentes would present a report to the Defendant. The survey questionnaires and reports were produced in court. The reports showed that the Defendant was the most well-recognized telecommunications service provider in the Singapore market (as compared with other telecommunications service providers *eg*, StarHub, M1, Pacific Internet).

64 As part of the surveys, the survey respondents were shown slides from the Defendant's advertisements on television or in print on which the SingTel brand or mio sub-brand were not readily apparent and asked if they had seen the advertisement before and if so, which brand they thought the advertisement referred to. Although there was some misattribution (*ie*, a certain proportion of the survey respondents identified the advertisements as being for brands other than SingTel), none referred to the Plaintiff's mio DigiWalker.

65 During cross-examination, Fuentes conceded that it was possible that the reason why no respondents had referred to the Plaintiff's mio DigiWalker or the Plaintiff when asked to identify the advertisements was due to the fact that the survey questions leading up to that point were all concerned with the respondents' knowledge of and impressions of the services provided by telecommunications service providers in Singapore (including StarHub, M1, etc) and thus it was possible that the respondents had been conditioned to think only of telecommunications service providers in Singapore.

The parties' submissions

(i) The plaintiff's submissions

66 As the grounds for refusal of registration of a trade mark under ss 8(1) and 8(2) of the TMA are *in pari materia* with the acts amounting to infringement under ss 27(1) and 27(2) of the TMA, counsel relied on the same submissions in respect of both S519/2007 and OS1655/2007.

67 Counsel for the Plaintiff submitted that the marks complained of were identical with the Plaintiff's Trade Marks. The generic English words "Voice", "Plan", "Mobile", "Box", "Home", "TV" and "Generation" merely served as a descriptive function, whereas the word "mio" was clearly distinctive and constituted the "idea" of the marks. The descriptive words had no trade mark impact and did not change the identity of the marks (*Compass Publishing v Compass Logistics* [2004] EWHC 520 ("*Compass Publishing*"). The words constituted insignificant differences from the Plaintiff's Trade Marks and would go unnoticed by the average and reasonably well-informed, observant and circumspect consumer of the subject goods and services (*SA Societe LTJ Diffusion v Sadas* [2003] FSR 34 ("*LTJ Diffusion*"). In support of this submission counsel for Plaintiff highlighted amongst other documents the Defendant's full-page newspaper advertisements, in which the word "mio" was used on its own.

68 It was argued that, in the alternative, that the marks complained of were similar to the Plaintiff's Trade Marks. Considered from the perspective of the average consumer of the subject goods or services, the parties' marks were visually, aurally and conceptually similar (*The Polo/Lauren Co, LP v Shop In Department Store* [2006] 2 SLR 690 ("the *Polo* case")). It was said that both parties' marks had two elements, one comprising the distinctive word "mio" and the other comprising a descriptive word. In both, the distinctive and dominant element was clearly the word "mio" which constituted the "idea" of each of the marks. The script and font for both parties' marks shared similar traits of simplicity and definitive clean lines. The layout and typesetting of both marks also placed visual emphasis on the word "mio", in that: the word "mio" in both parties' marks was stylised; the letters in the word "mio" were not aligned in terms of height; and the descriptive word was placed below the word "mio". The concept of the word "mio" related to similar, multi-functional natures of the parties' goods (*eg*, mobile or cellular phones).

69 Counsel for the Plaintiff pointed out that the mio Box is a modem and therefore identical to a product in the specifications of the Plaintiff's Trade Marks. He also submitted that the marks complained of were used in relation to computers, mobile phones, cellular phones, fixed line phones and monitors in the Defendant's newspaper advertisements and television commercials. All these products were part of the specifications covered by the Plaintiff's Trade Marks. Counsel for the Plaintiff highlighted that the Defendant did supply and sell mobile phones (see [\[50\]](#) above).

70 It was also submitted that the mio TV set-top box was similar to a modem and therefore similar to a product within the specifications of the Plaintiff's Trade Marks.

71 It was further argued that the Defendant's restriction and cancellation of its trade marks in Class 9 implied that the Defendant acknowledged that the Defendant's Trade Marks were similar to, if not identical with, the Plaintiff's Trade Marks.

72 The Plaintiff pointed out that the appearance of the "mio Box" and "mio TV" marks *on* the modems and set-top boxes meant that those marks were used *in relation to* those goods. It was further said that the Defendant's Trade Marks were used *in relation to* laptops, mobile phones and telephones, etc (*ie*, goods covered in the specifications of the Plaintiff's Trade Marks) because such goods appeared in the Defendant's newspaper advertisements and television commercials together with the Defendant's Trade Marks.

73 The Plaintiff argued that the likelihood of confusion had to be considered in the light of not only

the actual use of the registered mark but also its notional use in a normal way in respect of the goods or services covered by the registration. Thus, it should not matter even if there was no use of the Plaintiff's Trade Marks in Singapore (although counsel maintained that there had been such use at the IT shows mentioned at [\[36\]](#) above). In its closing submissions, the Plaintiff suggested that it intended to introduce in Singapore modems under its Trade Marks.

74 The Plaintiff contended that the Defendant's position that (i) there was no evidence of actual confusion in the Singapore market and (ii) that the Plaintiff had failed to conduct any survey to obtain such evidence was unsustainable since, in order to succeed in a claim under s 27 of the TMA, the claimant was only required to show a likelihood of confusion and not actual confusion.

75 Counsel for the Plaintiff submitted that, applying the *Polo* case, the Defendant's use of the Defendant's Trade Marks gave rise to a likelihood of confusion because: the dominant and distinctive component in both parties' marks was the word "mio". Even allowing for imperfect recollection by customers, it was likely that the reasonable consumer would believe that the parties' goods emanated from the same or economically-linked sources, especially since the Millward Brown survey revealed that consumers were not sure of the nature of goods and/or services offered under the "mio" mark and the parties' marks were used in the same telecommunications field.

76 It was further said that the Defendant's provision of installation and maintenance services was in law similar to the modems, computers and telephones which were the subject of the installation and maintenance process (relying *inter alia* on *British Sugar v Robertson* [1996] RPC 281 ("*British Sugar*") and *Registrar of Trade Marks v Woolworth* [1999] 93 FCA 365). Based on the "global assessment" test as well as the actual or notional use of the Plaintiff's Trade Marks in relation to its Class 9 goods, the average consumer was likely to wrongly believe that the Defendant's installation and maintenance services came from an undertaking that was associated in some way with the Plaintiff.

77 Finally, it was argued that the Plaintiff's claim under s 31(5) of the TMA should succeed because first, under the old common law, the phrase "so nearly resembling the registered trade mark as to be calculated to deceive" meant "so nearly identical as to be confusing" (*Alex Pirie* case (1933) 50 RPC 147 at 152) and "calculated to deceive" did not necessarily involve any intention to deceive (*Lyndon's Trademark case* (1886) 32 Ch D 109)). It was suggested that the law on this aspect had not changed under the TMA. Secondly, the court should show no sympathy for the Defendant's reckless actions in proceeding to register the Defendant's Trade Marks notwithstanding its undisputed awareness of the Plaintiff and the Plaintiff's Trade Marks (see [\[47\]](#) above).

(ii) The defendant's submissions

78 Counsel for the Defendant pointed out that the Defendant did not provide the mio services under its "mio" trade marks in Class 37. Rather, the mio services were provided under trade marks registered in, *inter alia*, Classes 38 and 41, to which trade marks the Plaintiff had no objection.

79 Counsel for the Defendant submitted that the marks complained of were not identical with the Plaintiff's Trade Marks. He relied on *Nation Fittings v Oystertec* [2006] 1 SLR 712 ("*Nation Fittings*") (in which the court quoted with approval *LTJ Diffusion* – a case which, ironically, the Plaintiff itself relied on: see [\[67\]](#) above) to contend that the test for identity was a strict one and the two marks should be the same in all respects. He also contended that both aural and visual identity are required (citing *Kerly's Law of Trade Marks and Trade Names* (David Kitchen et al, 14th ed, Sweet & Maxwell, 2005) ("*Kerly's*"); *Reed Executive PLC v Reed Business Information Ltd* [2004] RPC 40 ("*Reed*"). Thus, the test for identity was not met because: visually, a distinctive element of the Plaintiff's Trade

Marks, the stylized "M" (see [\[4\]](#) above) was absent from all of the Defendant's Trade Marks and the added elements of the words "Voice", "Plan", "TV", "Home", "Box" or "Mobile" were not so minute that the marks being compared would still be "identical"; aurally, the Plaintiff's Trade Marks would be pronounced "Mio" whereas the marks complained of would be pronounced "mio Voice", "mio Box", and so on. Counsel concluded that an average customer would not consider the Plaintiff's **[Image 11*]** and the Defendant's marks to be identical and *a fortiori*, the Plaintiff's **[Image 12*]** which contained the additional "DigiWalker" element was not identical to the Defendant's marks.

[*LawNet Admin Note: Images 11 and 12 are viewable only by [LawNet](#) subscribers via the PDF in the Case View Tools.]

80 The Defendant did not dispute that the marks complained of had been used "in relation to" the mio Box and mio TV set-top box and that these products, being essentially modems, were identical to goods within the specifications of the Plaintiff's Trade Marks. Rather, counsel for the Defendant submitted that there was no likelihood of confusion arising from such use (the submissions on likelihood of confusion are set out below at [\[84\]](#)).

81 Counsel for the Defendant argued that apart from the mio Box and the mio TV set-top box, the marks complained of did not appear on its goods. It was said that the Defendant was providing services and not goods under the marks complained of. Although mobile phones, desktop computers, LCD monitors and/or telephones appeared in the Defendant's newspaper advertisements, when these newspaper advertisements were viewed in their context and in their entirety, it was clear that (i) the marks complained of were used in relation to the *services* being offered and (ii) that these *services* were offered by the Defendant.

82 Counsel for the Defendant pointed out that the Plaintiff had neither specified nor adduced evidence of the services provided by the Defendant which allegedly infringed the Plaintiff's Trade Marks.

83 Hence, the issue of whether confusion was likely arose only in relation to the Defendant's use of the marks complained of on the mio Box and the mio TV set-top box.

84 Counsel for the Defendant then relied on *McDonald's Corp v Future Enterprises Pte Ltd* [2005] 1 SLR 177 ("the *McDonald* case") and the *Polo* case to say that there was no such likelihood of confusion *inter alia* because: first, the Plaintiff had not adduced evidence to show that "mio" had become distinctive of it and indeed, had admitted that there was a big difference in terms of money invested in the promotion undertaken by the Plaintiff and Defendant in promoting their respective mio trade marks.

85 Secondly, the Defendant had established itself as a well-known telecommunications service provider under the brand SingTel with "mio" being used as a sub-brand. The Defendant's SingTel mark was always found in conjunction with the marks complained of.

86 Thirdly, the Defendant's mio Box could only be obtained from its hello! stores and the mio TV set-top box was not available for sale and only leased to the customer upon subscription to the Defendant's mio TV service.

87 Fourthly, the customers of the Plaintiff's modems (if any) and the Defendant's mio Box and mio TV set-top box would be different. The Defendant's goods were offered to enable the Defendant's services. A customer looking to subscribe to the Defendant's mio services would not want to purchase the Plaintiff's mio digiwalker or other items specified in its registrations as an alternative.

88 Fifthly, the process of subscribing to the Defendant's mio services made it impossible for any confusion to arise.

89 Further, the process of installing or maintaining the Defendant's home gateway or set-top box also left no room for doubt that it was the Defendant's mio service which the customer was subscribing to.

90 Counsel for the Defendant emphasised that the Plaintiff had not adduced any evidence (including any survey results) of confusion in the market place. It relied on authorities (including the High Court decision in *Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2005] 4 SLR 816 ("the High Court's decision in the *Polo* case") to show that, while the test was not one of actual confusion, the likelihood of confusion must not be speculative and thus, actual confusion was a useful and relevant factor in assessing the likelihood of confusion.

91 Finally, counsel submitted that it was clear that the Defendant had never intended to deceive the public by its use of the marks complained of. There was a proper selection process and deliberation before the "mio" mark was decided upon. The Plaintiff had adduced no evidence of any deception. The evidence also showed that the Defendant had not falsely represented its services to be those of the Plaintiff's. Indeed, the Plaintiff did not provide services.

The applicable law

Identity

92 The test for identity of marks is a strict one. In *Nation Fittings* (see [79] above), the registered proprietor of trade marks ("Oystertec") for pipe fittings brought an action under s 27(1) of the TMA against a supplier of pipe fittings ("NF"). Oystertec had to show that the pipe fittings of NF were either identical with or similar to Oystertec's registered marks. NF's pipe fittings were three-dimensional, whereas Oystertec's marks were two-dimensional marks registered under the previous Trade Marks Act. Justice Andrew Phang quoted (at [78]) with approval the *LTJ Diffusion* decision at [50]:

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

The *LTJ Diffusion* decision further states (at [51]): "There is therefore identity between the sign and the trade mark where the former reproduces, *without any modification or addition*, all the elements constituting the latter. [emphasis added]"

93 It should however be noted that the court in *Nation Fittings* had already determined the case on a separate issue and therefore those remarks were strictly *obiter*. Regard should also be had to an important gloss in *LTJ Diffusion*. It was said (at [52]–[53]):

52 However, the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect. The sign produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind. Moreover, his level of attention is likely to vary according to the category of goods or services in question...

53 Since the perception of identity between the sign and the trade mark is not the result of a direct comparison of all the characteristics of the elements compared, *insignificant differences between the sign and the trade mark may go unnoticed by the average consumer*. [emphasis added]

Thus, the law may be summarised as follows: there is identity between any sign/mark complained of and the registered trade mark where, first, the former reproduces *without any modification or addition* all the elements constituting the latter, or where viewed as a whole, the sign/mark complained of contains differences *so insignificant* that they may go unnoticed by an average consumer.

94 The law on the effect of additions to a trade mark (usually the addition of a generic word or suffix such that the mark/sign complained of becomes a composite mark/sign) remains unsettled. It has been said that the determination of whether the composite mark/sign is identical to the registered trade mark turns on the question of whether the addition has “trade mark significance” (*Kerly’s* at [14-053]). The courts have reached differing decisions in many cases involving this issue. For example, in *Decon Laboratories Ltd v Fred Baker Scientific Ltd* [2001] RPC 293, the English High Court (Chancery Division) held that the marks “Decon-Ahol”, “Decon-Clean”, “Decon-Phase” and “Decon-Phene” were identical to the mark “Decon”. In *Compass Publishing* (also a decision of the English High Court (Chancery Division)), however, it was held that “Compass Logistics” was not identical to “Compass”. Similarly, although in *Pan West Pte Ltd v Grand Bigwin* [2003] 4 SLR 755 it was held that “Katana” and “Katana Golf” were identical, the Court of Appeal noted in the *Polo* case (at [20]) that “there could be a difference of views as to whether ‘Katana’ could really be said to be identical to ‘Katana Golf’”. It is not necessary to try to rationalize these disparate authorities except to say that the question is one of fact and perception since, as shall be seen below, it is possible to distinguish the marks complained of and the Plaintiff’s Trade Marks on the basis of the word “mio” alone without resort to the addition of the generic words (*viz*, “Box”, “Voice”, etc).

95 Finally, it is important to note that the marks must be both visually and aurally identical. As is stated in *Kerly’s* at [14-052]:

[I]n the case of any accused sign which has some visual significance, one must take that into account in considering the question of identity. The visual impact may be slight, but it will count even if the marks are identical to the ear. There can only be “identity” if there is *both aural and visual identity*. (emphasis added)

96 The authority for this proposition of law is found in the case of *Reed* (see [79] above), where Jacob J stated (at [31]–[32]):

Nor do I think it makes any difference to the identity question that trade mark use includes spoken use...in the case of any accused sign which has some visual significance, one must take that into account in considering the question of identity. The visual impact may be slight, but it will count even if the marks are identical to the ear. *You can only have “identity” if there is both aural and visual identity*. [emphasis added]

Similarity

97 I now turn to the law on similarity of marks. In the *Polo* case, the Court of Appeal (at [10]) adopted the approach of the trial judge below (at [26]):

The decided cases suggest that there are three aspects to similarity: visual, aural or phonetic, and conceptual. In terms of visual similarity, it is clear that the mark and the sign share one common denominator: the word "POLO". In cases where there is a common denominator, it is important to look at the differences between the mark and the sign in order to decide whether the challenged sign has been able to distinguish itself sufficiently and substantially...

The trial judge cited "different font and design" as one of the "obvious" differences between the sign complained of and the registered trade mark (at [27]). In the Court of Appeal, the court focused on the question of whether the generic English word "Polo" was sufficiently distinctive and thus did not elaborate on the criteria of visual, aural and conceptual similarity.

98 The Court of Appeal in the *Polo* case also referred with approval *In the Matter of an Application by the Pianotist Company Ltd for the Registration of a Trade Mark* (1906) 23 RPC 774 ("*Pianotist*") and stated (at [24]) that "for the purpose of determining similarity under s 27(2) of the [Trade Marks] Act, one must look at the mark and the sign as a whole".

99 In *Pianotist*, Parker J set out the rules of comparison as follows (at 777):

You must take the two words. You must judge them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks.

100 Guidance can also be found in Tan Tee Jim SC's "*Law of Trade Marks and Passing Off in Singapore*" (2nd ed, Sweet & Maxwell, 2005) at [6.23]–[6.24]:

The marks are to be considered from the perspective of the average consumer of the goods or services in question. He is deemed to be reasonably well-informed and reasonably observant and circumspect and would normally perceive a mark as a whole, rather than analyse its various details. He would rarely have the chance to make direct comparisons between the different marks but would place his trust in the imperfect picture of the marks in his mind.

To such a consumer, visual similarity will usually be the most important factor in respect of device marks (and, to a lesser extent, composite marks consisting predominantly of a device)... In respect of word marks which are aurally and visually similar, the question whether they are conceptually similar becomes important.

101 As to what constitutes conceptual similarity, the case of *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767 ("*Premier Brands*") is helpful. In *Premier Brands*, the proprietor of the "Ty.Phoo" tea sued a supplier of "oriental kitchen hardware" for infringement of three of its trade marks by the use of the mark "Typhoon". Neuberger J held that although there was aural and visual similarity between the marks, there was much less conceptual similarity. He stated (at 781):

So far as conceptual features are concerned, there is much less similarity. TYPHOON is not merely a dictionary word; it is a well known word used in common parlance. TY.PHOO is *an invented mark, and is what is known in this field as a fancy word (or two fancy words separated by a full-stop) with no other meaning*. To some extent, the force of this argument can fairly be said to be blunted by the fact that *the use of the word TYPHOON in relation to kitchenware is arbitrary, in the sense that there is no inherent connection between (a) the word typhoon and its natural dictionary meaning and (b) the goods in connection with which the word is used by [the supplier]*.

[emphasis added]

Use in relation to

102 I turn next to examine the law on what constitutes “use in relation to” goods and/or services. In this respect, the cases decided under the Trade Marks Act 1994 (UK) (on which our TMA is modelled) are relevant. In *Elle Trade Marks* [1997] FSR 529, the proprietors who were publishers of the well-known women’s magazine, “Elle”, registered the mark for various perfumes. To promote the sales of the magazine, they distributed free samples of perfume of another brand as well as invited subscribers to attend spa treatments where they would be given complimentary “Elle” bags containing gifts. The judge rejected the proprietors’ submission that the mark “Elle” appearing on the bags constituted use of the mark in relation to perfumes. He said (at 534) that the mark “was used, if in any context at all other than the magazine, *in relation to the event* and not of the particular goods to be used at or offered in connection with the event. [emphasis added]”

103 In *Premier Brands* (see [\[101\]](#) above), the proprietor of the “Ty.Phoo” mark was an importer and supplier of tea under the mark. It registered the mark in respect of tea as well as domestic utensils and containers. It applied the mark on domestic utensils and containers (such as tea canisters, tea pots, mugs and biscuits barrels) to promote its tea. Most of these promotional goods were given away free. The supplier (the defendant) applied to revoke the registration of the “Ty.Phoo” mark in respect of domestic utensils and containers on the ground that there was no genuine use of the mark in relation to the said goods.

104 In dismissing the application, Neuberger J stated (at 806) that it was right to go back to the nature and purpose of a trade mark, *viz*, “to guarantee the identity of the origin of the marked product to the consumer” (quoting from *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 at 133). Thus, it was a matter of how the public perceived the usage. He stated (at 806–07):

So far as conceptual features are concerned, there is much less similarity. TYPHOON is not merely a dictionary word; it is a well known word used in common parlance. TY.PHOO is *an invented mark, and is what is known in this field as a fancy word (or two fancy words separated by a full-stop) with no other meaning*. To some extent, the force of this argument can fairly be said to be blunted by the fact that *the use of the word TYPHOON in relation to kitchenware is arbitrary, in the sense that there is no inherent connection between (a) the word typhoon and its natural dictionary meaning and (b) the goods in connection with which the word is used by [the supplier]*.

[emphasis added]

105 The factors on which Neuberger J determined the case are particularly instructive. These were

(at 807):

- (a) in the great majority of cases, the offending goods were obtained by members of the public from the proprietor of "Ty.Phoo" itself;
- (b) in the case of the majority of the goods which it was alleged the "Ty.Phoo mark" was used in relation to (and in fact the mark appeared on these goods) ("the offending goods"), no brand name other than "Ty.Phoo" was found on the goods;
- (c) the offending goods were supplied in part for their own intrinsic merit; and
- (d) although the offending goods were given away, unlike in the case of Elle (see [\[102\]](#) above), the defendant was not indulging in charitable activities but hoped to profit indirectly from the manufacture and distribution of the offending goods.

106 Tan Tee Jim SC in *The Law of Trade Marks and Passing Off in Singapore* (*supra* [\[100\]](#)) suggests that (at [10.50]):

Pending a decision of a Singapore Court, it is suggested that whether there is use "in relation to goods or services depends on *whether those goods or services are the primary or principle items of trade or merely vehicles used to serve other trade objectives*. This is a question of fact and degree, to be considered from the perspective of average consumers of the goods or services in question". [emphasis added]

Similar goods or services

107 The Plaintiff had relied on *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 ("*British Sugar*") as authority for the proposition that goods and services can be similar to each other. In that case, Jacob J stated (at 297):

I do not see any reason in principle why, in some cases, goods should not be similar to services (a service of repair (a service of repair might well be similar to the goods repaired, for instance).

Jacob J listed the following factors as relevant in determining whether there is a similarity of goods and services (at 296–97):

- (a) the respective uses of the goods and services
- (b) the respective users of the goods or services
- (c) the physical nature of the goods or acts of service
- (d) the respective trade channels through which the goods and services reach the market
- (e) in case of self-service consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be found on the same or different shelves

- (f) the extent to which the respective goods and services are competitive.

108 The *British Sugar* approach has been applied in several cases by the Intellectual Property Office of Singapore (*Ismet Nadir Aslan v Oracle International Corporation* [2006] SGIPOS 9 at [36]; *Pt Lea Sanent v Levi Strauss & Co* [2006] SGIPOS 6 at [43]; see also most recently *Astro All Asia Networks plc v Mediacorp News Pte Ltd* [2008] SGIPOS 13 at [59]) as well as by the High Court in *Johnson & Johnson v Uni-Charm Kabushiki Kaisha (Uni-Charm Corp)* [2007] 1 SLR 1082.

Likelihood of confusion

109 Turning to the question of likelihood of confusion, it is clear that after the Court of Appeal's decision in the *Polo* case, even if the earlier requirements (*viz*, identity and/or similarity of marks; identity and/or similarity of goods and/or services) are fulfilled, that does not *ipso facto* mean that there will be confusion in the minds of the public (see the *Polo* case at [8]). In other words, there is no presumption of likelihood of confusion. Rather, the court stated (at [8]):

[Whether there is a likelihood of confusion] is a question of fact to be determined by the court, *taking into account all the relevant circumstances*. ...

... To determine the existence of confusion, the court is *entitled to look outside the mark and the sign, as well as the articles*, to assess whether there exists a likelihood of confusion.

[emphasis added]

110 It elaborated (at [28]):

The question of likelihood of confusion has to be looked at globally taking into account all the circumstances including the closeness of the goods, the impression given by the marks, the possibility of imperfect recollection and the risk that the public might believe that the goods come from the same source or economically-linked sources... But that is not all. Steps taken by the defendant to differentiate his goods from those of the registered proprietor are also pertinent... So also is the kind of customer who would be likely to buy the goods of the appellant and the respondent...

[underlining added]

111 It also appears that the greater the exposure and use of a particular registered mark, the greater its reputation is likely to be, and therefore the greater the likelihood of confusion (see the *Polo* case at [34]). On the other hand, it may also be possible that the registered mark is so well-known that no possibility of confusion arises from the subsequent use of the mark/sign complained of. In *McDonald's Corp v Future Enterprises Pte Ltd* [2005] 1 SLR 177 ("*McDonald's case*"), McDonald's had unsuccessfully sought to oppose another company's registration of "MacTea", "MacChocolate" and "MacNoodles". In dismissing McDonald's appeal, the Court of Appeal reasoned (at [64]):

With widespread education and a public which is constantly exposed to the world, either through travel or the media, one should be slow to think that the average individual is easily deceived or hoodwinked. In fact, the very success of the appellant, which is inseparable from its logo, is also the very reason why confusion is unlikely.

112 As the Court of Appeal in the *McDonald's* case stated (at [66]):

Ultimately, the question whether a proposed mark will likely give rise to confusion on account of some similarity with an existing mark is a question of fact depending on all the circumstances of the case. Besides comparing the marks, also germane are the extent of the reputation of the existing mark, how the proposed mark is to be used, the nature of the goods to which the mark will be put, how the goods are to be sold and who the target customers are...Obviously, these considerations are not exhaustive. The whole question must be looked at sensibly.

113 What then is the significance of proof of actual confusion in the market place? It is clear that the test is for likelihood of confusion and not actual confusion. However, this likelihood of confusion must be a real one and not merely speculative or hypothetical (see the High Court's decision in the *Polo* case at [22]; see also the *McDonald's* case at [59]). The burden lies squarely on the registered proprietor of the trade mark who is bringing the claim for infringement to establish a likelihood of confusion. In this respect, the approach encapsulated in the following passage from *The Law of Trade Marks and Passing Off in Singapore* (at [6.37] and [6.38]) is helpful:

6.37 Where either or both of the trade marks have not been used, the judge is entitled to assume notional use of the marks in a 'normal and fair manner' in respect of the goods or services covered by the registration or application in question and then make an intuitive and speculative judgment about whether there is a likelihood of confusion...

[6.38] On the other hand, where the marks have been in use, it would be useful to adduce evidence to prove likelihood of confusion, such as:

- (1) evidence of witnesses purporting to testify to actual confusion;
- (2) evidence of trade witnesses who have their opinion of the likelihood of confusion; and
- (3) evidence of witnesses who had responded to a survey carried out on behalf of the plaintiff.

The decision

114 I was of the view, even without considering the generic English words in the Defendant's Trade Marks, that the "mio" mark used by both parties were clearly not identical. Although there was aural similarity, there was no visual identity, which from the authorities submitted was clearly necessary for two marks to be considered identical. The "m" in the Plaintiff's Trade Marks was highly stylised and distinctive; Yuan himself conceded that this was the reason that it had been registered as a standalone trade mark (see [\[34\]](#) above).

115 I was also of the view that, from the perspective of an average customer, the parties' "mio" marks were not similar. Contrary to the position taken by counsel for the plaintiff, their script and font were clearly not visually similar. Apart from the fact that the "m" in the Plaintiff's Trade Marks was highly stylised while the "m" in the marks complained of was very plain, I also noted that the letters in the Plaintiff's "mio" were all of the same size, whereas the letters in the Defendant's "mio" were of different sizes, namely featuring an elongated "I". Furthermore, the placement of the letters in the Plaintiff's "mio" was on the same level plane, whereas in the Defendant's "mio" the letters all sat on different levels. I also did not agree that the concept of the word "mio" related to the similar, multi-functional natures of the parties' goods (and as shall be seen below, the Defendant does not even

supply goods). To my mind, the average consumer would not draw this conceptual link based on the word "mio" itself. Indeed, Yuan's averment (in his second affidavit dated 19 September 2008) that the Plaintiff had coined the word "mio" in early 2002 from the words "Mobile, Intelligence and Onboard" contradicted his earlier statement that the word "mio" means "my" in Italian, has no meaning in the English language and no natural association with the goods or services in respect of which the Plaintiff's Trade Marks were registered.

116 Thus, the Plaintiff did not even manage to cross the first hurdle of establishing identity or similarity between the Plaintiff's Trade Marks and the marks complained of. On this basis alone, its claims could have been dismissed. Nevertheless, for the sake of completeness, I went on to consider the other issues raised by counsel.

117 The marks complained of were in fact used only in relation to the mio Box and mio TV set-top box (as the Defendant admitted). They were not used in relation to goods such as mobile phones, telephones or televisions (albeit the marks complained of appeared in the Defendant's promotional material which also contained such goods). Although the marks were used in isolation with such goods in the teasers in the Defendant's full-page newspaper advertisements, these were shortly followed by advertisements clearly aimed at marketing the services under the umbrella of "Generation mio". Similarly, the tenor of the Defendant's TV commercials was that the Defendant was introducing a bundle of services that would lead to greater value for money and convenience in the consumers' lives. Although I noted Heng's evidence that mobile phones could be purchased at SingTel hello! shops or exclusive retailers at the same time as the customer subscribed to the Defendant's mio services, those phones were not provided under the "mio" mark but bore the brands of their manufacturers, *eg*, Nokia, Ericsson etc. The fact that the hardware in these promotional materials was invariably generic and nondescript showed that the Defendant was certainly not using the marks complained of to market these hardware products.

118 I accepted Sim's evidence that the Defendant's installation and maintenance services were not provided under the marks complained of. The Plaintiff was not able to undermine or challenge this evidence. Indeed, Yuan was unable to identify any infringing services provided by the Defendant, even after extensive cross-examination.

119 I accepted the explanation of counsel for the Defendant that his client had restricted and withdrawn certain of its trade marks so that the court would not have to consider any notional use of the Defendant's Trade Marks. I was therefore not persuaded by the Plaintiff's argument that such restriction and withdrawal implied that the Defendant had accepted that the marks complained of were similar to the Plaintiff's Trade Marks.

120 I agreed with the Defendant's arguments that the issue of likelihood of confusion only arose in respect of the mio Box and mio TV set-top box. As noted, it was not disputed that the Defendant's Trade Marks had been used in relation to these goods and that they were essentially modems, *ie*, goods covered in the specifications of the Plaintiff's Trade Marks. However, for the reasons given by counsel for the Defendant (see [\[84\]](#) above), there was simply no likelihood of confusion. Although the Plaintiff tried hard to suggest that the Plaintiff's goods had been sold and marketed in Singapore since 2003, at best the documentary evidence showed that this was true only from 2006. The marketing expenditure of and number of events the Plaintiff participated in paled in comparison to the Defendant's, leading to the conclusion that it was unlikely that an average customer would think of the Plaintiff at all when confronted with the Defendant's Trade Marks.

121 I was supported in my view by the evidence of Heng and Sim that they had received no feedback that any customers had confused the Plaintiff's products with the hardware products

available in the Defendant's hello! stores and from exclusive retailers, the mio Box or mio TV set-top box. I agreed that the test for infringement in this respect is *likely*, not *actual* confusion. However, the burden was on the Plaintiff to prove likelihood of confusion but it failed to discharge that burden to the court's satisfaction. Evidence of some actual confusion would have helped but there was none. Ironically, the Plaintiff relied on the Millward Brown survey commissioned by the Defendant to claim that confusion was likely because consumers were not sure of the nature of goods and/or services offered under the "mio" mark. However, the survey showed that misattribution of the Defendant's TV commercials and newspaper advertisements to other parent brands was low, and it did not appear that any respondents misattributed them to the Plaintiff. Although it was possible that the reason for this was that the respondents had been conditioned to think only of telecommunications service providers in Singapore, the burden was still on the Plaintiff to establish a likelihood of confusion. (by adducing concrete evidence of actual confusion). It could not do so by attempting to poke holes in the Defendant's survey findings.

122 Finally, the Plaintiff's claim under s 31(5) of the TMA could not stand. As mentioned above, I was of the view that the marks complained of were neither identical with nor similar to the Plaintiff's Trade Marks. *A fortiori*, they could not so nearly resemble the Plaintiff's Trade Marks as to be calculated to deceive. Hence, it was not necessary for me to decide whether or not intent to deceive must be shown. The Plaintiff's claim under this head was plainly unsustainable.

Conclusion

123 Consequently, the Plaintiff having failed to discharge its burden to prove there was a likelihood of confusion (or that there was actual confusion) between its **[Image 13*]** mark and the **[Image 14*]** mark of the defendant, I had no hesitation in dismissing both S519/2007 and the OS1655/2007 with costs to the Defendant.

[*LawNet Admin Note: Images 13 and 14 are viewable only by [LawNet](#) subscribers via the PDF in the Case View Tools.]

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Image 1



Image 2



Image 3



Image 4



Image 5



Image 6



Image 7



Image 8



Image 9



Image 10



Image 11



Image 12



Image 13



Image 14

