

Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another
[2012] SGHC 204

Case Number : Originating Summons No 679 of 2011
Decision Date : 09 October 2012
Tribunal/Court : High Court
Coram : Judith Prakash J
Counsel Name(s) : Prithipal Singh (instructed) and Denise Mirandah (Mirandah Law LLP) for the plaintiff; Elaine Tan (Amica Law LLC) for the defendants.
Parties : Staywell Hospitality Group Pty Ltd — Starwood Hotels & Resorts Worldwide, Inc and another

Trade Marks and Trade names – grounds for refusal of registration

Trade Marks and Trade names – Registration criteria – distinctiveness

Trade Marks and Trade names – well-known trade mark

9 October 2012

Judgment reserved.

Judith Prakash J:

1 This trademark appeal pits an Australian hotel operator against two connected hotel operators based in the United States. The Australian appellant, Staywell Hospitality Group Pty Ltd (“Staywell”), owns and operates 24 hotels, mainly in Australia and New Zealand. The American respondents, Starwood Hotels & Resorts Worldwide, Inc (“Starwood”) and its subsidiary, Sheraton International Inc (“Sheraton”), own and operate more than 900 hotels worldwide. The dispute here involves the “ST. REGIS” trademark belonging to Sheraton and the “” trademark belonging to Staywell.

2 Staywell operates two hotel brands – Park Regis and Leisure Inn. The first Park Regis hotel was opened in Sydney in 1972 and that hotel has been operated under the Park Regis banner continuously since then. Staywell opened a hotel in Singapore in 2010 called Park Regis Singapore and operates it as a 4-star business hotel.

3 As for the “St. Regis” brand of hotels, there are currently 17 hotels bearing this brand throughout the world. The first St. Regis hotel was opened in New York in 1902. The brand is marketed as a luxury brand with excellence and sophistication and the Opponents claim that it is highly regarded worldwide as an exclusive and luxury name. In Singapore, the brand is attached to a hotel called The St. Regis Singapore which opened officially in April 2008.

Background to the appeal

4 On 3 March 2008, Staywell applied to register the trademark in a series of two marks (“the Application Mark”) in Singapore under Singapore Trade Mark No T08/02642I in Classes 35 and 43. Class 35 deals with advertising, marketing, promotion and publicity services; business management, business administration, office functions and provision of office facilities, among other

things. Class 43 basically deals with providing hotel services and other services related to or connected with the hospitality industry. The difference between the two marks in the series is that in the first mark, the device is coloured black whereas in the second, it is coloured royal purple.

5 Staywell's application was published on 7 May 2008 for opposition purposes. On 8 September 2008, Sheraton and Starwood filed a notice of opposition to oppose the registration of the Application Mark. In the opposition and before me, Sheraton and Starwood took a joint stand and therefore when dealing with them jointly, I shall refer to them as the "Opponents".

6 In Singapore, Sheraton is the registered proprietor of the ST. REGIS trademark in various classes. In four of these classes, namely 41, 42 (the predecessor of the current class 43), 36 and 37, the trademark is the simple word mark "ST. REGIS". In other classes, Sheraton is the owner of a device which has no words but includes the capital letters "S" and "T" in an intertwined format. For the purpose of this judgment, I shall refer to Sheraton's trademarks in classes 41, 42, 36 and 37 as "the Opponents' Mark". These trade marks were registered on various dates well before 3 March 2008.

7 The Opponents relied on ss 8(2)(b), 8(4)(a) read with (b)(i), 8(4)(a) read with (b)(ii), 7(4)(b) and 7(6) of the Trade Marks Act (Cap 332, 2005 Rev Ed) ("the Act") as their grounds of opposition to the registration of the Application Mark.

8 After evidence was filed by both parties, the hearing took place before the Principal Assistant Registrar of Trade Marks ("the PAR") on various dates in 2011. The PAR delivered her decision on 19 July 2011. The PAR held as follows:

(a) The Opponents had failed to discharge their burden of proof that the Singapore public had goodwill attaching to the St. Regis Hotel Singapore and therefore the ground of opposition under passing off (s 8(7)(a) of the Act) failed.

(b) On the ground of opposition under s 8(2)(b), the Application Mark and the Opponents' Mark were on the whole similar, and the services of Staywell and the Opponents were similar, and taking into account all the surrounding circumstances, there was a real likelihood of confusion amongst the public as to the source of Staywell's services if the Application Mark was allowed to proceed to registration. Therefore, the opposition under s 8(2)(b) was successful.

(c) On the ground of opposition under s 8(4)(a) read with (b)(i), the Opponents' Mark was well known in Singapore as at 3 March 2008, the date of the Staywell application, and as the Application Mark and the Opponents' Mark were similar, there was a likelihood of confusion and it was likely that potential customers would be misled into thinking that Staywell's services originated from the Opponents or that there was some connection between the two parties. Therefore, this ground of opposition was successful.

(d) On the ground of opposition under s 8(4)(a) read with (b)(ii), the Opponents' Marks were not well known to the public at large because the PAR was not convinced that they were known to the general public let alone most sectors of the public and the Opponents had not submitted concrete evidence to prove that their marks were recognised by most sectors of the public. As such, this ground of opposition failed.

(e) On the grounds of opposition under s 7(6) and s 7(4), both these grounds failed. First, the Opponents had not been able to establish bad faith on the part of Staywell in applying for the registration of the Application Mark in Singapore. Secondly, s 7(4) did not apply at all to the situation in this case.

9 Staywell has appealed against the decision of the PAR on s 8(2)(b) and on s 8(4). The Opponents lodged a cross appeal in respect of the PAR's decision to reject the opposition under s 8(7)(a) of the Act. Staywell also appealed in respect of certain decisions that the PAR made regarding the admissibility of two sets of documents, one adduced by Staywell and the other adduced by the Opponents. I will deal with the various appeals in turn.

Appeal in relation to s 8(2)(b) of the Act

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

A trade mark shall not be registered if because –

(a) ...

(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.

11 Therefore, for the registration of the Application Mark to be denied, it must be established that:

(a) The Application Mark is similar to the earlier marks viz the Opponents' Mark;

(b) The Application Mark is to be registered for services identical or similar to those for which the Opponents' Mark is protected; and

(c) There exists a likelihood of confusion on the part of the public because of the above.

Are the marks similar?

12 The authorities have established that there are three aspects of similarity to be considered in relation to competing marks: aural, visual and conceptual. In this case, the PAR found that the Application Mark and the Opponents' Marks were not similar visually, but were similar aurally and in concept. Her finding on the visual dissimilarity is not contested by either party but Staywell does not accept that the marks are otherwise similar.

13 Staywell's submission is that the marks are conceptually dissimilar as "PARK REGIS" denotes a wide open space while "ST. REGIS" denotes a person and that they are also aurally dissimilar because the first word of each mark is different and is pronounced quite differently from the other. The Opponents' case is that the marks are aurally and conceptually similar as the dominant feature in the Opponents' Mark is "REGIS" and not "ST. REGIS" and that REGIS is a distinctive word unlike PARK or SAINT and therefore the Application Mark has wholly incorporated the distinctive component of the Opponents' Mark.

14 In *Ozone Community Corp v Advance Magazine Publishers Inc* [2010] SGHC 16 ("Ozone"), the court articulated a two-stage test in the determination of similarity between a trademark and a sign. The first stage was to determine to what extent the three aspects of similarity enumerated above had been met and the second stage was to enquire as to the distinctiveness of the trademark in question because the distinctiveness of the trademark is an important factor in the inquiry into the similarity between the marks under s 8(2)(b) of the Act (see *Ozone* at [67]). The court there observed that the PAR had erred in failing to consider the level of distinctiveness of the trademark in

his inquiry into the similarity between the mark and the sign under consideration.

15 In the earlier case of *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2006] 2 SLR(R) 690 ("*Polo*"), the Court of Appeal considered the issue of distinctiveness before it went on to discuss whether the marks and signs involved there were similar.

16 The question arises as to which step should be taken first. I have adopted different approaches in different cases. In *Doctor's Associates Inc v Lim Eng Wah Trading as Subway Niche* [2012] SGHC 84, I followed the order established in *Ozone* but in *Intuition Publishing Ltd v Intuition Consulting Pte Ltd* [2012] SGHC 149 ("*Intuition*"), I adopted the approach taken in *Polo*. This was because the Court of Appeal in *Polo* had indicated (at [10]) that a more distinct mark generally receives greater protection and on the facts before me in *Intuition*, this was helpful in determining how many differences there should be between the allegedly infringing sign and the registered mark to make the sign different from the mark. I do not think that there is any specific way of implementing the two-step test. Which step is adopted first must depend on the circumstances of the particular case and the assessor's determination as to which method would be more helpful in the analysis before him. The only point to be remembered is that both steps should be undertaken as distinctiveness would affect the global assessment of similarity.

17 In this case, I will adopt the order followed in *Polo* case since the Opponents have emphasised the distinctiveness of the word REGIS as being pivotal in the determination of aural and conceptual similarity of the Application Mark and the Opponents' Mark.

18 Concerning the distinctiveness of a word mark, the *Polo* judgment noted (at [23]) that some marks are inherently distinctive because they consist of inventive words and that where common words are included in a registered mark, the court should be wary of granting a monopoly in their use. Further, alleged distinctiveness must be acquired through use. In the present case, the Opponents contend that the word "REGIS" is inventive and fanciful when used for hotel services as it is in no way descriptive of the hotel on offer. It is a randomly chosen word which distinguishes the Opponents' hotels from others. Although Staywell had argued that "REGIS" is a common name and "Saint Regis" may be a historical person who had been elevated to sainthood, the marks had to be considered in the light of the services for which they were registered. The choice of ST. REGIS or "REGIS" for a commercial hotel was entirely random.

19 From the evidence, the word "regis" has various applications. In Latin, it means "of the king" and although it is not an English word it is related to other Latin words which are well known in English such as "regina" and "rex". It is also the name of a catholic saint, one St. John Regis, who lived in France in the 16th Century. The word "regis" has been used as the first name of a number of notable, though not world famous, people. It is also used as a surname and a place name in England and Germany. Despite all the examples of its use that have been given to me by Staywell, however, I cannot conclude that it is a common place word in English such as "intuition" or "glamour" for example. It is also irrefutable that the word is not descriptive of and does not connote the hospitality industry or hotel services in any way.

20 In *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] SGCA 23 ("*CDL Hotels*"), the Court of Appeal had to consider whether the word "Millenia" was a distinctive one. The court said (at [68]) that whether a word is distinctive is a matter of degree and that the more descriptive it is the less distinctive it tends to be. The more fanciful the word, the easier it is to establish distinctiveness. In the case of "Millenia" as applied to a hotel, the Court of Appeal agreed that it lay somewhere in the middle, perhaps closer to being highly fanciful rather than obviously descriptive. In the present case, "regis" is not a common word used in the hotel industry and is therefore unlike "Glamour" in *Ozone*

which was a word that magazines and printed materials commonly used. Staywell's evidence was that "Regis" is a distinctive surname and place name. Thus, in relation to hotels, it would be somewhat distinctive. However, being a surname, a place name and a personal name, it is not as distinctive as an inventive word like "Volvo". It follows that a great number of distinguishing elements need not be added for the marks to be dissimilar. Nevertheless, it is distinctive enough that a higher threshold for dissimilarity would apply than that used in *Ozone* where the court had to determine the similarity of the marks "HYSTERIC GLAMOUR" and "GLAMOUR". Although the Opponents emphasised the word "REGIS", the registered mark is "ST. REGIS" and the Opponents' Mark must be looked at as a whole in comparison with the Application Mark as a whole ie "PARK REGIS". However, even taking the whole of the mark "ST. REGIS", that name when applied to a hotel is as fanciful as "Regis" on its own since a saint is not generally associated with a hotel of any sort, let alone a luxurious one. Thus, the addition of "St." does not change the mark's place on the scale of distinctiveness.

21 Moving on to the similarities between the marks, as stated, visual dissimilarity had been found by the PAR and was not disputed on appeal. The PAR found that the marks were similar aurally because, with imperfect recollection, members of the public are likely to hear "Regis" as the dominant word when either mark is read out. Staywell submitted that there was dissimilarity in this respect as well. In the Application Mark, the words "PARK" and "REGIS" would be read and pronounced as two separate and distinct words and for the Opponents' Mark, the words "ST." and "REGIS" would be read as two separate and distinct words. The target customers of the St. Regis hotel are the rich who are likely to be educated and such customers would be able to appreciate the difference between "PARK REGIS" and "ST. REGIS". It argued that a consumer of the Opponents' services would certainly understand that the Application Mark is "PARK REGIS" while the Opponents' Mark is "ST. REGIS".

22 There are aural dissimilarities in the marks. Each mark consists of two separate words and each of those two separate words would be read and pronounced as separate and distinct elements. The situation is somewhat akin to that in *Ozone* where the court had to deal with the addition of the word "hysteric" to the word "glamour". The judge observed at [56] that:

[I]t must be borne in mind that Ozone's word mark starts with the entirely separate word "hysteric" preceding the word "glamour". Also, Ozone's HYSTERIC GLAMOUR word mark would be read and pronounced as two separate and distinct words, in the order of "hysteric" and "glamour". AMP's GLAMOUR word mark, on the other hand, would be read as a single word.

23 Whilst this is not a case of a single word versus two separate words, the observation that words are read and pronounced as separate and distinct elements is equally applicable. The words "Park" and "Saint" are separate words heard as a distinct element additional to the word "Regis". The PAR pointed out, in the context of discussing aural similarity at [55], that there were many other place names which contained the prefix "St", such as "St James Power Station", and the prefix "St" would not be striking. This does not mean, however, that the prefix "St" would not be pronounced or aurally remembered. Even taking into account imperfect recollection, the mark "ST. REGIS" would not be pronounced "Regis" anymore than "St James Power Station" is pronounced "James Power Station" or "St Joseph's Institution" is pronounced "Joseph's Institution". Similarly, the word "Park" would not easily be dropped from the mark "PARK REGIS", in the same way that "the Goodwood Park Hotel" is not referenced as "the Goodwood Hotel". The fact that the words "Park" and "Saint" are commonly used in place names actually eliminates the risk that "careless pronunciation and speech" would result in dropping the prefixes from an aural rendering of the marks.

24 Having said that, however, it remains the case that the second word element of each mark is the same name and that name is an unusual one in the context of Singapore. Therefore persons enunciating both marks may pay more attention to the second distinctive word in each mark rather

than to the more common first word even though they do give that first word its due pronunciation. In this respect, there would be some, perhaps slight, degree of aural similarity between the marks.

25 Next, conceptual similarity. The PAR found that there was conceptual similarity. Staywell argued that this finding was wrong and that the marks were conceptually dissimilar as the name "ST. REGIS" conjures up the picture of the historical figure, St John Regis, while the word "PARK REGIS" brings to mind the idea of an open space or park. The Opponents submitted that there was no reason to interfere with the PAR's approach in this regard.

26 The argument that the name "ST. REGIS" conjures up the historical figure St John Regis is far-fetched as he is not a well known saint or personage in Singapore. Singaporeans who know about The St. Regis Singapore would probably conjure up that hotel when hearing these words but those who are unfamiliar with the hotel and simply hear the words "ST. REGIS" without the appendage "hotel" are likely to think that it signifies a person who is a Catholic saint even though they have never heard of him before. Therefore, the Opponents' Mark used on its own would import the notion of a saintly person. The concept behind "PARK REGIS" is less certain. While the common meaning of the word "Park" is "a large public garden in a town, used for recreation" (see *Concise Oxford Dictionary*, 11th Ed (revised) 2008), when this word is used in Singapore as part of a name it can refer to an actual park or a building or shopping centre or a condominium or even a hotel. To quote some examples from Singapore, it can be part of the name of a hotel (eg Park Sheraton), a road (eg Parklane), a shopping centre (eg Park Mall or People's Park), a condominium (eg Ardmore Park) or a green recreational space (eg Pasir Ris Park or Fort Canning Park). Persons hearing or reading the mark "PARK REGIS" would probably not think that it refers to a city park. Rather, "park" being a common word used in a variety of ways, they are likely to think that it refers to some place without being able to specify a particular type of place. Thus, conceptually, "ST. REGIS" as a whole and "PARK REGIS" as a whole are not close.

27 However, there is some force to the Opponents' submission that since "St" and "Park" are very common words, persons who come across them in conjunction with the word "Regis" are more likely to be struck by "Regis" and remember it rather than the common prefixes "St" and "Park". "Regis" therefore adds distinctiveness to both marks. Although both "rex" and "regina" are Latin words, people who are familiar with English may be aware that they mean king and queen respectively in Latin and such people would therefore likely associate "Regis" with royalty as well. They may think therefore that both "PARK REGIS" and "ST. REGIS" have something to do with royalty.

28 It should be noted here that both Staywell and the Opponents have tried to emphasise a connection with royalty/royal treatment in relation to their hotels. The device which Staywell uses in the Application Mark before the words is a stylised fleur-de-lis symbol which is reminiscent of French royalty and, as stated above (at [4]), the device in one of the marks in the series is coloured royal purple which is a colour associated with royalty in some societies. In advertisements for "ST. REGIS" brand hotels which appeared in magazine articles, there were references to royalty or the royal treatment at those hotels. Further, the device used by the St. Regis Hotel group is designed to look like a crest, with similarly elaborate lettering reminiscent of royal opulence. Therefore, both marks employ the concept of royalty or aristocracy pictorially and aurally and they imply class, status and luxury. In this way, at least, the marks are conceptually similar.

29 I have accepted above that because of the word "Regis" the Opponents' mark "ST. REGIS" is fairly distinctive and that a higher threshold for dissimilarity should be applied to it. In *Ozone*, the court found that because the marks were visually and aurally dissimilar and the word "glamour" was merely descriptive, conceptual similarity did not make the marks similar. This followed the orthodox approach that conceptual similarity is "not overriding or determinative"; see *McDonald's Corp v Future*

Enterprises Pte Ltd [2004] 2 SLR(R) 652 at [44] (*McDonald's*), quoted with approval at [59] of *Ozone*. However, given that "Regis" is more than merely descriptive, this may not be the appropriate approach to take here. It was further observed in *Ozone*, at [61], that:

[T]he relative importance of each type of similarity must necessarily vary with the circumstances in hand, in particular the goods and the types of mark being compared... To adopt an overly generalised and restrictive principle that conceptual similarity is *only* relevant to determining similarity between marks when either visual or aural similarity has been made out would be to ignore the fact that each aspect of similarity can vary in different degrees *vis-à-vis* each other depending on the circumstances, and trade-offs are entirely possible between the three aspects of similarity – for example, conceptual similarity can offset visual and aural dissimilarities.

[emphasis original]

The fact that the word "glamour" was merely descriptive and not distinctive was a controlling factor in the *Ozone* court's finding that conceptual similarity did not offset visual and aural dissimilarities (see [73]). As "Regis" is a more distinctive word, in this case, I consider that the fact that in some respects the marks are conceptually and aurally similar should offset the visual dissimilarity and the fact that some people might not perceive such aural and conceptual similarities because of unfamiliarity with the Latin meaning of the word "regis". This has been a difficult balancing exercise, but I have come to the conclusion that, in the global assessment, the marks are similar.

Are the services similar?

30 In my judgment, there is no doubt that the services provided by Staywell and the Opponents are similar. This was the conclusion of the PAR as well.

31 Staywell argued that since the Opponents' mark is not registered in class 35, it cannot be the provision of a similar service and is an unwarranted expansion. Class 35 covers the following:

Advertising, marketing, promotion and publicity services; business management; business administration; office functions; provision of office facilities; administration of the business affairs of retail stores; advisory, information and consultancy services relating to all the aforesaid; all the aforesaid services also provided on-line from a computer database or via the global communications network.

32 The relevance of the opposition to registration in Class 35 is limited because the services covered by that class are not the main services provided by Staywell as part of the Park Regis hotel business. Regardless of the choice to challenge the mark in Class 35, both marks are registered in Class 43, which covers the following:

Services for providing food and drink; temporary accommodation; hotel services; resort hotel services; hotel accommodation services; hotel catering services; hotel reservation services; hotel restaurant services; provision of hotel venues for business exhibitions, business fairs, conferences, congresses, lectures and meetings; providing facilities [accommodation] for conducting conferences, conventions, exhibitions, fairs and holidays; rental of meeting rooms; hospitality services [accommodation]; hospitality suites [provision of accommodation, food or drink]; holiday information and planning relating to accommodation; inn keeping [bar, restaurant and accommodation]; restaurants; cafes; bar and catering services; advisory, information and consultancy services relating to all the aforesaid; all the aforesaid services also provided on-line from a computer database or via the global communications network.

33 It is not disputed that Class 43 is the primary business of both parties. The dichotomy between Staywell's Class 35 and Class 43 services is false. The PAR rightly observed at [63] of her judgment that "the intention of Staywell is to go into a business complementary to their hotel services". It is difficult to imagine, and Staywell made no submissions on, what its Class 35 business would look like if it was severed from its hotel services. As a consequence, I agree with the PAR that these services cannot be separated.

34 Staywell further contended that the services provided by its hotel group are different from those provided by the Opponents because it specialises in 4-star hotel services, and the St. Regis hotel brand is a 6-star brand. It contended that neither brand would appear in each other's search categories, and therefore the products were dissimilar. While the target clientele of a Park Regis hotel is different from that of a St. Regis hotel, it does not follow that the services are dissimilar. Their registration in the same category establishes a *prima facie* case for similarity. Lai Kew Chai J who was the first instance judge in *Polo* stated at [33] of his judgment (see [2005] 4 SLR(R) 816) ("*Polo (HC)*"), "it would be a very rare case, if ever, that a defendant could claim that its products, if listed in the same classification as the plaintiff's, were not similar." Lai J went on to observe in the same passage that the considerations of price, design and quality of the goods went to the likelihood of confusion, and not the similarity of goods and services. This issue was not appealed in *Polo*.

35 While *Polo* was a decision on s 27 of the Act, the criteria under s 27 and s 8 are substantially the same, and are two different routes to getting the same result (*ie* exclusive rights to the mark). Staywell's argument in the present case is a replay of the defendant's argument in *Polo*; the difference between a 4-star and 6-star brand is one of price and quality but does not go towards the nature of the services provided. This is relevant to the enquiry on confusion, and not on the similarity of services. There is therefore no need to apply the test in *British Sugar Plc v James Robertson & Sons Ltd* [1997] ETMR 118 ("*British Sugar*").

Is there a likelihood of confusion?

36 The likelihood of confusion must be looked at globally, taking into account all the circumstances including (*Polo* at [28]):

- (a) The closeness of the services;
- (b) The impression given by the marks;
- (c) The possibility of imperfect recollection;
- (d) The risk that the public might believe that the services come from the same source or economically-linked sources;
- (e) The steps taken by the applicant to differentiate the services from those of the opponent;
and
- (f) The kind of customer who would be likely to buy the services of the applicant and opponent.

The closeness of the goods and services

37 Staywell's argument is essentially that Park Regis Singapore is a hotel for the down-to-earth traveller wanting a convenient place to stay but not necessarily craving the luxury that The St. Regis

Singapore provides. This is an overstatement. As observed earlier, both Park Regis Singapore and The St. Regis Singapore draw on the idea of royalty and luxury. Park Regis Singapore is not a budget hotel built for the backpacker. In its pre-opening promotional material, it was described as “an unbeatable choice for both business and leisure”, with “impressive facilities... and brand new, highly modern furniture and fittings”. Other Park Regis properties are sold as “offering guests luxury and comfort” and “your ideal ‘home away from home’”. Park Regis Singapore provides the same goods and services as The St. Regis Singapore for the discerning traveller – comfortable and well-appointed hotel rooms, facilities such as a swimming pool and gymnasium, convention halls, and dining facilities – all the while drawing on the concept of luxury and comfort. Park Regis Singapore is a business hotel targeting the lower end of the same business traveller category as The St. Regis Singapore; it is not a qualitatively different good or service.

The impression given by the marks

38 The impression given by the marks taken as a whole is determined by the dominant concept: that of royal or luxurious treatment. However, the marks are visually dissimilar and these differences would at least raise some questions as to whether they originated from the same source. The marks are displayed prominently on both websites, and printed on the towels, stationary and coasters in the rooms of the respective hotels. The marks are also displayed in the hotel lobbies. Thus, the impression given is likely to be mixed.

The possibility of imperfect recollection

39 It is difficult to ascertain what the recollection of the average customer would be – whether he would remember the “ST. REGIS” and “PARK REGIS” marks conceptually, or whether he would remember the marks visually and aurally. The possibility of imperfect recollection does not take us very far.

The risk that the public might believe that the goods come from the same source or economically-linked sources

40 What is relevant in this enquiry is how both hotels are marketed, and whether there is likelihood of confusion when customers or potential customers book a room in either of these hotels.

41 As a preliminary point, I agree with the holding of the PAR on the inadmissibility of the letters from travel agents that Staywell sought to introduce as part of the evidence regarding confusion. These letters each contain a confirmation from the agent writing it that they had never witnessed any confusion in the travel and tourism market between the PARK REGIS and the ST. REGIS brands. These letters are not statutory declarations; they are letters of unverified origin put forward to prove the truth of the statements within them, *ie*, that the St. Regis and Park Regis hotels are not easily confused. The application of the hearsay rule means that such evidence has to be excluded; see *Soon Peck Wah v Woon Che Chye* [1997] 3 SLR(R) 430.

42 It was observed in *Polo (HC)* that trading circumstances are important for this analysis. Customers may book a hotel room in four ways:

- (a) Booking through the website: The websites are completely different. The website of Park Regis Singapore is a simply formatted website on a green background, with the marks “PARK REGIS” and “LEISUREINN” displayed at the top left hand corner, and alternating every few seconds. The mark “Staywell Hospitality Group” is also prominently displayed at the top right hand corner. The website is simply designed with a few hyperlinks to a video on the hotel, Staywell’s

loyalty and discount programmes, and their email address, with other information in basic font. At the bottom of the page, there is a reference to the Staywell Hospitality Group and clicking on this takes the customer to details of other hotels in the group. The website of The St. Regis Singapore has a black background and presents a much more sophisticated image. At the bottom of each page, the mark "Starwood Preferred Guest", and the names of the other hotels owned by Starwood and the other hotel brands operated by the Opponents are displayed. The cover page provides little practical information about the hotel, and instead piques the visitor's interest with captions such as "the Address of Luxury", "Epicurean Voyages" and "the Art of Living", in gold type. The mark "ST. REGIS" is displayed at the top right hand corner. It would be clear to the reasonable and discerning customer booking online, that these are not economically linked entities, and that they belong to different groups. It is worth emphasising that a reasonable customer looking at the lists of related hotels in either site would notice that there is no reference to the other. This omission is particularly significant in the case of the Park Regis Singapore site since the operators of a 4-star hotel would definitely advertise any association they had with a 6-star hotel brand.

(b) Booking through travel agent: When this method is used, whilst there may be some confusion because there would be no opportunity for the would-be customers to see the marks, such confusion can be easily cleared up since the travel agents would be knowledgeable about the attributes of each hotel and would be able to explain the different category each belongs to and that one is not connected with the other.

(c) Telephone bookings: Telephone bookings also do not give customers the opportunity to see the mark. There is a greater likelihood of confusion for those who book over the telephone since they would be dealing with staff of the hotel rather than an independent agent who would ask questions to determine the identity of the hotel required.

(d) Walk-ins: the "PARK REGIS" and "ST. REGIS" marks are prominently displayed on both the hotel buildings and in the lobbies. There would be less likelihood of confusion when guests walk into the hotel, see the different standards of decor and can be immediately disabused of their earlier misconceived notions, if any.

43 No statistics have been adduced as to which is the most popular method of booking. Starwood has, however, adduced evidence showing a large spike in the number of page views in Singapore for both its St. Regis hotel site, and its Starwood hotels site from 2007 to 2008. There are no statistics for 2009-2012. In the modern world, it is likely that many would-be guests of the respective hotels would use either the internet or a travel agent to make their bookings. Unless guests book over the telephone, it would appear that there is little scope for confusion. This is not a case like *Reckitt & Colman Products Ltd and Borden Inc and Others* [1990] 1 WLR 491, where the label was readily detachable from the product and customers were likely to associate the brand with the product packaging. The marks in the present case cannot readily be detached from the hotel itself. Even if a guest booked over the telephone, any confusion is likely to be dispelled when he checks in.

44 The Opponents' contentions regarding the likelihood of confusion were based more on arguments than on evidence. They did not submit survey results showing a likelihood of confusion which was not "merely speculative or hypothetical"; see *Polo (HC)* at [22]. The situation in the present case is not unlike the situation faced by Belinda Ang J in *MacDonald's*. She observed at [61] that:

No survey was carried out. The arguments are founded on nothing more than mere speculative use of the "caused to wonder" test Lord Upjohn warned against in *"Bali" Trade Mark*.

The lack of survey evidence was clearly a factor in the Judge's mind in finding no likelihood of confusion. In other cases where likelihood of confusion has been found, survey evidence has been adduced (*eg Clinique*, where survey results showed that 46% of people surveyed were confused).

45 The evidence in the present case is sparse. The Opponents rely on three isolated incidents of confusion: a magazine article attributing the St. Regis property to Staywell Hospitality Group, a Tripadvisor website review from a guest who connected the Park Regis Hotel with "the Regis Brand", and a guest who had stayed in the Park Regis Hotel in Sydney and asked whether it was part of "the St. Regis Group". It is impossible to tell from these pieces of evidence, whether the confusion was caused by the similarity between the marks and goods, or whether it resulted from other factors which ought not to be taken into account (*eg* a mere typo in the magazine article which had confused the St. Regis and Park Regis properties); see *Polo (HC)* at [23]. Moreover, out of the three instances of confusion, one was a query which could have easily been answered by a quick internet search. The PAR rightly observed, at [68] of her judgment, that the evidence raised by the Opponents was "from an unidentifiable source and the nature of such internet entries is that it makes such evidence, even if admissible, not very reliable".

46 The Opponents' submission that a Park Regis hotel would be seen as a ST. REGIS hotel near a park is also not persuasive. The *CDL Hotels'* case is of little help to the Opponents. The addition of the word "Millenia" was found, at [83], to be a distinguishing mark which set apart that particular Ritz-Carlton Hotel from the normal standards of the Ritz-Carlton. The present case is different. The Opponents' other ST. REGIS properties have not dropped the prefix "St.". These properties include the St. Regis Residence Club Aspen, the St. Regis Aspen Resort, the St. Regis Grand, the St. Regis Punta Mita, and the Grand Hotel St. Regis. The prefix "ST." is clearly an integral part of the brand "ST. REGIS". "REGIS" is not a distinguishing mark which qualifies the brand in the same way that "Millenia" set apart the Ritz-Carlton Millenia Singapore in *CDL Hotels*.

The steps taken by the Applicant to differentiate the goods from those of the Opponent

47 The prominent display of the "Staywell Hospitality Group" mark on Park Regis Singapore's website, the attempt to classify the hotel as a 4-star hotel in a different category from The St. Regis Singapore, and the marketing of Park Regis Singapore as a business rather than as a luxury hotel (deliberately differentiating it from the Park Regis Piermonde), are all steps taken by Staywell to differentiate their goods and to reduce confusion.

The kind of customer who would be likely to buy the goods of the applicant and opponent

48 It is not possible to state categorically that only rich Singaporeans would patronise The St. Regis Singapore while Park Regis Singapore would cater to the middle income guest. People who would not regard themselves as rich may on occasion treat themselves by patronising The St. Regis Singapore. This does not mean, however, that the choice would be made because they are confused. The average Singaporean consumer is "not an unthinking person in a hurry but ... someone who would exercise some care and good sense in making his purchases"; *Polo* at [34]. This would particularly be the case with discerning guests who choose The St. Regis Singapore because of its exclusivity and reputation for luxury. Given that ST. REGIS hotels are not cheap hotels, potential guests are likely to either do a quick internet search or seek clarification from the travel agent or hotel before making their booking, and this would suffice to dispel any confusion.

Conclusion on s 8(2)(b) of the Act

49 Having considered all the factors, I have come to the conclusion that the marks are not likely

to be confused, despite the fact that I have found that they are similar. Accordingly, I reverse the PAR's findings on s 8(2)(b) of the Act.

Section 8(4) of the Act

50 The relevant portions of s 8(4) of the Act for the purposes of this part of Staywell's appeal are the body of the section and ss (a) and (b)(i). These provisions read as follows:

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

(a) The earlier trade mark is well known in Singapore; and

...

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

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

51 The PAR found that the Opponents' Mark was well known in Singapore as of 3 March 2008 when Staywell sought to register the Application Mark. She also held that the use of the Application Mark would lead to a real likelihood that the interests of the Opponents would be damaged because potential customers would be misled into thinking that Staywell's services originated from the Opponents or that there was some connection between the two parties.

Is the "St. Regis" mark a well-known mark connected to the unique "St. Regis" brand?

52 The definition of a well known trade mark is set out in s 2(1)(a) of the Act, and is "any registered trade mark that is well known in Singapore". This is subject to the deeming provision in s 2(8) of the Act, which reads:

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

53 What a well-known trademark is was considered in *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] SGCA 13 ("*Amanresorts*") in the context of s 55 of the Act. The wording of s 55(3) is almost identical to that of s 8(4). The only difference is that s 8 entitles the party who successfully pleads it to remove a mark from the register, while s 55 entitles the same party to get an injunction against the proprietor of the offending mark regardless of whether it is registered. The Court of Appeal considered the intention of the legislature to "give better protection [to] well-known marks", and concluded that the relevant sector of the population was the actual and/or potential consumers of the opponent's goods and services, and not the actual and/or potential consumers of the type of goods and services to which the opposing mark applied. In construing s 2(8), the Court of Appeal added the following caveats:

(a) The additional protection granted to a well-known trademark is not very extensive as compared to the protection granted to ordinary trademarks (see [147]);

(b) The likelihood of confusion between the marks and its accompanying goods and services must still be proved, and the fact that a good or service is only known in a niche market may make proving the likelihood of confusion more difficult (see [148]); and

(c) The requisite level of knowledge of the mark should tend towards the higher end of the scale to qualify for protection as a well-known mark (see [149]).

54 On the basis of the holdings of the Court of Appeal in *Amanresorts*, the ST. REGIS mark would be a well-known trademark if at the material time it was well-known to the actual and/or potential client base of The St. Regis Singapore.

55 To establish that The St. Regis Singapore was well-known to its actual or potential client base in Singapore, the Opponents relied on, *inter alia*, a statutory declaration from one Michael Dojlidko who is employed by Starwood. Mr Dojlidko stated that Starwood's customer loyalty programme, which covered the St. Regis hotels worldwide, had more than 30,000 Singaporean members as of 2007. The number of visitors in Singapore to the St. Regis website was 690,941 in 2008. Further, the Opponents referred to and produced numerous newspaper and magazine articles, available in Singapore, about the ST. REGIS brand and its hotel in Singapore. This evidence was not effectively disputed by Staywell, except for a throwaway line in its written submissions asserting, without explaining, that "the [Opponents] have not adduced any evidence that they are well-known for the earlier mark 'ST. REGIS' in Singapore." The evidence substantiates the PAR's finding that the requisite level of knowledge was high enough to qualify the Opponents' Mark as a well-known trademark.

Is the "PARK REGIS" mark similar or identical to the "ST. REGIS" mark?

56 I have already found at [29] above that the marks are similar.

Does this similarity indicate a connection between Staywell's and the Opponents' hotels?

57 This question is another way of asking whether there is a likelihood of confusion. Considering this question in the context of s 55(3)(a) in *Amanresorts*, the Court of Appeal held, at [233], that:

[T]he widespread availability of protection to trade marks which are "well known in Singapore" should be balanced by interpreting s55(3)(a) of the current TMA as requiring a likelihood of confusion to be shown before an injunction to restrain the use of the defendant's trade mark on (*inter alia*) goods or services dissimilar to those of the plaintiff can be obtained.

Section 55(3)(a) of the Act is identical to s 8(4)(b)(i), save that the latter has the additional words "of the earlier trademark" as it specifically allows proprietors of marks which have been registered earlier in time to oppose the entry of similar or identical marks subsequently sought to be registered. It may be argued that the availability of an injunction under s 55(3)(a) necessitates a stricter test than for s 8(4)(b)(i). However, the removal of Staywell's trademark from the register is no less draconian than an injunction to prevent its use. Once the Application Mark is deprived of the protection accruing to a registered trademark, the Opponents can easily prevent the use of the mark. Section 55(3)(a) fulfils the same substantive aims as s 8(4)(a), and the Court of Appeal's findings in *Amanresorts* therefore apply to the present case.

58 I have held above (at [49]) that there is no real possibility of confusion. The fact that "ST. REGIS" is a well-known mark does not affect this analysis. The difference between s 8(2) and s 8(4)(b)(i) is that the former requires that both marks be tied to similar goods and services, while the latter allows a proprietor of an earlier mark to prevent registration of a later mark *even though* the

goods and services offered by the later mark are *dissimilar*. The additional protection granted to a well-known mark is thus not much more extensive than that granted to a normal mark. The fact that "ST. REGIS" is a well-known mark clearly does not warrant a relaxation of the test of likelihood of confusion. This additional avenue is of little use to the Opponents where there is no likelihood of confusion.

Is there a likelihood of damage to the "St. Regis" brand from use of the "Park Regis" mark?

59 Given that there is no likelihood of confusion, the question of likelihood of damage is moot. In any event, it appears to me that there is no real likelihood of damage to the "ST. REGIS" brand from use of the "PARK REGIS" mark. *Even if* the hotels were perceived to be economically linked, it is clear from the marketing of both hotels that Park Regis Singapore is pitched at a class or two below The St. Regis Singapore. The standards expected of Park Regis Singapore would accordingly be lower. The fact that this hotel does not offer luxury services such as a Bentley limousine pick-up from the airport would not cause damage to the "ST. REGIS" brand. The Opponents' argument that being associated with the 3 to 4 star Park Regis hotel group affects their reputation for luxury is not persuasive.

60 It may be thought that there is damage as allowing registration of the Application Mark may prevent Starwood from expanding into the 3 to 4 star hotel segment under the "ST. REGIS" brand to capture more market share. This was found to be an acceptable head of damage in *Amanresorts* (at [121]). The present case is, however, distinguishable from *Amanresorts*. In *Amanresorts*, not only did the respondents plead that allowing the appellant to use the name "Amanusa" for its condominium project would prejudice their commercial plans to expand into residential development, it was also shown that they were already involved in that field. There is no indication here that the Opponents have any intention of moving the ST. REGIS brand into a different market segment. In fact, all of the hotels in the Starwood Group under this brand are luxury hotels above the 3 to 4 star range. There is thus no basis for finding that the Opponents will suffer damage because their future commercial expansion has been prejudiced.

61 In the circumstances, I have concluded that the PAR's findings on s 8(4)(a) should be reversed.

Section 8(7)(a) of the Act

62 I now turn to deal with the Opponents' cross appeal against the PAR's findings in respect of their opposition to the Application Mark on the basis of s 8(7)(a) of the Act.

63 Section 8(7)(a) reads:

A trademark 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.

64 Under the law of passing off, three elements must be established by the Opponents in order to obtain the protection of this section. First, they must show that goodwill for the Opponents' Mark existed in Singapore as at 3 March 2008, the application date for the Application Mark. Second, they must show that there was a misrepresentation by Starwood to the public which led, or is likely to lead, the public to believe that Staywell's services are those of the Opponents. Finally, they must establish a likelihood of damage to the ST. REGIS brand; see *Millenia* at [86].

65 The PAR found that there was no goodwill in Singapore as at the application date because at that date, there was no St. Regis hotel in Singapore. The Opponents' Mark may have had a reputation here at that time but the PAR pointed out (at [36] of her decision) that goodwill is different from reputation and whilst goodwill may have attached to the Opponents overseas, on that date, there was no goodwill in Singapore.

Was there goodwill for the "ST. REGIS" brand in Singapore?

66 There is no dispute that the relevant date for assessment of the Opponents' goodwill in Singapore is 3 March 2008. The St. Regis Singapore officially opened on 20 April 2008. The Opponents argue that there was a substantial amount of pre-opening advertising and this established goodwill before the relevant date. They rely on *CDL Hotels*.

67 Goodwill has been defined as "the attractive force which brings in custom"; see *The Commissioners of Inland Revenue v Muller & Co's Margarine, Limited* [1901] AC 217 ("*IRC v Muller*") at 224. There are two elements. First, the brand name must exude an attractive force. Second, this attractive force must bring in custom.

68 In the present case, as the PAR also pointed out, what is important is not whether the brand name is attractive and well-known but also whether it has actually brought in custom. On this basis, *CDL Hotels* was decided in very different circumstances. The relevant date in that case was 17 October 1995. The evidence of "business activities which had gone into full swing and which generated considerable income for the respondents" (see [61] of the *CDL Hotels* judgment) was as follows:

- (a) The topping up ceremony of the Ritz-Carlton Millenia Singapore ("RCMS") on 17 October 1994;
- (b) Pre-opening sales and marketing campaign since December 1994;
- (c) First room reservation at the RCMS in April 1995; and
- (d) The topping up ceremony for Millenia Tower on 17 April 1995, celebrating (*inter alia*) that 50% of the floor space of Millenia Tower had already been let.

69 There was custom for the respondents in *CDL Hotels*. The filling of 50% of the floor space of the Millenia Tower was essential because the development was a mixed one, with a large part of its income generated from its tenants. It is also significant that there was evidence of room reservations by the relevant date. In contrast, the pre-opening activity in the present case had not reached this level by the relevant date of 3 March 2008.

70 The Opponents rely on the following:

- (a) ST. REGIS brand's international reputation and the total net revenue earned by the Opponents for bookings at all their hotels worldwide in 2007 and 2008;
- (b) The advertising and promotion of the "ST. REGIS" name or marks in travel magazines, publications and television advertisements, as well as through the Starwood Preferred Guests Programme ("SPG Programme") in which 30,000 Singaporeans were enrolled. These advertisements announced that the hotel was opening in December 2007;

- (c) The acceptance of hotel guests from 22 December 2007, and perhaps even earlier;
- (d) The securing of restaurant tenants within the property by 22 December 2007;
- (e) Holding a much-publicised job fair to hire hotel staff; and
- (f) Purchases of units in the St. Regis Residences, a block of apartments flanking the hotel.

The items listed above do not, in my judgment, assist the Opponents a great deal. For starters, the item listed in sub-para (a) is too broad and does not indicate the attractive force of The St. Regis Singapore. Second, item (b) consisted of advertisements and therefore indicated marketing efforts rather than evidencing actual income or custom. I elaborate further below but I have come to the conclusion that, on balance, the activities undertaken by the Opponents prior to April 2008 were not significant enough to fall within the exception created by *CDL Hotels*.

St. Regis Brand's international reputation and total global revenue

71 Goodwill is territorial, and the fact that the St. Regis Group had custom globally does not help the Opponents. There is no breakdown showing which parts of this revenue were earned in Singapore. The Opponents did not provide figures for the actual earnings of their hotel in Singapore alone for the period from the soft launch until 3 March 2008. Moreover, reputation is not enough to establish goodwill. The Court of Appeal in *Amanresorts* at [62] found that:

A desire to become a customer of the plaintiff, without the ability to actually be one, cannot ordinarily form the basis of goodwill... In such a case, the plaintiff can be described as having a good reputation among such persons... but this is not the same as having goodwill.

[emphasis original]

Advertising and promotion of the St. Regis marks

72 It may be argued, by analogy to *Amanresorts*, that the custom of Singaporeans in other St. Regis hotels worldwide under the SPG Programme is sufficient to establish goodwill. This case is, however, again distinguishable from *Amanresorts*. First, the goodwill sought to be established here is specifically for The St. Regis Singapore, while the goodwill sought to be established in the *Amanresorts* case was for the Amanusa resort in Bali. At the time the competing mark in *Amanresorts* was set up, there had already been 1,382 customers from Singapore who had stayed in Amanusa Bali (see [14]). By contrast, the customers gained from the Opponents' SPG Programme were for different hotels, *albeit* within the same group. While the SPG Programme is mentioned in the statutory declaration, there is no mention of whether advance bookings for The St. Regis Singapore were possible through this programme. The advertisements included the address, phone number and email address of The St. Regis Singapore, but there is no direct evidence from the hotel staff that The St. Regis Singapore was accepting reservations at the time these advertisements were put up. Second, in *Amanresorts*, the Amanresorts Group's corporate headquarters and international reservations office were in Singapore and took 30-40% of all reservations and inquiries from Singapore. There is no evidence that The St. Regis Singapore was doing the same.

73 Nor is it persuasive that there have been many visitors from a Singaporean IP address to St. Regis's website. The real spike in web traffic occurred in 2008, when the number of visitors jumped from 187,868 to 690,941. There is no indication of how much of this traffic happened prior to early March 2008. It is also worth noting the observations of the Court of Appeal in *Amanresorts* (at [54])

in relation to the probative value of such websites:

[T]he Respondents' website... has received "millions of hits"... - but we do not know where or from whom. Without such information, we would place little weight on the existence of the Respondents' "Aman" websites in assessing the degree of exposure of the "Aman" names locally.

The acceptance of hotel guests

74 The evidence adduced for such acceptance is inadmissible. The evidence includes a newspaper article published on 23 December 2007 reporting that the hotel "has been receiving enquiries and bookings", a magazine article reporting that a Japanese couple had confirmed their reservation at The St. Regis Singapore for January 2008, and another article in November 2007 that stated "Go to stregis.com/Singapore to make your booking." The Opponents intend to use these statements to prove the truth of their contents. This use falls afoul of the hearsay rule. Reliance on such hearsay evidence was somewhat surprising as the Opponents must have had access to staff and records of The St. Regis Singapore and could have used the same to back up their assertions.

75 Section 108 of the Evidence Act (Cap 97, Rev Ed 1997) states that "when any fact is especially within the knowledge of any person, the burden of proving that fact is upon him." The Opponents have not discharged their burden of proof relating to the hotel's bookings and income between December 2007 and early March 2008. Further, there were no records to show whether the hotel guests who were allegedly accepted from 22 December 2007 were customers from Singapore rather than from other parts of the world who may have been attracted by the St. Regis Group generally rather than by the Singapore hotel itself. In fact, the Japanese honeymooners, the only guests identified as having made a booking in July 2007 for January 2008, were most probably from Japan and not from Singapore. There was no evidence that they in fact utilised the booking after the hotel opened.

The securing of restaurant tenants

76 Unlike in *CDL Hotels*, where a substantial part of the development was a retail tower, the restaurants in The St. Regis Singapore are ancillary to its primary business of providing accommodation and convention services. The custom The St. Regis Singapore needs to attract in order to establish goodwill comprises room reservations and convention bookings, *not* tenants.

Job fair to hire hotel staff

77 The activity in *CDL Hotels* was revenue generating, thus allowing the Court to draw the conclusion that its business activities had fully commenced. The hiring of hotel staff would not generate income for The St. Regis Singapore; it was a preparatory act for the hotel's future business and did not in itself constitute business activity. Attendance at the job fair is not enough for goodwill.

Custom for the St. Regis Residences

78 Custom for the St. Regis Residences is also insufficient. "Goodwill is worth nothing unless it has power of attraction sufficient to bring customers home *to the source from which it emanates*"; *IRC v Muller* at 224 (emphasis added). Reasoning from first principles, what is protected is the goodwill attached to the specific business of providing temporary accommodation, and not merely the brand "St. Regis" as applied to the Opponents' other businesses. Slade J in *My Kinda Bones v Dr. Pepper's Stove Co.* [1984] FSR 289 at 299 seems to assume that the goodwill must attach to the particular business:

[A]s a matter of principle, a plaintiff in this country cannot establish the existence of goodwill attached to the name of a projected restaurant, sufficient to ground a passing off action, at a time when he has as yet never opened a restaurant under such name to customers either in this country or elsewhere ... a substantial number of customers or potential customers must at least have had the opportunity to assess the merits of those goods or services for themselves.

79 Persons who purchased units in the St. Regis Residences at the material time did not do so on the basis of the merits of The St. Regis Singapore's services. It is likely that such purchasers of the St. Regis Residences would have been attracted mainly by the location and quality of those residences. There was no evidence that such purchasers bought these apartments because they were next to or linked with the hotel.

Was there misrepresentation or a likelihood of damage?

80 Since I agree with the PAR's finding that there was no goodwill, there is no need to consider the question of misrepresentation.

81 Since neither goodwill nor misrepresentation has been found, there is no need to consider the question of likelihood of damage.

82 The Opponents' cross-appeal on s 8(7) of the Act must, therefore, fail.

Conclusion

83 In the final analysis, the "PARK REGIS" mark, although similar to the "ST. REGIS" mark, is not likely to be confused with the "St. Regis" brand, particularly when taking into account the likely customers of both brands. In my judgment, therefore, the opposition to the "PARK REGIS" mark under s 8(2)(b) of the Act cannot succeed and the PAR's decision is, accordingly, reversed.

84 As there is also no likelihood of damage to the "ST. REGIS" brand from the use of the "PARK REGIS" mark and brand, the opposition to the "PARK REGIS" mark under s 8(4) is similarly unsuccessful and the PAR's decision on this ground is also reversed.

85 In the result, Staywell's appeal is allowed and the Opponents' cross-appeal is dismissed. The Opponents shall pay Staywell's costs of the appeal and the cross-appeal.

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