

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

[2022] SGIPOS 1

Trade Mark No. 40201722025Y-02

**IN THE MATTER OF A TRADE MARK APPLICATION BY
VIVO MOBILE COMMUNICATION CO., LTD.**

... Applicant

AND OPPOSITION THERETO BY

DAIMLER AG

... Opponent

GROUNDS OF DECISION

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Daimler AG
v
Vivo Mobile Communication Co., Ltd.

[2022] SGIPOS 1

Trade Mark No. 40201722025Y-02
Principal Assistant Registrar Sandy Widjaja
9 November 2021

9 February 2022

Principal Assistant Registrar Sandy Widjaja:

Introduction

1 This is an opposition action against trade mark application number 40201722025Y-02:

VIVO sought to be registered for the following goods:

Class 12

Electric vehicles; Cars; Motorcycles; Driverless cars [autonomous cars]; Bicycles; Mobility scooters; Trolleys; Tires for vehicle wheels; Remote control vehicles, other than toys; Water vehicles; Air vehicles; Upholstery for vehicles (“Application Mark”).

Background facts

2 Daimler AG (“*Opponent*”) is a company organised and existing under the laws of the Federal Republic of Germany and is the legal successor of

Daimler Motorenengesellschaft, which company was founded in 1882 in Stuttgart.¹ The *Opponent* is one of the largest manufacturers of vehicles in the world, including vans.²

3 Vivo Mobile Communication Co., Ltd. (“*Applicant*”) is a global technology company producing electronic consumer goods. At this point, its main product offerings relate to smartphones. Since its inception in 2009, the *Applicant* has amassed 370 million customers. The *Applicant* is headquartered in China but has a global presence, including in Singapore.³

Procedural history

4 The *Applicant* applied to register the *Application Mark* on 9 November 2017 (“*Relevant Date*”).

5 The application was accepted and published on 25 January 2019 for opposition. The *Opponent* filed its amended⁴ notice of opposition to oppose the registration of the *Application Mark* on 21 August 2019. The *Applicant* filed its counter-statement on 16 October 2019.

6 The *Opponent* filed its rectified evidence in support of the opposition on 20 November 2020. The *Applicant* filed its evidence in support of the application on 5 March 2021. The *Opponent* filed its evidence in reply on 1 July 2021.

¹ Opponent’s evidence dated 5 November 2020 (see below) at [5].

² Opponent’s evidence dated 5 November 2020 (see below) at [6].

³ Applicant’s evidence dated 4 February 2021 (see below) at [3].

⁴ IPOS letter of 7 August 2019.

7 Following the close of evidence, a Pre-Hearing Review was held on 29 July 2021. The *Applicant* indicated that it preferred to proceed via written submissions only while the *Opponent* indicated that it would need to take instructions in relation to the same. The Registrar then directed parties to confirm via writing and both parties confirmed on 12 August 2021 that they would like to proceed on the basis of written submissions only. As such, there was no oral hearing but the action was deemed to be “heard” on 9 November 2021.

Grounds of opposition

8 The *Opponent* relies on Section 8(2)(b) and Section 8(7)(a) of the Trade Marks Act (Cap 332, 2020 Rev Ed) (the “*Act*”) in this opposition.

Opponent’s evidence

9 The *Opponent’s* evidence comprises the following:

- (a) statutory declaration by Mr David Moore, partner with the firm of Jensen & Son, which is responsible for the day-to-day management of the *Opponent’s* trade mark portfolio in Singapore, dated 5 November 2020 (“*Opponent’s 1st SD*”); and
- (b) another statutory declaration by the same Mr David Moore, dated 30 June 2021 (“*Opponent’s 2nd SD*”).

Applicant’s evidence

10 The *Applicant’s* evidence comprises a statutory declaration made by Ms Lian Weihua, IP Manager of the *Applicant*, dated 4 February 2021 (“*Applicant’s SD*”).

Applicable law and burden of proof

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

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

12 Section 8(2)(b) of the *Act* reads:

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

...

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

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

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

(a) Under the step-by-step approach, the three requirements of similarity of marks, similarity of goods or services, and likelihood of confusion arising from the two similarities, are assessed systematically. The first two elements - namely similarity or identity of the marks and similarity or identity of the goods / services - are assessed individually before the final element which is assessed in the round.

(b) Once the two threshold requirements have been met, the issue of the likelihood of confusion arises and the tribunal / court is directed to look at a. *how* similar the marks are, b. *how* similar the goods / services

are, and c. given this, how likely the relevant segment of the public will be confused (emphasis in the original).

Applicable legal principles: Marks-similarity assessment

14 The law in relation to this issue is not in dispute and is as follows (at [15] to [30] *Staywell*):

(a) The three aspects of similarity (i.e. visual, aural and conceptual similarities) are meant to guide the court’s inquiry. Trade-offs can occur among the three aspects of similarity.

(b) Technical distinctiveness (discussed further below) is an integral factor in the marks-similarity inquiry. A mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it.

(c) While the components of a mark may be inherently technically distinctive, ultimately the ability of the mark to function as a strong badge of origin must be assessed by looking at the mark as a whole. Conversely, the components of a mark may not be inherently distinctive, but the sum of its parts may have sufficient technical distinctiveness.

(d) When speaking of the assessment of a mark as a whole, the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.

(e) The similarity of marks is ultimately and inevitably a matter of impression rather than one that can be resolved as a quantitative or

mechanistic exercise. The court must ultimately conclude whether the marks, when observed in their totality, are similar or dissimilar.

(f) The assessment of marks similarity is mark-for-mark without consideration of any external matter.

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

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

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

The distinctiveness of the Opponent's Earlier Mark

16 The ***Opponent*** relied on the following earlier mark for this action (“***Opponent's Earlier Mark***”):

<i>Opponent's Earlier Mark</i>	Goods/Services
<p style="text-align: center;">VITO</p> <p>T0112764E</p>	<p><u>Class 12</u></p> <p><i>Motor vehicles; parts and fittings therefor.</i></p>

17 The ***Opponent*** argued that:

(a) The ***Opponent's Earlier Mark*** is inherently highly distinctive as it has no direct meaning or significance in relation to the goods for which it is registered for;⁵

(b) The ***Opponent*** also has long-standing and extensive use and enjoyed substantial sales in relation to the ***Opponent's Earlier Mark*** for many years in Singapore such that the ***Opponent's Earlier Mark*** enjoys an enhanced level of distinctiveness;⁶ and

⁵ Opponent's written submissions (***OWS***) at [8].

⁶ ***OWS*** at [9].

(c) as a natural consequence of the greater technical distinctiveness of the ***Opponent's Earlier Mark***, it enjoys a high threshold before a competing sign will be considered dissimilar to it.⁷

18 I agree with the ***Opponent*** that the ***Opponent's Earlier Mark*** is distinctive to the extent that it has no direct significance in relation to the goods. However, I do not agree that it has acquired distinctiveness as a result of use.

19 In summary, as alluded to by the ***Applicant***,⁸ the evidence provided by the ***Opponent*** is “sparse”⁹ and crucially, the evidence suggests that the ***Opponent's Earlier Mark*** is *seldom, if ever, used on its own*.¹⁰

Whether the Opponent's Earlier Mark had acquired a high level of distinctiveness through use

20 As a preliminary point, it is not necessary for me to discuss the issue as to whether acquired distinctiveness can be taken into account at this mark comparison stage, given my finding (below) that the ***Opponent*** has *not* established that it has acquired distinctiveness in relation to the ***Opponent's Earlier Mark***.

⁷ ***OWS*** at [10].

⁸ ***Applicant's*** written submissions (***AWS***) at [10] – [14].

⁹ ***AWS*** at [10].

¹⁰ ***AWS*** at [13].

21 The *Opponent* deposed that “the VITO has been on sale in Singapore since...2002”¹¹ and that it is “currently offered to the local market in two variations: a panel van¹²...and a passenger version”.^{13 14}

22 The main evidence pertaining to use of the *Opponent’s Earlier Mark* in Singapore is as follows:¹⁵

S/N	Year	Sales volume
1	2017	154
2	2018	114
3	2019	77

23 The *Opponent* deposed that:¹⁶

...[t]he cost of each vehicle sold will depend on a number of factors...and it is not possible to provide a breakdown of value for the VITO due to the complexities involved...

¹¹ *Opponent’s 1st SD* at [9].

¹² See also the *Opponent’s 1st SD* at Exhibit 3 at page 43. While the brochure is dated after the *Relevant Date*, it does provide a sense of how the van looks like.

¹³ *Opponent’s 1st SD* at [9].

¹⁴ See also the *Opponent’s 1st SD* at Exhibit 4 at page 46. While the brochure is dated after the *Relevant Date*, it does provide a sense of how the van looks like.

¹⁵ *Opponent’s 1st SD* at [10].

¹⁶ *Opponent’s 1st SD* at [10].

24 In addition, the **Opponent** also provided a copy of its annual report for the financial year 2018,¹⁷ which provides information for the financial year 2017 as well. However, the annual report only provides the **Opponent's** revenue in *Asia* in relation to “*Mercedes-Benz*” vans¹⁸ for the financial year 2017, and I fail to see how this would advance the **Opponent's** cause to show the extent of sales (of products) bearing the **Opponent's Earlier Mark** in *Singapore*.

25 In relation to promotional expenditure, the **Opponent** deposed that marketing is often dealer led and involves sponsorship or customer events.¹⁹ In this regard, the **Opponent** provided examples of marketing events which took place in 2015 and 2007 which “[reflect] a consistent pattern of use over the years”.²⁰ The **Opponent** concluded that “this type of marketing is not collated centrally by the **Opponent** as it is conducted through the dealer network with dealers undertaking such actions regularly...each year to help to maintain and develop the market...in Singapore”.²¹

26 The examples of promotional material include:

- (a) an article dated 12 June 2015 from “SGCarMart.com” entitled *A new fuel efficient Mercedes-Benz Vito is officially launched* [emphasis in bold mine];²² and

¹⁷ **Opponent's 1st SD** at Exhibit 1 at pages 5 - 37.

¹⁸ **Opponent's 1st SD** at Exhibit 1 at page 24.

¹⁹ **Opponent's 2nd SD** at [5].


²⁰ **Opponent's 2nd SD** at [5].

²¹ **Opponent's 2nd SD** at [5].

²² **Opponent's 2nd SD** at Exhibit 7 at pages 8 – 10.

(b) a Singapore Press Holdings (“*SPH*”) press release dated 7 August 2007 entitled *Mercedes Vito vans of Radio 91.3FM & Radio 100.3FM hit the road* [emphasis in bold mine].²³

27 Last but certainly not least, the *Opponent* also deposed that the VITO van has “won several industry prizes”.²⁴ In this regard, I agree with the *Applicant* that the award being awarded by a company based in Stuttgart,²⁵ it is difficult to draw the link to the *Singapore* market.


28 Having regard to the *Relevant Date*, I am unable to conclude that the *Opponent’s Earlier Mark* has acquired distinctiveness on the basis of the evidence above. This is because *most, if not all*, of the evidence does *not* pertain to the *Opponent’s Earlier Mark itself* but include “Mercedes-Benz”, “Mercedes” or the “” device in close proximity. This is apparent from:²⁶

(a) Brochures pertaining to the two types of “VITO” vans used in Singapore (while both Exhibits 3 and 4 are dated after the *Relevant Date*,²⁷ they can still provide a sense of how the vans look like):²⁸

²³ *Opponent’s 2nd SD* at Exhibit 7 at pages 11 – 14.




²⁴ *Opponent’s 1st SD* at [10], in particular at Exhibit 5.

²⁵ *AWS* at [10.3]; see Exhibit 5 of the *Opponent’s 1st SD* at page 49, at the beginning of the second paragraph, “This year was the 14th time that the *Stuttgart-based* ETM publishing company organized the “CEP van of the year” award competition” [emphasis in italics mine].

²⁶ For clarity the *Opponent* also tendered evidence in a bid to show that the *Opponent’s Earlier Mark* was used on the rear of the van (Exhibit 6 of the *Opponent’s 2nd SD*). This document does not pertain to the Singapore market (the licence plate of the vehicle suggests that it is in relation to the European market) and is undated. Critically, it again shows that the “” device is placed in a more prominent position in comparison to the *Opponent’s Earlier Mark*.

²⁷ Namely, 1 October 2018 (see *Opponent’s 1st SD* at page 43 and 46 respectively).

²⁸ *Opponent’s 1st SD* at [9].

(i) The panel van:²⁹ the brochure is entitled *The Vito 114 CDI Panel Van*. The “” device is prominently (in terms of size) displayed at the lower right hand corner while “Mercedes-Benz” is at the lower left hand corner. The front view of the van is also depicted and again the “” device is prominently (both in terms of size and location) displayed while the ***Opponent’s Earlier Mark*** is placed *below* the “” device in a smaller font.

(ii) The same holds true for the passenger version³⁰ (the brochure is entitled *The Vito 116 CDI Tourer (Extra-Long version)*).

(b) The two examples of promotional material above, namely:

(i) an article dated 12 June 2015 from “SGCarMart.com” entitled *A new fuel efficient Mercedes-Benz Vito is officially launched* [emphasis in bold mine];³¹ and

(ii) a ***SPH*** media release dated 7 August 2007 entitled ***Mercedes Vito vans of Radio 91.3FM & 100.3FM hit the road*** [emphasis in bold mine].³²

(c) The 2018 financial report:³³

(i) As alluded to above, the financial report provides *consolidated* information in relation to the financial year 2017

²⁹ At Exhibit 3 of the ***Opponent’s 1st SD*** at pages 42 – 44.

³⁰ At Exhibit 4 of the ***Opponent’s 1st SD*** at pages 45 – 47.

³¹ ***Opponent’s 2nd SD*** at Exhibit 7 at pages 8 – 10.

³² ***Opponent’s 2nd SD*** at Exhibit 7 at pages 11 – 14.

³³ ***Opponent’s 1st SD*** at Exhibit 1 at pages 5 – 37.

with regard the **Opponent's** revenue in *Asia* for “**Mercedes-Benz Vans**” [emphasis in bold and italics mine].³⁴

(ii) There is also a reference to the **Opponent's Earlier Mark** in the financial report, describing **Opponent's Earlier Mark**, that is “VITO”, as *one type of van* in the portfolio of “**Mercedes-Benz Vans**” [emphasis in bold and italics mine].³⁵

29 For clarity, as alluded to by the **Applicant**, referring to *Societes des Produits Nestle SA v Petra Foods Ltd* [2017] 1 SLR 35 at [59]:³⁶

...there is no absolute rule that a mark that has only been used with other trade marks cannot also on its own distinguish the relevant goods or services. Ultimately, the question is whether the mark can stand up on its own as an indicator of trade origin, and in each case, this will depend on the evidence...

[Emphasis in bold mine]

In this case, based on the evidence tendered, I am of the view that the **Opponent's Earlier Mark** does *not* “stand up on its own as an indicator of trade origin”.³⁷

³⁴ **Opponent's 1st SD** at Exhibit 1 at pages 23 – 26.

³⁵ **Opponent's 1st SD** at Exhibit 1 at page 26.

³⁶ **AWS** at [12].

³⁷ **AWS** at [12], quoting *Societes des Produits Nestle SA v Petra Foods Ltd* [2017] 1 SLR 35 at [59].

30 The *Opponent* deposed that “the mark VITO appears on its own on the vehicle and so there is use apart from Mercedes-Benz”.³⁸ However, this is a bare assertion which has *not* been substantiated. On the contrary, as alluded to above, most, if not all, of the evidence tendered by the *Opponent* suggests the *opposite*, that is, the *Opponent’s Earlier Mark* has *seldom*, if at all, been used on its own.

31 Returning to the issue of distinctiveness, I have mentioned above that the *Opponent’s Earlier Mark* is distinctive to the extent that it has no direct significance in relation to the goods.

32 In this regard, the *Opponent* submitted, (albeit in relation to the issue of conceptual similarity), that both marks are words of Italian origin and would be perceived as foreign words by members of the public in Singapore (the *Opponent* deposed that the Latin meaning of VITO is “life”, while VIVO means “to live”).³⁹

33 I am also of the view that the *Opponent’s Earlier Mark* is distinctive *as a whole*. This follows from my conclusion above that the *Opponent’s Earlier Mark* will simply be construed as a foreign word and in that regard, a *short*, four letter foreign word mark.

34 Having regard to all of the above, I am of the view that the *Opponent’s Earlier Mark* is *not* so distinctive as to “[enjoy] a higher threshold before a competing sign will be considered dissimilar to it”.⁴⁰

³⁸ *Opponent’s 1st SD* at [13].

³⁹ *Opponent’s 1st SD* at [11].

⁴⁰ *OWS* at [10].

Visual similarity

35 For the purposes of ease of comparison only, the marks are as follows:

<i>Opponent's Earlier Mark</i>	<i>Application Mark</i>
VITO	VIVO

It is obvious that both marks are simply word marks with minimal stylisation.

36 The test for visual similarity is not in dispute. As provided by the High Court in *Ferrero SPA v Sarika Connoisseur Cafe Pte Ltd* [2011] SGHC 176 at [51], in the case of word marks, a determination of visual similarity typically involves looking at:

- (a) length of the marks;
- (b) structure of the marks (i.e., whether there are the same number of words); and
- (c) whether the same letters are used in the marks.⁴¹

37 Applying the above, it is obvious that both marks consist of only one word, that the marks are short word marks (four letters for each mark) and they differ only by one letter (namely the third letter in each mark).

⁴¹ *OWS* at [11] and *AWS* at [15].

38 The *Opponent* argued that from a visual standpoint, the marks are highly similar as the marks share three out of four letters,⁴² including the entire first syllable and the last letter.

39 However, I agree with the *Applicant* that as both marks are *short word marks*, “consumers are very likely to *pay close attention to each letter* in the respective marks⁴³ (emphasis in bold and italics mine).

40 As argued by the *Applicant*,⁴⁴ quoting *Kiko S.p.A. v Dooyeon Corp* [2016] SGIPOS 4 (“*Kiko*”) at [37], the “*differences* in letters would be more *amplified* as compared to longer marks” and the fact that “there are more letters in common than not does not necessarily lead to a conclusion that the marks are therefore similar” (at [34], emphasis in bold and italics mine).

41 Thus, I am of the view that while the marks only differ in one letter (out of a total of four letters), “[t]his one dissimilarity is...*amplified* given the short nature of both marks” (emphasis in bold and italics mine)⁴⁵ such that the marks are only similar to some extent.

⁴² *OWS* at [13]; for clarity, I am of the view that the case of *Hyundai Mobis v Mobil Petroleum Company, Inc.* [2007] SGIPOS 12 (“*Mobis*”) can be distinguished. In *Mobis*, the marks differ in relation to the last letter only (that is, *Mobis* versus *Mobil*), which is clearly not the case here (*OWS* at [12]).

⁴³ In comparison to the attention they may give to each letter of a longer mark; see *AWS* at [16].

⁴⁴ *AWS* at [15].

⁴⁵ *AWS* at [18].

Aural similarity

42 The test for aural similarity is also not in dispute. The Court of Appeal in *Staywell* at [23-33] provided two main approaches, namely:

- (a) "Dominant Component Approach", having special regard to the distinctive or dominant components of the marks; and
- (b) "Quantitative Assessment Approach", where the competing marks are assessed to see if they have more syllables in common than not.

In this case, I agree with the *Opponent* that the quantitative approach is more appropriate,⁴⁶ since the marks are respectively distinctive as a whole (in contrast to having multiple distinctive components).

43 Here, both marks have two syllables each and they both share an identical first syllable "Vee". However, I agree with the *Applicant* that⁴⁷ "the beginnings of marks need **not** always be more important" (emphasis in bold and italics mine).

44 In this regard, I agree with the *Applicant* that "the aural emphasis is likely to fall on the second syllable because of the contrast between the smooth "V" sound of the first syllable [for the *Application Mark*] and *harsh* "T" sound of the second syllable [for the *Opponent's Earlier Mark*]"⁴⁸.

⁴⁶ *OWS* at [14]; however, the *Opponent* did not explain why this is so.

⁴⁷ *AWS* at [21], quoting *Mobis* (at [39] and [40]).

⁴⁸ *AWS* at [23].

45 I am of the view that the above will likely override the tendency for “English speakers...to slur subsequent syllables”.⁴⁹

46 I therefore find that the marks are aurally similar to a low extent.

Conceptual similarity

47 Similarly, the test for conceptual similarity is trite. The Court of Appeal in *Staywell* expounded at [35] as follows:

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

[Emphasis in bold and italics mine]

48 As alluded to above, both marks comprise of words of Italian origin. They would be perceived as *foreign* words by members of the public in Singapore, though it is unlikely that members of the public would perceive them as words of *Italian* origin specifically. I also agree with the ***Applicant*** that it is unlikely that the average consumer in Singapore would be aware of the meanings of the ***Opponent’s Earlier Mark*** and the ***Application Mark*** in Latin (specifically “vito” meaning “life”, and “vivo” meaning “to live”).^{50 51} Thus, I am of the view that the general public will construe both marks as meaningless.

⁴⁹ ***OWS*** at [15] quoting ***Doctor’s Associates Inc vs Lim Eng Wah*** [2012] SLR 193 at [35].

⁵⁰ ***AWS*** at [28].

⁵¹ See above as to the marks’ Latin meaning.

49 The **Opponent** also argued that both marks are conceptually similar as they would “[evoke] and [call] into mind words such as vitality, vivid and vivacious in English”.⁵² I find this argument rather fanciful. Further, even if this is the case, any conceptual similarity will be minimal.

50 In light of the above, the marks are conceptually neutral or at most similar to a low extent.

Conclusion on mark-similarity assessment

51 In light of all the above, I am of the view that the marks are visually similar to some extent, aurally similar to a low extent and conceptually neutral or at most similar to a low extent, such that the marks are overall more similar than dissimilar.

Good-similarity assessment

52 For ease of reference, the goods are as follows:

<i>Opponent’s Earlier Mark</i>	<i>Application Mark</i>
<p><u>Class 12</u></p> <p><i>Motor vehicles; parts and fittings therefor.</i></p>	<p><u>Class 12:</u></p> <p><i>Electric vehicles; Cars; Motorcycles; Driverless cars [autonomous cars]; Bicycles; Mobility scooters; Trolleys; Tires for vehicle wheels; Remote control vehicles, other than toys;</i></p>

⁵² *OWS* at [16].

	<i>Water vehicles; Air vehicles; Upholstery for vehicles</i>
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53 It is clear that there is an overlap in the goods (these are in bold above) and as such, this element is satisfied.

Likelihood of Confusion

54 Again, the law pertaining to the issue of likelihood of confusion is not in dispute. The relevant principles for assessing likelihood of confusion have been expounded by the Court of Appeal in *Staywell* at [60], [64], [83] and [96]:

(a) In opposition proceedings, the inquiry must take into account the full range of the competing monopoly rights that are already enjoyed on the one hand, namely the *actual and notional fair uses* to which the incumbent proprietor has or might fairly put his registered trade mark, and compare this against the *full range of such rights* sought by the applicant *by reference to any actual use by the applicant (assuming there has been prior use) as well as notional fair uses* to which the applicant may put his mark should registration be granted.

(b) Once similarity between the competing marks and goods or services has been established, the *impact* of these similarities on the relevant consumers' ability to understand where those goods and services originate from falls to be considered. The only relevant confusion is that which results from the similarity between marks and goods or services. However, the plain words of section 8(2) do *not* have the effect of making a finding of confusion automatic upon the establishment of similarity of marks and goods or services.

(c) On the effect of the foregoing (i.e. similarity of marks and goods or services) on the relevant segment of the public – *extraneous* factors may be considered to the extent that they inform the court as to how the *similarity of marks and goods* will likely *affect* the consumer’s perception as to the source of the goods.

(d) The following represents a non-exhaustive list of factors which are regarded as admissible in the confusion inquiry:

(i) Factors relating to the impact of *marks-similarity* on consumer perception:

- (A) the *degree of similarity* of the marks themselves;
- (B) the *reputation* of the marks (a strong reputation does *not* necessarily equate to a higher likelihood of confusion, and could in fact have the contrary effect);
- (C) the *impression* given by the marks; and
- (D) the *possibility of imperfect recollection* of the marks.

(ii) Factors relating to the impact of *goods-similarity* on consumer perception (factors concerning the very nature of the goods without implicating any steps that are taken by the trader to differentiate the goods):

- (A) The *normal way in, or the circumstances under which, consumers would purchase goods of that type*;
- (B) Whether the products are *expensive or inexpensive items*;

(C) Whether they would tend to *command a greater or lesser degree of fastidiousness and attention* on the part of prospective purchasers; and

(D) The *likely characteristics of the relevant consumers* and whether the relevant consumers would or would not tend to apply care or have *specialist knowledge* in making the purchase.

[Emphasis in italics mine]

Factors relating to the impact of mark-similarity

55 I have already concluded above that the marks are visually similar to some extent, aurally similar to a low extent and conceptually neutral or at most similar to a low extent such that the marks are more similar than dissimilar. However, having regard to the fact that the marks are short word marks, and having regard to the type of the goods here (that is, parts and fittings of vehicles) I am of the view that the conceptual aspect takes precedence.

56 In terms of reputation, I have already commented in relation to the evidence pertaining to use of the *Opponent's Earlier Mark* in Singapore and I will not repeat my comments here. In short, the evidence relating to the same is sparse and critically, the evidence suggests that the *Opponent's Earlier Mark* is *seldom, if ever, used on its own*. Accordingly, there is no reputation to be considered for the *Opponent's Earlier Mark*. On the other hand, the *Applicant* has deposed that it has not used the *Application Mark* in relation to the goods sought to be registered.

57 Taking all of the above into consideration, I am of the view that, even having regard to the imperfect recollection of the consumers, the overall impression of the marks is that they are only similar to a low extent.

Factors relating to the impact of good-similarity

58 As indicated above, the goods overlap. There are two main areas of overlap, namely, in relation to “vehicles” as well as “parts and fittings [for vehicles]”. Understandably, the *Opponent* focused their arguments on “parts and fittings” while the *Applicant* focused on “vehicles”.

59 It is clear that there would be *no* likelihood of confusion in relation to “vehicles” given the very high price point of vehicles in Singapore. Consumers would pay close attention to such goods before making a purchase and would not be confused.

60 I will therefore focus on “parts and fittings”, specifically, “tires for vehicles” as well as “upholstery for vehicles”. This is because “parts and fittings” have a lower price point than “vehicles” and the two items are the most obvious “parts and fittings” which overlap in the above specifications.

61 Applying the principles above, the normal way to purchase parts and fittings for vehicles entails the help of sales assistants as these products are specific to particular vehicles in that they ultimately have to fit properly into the vehicle.

62 In terms of the price, they are not cheap either. I accept, as argued by the *Opponent*,⁵³ that they span a wide price range. However, this does not

⁵³ *OWS* at [25].

detract from the fact that they are not inexpensive items since the “lower end” of the price range would still be a price tag in the range of a few hundred dollars.

63 I also fail to see how these items can be “common” as argued by the *Opponent*.⁵⁴ To begin with, as alluded to above, vehicles are very expensive in Singapore such that not many residents can afford to own one. This applies accordingly to the “parts and fittings” which form an integral part of a vehicle; people who do not own a vehicle would generally not purchase “parts and fittings” for vehicles.

64 All of the above (the high price and “must fit” criteria) translate to a high level of attention on the part of the consumer.

65 The *Opponent* also argued that there is a high chance that consumers will be misled into believing that there is an *economic link* between the parties, that the *Application Mark* is a sub-brand of the *Opponent’s Earlier Mark*.

66 In my view, any such possible confusion will be dispelled as a result of assistance that would be rendered for the sale of “parts and fittings” of vehicles as alluded to above. In particular, having regard to the price of the products, any confusion would be dispelled, at the very latest, at the point of purchase.

67 Taking all of the above into account, I am of the view that there is *no* likelihood of confusion.

Conclusion on Section 8(2)(b)

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

⁵⁴ *OWS* at [26(e)].

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

69 Section 8(7)(a) of the *Act* reads:

(7) A trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented —

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade

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

- (a) Goodwill;
- (b) Misrepresentation; and
- (c) Damage.

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

(a) The ***Opponent*** must establish that they have acquired goodwill as at the *relevant date*, that is, the date on which the defendant's conduct complained of started. Applying this principle, it is the ***Relevant Date*** in this instance (*Law of Intellectual Property of Singapore (Sweet & Maxwell, Third Edition, 2021)* by Professor Ng-Loy Wee Loon (“***Law of Intellectual Property of Singapore***”) at [17.1.6]).

(b) Goodwill, in the context of passing off, is concerned with goodwill in the *business as a whole*, and not specifically in its constituent elements. The issue of *whether a mark or get-up is distinctive* of a plaintiff's products or services is a question best dealt with in the context of the inquiry as to whether the defendant has made a misrepresentation (*Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading* [2016] 4 SLR 86 (“***Singsung***”) at [34] and [37] respectively). Evidence of sales and income of the business are

a “proxy for the attractive force of the business” (*Singsung* at [58]). The “get up” can include various aspects of the business and is not pegged to any particular mark (*Law of Intellectual Property of Singapore* at [17.2.10] – [17.2.20]).

(c) Section 8(7)(a) of the *Act* at the very least requires an opponent to adduce sufficient evidence to establish a *prima facie* case on goodwill, misrepresentation and damage (*Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] SGHC 216 at [164]).

Goodwill

72 It is not in dispute that the *Opponent* has acquired goodwill in its business in Singapore.⁵⁵ In this regard, I disagree with the *Applicant* that this element has not been satisfied as there is no goodwill “specifically in relation to the [*Opponent’s Earlier Mark*]”.⁵⁶


73 As alluded to above, the Court of Appeal in *Singsung* has clarified that “goodwill, in the context of passing off, is concerned with goodwill in the business *as a whole*, and not specifically in its constituent elements, such as the mark, logo or get-up that it uses” (*Singsung* at [34]).

74 As referred to above, while the evidence pertaining to the *Opponent’s* sales activity is sparse, it is clear that there were sales conducted by the *Opponent* for the period 2017 - 2019.

⁵⁵ See above evidence of sales volume pertaining to the *Opponent’s* products.

⁵⁶ *AWS* at [38].

Misrepresentation

75 However, crucially, there is no misrepresentation. For the purposes of this ground, the ***Opponent's*** get-up includes the ***Opponent's Earlier Mark***. My comments above in relation to the ***Opponent's*** evidence apply here as well, that is, ***most***, if not all, of the ***Opponent's*** evidence reflect the use of the ***Opponent's Earlier Mark*** together with “Mercedes-Benz”, “Mercedes” or the “” device in ***close proximity***.

76 In light of above, it is clear that misrepresentation is not established.

Conclusion for Section 8(7)(a)

77 Following the above, there is no need for me to address the issue of damage and the ground of opposition under Section 8(7)(a) therefore fails.

Overall conclusion

78 Having considered all the pleadings and evidence filed and the submissions made in writing, I find that the opposition fails on all grounds. The application will proceed to registration. The ***Applicant*** is also entitled to costs to be taxed, if not agreed.

Sandy Widjaja
Principal Assistant Registrar

Mr Anthony Soh and Ms Shannon Ker (Taylor Vinters Via LLC) for
the ***Applicant***;
Mr Chua Shang Li (Donaldson & Burkinshaw LLP) for the
Opponent.
