

Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd  
[2015] SGHC 216

**Case Number** : TA No 11 of 2014  
**Decision Date** : 21 August 2015  
**Tribunal/Court** : High Court  
**Coram** : George Wei JC (as he then was)  
**Counsel Name(s)** : Moiz Haider Sithawalla and Tham Chang Xian (Tan Rajah & Cheah) for the appellant; Teo Kwan Soon Paul (Ravindran Associates) for the respondent.  
**Parties** : ROVIO ENTERTAINMENT LTD — KIMANIS FOOD INDUSTRIES SDN BHD

*Trade marks and trade names – grounds for refusal of registration*

*Trade marks and trade names – registration criteria – conflicts with earlier marks*

*Trade marks and trade names – passing off*

21 August 2015

Judgment reserved.


**George Wei J:**

1 This is an appeal from the principal assistant registrar of trade marks's ("PAR") decision, regarding Rovio Entertainment Ltd's ("the Opponent") opposition to Kimanis Food Industries Sdn Bhd's ("the Applicant") Trade Mark Application No. T1204840G.

**The Opponent's Trade Marks**

2 The Opponent is a software development and entertainment company incorporated in Finland. Its most famous and successful product is the mobile phone game franchise *Angry Birds*, which was first released in 2009. According to the Opponent, the *Angry Birds* game has 200 million active users worldwide, and has seen 350 million downloads globally. [\[note: 1\]](#)

3 The Opponent is the registered proprietor of the following trade marks:

Trade Mark	Classes registered	Date
T1111886Z "Red Bird Mark" 	3, 9, 14, 16, 18, 20, 21, 24, 25, 27, 28, 29, 30, 32, 33, 34, 35, 36, 38, 41 and 43	Priority Claim: 31 March 2011 Date of Filing: 15 April 2011

T1113897F "Angry Birds Word Mark" <b>ANGRY BIRDS</b>	3, 9, 14, 16, 18, 20, 21, 24, 25, 27, 28, 29, 30, 32, 33, 34, 35, 36, 3, 41, and 43	Priority Claim: 31 March 2011 Date of Filing: 15 April 2011
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(collectively, "the Opponent Marks")

4 For convenience, the registered trade marks will be referred to as the "Red Bird Mark" and the "Angry Birds Word Mark".

5 The Opponent also uses a stylised version of the Angry Birds Word Mark ("Fancy Word Mark"). The Fancy Word Mark is exhibited at [10] of the Opponent's "Amended Grounds of Opposition" [\[note: 2\]](#). While the Fancy Word Mark is not a registered trade mark in Singapore, the Opponent has asserted that it enjoys copyright in the Fancy Word Mark. [\[note: 3\]](#) The Fancy Word Mark and the Red Bird Mark were registered for copyright in the USA and China. [\[note: 4\]](#) I reproduce the Fancy Word Mark below:



6 Aside from being used in respect of the *Angry Birds* game, the Opponent Marks (as well as the Fancy Word Mark) appear to have been used in Singapore on a wide variety of merchandise, including toys, cakes, snacks and fast food. The merchandise is not manufactured and sold by the Opponent itself. It is sold by the Opponent's licensees. In fact, the Opponent's business model is at least in part reliant on licensing the Opponent Marks to a wide range of businesses for their use on merchandise. That said, the date on which the use of the Opponent Marks on merchandise commenced in Singapore and the scale of such use are somewhat unclear from the evidence before me.


7 There is some evidence that the *Angry Birds* concept has been marketed in Singapore. For example, it was promoted in association with Singapore's 2011 and 2012 Formula 1 Night Race, and the Singapore Cable Car from June 2012. It has also been advertised at the Singapore Changi airport in November 2012, and at the Takashimaya Department Store in 2011. [\[note: 5\]](#)

### The Applicant's Trade Mark

8 The Applicant is a snack food manufacturer. It is a company incorporated in Malaysia. It has sold its snacks under the brands "Jimbo" and "D-Jack" in Malaysia and abroad.

9 The Applicant applied to register the following mark in Trade Mark Application No. T1204840G on 5 April 2012:

Trade Mark	Classes registered	Date

<p>T1204840G</p> <p>"Angry Bite Mark"</p> 	<p>30</p> <p><i>Flour based savoury snacks; food products containing (principally) flour; cereal based snack food; snack food products made from maize flour; snack food products made from potato flour; snack food products made from rice flour; snack food products made from soya flour; rice based snack foods; flour confectionary; sesame snacks.</i></p>	<p>Date of application: 5 April 2012</p>
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(Referred to as the "Angry Bite Mark")

### The Decision below

10 Before the PAR, the Opponent objected to the registration of the Angry Bite Mark on the grounds of ss 8(2)(b), 8(4) and 8(7) of the Trade Marks Act (Cap. 332, 2005 Rev Ed) ("TMA").

11 Five main grounds of opposition were relied on:

(a) Pursuant to s 8(2)(b) of the TMA: The Angry Bite Mark is similar to the Opponent Marks in respect of identical or similar goods, and there exists a likelihood of confusion.

(b) Pursuant to s 8(4)(a) read with s 8(4)(b)(i) of the TMA: The Angry Bite Mark (or an essential part of it) is similar to the Opponent's earlier well known trade marks and indicates a connection in the course of trade with the likelihood of causing damage to the interests of the Opponent.

(c) Pursuant to s 8(4)(a) read with s 8(4)(b)(ii) of the TMA: The Angry Bite Mark (or an essential part of it) is similar to the Opponent's earlier well known trade marks, the use of which will cause dilution or take unfair advantage of the earlier well known trade marks.

(d) Pursuant to s 8(7)(a) of the TMA: The Applicant's use of the Angry Bite Mark constitutes passing off.

(e) Pursuant to s 8(7)(b): The Angry Bite Mark infringes the copyright in the Opponent's Red Bird Mark as well as the copyright in the Fancy Word Mark.

12 The evidence for the Opponent comprised two statutory declarations by Mr Harri Koponen and Ms Kati Levoranta. Evidence for the Applicant consisted of a statutory declaration of Mdm Huang Len Len. No expert or survey evidence was provided.

13 Having considered the evidence and submissions presented by both parties, the PAR dismissed the Opponent's opposition, and awarded costs to the Applicant (see [2014] SGIPOS 10 ("the PAR's GD")). In summary, the PAR held that:

(a) In relation to s 8(2)(b) of the TMA, the marks are more dissimilar than similar in totality, and there is no likelihood of confusion.

(b) In relation to s 8(4) of the TMA, the Opponent Marks are “well known in Singapore” under s 8(4)(a), but are not “well known to the public at large” under s 8(4)(b)(ii) of the TMA. Regardless, the Opponent Marks and the Angry Bite Mark are not identical or similar. Further, the Applicant’s use of the Angry Bite Mark would not indicate a connection between its goods and the Opponent.

(c) In relation to s 8(7)(a) of the TMA, under the law of passing off, there is insufficient evidence to demonstrate goodwill in the Opponent Marks, and there is no misrepresentation.

(d) In relation to s 8(7)(b) of the TMA, there is no copyright infringement because there is no proof that the Opponent Marks are original creations, and there is no proof of copying.

## **The present appeal**

14 The matter is now before me on an appeal filed by the Opponent against the PAR’s decision. In the present appeal, the Opponent has dropped its objection on the ground of s 8(4)(b)(ii) read with s 8(4)(a) of the TMA which concerns earlier trade marks which are “well known to the public at large in Singapore”. [\[note: 6\]](#)

15 It pursues the appeal on the ground that the PAR erred in relation to s 8(2)(b), s 8(4)(b)(i) read with s 8(4)(a), s 8(7)(a) and s 8(7)(b) of the TMA.

## **Legal issues**

16 The issues that arise for my consideration in this appeal can be neatly structured around the statutory grounds upon which the Opponent relies to object to the registration of the Angry Bite Mark.

17 The first broad issue is whether the Opponent’s objection on the ground of s 8(2)(b) of the TMA can succeed. Specifically, the following points were canvassed:

(a) For the purposes of the similarity comparison in s 8(2)(b) of the TMA, can this court consider the separately registered Opponent Marks as a composite mark, or is the court limited to considering the Angry Bite Mark separately against the Red Bird Mark and the Angry Bird Word Mark respectively?

(b) In light of the conclusion in (a), are the Angry Bite Mark and the Opponent Marks similar?

(c) If the Applicant is allowed to register and use the Angry Bite Mark, is there a likelihood of confusion on the part of the public?

I note in passing that in its submissions, the Applicant did not put in question whether the similarity of goods requirement is satisfied. [\[note: 7\]](#) Thus, this is not a live issue before me.

18 The second broad issue relates to the Opponent’s objection on the ground of s 8(4)(b)(i) read with s 8(4)(a) of the TMA. The following points arise for consideration:

(a) Is the “whole or an essential part” of the Angry Bite Mark identical or similar to either of the Opponent Marks?

(b) Are the Opponent Marks “well known in Singapore”?

(c) Would the use of the Angry Bite Mark indicate a connection between the goods of the Applicant and the Opponent?

(d) If so, is the connection likely to damage the interests of the Opponent?

19 The third broad issue relates to s 8(7)(a) of the TMA, namely whether the Defendant's use of the Angry Bite Mark is liable to be prevented under the tort of passing off. The following sub-issues arise for consideration:

(a) Do the Opponent Marks generate goodwill?

(b) Will the Applicant's use of the Angry Bite Mark amount to a misrepresentation leading to a likelihood of confusion and damage?

20 The fourth broad issue is whether the use of the Angry Bite Mark is liable to be prevented for copyright infringement under s 8(7)(b) of the TMA. Specifically, it is necessary to consider,

(a) Whether the Opponent has subsisting copyright in the Opponent Marks or any other relevant works; and

(b) Whether the Applicant copied a substantial part of any of the Opponent's copyright works in creating the Angry Bite Mark.

### **Issue 1: s 8(2)(b) of the TMA**

21 Section 8(2)(b) of the TMA provides as follows:

A trade mark shall not be registered if because —

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

(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.

22 In considering if s 8(2)(b) of the TMA is made out on the facts, the Court of Appeal in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another and another appeal* [2014] 1 SLR 911 ("*Staywell*") at [15] has affirmed the step-by-step approach. This entails assessing the three requirements of similarity of marks, similarity of goods or services, and likelihood of confusion arising from the two similarities, systematically. The first two elements are assessed individually before the final element which is assessed in the round (see [15] of *Staywell*).

### ***Similarity of marks***

23 There is no dispute that the Opponent's marks are earlier trade marks under the TMA. An important preliminary issue, however, needs to be addressed before embarking on a comparison of the marks. This concerns whether the Red Bird Mark and the Angry Bird Word Mark can be treated as a composite registered trade mark for the purposes of comparison with the Angry Bite mark.

*Preliminary issue: Can the Opponent Marks be considered as a composite mark in the similarity*

comparison?

24 Before the PAR, the Opponent submitted that in engaging in the similarity comparison, the court may combine the Opponent Marks, even though they are individually registered as separate trade marks. This means that the court can consider if the Angry Bite Mark is similar to a composite mark made up of *both* the Red Bird Mark and the Angry Bird Word Mark.

25 I start by making a preliminary observation that the Opponent Marks were not registered as a series of trade marks under s 17 of the TMA. Indeed, it seems improbable that the Red Bird Mark and Angry Bird Word Mark would qualify as “a series of trade marks”, which is defined in s 17(2) of the TMA as “a number of trade marks which resemble each other as to their material particulars and which differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark”. The significance of this shall be discussed below.

26 The PAR considered the issue, and found that the Opponent Marks should be treated separately. She reasoned that it is the mark *as registered* that is treated as a property right, and protected under the TMA. The Opponent could gain protection over a composite mark consisting of two of its earlier trade marks *only if* it had separately registered the composite mark as well.

27 On appeal, the Opponent submits that the case law cited by the PAR does not support her position that the court may not consider the Opponent Marks as a composite. The submission was that from a policy perspective, requiring trade mark proprietors to register their marks in various permutations in order to be afforded what is perhaps best described as “holistic protection” under the TMA was untenable.

28 That said, the Opponent submits that the composite mark could have been successfully registered as a trade mark. Given that the individual parts (the Red Bird Mark and the Angry Bird Word Mark) of the composite mark were successfully registered as trade marks (thereby appearing to satisfy the requirements of distinctiveness *etc.* and see section 101(1)(c) TMA), it followed that the composite mark would also have been registrable. Accordingly, since the Opponent does in fact use the Opponent Marks as a composite on its products, the court should consider it as a composite mark in conducting the similarity comparison.

29 The Applicant seeks to affirm the PAR’s reasoning, and disputes both the Opponent’s interpretation of the relevant cases as well as its policy reasoning.


The relevant case law

30 The first case relied on by the PAR and the Applicant is *Staywell*. The PAR relied on the Court of Appeal’s statement that “assessment of marks similarity is mark-for-mark without consideration of any external matter” (*Staywell* at [15] and [20]) in concluding that the comparison must be “[a] mark-for-[a]-mark” ([50] of the PAR’s GD).


31 In my view, the Court of Appeal’s statement must be read in context of the issues raised by the parties and the facts of *Staywell*. I agree with the Opponent that the Court of Appeal, in making that comment at [20], did not *specifically direct its mind* to whether two separately registered marks may be considered as a composite at the similarity of marks stage. The Court of Appeal was merely making the point that “external matter”, such as factors that affect the relative importance of different types of similarities, is irrelevant at the similarity of marks stage.

32 However, another part of the *Staywell* judgment, not raised by the parties, is perhaps more


directly on point.

33 When the *Staywell* case was before the High Court, the Judge found that the "ST REGIS" trade mark conveys the idea of royalty. The learned judge held that this idea of royalty was reinforced by the  device (the *fleur-de-lis* device) used by the "ST REGIS" brand of hotels in its advertisements (see *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another* [2013] 1 SLR 489 ("*Staywell (HC)*") at [28]). The point is that the *fleur-de-lis* device, whilst it does not appear (from the report of the decision) to have been registered as a trade mark, was used by the St Regis hotel chain in its advertisements (see *Staywell (HC)* at [6]).

34 However, the Court of Appeal in *Staywell* (at [36]) held that

... [T]he Judge erred in treating the Opponent's  device as a reinforcement of the concept of royalty. The device was not part of the Opponent Mark, and the authorities are clear that marks-similarity must be assessed without regard to "external added matter or circumstances..."

35 Whilst the Court of Appeal in *Staywell* was not addressing the case of two related but separately registered trade marks belonging to the same proprietor, the holding lends support to the Applicant's position that a court may not consider a proprietor's other registered marks in the similarity of marks comparison. Other registered marks are in this sense also considered "external added matter or circumstances". Instead, each opponent mark must be compared individually against the applicant mark; what is required is a mark for mark comparison. As the learned author of Ng-Loy Wee Loon, *Law of Intellectual Property in Singapore* (Sweet & Maxwell, 2nd Ed, 2014) ("*Ng-Loy Wee Loon*") opines at para 21.5.18(b), even if the earlier trade mark is always used by its proprietor with a tag line, it is inappropriate to make the comparison between 'the earlier trade mark plus tag line' and the later mark.

36 Of course, the Opponent is entitled to argue that [36] of *Staywell* does not conclusively decide the preliminary issue before this court. This would be because the Court of Appeal was not explicitly considering the possibility of a composite consisting of  and the "ST REGIS" trade mark being *the mark in question*. Instead, it was undisputed that the court was to compare the "ST REGIS" trade mark against the applicant mark. In that sense, the *fleur-de-lis* device was naturally "external matter". However, if the Opponent is correct that the mark that is to be the subject of comparison can consist of a composite of two earlier registered trade marks, then neither of the two earlier registered trade marks would be "external matter". Instead, they would be part of the mark which is the subject of comparison.

37 While this argument may be criticised for its reliance on overly fine technical distinctions, there is nevertheless some merit to the view that the Court of Appeal did not directly consider the permissibility of combining two earlier registered trade marks into one composite mark for the purposes of the comparison.

38 The second case to consider is *Infamous Nut Co Ltd's Trade Marks* [2003] RPC 7 ("*Infamous Nut*"). This was a decision of the Appointed Person, Professor Ruth Annand, of the UK Trade Mark Registry.

39 In that case, the applicant was attempting to register four device marks, each comprising a monkey eating a monkey nut. The opponent had a series of registered trade marks consisting of monkeys holding a nut. The opponent argued that one factor to consider is that it has a "series" or "family" of "monkey holding a nut" marks. In addressing the sole question before the court, which is whether there was a likelihood of confusion under s 5(2)(b) of the UK's Trade Mark Act (which is

almost in *pari materia* to Singapore's s 8(2)(b) of the TMA), the court held at [36] that "where the opponent relies on proprietorship of more than one earlier trade mark, the registrability of the applicant's mark must be considered against each of the opponent's earlier trade marks separately".

40 *Prima facie*, this case lends support to the PAR's and the Applicant's position. However, the Opponent submits that *Infamous Nut* is inapplicable because that case concerned a common theme over a "family of marks", rather than an attempt to combine two separately registered marks.

41 While the Opponent is correct in arguing that unlike the present case, *Infamous Nut* was concerned with the thematic similarity across a "family of marks", it seems to me that the court's approach is *generally* of guidance in situations "where the opponent relies on proprietorship of more than one earlier trade mark" (*Infamous Nut* at [36]).

42 The key finding of the Court in *Infamous Nut* is that "the registrability of the applicant's mark must be considered against each of the opponent's earlier trade marks separately" (*Infamous Nut* at [36]). This was based (at least in part) on the court's interpretation of s 5(2)(b) of the UK's Trade Marks Act 1994 ("UK TMA 1994"), which contemplates refusal of registration on the basis of *an earlier trade mark* as defined in the same statute. Nothing in this reasoning suggests that the court's findings are or ought to be limited to its specific facts or trade marks registered as a series. Rather, it is of general guidance when considering situations where an Opponent relies on more than one earlier registered trade mark in opposing the registration of a new mark.

43 Indeed, I repeat my earlier observation that trade marks are only registered as a series when they resemble each other as to their material particulars and differ only as to matters of a non-distinctive character which do not substantially affect the identity of the trade mark. The UK's statutory provision on when marks may be registered as a series is found at s 41 of the UK TMA 1994, which is similar to s 17 of the TMA. If it is impermissible to take into account other registered trade marks within a series for the purpose of comparison with the applicant's mark, the same must follow (and even more so) where the earlier registered trade marks are not registered as a series.

44 The Opponent also cited *McDonald's Corp v Future Enterprises Pte Ltd* [2005] 1 SLR(R) 177 ("*McDonalds*") and *The Polo/Lauren Co. LP v Shop in Department Store Pte Ltd* [2006] 2 SLR(R) 690 ("*Polo*") in support of its position that the court should take into account the way the earlier trade marks are used in the similarity of marks comparison.

45 In *McDonalds*, McDonald's Corporation ("McDonalds") opposed the applicant's registration of three trade marks, each of which contained a stylised American eagle with the words "MacNoodles", "MacTea" and "MacChocolate". McDonalds had its own registered trade marks – "BIG MAC", "MAC FRIES", "SUPERMAC", "EGG McMuffin", "McChicken", "McNuggets" and "McDonald's". Given the applicant's application for registration was made in 1995, the Court of Appeal had to consider s 15 of the previous Trade Marks Act (Cap 332, 1992 Rev Ed) ("Old TMA"), which states:

It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being **likely to deceive or cause confusion** or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

[emphasis added]

46 In mounting the attack on the applicant marks, McDonalds stressed that the applicant had copied the "distinctive prefix of the appellant's family of marks", namely, "Mc" (see *McDonalds* at [7]).



In brief, the argument was that McDonalds had established a reputation and goodwill in the prefix “Mc”, and that the prefix had become an essential feature in the McDonalds’ family of marks. On this basis, it was claimed that by adopting the prefix “Mac”, the applicant may confuse the public by giving the impression that their products come from McDonalds. McDonalds’ opposition failed and its appeal to the Court of Appeal was dismissed.

47 In the present case, the Opponent relies on the Court of Appeal’s *dicta* in *McDonalds* at [26]. [\[note: 8\]](#) In considering the similarity between the marks in question under s 15 of the Old TMA, the Court of Appeal took into account the fact that McDonalds’ logo (the golden arches) was often used with McDonalds’ registered trade marks *even though* the logo does not form a part of the registered trade marks. Presumably, this is argued as lending support to the claim that in assessing similarity, one must consider how the Opponent’s registered trade marks *are actually used*. Specifically, it is relevant to consider if the Opponent Marks are used in conjunction with anything else (or with each other).

48 While the Court of Appeal in *McDonalds* did take into account how the earlier trade marks were used under s 15 of the Old TMA, this lends little support to the Opponent’s position in the present case. As the Applicant points out, the *dicta* in *McDonalds* at [26] was made in the context of a *different statutory provision*. Importantly, the court was assessing the likelihood that the applicant’s marks would “deceive or cause confusion”. What s 15 required was an examination of whether the *use* of the applicant’s trade mark or a part of the trade mark was likely to deceive or cause confusion or otherwise be disentitled to protection in a court of justice. The emphasis was on the use of the applicant’s mark and the likelihood of deception or confusion. By contrast, what is in issue under s 8(2)(b) of the present TMA is *the similarity of marks comparison*. This involves a mark-for-mark comparison, which precludes consideration of external matters such as the actual or potential use of the trade marks (*Staywell* at [20]). What is in dispute is whether the “mark” under the current TMA can consist of two previously registered trade marks combined into one composite mark. The *McDonalds* case does not speak to this question. It merely stands for the proposition that in assessing the *likelihood of deception or confusion*, actual use may be relevant.

49 The final case to consider is *Polo*. The appellant was the registered proprietor of six trade marks: “POLO”, “POLO BY RALPH LAUREN”, “RALPH LAUREN & Polo Player device”, “POLO RALPH LAUREN & polo player device”, “LAUREN RALPH LAUREN” and “RALPH LAUREN”. Whilst there were six registered marks, only the “POLO” word mark was in issue.

50 In brief, the appellant claimed that the respondent’s use of the “POLO PACIFIC” mark in a particular font, typeface and design infringed its “POLO” trade mark under s 27(2)(b) of the Old TMA (which is in *pari materia* with s 27(2)(b) of the current TMA). In particular, the appellant submitted that the judge below was wrong to hold, *inter alia*, that the mark “POLO” was not distinctive (*Polo* at [12(a)]).

51 At this juncture, I pause to note that in *Polo*, the appellant made an “argument based on a family of trade marks with the prefix POLO” (see *Polo* at [17]). With respect, it is not entirely clear to me what the appellant’s argument entailed. The appellant’s argument might have been that since the word “POLO” was the common denominator of some of its registered trade marks, it had acquired distinctiveness and a reputation in the minds of the public. On this basis, it appears that what was being claimed is that the “POLO” word mark should be regarded as similar to “POLO PACIFIC” despite the differences between the two marks.

52 In its judgment, the Court of Appeal applied the three-step approach and affirmed the High Court’s finding that the sign “POLO PACIFIC” was not similar to “POLO”. The Court of Appeal also

found that there was no likelihood of confusion. What is of interest at this juncture is the court's decision in relation to similarity of marks.

53 In assessing similarity of marks, the Opponent rightly noted that the Court of Appeal did consider how the "POLO" mark was *used* on the appellant's products. In particular, the court found it relevant that the appellant never *used* the word "POLO" *simpliciter* on its products (*Polo* at [23]). However, it is vital to note that the above observations of the Court of Appeal were made as part of the court's assessment of the *distinctiveness* of the "POLO" word mark (see *Polo* at [17] and [23]). What the Court of Appeal held, in effect, was that the "family of trade marks" argument was a non-starter. On the facts, there was no evidence that the appellant had done anything to promote the "POLO" mark on its own. There was no evidence of distinctiveness acquired through use. Therefore, the court held that the argument based on family of trade marks carried little weight (*Polo* at [17]).

54 In coming to its decision, the Court of Appeal referred to the decision of the Appointed Person (Geoffrey Hobbs QC) in *10 Royal Berkshire Polo Club Trade Mark* [2001] RPC 32 ("*Royal Berkshire*"). In that case, the court found that the mark "POLO" was not similar to "10 Royal Berkshire POLO CLUB" even though the evidence before the Appointed Person established that the average consumer would expect "POLO" brand toiletries to come directly or indirectly from the same undertaking (*Royal Berkshire* at [27]). The Appointed Person held that the marks were not similar because he did not think that people exposed to the use of the applicant's mark would notice that it contained the word "POLO" without also noticing that it contained the words "ROYAL BERKSHIRE" and "CLUB". The message of the applicant's mark was in the combination (*Royal Berkshire* at [31]).

55 Accordingly, I am of the view that the Court of Appeal was not establishing a proposition that the court ought to take into account *how a mark is used* in conducting a *similarity of marks comparison*. The decision does not support the Opponent's position that its earlier marks can be combined and considered as a composite. I thus find that this case is of no assistance to the Opponent.

56 For completeness, I note that the Applicant also cited *Time Inc. v Li San Zhong* [2014] SGIPOS 14. However, given that the conclusions of the principal assistant registrar in that case were based largely on the PAR's decision in our present case, I agree with the Opponent that little weight should be placed on it in the current appeal.

57 To sum up, based on what has been argued before me, there is no direct local authority on the issue of whether two earlier registered trade marks may be combined into a composite whole for the purposes of the similarity of marks comparison (even if *Staywell* may be argued to suggest that it should be disallowed). On the other hand, the English approach, based on the *Infamous Nut*, seems to be that any such combination is likely to be disallowed.

My decision

58 In the absence of legally binding judicial authority, it is apposite to start from the words of s 8(2)(b) of the TMA, and consider them in light of the objectives of trade mark law.

59 Section 8(2)(b) of the TMA states:

A trade mark shall not be registered if because 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.

[emphasis added]

60 The key interpretive question for the Court is whether “an earlier trade mark” can include a composite of two previously registered trade marks. Section 2 of the TMA defines an “earlier trade mark” as, *inter alia*

[A] registered trade mark or an international trade mark (Singapore), the application for registration of which was made earlier than the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks...

The other parts of the definition of an “earlier trade mark” are irrelevant for our present purposes.

61 In her judgment (at [49]), the PAR alluded to the argument that given the consistent use of the singular (eg “an earlier trade mark”, “a registered trade mark”), a plain reading of the statutory provisions above suggests that an “earlier trade mark” must refer to a *single* trade mark. This militates against the Opponent’s position that in considering the similarity of marks, the Court may consider the applicant mark against a composite of two or more separately registered trade marks. Against this argument, the Opponent submits that the use of the singular and/or plural in statutes should not be taken literally unless there is evidence that Parliament specifically intended the singular and/or plural.

[\[note: 9\]](#)

62 However, leaving aside for the moment well known unregistered marks, even assuming the Opponent is correct, under s 2 of the TMA, an “earlier trade mark” must still be “a *registered* trade mark” [emphasis added]. It is undisputed that the *composite* of the Opponent Marks is not “a registered trade mark”. The fact that it may have been *registrable* is neither here nor there. This thus brings into serious question the possibility of adopting the Opponent’s approach to the similarity of marks comparison (*ie* treating an “earlier trade mark” as being a composite of two separately registered trade marks) without doing violence to the statutory wording.

63 Of course, while the words of a statute are, and should be, the cornerstone of statutory interpretation, courts have on occasion departed from the literal meaning of statutory language in light of the purposes behind the statute. Such purposive interpretation is mandated under s 9A of the Interpretation Act (Cap. 1, Rev Ed 1985).

64 Is any such departure in favour of the Opponent justified in this case? The Opponent’s main submission on this front is that it is untenable to require trade mark proprietors to register every permutation of their registered trade marks. It is submitted that it is not uncommon for trade mark proprietors to use their registered trade marks in a variety of combinations. If the law did not protect composites of two or more separately registered trade marks belonging to the same proprietor, this would severely reduce protection for registered trade marks. This, it was argued, would be contrary to what was intended under the statutory regime. Moreover, allowing the registration of the Angry Bite Mark potentially gives the Applicant legal grounds to object to the Opponent registering the Opponent Marks as a composite should it wish to in future. This, it was said, would be unfair.

65 The Applicant submits that there is nothing untenable about requiring trade mark proprietors to register all the permutations of their existing marks that they wish to use. In fact, they assert that this is currently done by some trade mark proprietors. [\[note: 10\]](#) Moreover, allowing proprietors to mix and match different registered marks to form a composite, *de facto* registered mark provides excessive (indeed unwarranted) protection.

66 Having considered the submissions, I am of the view that the statutory purpose behind trade

mark protection does not compel a departure from the plain words of the statute. On the contrary, it points against allowing the court to combine the Opponent Marks for the similarity of marks comparison.

67 The argument that it is impractical or untenable to expect trade mark proprietors to register each combination of the marks they intend to use has not been substantiated. Indeed, whilst there was little evidence on this before the court, it appears that businesses frequently register various permutations of their registered marks. In some cases, the registrations will be pursuant to separate and distinct applications. In other cases, a series of trade marks may be registered pursuant to a single application. It is true that over the course of time, a business may well evolve its trade marks and its use of its trade marks such that the registered marks may no longer sufficiently protect the trade marks that are used in practise. However, it does not follow that it would be unduly onerous or “unfair” to require a trade mark proprietor to register the evolved mark. On the contrary, the reverse is true. Certainty as to what is the mark protected by registration is important.

68 Section 36 of the TMA provides that a registered trade mark is personal property. Property rights are enforceable *in rem*. Registration confers rights both to object to the registration of other marks, and to sue other persons for trade mark infringement. As with *in rem* rights generally, liability for infringement is strict. In some cases, criminal provisions may also come into play. A key objective of the trade mark registration system and the trade mark register must be to give what is best described as fair warning to other business and the public generally. Members of the public whose duty it is not to infringe registered trade marks are entitled to know with objective certainty which trade marks (and what they comprise) are protected by registration.

69 Allowing a trade mark proprietor to claim protection over *all* the permutations of its registered marks would be granting excessive protection of a wholly uncertain scope. It limits competition from other businesses, opens them up to unpredictable risks of infringement, and potentially increases trade mark litigation generally. Even granting protection over a composite of just two separately registered marks which are used together in practise (as proposed by the Opponent in the present case) would create considerable uncertainty. By granting protection, what is meant is to treat the two separately registered trade marks as a single composite trade mark for the purpose of determining infringement under the Trade Marks Act. There is no reason why the trader should not be expected to register the composite mark either at the time when he applies to register the first two marks, or subsequently when his use of the registered trade marks and branding strategies makes registered protection of the composite mark desirable.

70 Given the above analysis, I affirm the decision of the PAR. Under s 8(2)(b) of the TMA, two earlier separately registered trade marks cannot be combined so as to form a single composite mark. This is also consistent with the substantive finding in *Staywell* that a court may not consider extraneous matter in comparing an earlier registered trade mark against the applicant mark.

71 Quite belatedly, at the hearing of the appeal itself, the Opponent attempted to argue that in any case, a composite mark consisting of the Opponent Marks has acquired the status of an *unregistered trade mark*. The Opponent submits that the unregistered trade mark is an “earlier trade mark” for the purposes of s 8(2)(b) of the TMA, given that it falls under the definition in s 2 of the TMA. While s 2 of the TMA undoubtedly leaves open the possibility that an unregistered trade mark may be an “earlier trade mark” if it is a well-known trade mark, I am of the view that the Opponent has not adduced sufficient evidence to show that a composite of the Opponent Marks has acquired the status of an unregistered trade mark. This point was not argued before the PAR (see [7] of the PAR’s GD), nor was it properly argued by the Opponent in his written or oral submissions for the appeal. Indeed, all that was produced was a few photographs where the Opponent Marks were used

together. This is clearly insufficient to prove that such an unregistered trade mark exists.

72 For these reasons, I affirm the PAR's decision on the preliminary issue, and shall proceed on the basis that the Angry Bite Mark is to be compared against the Red Bird Mark and the Angry Bird Word Mark *separately*.

#### *Legal principles governing the similarity of marks comparison*

73 It is well-established that in considering the similarity of two marks, the court should look at visual, aural, and conceptual similarity. These three aspects of similarity are merely meant to guide the court's inquiry. Ultimately, the marks must be appraised as a whole: *Staywell* at [17]–[18].

74 Significantly, previous judicial authorities have uniformly affirmed the importance of what has been termed "the technical distinctiveness of a trade mark" in the similarity of marks comparison. As the Court of Appeal stated in *Staywell* at [25], "a mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it". I pause to say a few words on the meaning of "distinctiveness".

75 In *Staywell* (at [24]), the Court of Appeal held that distinctiveness in the "technical sense" was to be understood "in contradistinction to descriptiveness". As an example of what was meant by "technical distinctiveness", the Court of Appeal (at [28] of *Staywell*) gave the example of a trade mark which comprised (in whole or part) a "non-descriptive word" or an "elaborate and inventive graphic device." On the basis of these examples, an invented word (especially one that has been freshly coined and is meaningless) would also likely possess "technical distinctiveness". Whilst the expressions "technical distinctiveness", and indeed "inherent distinctiveness", have found their way into judgments, I observe that the TMA does not in fact use the terms "technical" or "inherent". Instead, what is stated in s 7(1)(b) of the TMA is that "trade marks which are devoid of any distinctive character" are not registrable. This does not however prevent registration where the trade mark has "acquired a distinctive character as a result of the use made of it": s 7(2) of the TMA.

76 In my view, the essential point made by the Court of Appeal in *Staywell* was that in comparing the applicant mark to the opponent's mark, the court is entitled to take into account the "dominant" components or features of the opponent's mark (*Staywell* at [23]). Where the opponent mark has a feature that is clearly dominant, the fact that this feature is also found in the applicant mark may lead to a finding of similarity even if some other features are different or absent. Whether there is a dominant feature as such is a matter of impression and degree. The observations made by the Court of Appeal in *Staywell* at [23]–[29] go no further than the proposition that where a component or feature of a mark is technically distinctive (invented, non-descriptive *etc*), that feature may well (as a matter of fact and impression) be regarded as a dominant feature of the mark and hence affect the overall assessment of similarity. That said, the Court of Appeal underscored the point that the distinctiveness of the separate components of a mark must ultimately be related back to the impression given by the mark as a whole (*Staywell* at [26]).

77 Finally, it bears emphasis that the similarity of marks comparison is "more a matter of feel than science": see *Wagamama Ltd v City Centre Restaurants plc* [1995] FSR 713 at 732. Indeed, the comparison of any two marks should take place at an impressionistic level, rather than on a quantitative or mechanistic basis: *Staywell* at [17].

#### *Role of the appellate court*

78 Before proceeding further, it is important to clarify the role of an appellate court hearing an

appeal from the PAR. In *Future Enterprises Pte Ltd v McDonald's Corp.* [2007] 2 SLR(R) 845 ("*Future Enterprises*") at [5], the Court of Appeal quoted *SC Prodal 94 SRL v Spirits International NV* [2003] EWHC 2756 (Ch), which states:

It is not the duty of this court to overturn a decision of the Trade Mark Registry simply because it comes to the conclusion that it might have decided the case differently... It has to be demonstrated that the decision at first instance was wrong in a material way; that is to say there must be some significant departure from a proper assessment of the law or the facts.

79 The Court in *Future Enterprises* continues at [7], stating:

... In the light of the highly subjective nature of assessing similarity and the likelihood of confusion, we agree with the approach that an appellate court should not disturb the findings of fact of a trade mark tribunal unless there is a material error of principle.

80 Bearing in mind that the appellate court's role is not to decide the case (and in particular, the factual findings) *de novo*, but to intervene *only* if there has been a material error of fact or law, I proceed to consider the similarity of marks.

#### *Comparison between the Red Bird Mark and the Angry Bite Mark*

81 On visual similarity, the Opponent submits that the Red Bird Mark and Angry Bite Mark are similar because of the presence of the angry eyes, eye brows, and the bird like features in the latter (including the rather small tail feathers and beak like tongue). It further submits that the angry eyes and eye brows are the dominant features of both the Red Bird Mark and Angry Bite Mark.

82 The Applicant repeats the PAR's reasoning on visual similarity. The PAR found that the only possible similarity is the "angry eyes device". To be clear, by "angry eyes device", what is being referred to are "the eyes and eyebrow" of the red bird. These are said to depict anger, hence the description "angry eyes device". The angry eyes are not a device separate from the Red Bird Mark. The applicant submits that even if the angry eyes were the dominant component of the two marks, the court cannot focus on that alone. The marks are to be compared as a whole. The Red Bird Mark comprises angry eyes, accented eyebrows, a sharp beak and a red bird. On this basis it is said that, the Angry Bite Mark shows a creature biting angrily into something, the "ANGRY BITE" words, and the "D-Jack" words at the corner. These elements are absent from the Red Bird Mark, and create dissimilarity.

83 The Angry Bite Mark is a composite mark. It comprises a number of elements. Some of these have been described in the previous paragraph. The "creature" is depicted face-on with a mouth biting down on an object. The phrase "ANGRY BITE" appears in the middle of the face. The word "D-Jack" in smaller lettering appears on a banner to the left, just above the creature's right eye. A small (indeed tiny) mark (said to represent feathers) also appears next to the letter "B".

84 On visual similarity, I affirm the PAR's decision, and do not find any material error of fact or law in her reasoning or conclusion. Indeed, while the angry eyes and eye brows may (on one view) be the dominant and distinctive components of both marks, the PAR has given due weight to this fact. She was correct in stating that notwithstanding the similarity between the alleged dominant components of the marks, the marks still are to be assessed *as a whole*. I do not find that she erred in coming to the factual conclusion that the Red Bird Mark and the Angry Bite Mark are visually dissimilar on the whole. Indeed, the actual depiction of the eyes and eyebrows in the Red Bird Mark and the Angry Bite Mark whilst similar, are not identical.

85 On aural similarity, neither side disputes the PAR's finding that there can be no aural similarity here given the Red Bird Mark has no aural component. I find no reason to disturb this finding.

86 Finally, on conceptual similarity, the PAR found the Red Bird Mark and the Angry Bite Mark to be dissimilar. She noted that what is important is "the impression of the average consumer" (see [65] of the PAR's GD). The Red Bird Mark conveys a bird with angry eyes; the Angry Bite Mark conveys an idea of a creature biting angrily. Only the emotion of anger is common.

87 The Opponent submits that not only is the "anger emotion" common, the Angry Bite Mark also has elements of a bird. It points to the feather at the bottom left corner of the Angry Bite Mark, and the mouth of the creature which is said to look like a beak. In fact, the Opponent adduced evidence that the Malaysian trade marks registry described the creature in the Angry Bite Mark as a "bird". [\[note: 11\]](#)

88 Having reviewed the PAR's reasoning on conceptual similarity, I find no reason to overturn her finding. Notwithstanding the apparent position taken by the Malaysian trade marks registry, I do not find that the Angry Bite Mark conveys the impression or idea of a bird. In particular, I do not see how the mouth of the creature looks like a bird's beak at all. Whilst the Opponent claims that there is a feather device shown in the Angry Bite Mark (next to the letter "B" in "BITE"), I am unable to draw any conclusion as to what was being depicted. The device is very small and in my assessment, makes little to no visual or conceptual impact at all even though there is a similar device on the Red Bird Mark.

89 In summary, having affirmed the PAR's finding that there is no visual, aural or conceptual similarity between the Red Bird Mark and the Angry Bite Mark, I naturally also affirm her overall conclusion that the abovementioned marks are *dissimilar on the whole*. To be clear, even accepting that both marks share "anger" as a common emotion, I find that the marks on the whole are not similar.

#### *Comparison between the Angry Birds Word Mark and the Angry Bite Mark*

90 The PAR found that while there is aural similarity between the Angry Birds Word Mark and the Angry Bite Mark, the two marks were visually and conceptually dissimilar.

91 Visually, the PAR found that similarity can only be found in the letters "ANGRY BI". The other elements of the Angry Bite Mark clearly distinguish it from the Angry Birds Word Mark. The Opponent merely repeated the observation that the letters "ANGRY BI" are similar. It did not address the PAR's observation that there are other elements to the Angry Bite Mark (namely, the creature) that distinguishes it from the Angry Birds Word Mark. I agree with the PAR's observation that the pictorial elements of the Angry Bite Mark create visual dissimilarity, and thus see no reason to disturb the PAR's decision that the Angry Bite Mark and the Angry Birds Word Mark are visually dissimilar.

92 In terms of aural similarity, the PAR found that there was some aural similarity. She reasoned that the competing marks have more syllables in common than not. The Opponent added that the two marks have the same number of syllables (*ie* three). The Applicant however submits that the "I" in the word "BITE" sounds different from the "I" in the word "BIRDS", creating a degree of aural dissimilarity. In my view, the PAR's finding that there is *some* aural similarity is consistent with both the Applicant's and Opponent's submissions. Indeed, we may all agree that while the "ANGRY" component in both marks are aurally identical, "BIRD" and "BITE" contain some aural dissimilarity.

93 Finally, on conceptual similarity, the PAR found that the only similarity is the emotion of anger

conveyed. The concept of a creature angrily biting something is missing from the Angry Birds Word Mark. The Opponent however repeats its submissions that the concept of anger is a significant similarity, and there are hints of a bird in the Angry Bite Mark. In this regard, I repeat my findings above on the ideas conveyed by the Angry Bite Mark. I see no reason to disturb the PAR's factual finding that the marks are conceptually dissimilar on the whole.

94 Given that there is some aural similarity, I will set out in more detail why I agree with the PAR that the Angry Bird Word Mark and Angry Bite Mark are dissimilar *on the whole*, bearing in mind the need for the court to weigh up the relative importance of similarities/dissimilarities in order to decide whether the marks are similar *on the whole*.

95 In this regard, following *Hai Tong Co Pte Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941 ("*Hai Tong*") at [40], the PAR (at [68] of the PAR's GD) took into account the fact that the average consumer is one who would exercise care and a measure of good sense in her purchases, rather than an unthinking person in a hurry. She found that the snack products were bought by consumers of all ages, not just the young. As such, she concluded that to the average consumer as described above, the marks would be more dissimilar than similar on the whole. The Opponent, however, contends that children are the target, and indeed, the main, audience of the snack food products.

96 At this juncture, a question arises as to the relevance of the *nature of consumers purchasing the parties' products* at the similarity of marks stage. As the court in *Staywell* at [20] clarified, at the similarity of marks stage, we are concerned with a mark-for-mark comparison, rather than the "effect of objective similarity between the marks". It may be argued that the actual type of consumers purchasing the product is irrelevant to the assessment of the objective similarity between two marks. It is relevant only in assessing the *confusing effect* of that similarity (where, for example, children are presumably more likely to be confused than adults by a certain objective similarity).

97 We should first consider the position taken by the Court of Appeal in *Hai Tong*. The Court of Appeal stated at [40(c)] that:

Although the focus of this part of the inquiry is on the marks in question, *it is necessary to set out the viewpoint the court should assume. This 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 (see Polo (CA) ([16] supra) at [34]). Would such a person consider the marks similar?* We pause to note that despite the differing expressions that are sometimes used, this viewpoint is, for all intents and purposes, the same as that which is assumed when assessing the separate but related question of whether there is a sufficient likelihood of confusion. This is unsurprising given that there will be some inevitable overlap in the factual assessment of both elements.

[emphasis added]

9 8 *Prima facie*, the PAR's approach seems to be supported by the passage in *Hai Tong* cited above, which suggests that similarity is to be assessed from the perspective of the "average consumer". However, the question is whether the Court of Appeal in *Hai Tong* meant the viewpoint of the average consumer who *actually purchases the parties' products*, or whether the "average consumer" at the similarity stage is a *notional* "average consumer", having no regard to the actual goods or services in question. The PAR seemed to have adopted the former interpretation in considering whether children were the main consumers of the Applicant's and the Opponent's products.



99 In my view, the latter interpretation of the above passage in *Hai Tong* is preferable. In *Hai Tong* at [85(c)(iii)] and [87], the court classified the “particular characteristics of the relevant segment of the public” (referring to the likely purchasers of the parties’ products) as an extraneous factor which could be taken into account when assessing “likelihood of confusion”, but not the similarity of marks.

100 This is the position taken in *Staywell* at [96(b)] also, where “the likely characteristics of the relevant consumers and whether they would or would not tend to apply care or have specialist knowledge in making the purchase” was considered an extraneous factor relevant at the “likelihood of confusion stage”. The court in *Staywell* held (at [20]) that the “issue of *resemblance* between competing marks is distinct from the question of the *effect* of such resemblance” [emphasis in original], and that it was impermissible to consider extraneous factors at the similarity of marks stage. This did not mean that the court ignored the reality that the effect of aspects of similarity might depend on circumstances such as the nature of the goods and the perception of customers (*Staywell* at [20]). However, the Court of Appeal held that these considerations were better reserved for the confusion stage of the inquiry, where the court was asked to assess the *effect* of the objective similarity between the marks.

101 Applying *Staywell* and *Hai Tong*, it follows that a court in deciding whether the applicant’s mark is similar to the opponent’s mark (the first stage of the three step test) must make the assessment on an objective basis. The points of similarity and dissimilarity must be assessed in relation to the marks as a whole. This is a matter of impression for the judge. While the judge should put himself/herself into the position of a reasonable or notional average consumer (as opposed to an unthinking person in a hurry), the court should not, following *Staywell* and *Hai Tong*, delve into the detailed characteristics and perceptions of the actual consumers of the parties’ products at the similarity of marks stage. Thus, I find that the PAR’s conclusion that the Angry Bite Mark and the Angry Birds Word Mark are dissimilar (on the whole) is fully supportable.

102 To sum up, having considered the visual, aural and conceptual similarities and dissimilarities between the marks, and having considered the marks as a whole, I do not think that the PAR erred in finding that the Angry Bite Mark and Angry Birds Word Mark are dissimilar. While the Opponent did submit that the Court should place some weight on the fact that the designer of the Angry Bite Mark was *inspired by* the Opponent Marks, the argument does not carry the Opponent any further. Trade mark law does not have as one of its goals the objective of stopping competition *simply* on the basis that the competitor’s trade mark was *inspired by* the trade mark proprietor’s trade mark, branding or marketing. In the present case, the Opponent must still prove that the relevant marks are *similar*. The fact that the Angry Bite Mark was inspired by the Opponent Marks may give rise to a *heightened possibility* of similarity, but in no way *establishes* it.

103 In conclusion, I affirm the PAR’s findings that the Angry Bite Mark is not similar to either the Angry Birds Word Mark, or the Red Bird Mark. While this is sufficient to dispose of any opposition on the ground of s 8(2)(b) of the TMA, I shall nevertheless proceed to consider the “likelihood of confusion” in case I am wrong on similarity of marks.

### ***Likelihood of confusion***

104 As discussed above, at the “likelihood of confusion stage”, the court is broadly concerned with the “*effect* of objective similarity between the marks, on the perception of consumers” [emphasis in original]: *Staywell* at [20]. In *Hai Tong* at [74], the Court of Appeal stated that there are “at least two specific aspects to the element of confusion”. The first is “mistaking one mark for another”, and the second is where “the relevant segment of the public may well perceive that the contesting marks are different, but yet remain confused as to the origin which each mark signifies”. The court in *Hai*

*Tong* at [75] went on to distinguish “mere association” from a “likelihood of confusion”. Specifically, “it is not sufficient that the relevant segment of the public would recognise or recollect similarities between the contesting marks if there is no likelihood of confusion as to origin ensuing”.

105 In assessing the likelihood of confusion, the PAR (at [73]–[74] of the PAR’s GD) considered it relevant that the Opponent Marks were used on products together, but stated that “this only renders the marks somewhat more similar”. She found that the overall impression given by the Angry Bite Mark (that of a creature angrily biting) is different from the overall impression given by the Opponent Marks. Further, the PAR weighed the following factors in concluding that there was no likelihood of confusion:

- (a) The reputation of the ANGRY BIRD brand is likely to reduce the likelihood of confusion.
- (b) Given the snacks are self-serve items on super market shelves, the visual and conceptual aspects figure more prominently than the aural aspects at the point of selection and sale (recall that she found there was some degree of aural similarity, but no visual or conceptual similarity).
- (c) The purchasing public is likely to exercise a greater degree of care in selecting the snack products given these are to be ingested.
- (d) The low price of the snack products is outweighed by the other factors pointing against a likelihood of confusion.

106 On appeal, the Opponent submits as follows:

- (a) The likelihood of confusion is enhanced by the similarity in colours used on the Applicant’s packaging, as well as the depiction of a catapult at the bottom right corner of the Applicant’s packaging (given that a catapult is a key feature of the Opponent’s Angry Bird mobile phone game). Pictures of crisps packets in identical shades of yellow, green, red etc were presented to the court.
- (b) The PAR erred in finding that the aural similarity is less significant than visual and conceptual similarities for self-serve items such as those sold in supermarkets.
- (c) The PAR erred in finding that the reputation of the Opponent’s brand detracts from the likelihood of confusion. Given the imperfect recollection of consumers, the fact that the Opponent’s brand is entrenched in the minds of its consumers furthers the likelihood of confusion.
- (d) The PAR erred in finding that a degree of care would be taken in choosing the snack products because they are to be ingested. On the contrary, food safety does not weigh heavily on the minds of consumers in Singapore when buying snacks in a supermarket.
- (e) The snack products are likely to be purchased by children and adolescents, who are unlikely to apply care or fastidiousness in the selection of snacks.

107 In response, the Applicant repeats the PAR’s reasoning, and additionally submits the following:

- (a) Following *Staywell*, extraneous factors like packaging or other “superficial marketing choices” are irrelevant in opposition proceedings, even at the “likelihood of confusion” stage.
- (b) Consumers who purchase goods from the supermarket are ordinary sensible members of the public who are not easily deceived or hoodwinked.

108 Based on the above, the following issues on the “likelihood of confusion” inquiry under s 8(2)(b) of the TMA arise for consideration:

- (a) Can extraneous factors such as the colour of the Applicant’s packaging and the catapult on the Applicant’s crisp pack be taken into account?
- (b) Does the reputation of the Opponent’s brand enhance or detract from a likelihood of confusion?
- (c) What is the relevance of the fact that the Applicant’s and Opponent’s goods are ingestible self-serve items sold in supermarkets?
- (d) Who are the likely consumers of the Applicant’s and Opponent’s goods?

*Can extraneous factors such as the colour of the Applicant’s packaging and the catapult on the Applicant’s crisp pack be taken into account?*

109 Extraneous factors may be taken into account in opposition proceedings at the likelihood of confusion stage. However, this general position is subject to important qualifications: *Staywell* at [77] and [83]. The Court of Appeal laid down the following guidelines in *Staywell* at [95]:

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

[emphasis added]

110 The Opponent rather ingeniously argues that the limits or qualifications placed on extraneous factors apply *only* when an applicant seeks to *distinguish* its goods on the basis of extraneous factors. It submits that *Staywell* only refers to certain extraneous factors being impermissible for the purpose of *differentiating* goods that are otherwise confusingly similar (for example, see *Staywell* at [86], [89], and [90]). It does not preclude an opponent using extraneous factors to show an *enhanced* likelihood of confusion. The Opponent submits that this is in line with the principle that an existing proprietor has monopoly rights over its trade mark which deserves full protection.

111 Reading *Staywell* as a whole, I find it hard to agree with the Opponent’s position on extraneous factors. It is true that the Court of Appeal in *Staywell* focused on the impermissibility of extraneous factors being used to *negate* a likelihood of confusion. However, this is readily explained by the fact that the Court of Appeal was asked to consider that very question.

112 A closer look at *Staywell* would reveal that the court *did not* intend to limit its remarks on

extraneous factors to the *negating* of a likelihood of confusion.

113 At [86] of *Staywell*, the Court of Appeal stated:

... In the same way that confusion stemming from sources other than the similarity of marks and goods is outside the reach of trade mark protection (see [64] above) so too must such factors be irrelevant to displace a finding of likely confusion if the property rights represented in the trade mark are to be meaningfully upheld.

114 Given that confusion must *stem from the similarity of marks and goods*, rather than from extraneous factors, the Court of Appeal's remarks on the "impermissible extraneous factors" clearly apply to both negating *and enhancing* the likelihood of confusion. In fact, based on the passage cited above, the impermissibility of admitting certain extraneous factors to *negate* the likelihood of confusion seems to be premised on the impermissibility of basing a finding of confusion on those very same factors.

115 Indeed, even looking at the matter from the point of view of legal principles and policy, this conclusion makes sense. Registered trade mark law gives proprietors proprietary rights over *trade marks only*; it does not give them rights over certain types of packaging, or marketing techniques. It follows that proprietors are protected *only to the extent* that confusion (or the likelihood of confusion) arises from a use of a mark similar to the registered trade marks in respect of similar or identical goods or services.

116 In this case, the Opponent does not have an exclusive right to use the coloured packaging for its crisps. Whilst the evidence on this was not explored in detail, I note that the same or similar coloured packaging is in fact used by many crisps manufacturers, not just the Applicant and the Opponent. The Opponent does not have any registered trade mark over the colour of the packaging. Also, since the Opponent is not claiming a trade mark over the catapult, any confusion caused by it (or likely to be caused by it) must be irrelevant.

117 I thus find that factors to do with the Applicant's packaging are superficial marketing choices and hence impermissible extraneous factors which may not be considered by this court in determining the likelihood of confusion arising from the alleged similarities between the marks.

*Does the reputation of the Opponent's brand enhance or detract from a likelihood of confusion?*

118 Under the registered trade mark system, new marks which have not been used previously (whether at all, or in respect of a particular category of goods and services) may be registered. While it is necessary for the applicant to have a bona fide intention to use the trade mark (s 5(2)(e)(ii) of the TMA), it is not necessary to show prior use before applying to register a trade mark. It follows that a new trade mark may be properly registered even though it has not yet acquired any reputation. The question that arises in the present case is whether the court can take into account the reputation generated by the use of the mark as a factor in determining whether there is a likelihood of confusion. Nothing in the question posed suggests that a registered trade mark must have a reputation in order for there to be a likelihood of confusion. The issue raised is really the reverse: where reputation in the opponent's mark is established, is this relevant in determining the likelihood of confusion?

119 The PAR was of the view that, on the facts, where a mark or brand becomes so well known that it is entrenched in the minds of consumers, this could have the effect of reducing the likelihood of confusion. The PAR cited [96(a)] of *Staywell* in support of her conclusion. There, the Court of

Appeal cites *Polo* at [34] for the proposition that the “reputation of the marks” is a factor that relates to the impact of marks-similarity on consumer perception. At [34] of *Polo*, the Court of Appeal states “the greater the exposure and use of a particular registered mark, the greater its reputation is likely to be, and therefore the greater the protection likely to be afforded to it”. None of these authorities seem to lend support to the PAR’s conclusion that where a mark is well known, that *reduces* the likelihood of confusion. On the contrary, [34] of *Polo* seems to suggest that where a mark is well known, it ought to be afforded more protection, and hence, it should be *easier* to find a likelihood of confusion.

120 However, the Applicant did cite some authorities which more directly support the PAR’s position. At [64] of *McDonalds*, the Court of Appeal stated “the very success of the appellant, which is inseparable from its logo, is also the very reason why confusion is unlikely”.

121 Indeed, I note that there is some Australian authority to that effect. In *Mars Australia Pty Ltd v Delfi Chocolate Manufacturing SA* [2014] ATMO 113 (*Mars Australia*) at [28], the court stated that if the reputation in the “MALTESERS” trade marks were taken into consideration (coupled with the recognition of the Australian consumer’s imperfect recollection), this would tend to reduce the likelihood of deception or confusion between it and the applicant trade mark, “MALTITOS”. Also, the learned authors of Mark Davidson & Ian Horak, *Shanahan’s Australian Law of Trade Marks and Passing Off* (Lawbook Co, 5th Ed, 2012) at para 50.2410 state “[i]n some cases the particularly well known nature of the opponent’s mark has in fact told against its argument that confusion is likely”.

122 That said, the relevant Australian statutory provisions are not the same as those in Singapore. The observation in *Mars Australia* was made in respect of s 44 of Australia’s Trade Marks Act 1995 (Cth) (“Australian TMA”), and opposition was based on the claim that the applicant’s trade mark was “deceptively similar”. Whilst under the Australian TMA, a mark is deceptively similar if it is likely to deceive or cause confusion, the difference in statutory language does in my view affect the persuasive weight of *Mars Australia* in Singapore.

123 It is also worth mentioning that in *Mars Australia*, whilst the objection under s 44 of the Australian TMA failed, the opposition under s 60 succeeded. Section 60 of the Australian TMA reads as follows:

The registration of a trade mark in respect of particular goods or services may be opposed on the ground that:

- (a) another trade mark had, before the priority date for the registration of the first-mentioned trade mark in respect of those goods or services, acquired a reputation in Australia; and
- (b) because of the reputation of that other trade mark, the use of the first-mentioned trade mark would be likely to deceive or cause confusion.

124 The court in *Mars Australia* held that opposition to registration succeeded under s 60 of the Australian TMA because an assessment of the reputation of the trade mark went beyond mere examination of turnover of goods, and included the “credit, image and values projected” and the “esteem” component of the reputation (*Mars Australia* at [40]). On this basis, the trade mark officer found at [51] that deception or confusion would arise from the demonstrated reputation in the opponent’s trade mark, taking into account the extent of use and the way in which the reputation was established in Australia. Even though the trade mark officer had earlier found that the applicant and opponent’s marks were not deceptively similar, there was some similarity (*Mars Australia* at [48]). In an opposition under s 60, what was in issue was whether the *use* of the applicant’s mark would

cause deception or confusion. On this basis, the finding at [50] was that the demonstrated reputation in the opponent's mark would "reduce rather than reinforced the effect of the differences". I note that the provisions in Singapore on well known earlier trade marks (considered below) are not the same as the Australian provisions.

125 Returning to s 8(2)(b), I do not find it necessary to review the jurisprudence on this matter in any more detail than I already have (especially as *Mars Australia* was not cited in argument). In my view, it is plain that there can be cases where the reputation of an opponent mark reduces the likelihood of confusion *as a matter of fact*. The more a mark is etched in the minds of consumers, and the more familiar consumers are with the details of a mark, the more discerning they may be in some cases, especially where on the facts, the customers will likely be able to detect differences at a glance. But of course, it all depends on the facts. I do not think case law goes so far as to establish a rule of law that the greater the reputation of a mark, the less the likelihood of confusion. I do not think such a rigid rule is conducive to guiding what is fundamentally a fact specific inquiry either. Whether there is a likelihood of confusion is a question of *fact* for the court, taking into account, *inter alia*, the reputation of the marks (as stated in *Staywell* at [96(a)]). The exact effect the reputation of a mark has may differ on the specific facts of a case. As the learned author of *Ng-Loy Wee Loon* states at para 21.5.29(c), whilst the reputation of an earlier trade mark is relevant, it is not "the determinant factor". The approach is not "reputation-therefore-confusion" (or the reverse).

126 In this case, I do not think that the PAR erred in her factual conclusion that "the Opponent's reputation in the current case is likely to have an effect contrary to a likelihood of confusion". In my view, the reputation and association between the "angry bird" character and the Opponent's Angry Bird brand renders the absence of a clear bird image in the Angry Bite Mark a factor that tends to reduce the likelihood of confusion.

*What is the relevance of the fact that the Applicant's and Opponent's goods are ingestible self-serve items sold in supermarkets?*

127 First, the PAR found that the *ingestible* nature of the Applicant's and the Opponent's snack food products made it more likely that consumers will pay greater attention to the labels and trade marks before buying the goods. On the facts and evidence, I do not agree that this proposition has been made out. In my view, the "ingestible" nature of the snack food products is a neutral factor in relation to the overall assessment of a likelihood of confusion.

128 Second, the PAR found that on the facts, the visual and conceptual similarities were more important than the aural similarity because the goods are self-serve items and sold in supermarkets. While I do not disagree that the visual and conceptual similarities play a significant role when consumers scan the supermarket shelves and pick out a packet of crisps, it does not follow that aural similarity is irrelevant. The more difficult question is the relative weight to be ascribed to aural similarity. In Singapore, the material time at which confusion must exist is at the time of purchase: *Ng-Loy Wee Loon* at para 21.5.26, citing *Staywell* (although questions may arise on post sale confusion). This explains the learned author's comment at para 21.5.29(d) that the normal way under which the average consumer would purchase the goods or services is a relevant factor in assessing the likelihood of confusion. Where the similarity lies mainly in their aural aspect, the risk of confusion would be greater if the goods are normally purchased by placing verbal orders. Given the snack products in the present case are not purchased by placing verbal orders, I find no reason to disturb the PAR's assessment that aural similarity is less important on the facts of the present case.

*Who are the likely consumers of the Applicant's and Opponent's goods?*

129 The PAR disagreed with the Opponent's submission that children were the primary consumers of the Applicant's and Opponent's goods. No evidence was given on this issue. The court is thus left to come to a decision based on its general impression of who the likely purchasers of snack food products are.

130 On that basis, there is no reason to disturb the PAR's conclusion that people who buy snacks are not merely, or even primarily, children. After all, people of all ages purchase snacks whether for themselves or others. It is likely that in many cases the parents or adults will be the actual purchasers (even if crisps are meant for consumption by the child).

#### *Conclusion on the likelihood of confusion*

131 I find that *on the whole*, the PAR is justified in concluding that there is no likelihood of confusion. In coming to this conclusion, I have ignored the alleged similarities in packaging between the parties' goods.

132 Given my conclusion that the marks are not similar, and that there is, in any event, no likelihood of confusion, I find that the opposition on the ground of s 8(2)(b) of the TMA must fail.

#### **Issue 2: s 8(4)(b)(i) read with s8(4)(a) of the TMA**

133 I set out the relevant parts of s8(4) of the TMA:

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

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

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

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

[emphasis added]

#### ***Are the Opponent Marks "well known in Singapore"?***

134 The PAR found that as of 5 April 2012 (the relevant date, being the date of the application of the Angry Bite Mark), the Opponent Marks were "well known in Singapore". She cited the Court of Appeal's holdings in *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 ("*Amanresorts*") at [229], which emphasised that pursuant to s 2(7)(a) of the TMA, the trade mark need only be well known to "any relevant sector of the public" in Singapore to be deemed "well known in Singapore". At [145] of her grounds of decision, the PAR repeated the observation of the Court of Appeal in *Amanresorts* at [229] that this was not too difficult a threshold to cross. Bearing that in mind, the PAR was prepared to hold that the Opponent Marks were well known in Singapore as of 5 April 2012.

135 The Applicant does not dispute this finding on appeal. [\[note: 12\]](#) However, it submits that even

if the Opponent Marks are well known in Singapore, it is well known *only in relation to computer games*. [\[note: 131\]](#) The Applicant does not, however, make any further submissions on the legal implications of its observation. There is no explanation as to how this may render s 8(4) of the TMA inapplicable on the facts.

136 In deciding whether a trade mark is well known, the court is essentially assessing the reputation of the trade mark. A trade mark is a sign which is capable of being represented graphically, and which is capable of distinguishing goods or services dealt with or provided in the course of trade by different traders. It is obvious that a trade-mark may be well known for particular goods or services only. Such a trade mark may not be well known for completely different goods or services. From this, it follows that there will be cases where the trade mark is well known only to the sector or class of the Singapore public that purchases the particular good or service, without being well known to the public in general. That said, there may also be cases where the trade mark is well known not just within the community of customers for those goods or services, but to the public at large.

137 Well known trade marks are especially valuable in the market place. The proprietor of a well known trade mark is likely to have committed substantial resources in promoting and developing brand awareness. Even if the proprietor's current business is concerned solely with a particular type of product or service, he may have very real concerns where the same or similar trade mark is taken and used on different goods or services. These concerns lie behind the special protection that is conferred on well known trade marks.

138 It is plain that s 8(4) of the TMA is not just concerned with the goods or services in respect of which the trade mark is well known. Section 8(4)(a) read with s 8(4)(b)(i) of the TMA grants proprietors of trade marks which are "well known in Singapore" protection from the registration and/or use of identical or similar trade marks on *dissimilar* goods or services: *Amanresorts* at [229] and *Ng-Loy Wee Loon* at para 21.5.41.

139 It does not matter that the mark is well known in respect of goods or services other than those which an applicant seeks to use a similar or identical mark for. As such, based on the parties' submissions, I have no reason to disturb the PAR's finding that the Opponent Marks are "well known in Singapore".

140 However, I would make one observation about the PAR's holding on this issue. It is not immediately clear who the "relevant sector of the public" she refers to comprises. Unlike high end luxury resorts in *Amanresorts*, the Opponent's Angry Bird game and merchandise do not seem to have a clearly defined group of consumers. The sector of the public might have been "the public interested in computer games and mobile apps." However, I note that the Red Bird Mark and Angry Bird Word Mark were registered in multiple classes that stretched across many different types of goods and services, including confectionery. At this juncture, I find it important to make a few more clarificatory comments on this issue.

141 Section 8(4)(a) requires that the earlier trade mark be well known in Singapore. Section 2(8) states that a trade mark that is well known to any relevant sector of the public in Singapore, is deemed to be well known in Singapore. That said, it does not follow that in order for the earlier trade mark to be well known in Singapore, it is necessary to show that the trade mark is well known to a particular and well-defined sector of the public. An earlier trade mark may be well known in Singapore even if it is difficult to define with precision the sector or class of the public among which it is well known. Section 2(7) makes clear that the question whether any trade mark is well known in Singapore is a question of fact which depends on all the circumstances. Apart from whether the trade mark is known or recognised by any relevant sector of the public, other relevant factors include the duration,



extent and geographical area of use and promotion of the mark. Any value associated with the mark can also be considered.

***Is the "whole or an essential part" of the Angry Bite Mark identical or similar to either of the Opponent Marks?***

142 Section 8(4) of the TMA requires that the "whole or an essential part of the trade mark" be identical or similar to an earlier trade mark. The question that arises is whether this inquiry is any different from the similarity of marks inquiry in s 8(2)(b) of the TMA.

143 The PAR found that given the similarity of wording between s 8(2)(b) and s 8(4) of the TMA, the same principles may apply to the similarity of marks comparison under both provisions. On that basis, she concluded that the similarity of marks requirement under s 8(4) of the TMA is *not* satisfied.

144 The parties agreed that the same principles applied to the similarity of marks comparison under both provisions as well. [\[note: 14\]](#) At the court's request, they jointly submitted that the Court of Appeal's holding in *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 ("*Sarika*") provided the necessary guidance. The court in *Sarika* was concerned with the interpretation of s 55(2), which gives the proprietor of a well known trade mark the right to "restrain by injunction the use in Singapore, in the course of trade and without the proprietor's consent, of any trade mark which, or an *essential part* of which, is identical with or similar to the proprietor's trade mark, in relation to identical or similar goods or services, where the use is likely to cause confusion" [emphasis added].

145 In *Sarika*, the Court of Appeal had to consider, *inter alia*, whether the difference in wording between s 27(2)(b) and s 55(2) of the TMA made a difference to the similarity of marks analysis. Section 55(2) makes reference to an "essential part" of the trade mark, while s 27(2)(b) (on infringement) does not. The Court of Appeal held at [69]–[73] that the High Court did not err in applying the same reasoning to both provisions. The difference in statutory wording was unintentional, and arose because the provisions were adopted from different legislative sources.

146 While *Sarika* was concerned with different provisions in the TMA, I am similarly of the view that little turns on the reference to "essential part" in s 8(4). After all, even under s 8(2)(b) where the phrase "essential part" does not appear, it is clear that court in making the mark for mark comparison is entitled (where relevant) to take into account the dominant features of the trade mark. Indeed, I agree with *Sarika* that the difference in statutory wording can be explained by the legislative history of the provision, rather than by any deliberate policy intention on Parliament's part. Section 8(4) was introduced into the TMA in 2004. The 2004 amendments as a whole were intended to ensure compliance with Singapore's obligations under the US-Singapore Free Trade Agreement ("US-Singapore FTA"). The US-Singapore FTA required compliance with the provisions on well known marks in Art 6 of the Paris Convention for the Protection of Industrial Property (1967) (see Article 16.2, para 4). [\[note: 15\]](#) Under Art 4 of the World Intellectual Property Organisation's ("WIPO") *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks* (1999), "a mark shall be deemed to be in conflict with a well-known mark where that mark or an essential part thereof, constitutes a reproduction, an imitation... of the well-known mark." Thus, it seems that Parliament imported the WIPO definition to ensure compliance with its international obligations, without deliberately intending to create any difference between the similarity of marks comparison in s 8(2)(b) and s 8(4) of the TMA.

147 I therefore affirm the PAR's conclusion and repeat my finding that the marks are *not* similar.

***Would the use of the Angry Bite Mark indicate a connection between the goods of the Applicant and the Opponent?***

148 The PAR found that there was *no* confusing connection under s 8(4)(b)(i) of the TMA for the same reasons that she found there was *no* likelihood of confusion. On appeal, the parties were also content to rely on their submissions on the “likelihood of confusion” under s 8(2)(b) of the TMA for this issue. [\[note: 16\]](#)

149 In *Amanresorts* at [226], the court held that:

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

150 Following *Amanresorts*, it seems that proving a likelihood of confusion is both *necessary* and *sufficient* to prove a connection between an applicant’s goods and services, and the proprietor of the earlier trade mark. I thus say no more on this issue, and following my finding that there is no likelihood of confusion, affirm the PAR’s conclusion also that there is no “confusing connection”.

***If so, is the connection likely to damage the interests of the Opponent?***

151 Given my findings above, it is unnecessary for me to consider whether the connection is likely to damage the interests of the proprietor of the earlier trade mark. Indeed, any assessment of damages arising from a confusing connection would be artificial given my finding that no such confusing connection exists in the first place. Having come to the conclusion that there is *no* confusing connection, the PAR did not deal with this issue. Nevertheless, in the event that I am wrong about similarity and a confusing connection under s 8(4) of the TMA, I shall briefly touch on the submissions made by the Opponent on damage.

152 The Opponent submits that it suffers the following types of damage:

- (a) Its entry into the snack food industry is limited. This in turn limits its business expansion opportunities.
- (b) The Opponent’s business model of licensing its trade marks would be severely affected if other businesses realise that marks similar to the Opponent Marks like the Angry Bite Mark can be freely used.

153 In response, the Applicant submits the following:

- (a) The Opponent has not offered any evidence that its interests have been damaged even though the Angry Bite Mark is already being used on snack food products.
- (b) The Plaintiff’s business is not in the snack food industry. Its primary business is in computer games. It has not offered any evidence of licensing agreements with snack food manufacturers.

154 In *Amanresorts*, the Court of Appeal at [234] agreed with the High Court holding that the test to be applied to determine the “connection” and “likely to damage the interests of the proprietor” requirements was essentially the same as the tests applied in a passing off action. That said, whilst

the focus in passing off was on goodwill, the focus in s 8(4) is on the “interests” of the proprietor. The proprietor of a well known mark may not in fact possess goodwill in Singapore. Similar views were expressed by the Court of Appeal in *Sarika* at [76]. In the latter case, the Court of Appeal agreed with the High Court’s assessment that damage was established on the basis that the opponent’s expansion into the drinks business in Singapore would be restricted. Even though the opponent had not suffered any actual loss in terms of sales, the Court of Appeal in *Sarika* at [78] agreed that the restriction on expansion into the Singapore drinks business would be a recognised head of damage. Similarly, in *Staywell*, damage was found on the basis of a restriction on the ability of the earlier trade mark proprietor to expand into the 4-star hotel market in Singapore (a closely connected field of business to 6-star hotel market).

155 In this case, if I did find that the similarity of marks and confusing connection requirements were met, the Opponent may well have been able to establish damage to its interests because its ability to expand into crisps and snacks is arguably restricted. Whether it succeeds would of course depend on all the facts, including an assessment of how closely related the fields of businesses are. However, in this case, given my finding that the marks are *not* similar, and that there is *no* likelihood of confusion, I similarly find that there is no likelihood of damage caused to the Opponent from the Applicant’s use of the Angry Bite Mark.

156 In conclusion, I find that the Opponent’s opposition to the registration of the Angry Bite Mark on the ground of s 8(4)(a) read with s 8(4)(b)(i) of the TMA must fail.

### **Issue 3: s 8(7)(a) of the TMA**

157 Under s 8(7)(a) of the TMA, a mark shall not be registered if “its use in Singapore is liable to be prevented by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other signed used in the course of trade”. The key question is whether the use of the Angry Bite Mark is “liable to be prevented” by the law of passing off.

158 In *Amanresorts* at [37], the Court of Appeal confirmed that there are three clear, identifiable core concepts fundamental to a passing off action. These are goodwill, misrepresentation and damage. Before going into the substance of what was argued, a threshold question arises. In the context of s 8(7)(a) of the TMA, to what extent must an opponent demonstrate that it would succeed in a passing off action in order to demonstrate that the use of the applicant mark is “liable to be prevented” by the law of passing off?

159 Opposition based on s 8(7)(a) of the TMA is based on the assertion of a private right (protected by the law of tort) which existed prior to the date of application for registration (or the priority date). However, in the context of trade mark opposition proceedings, a court is generally hampered in evaluating the potential success of any passing off action. For one, the mark may not even have been used by the trader yet. The decision is based on a notional action for passing off. Second, the court may have relatively few facts and evidence before it on which it has to make a decision as to whether the notional passing off action will succeed. It is in this context, that I now consider what is the appropriate threshold of proof an opponent must meet before succeeding under s 8(7)(a) of the TMA.

160 It is fairly well established that in evaluating opposition to trade mark registration under s 8(7)(a) of the TMA, the court considers whether the normal and fair use of the applicant mark in respect of the goods or services for which the mark is sought to be registered would result in passing off: Tan Tee Jim, *Law of Trade Marks and Passing Off in Singapore*, vol 1 (Sweet & Maxwell, 3rd Ed, 2014) (“*Tan Tee Jim*”) at para 8.159 and James Mellor *et al*, *Kerly’s Law of Trade Marks and Trade Names*

(Sweet & Maxwell, 15th Ed, 2011) ("*Kerly's on Trade Marks*") at para 9-147. Thus, s 8(7)(a) effectively requires the court to consider the position of the opponent in a notional passing off action.

161 It is also well-established that it is the opponent in opposition proceedings who bears the burden of making out the grounds of opposition he relies on: *Kerly's on Trade Marks* at para 9-166. In the context of s 8(7)(a), the question is whether an opponent relying on the said provision must prove, on a balance of probabilities, that he would have a valid passing off claim if the applicant mark was used in relation to any of the goods or services for which the mark is sought to be registered.

162 In *Wild Child Trade Mark* [1998] RPC 455 ("*Wild Child Trade Mark*"), the appointed person (Geoffrey Hobbs QC) concluded that the opponent's evidence, which comprised two declarations from the opponent's managing director on the use of the earlier mark (see *Wild Child Trade Mark* at [15]-[16]), did not clearly establish use of the mark as a trade mark and was an insufficient basis for a claim in passing off. In this regard, Hobbs QC opined:

I appreciate that the Registrar is often required to act upon evidence that might be regarded as less than perfect when judged by the standards applied in High Court proceedings. However, I am not willing to regard assertions without any real substantiation as sufficient to sustain an objection to registration under Section 5(4).

163 Indeed, the learned authors of Christopher Morcom, Ashley Roughton and Thomas St Quintin, *The Modern Law of Trade Marks* (Lexis Nexis, 4th ed, 2012) at para 6.89 ("*The Modern Law of Trade Marks*") rightly note that following *Wild Child Trade Mark*, save in plain cases in which the likelihood of deception is fairly clear, an opponent invoking the UK equivalent of s 8(7)(a) of the TMA must be prepared to obtain rather more evidence than his own declaration on his use of a same or similar earlier mark. Compared to the old statutory provision in the UK (*ie*, s 11 of the UK Trade Mark Act 1938), the present s 5(4)(a) of the UK TMA 1994 (which is *in pari materia* with s 8(7) of the TMA) is far narrower and demands far more from an opponent in terms of proof: *The Modern Law of Trade Marks* at para 6.88.

164 Having considered the statutory language of s 8(7)(a) of the TMA and the limited authorities on the matter, I am of the view that s 8(7)(a) of the TMA at the very least requires an opponent to adduce sufficient evidence to establish a *prima facie* case on goodwill, misrepresentation, and damage: see *Tan Tee Jim* at para 8.159. I use the phrase *prima facie* only to indicate the reality that the court is inevitably hampered by the lack of a full trial and detailed facts and evidence (especially if the mark has not been used yet) in determining if a passing off claim would actually succeed should one be brought. However, the opponent must still persuade the court that on the materials before it, there is at least a *prima facie* case that a passing off claim would be successful if, at the time of the application, the applicant mark were to be used in a normal and fair manner in respect of the goods or services for which the mark is sought to be registered. Indeed, it may be preferable to just use the words of the statutory provision: has the Opponent established that the use is "liable to be prevented" by passing off? In other words that the Opponent had proved a case of passing-off in the notional passing-off action. In the present case, for reasons which will be apparent, nothing turns on this as either way the opposition fails.

165 To this end, it is incumbent on an opponent to adduce evidence on, *inter alia*, (i) the nature and extent of the goodwill and reputation relied on, (ii) the closeness or otherwise of the respective fields of activity, (iii) the similarity of the marks, (iv) the manner in which the applicant has used the mark (if any), (v) the manner in which the particular trade is carried out, (vi) the class of persons whom the applicant mark is likely to be deceived, and (vii) the likely damage the opponent would suffer.

166 It is with these points in mind that I turn to consider the objection under s 8(7).

### **Goodwill**

167 In analysing goodwill, the PAR noted that goodwill may be shared by the Opponent and its licensees, and may be proven by showing volume of sales in relation to the vessels of goodwill (the Opponent Marks in this case): see the PAR's GD at [192]–[193]. She proceeded to analyse all the instances where the Opponent has entered the Singapore market, taking into account only evidence relating to events before 5 April 2012 (the date of the application for the registration of the Angry Bite Mark): see the table at [196] of the PAR's GD. Indeed, whilst nothing appears to turn on this, if the Applicant's use of the Angry Bite Mark in Singapore had started at an earlier date, this earlier date would become the relevant date for consideration because in a passing off action, the court considers if the plaintiffs had goodwill *etc* at the date of commencement of the activities complained of.

168 The PAR did not come to a firm conclusion on goodwill. This was because she found at [199] that subsistence was a "non-issue" because of her finding on "misrepresentation." Nevertheless, it is apposite to set out some comments made by the PAR on goodwill. In particular, she noted the following:

(a) There were no sales or advertisement figures relating specifically to Singapore. No evidence was given on what proportion of the worldwide figures relate to Singapore. Nor are there invoices buttressing the worldwide figures.

(b) In relation to several events that evidence the Opponent's entry into the Singapore market, it was unclear what merchandise was sold or what revenue was otherwise generated. For example, the PAR mentions that it is unclear what merchandise was sold (if at all) at the 2011 Formula 1 Singtel Singapore Grand Prix.

169 On appeal, the Opponent submits the following:

(a) There is evidence that the Opponent has spent substantial amounts on marketing and advertising in Singapore. Instances of marketing and advertising have been noted in the PAR's GD at [196].

(b) Merchandise with the Opponent Marks on them (*eg* toys, stationary, t-shirts, snack packets from Polar and Korean super markets) was being sold before 5 April 2012. Such merchandise was purchased precisely because the Opponent Marks were appended on them. In its oral submissions, the Opponent referred the court to pictures of snacks with the Opponent Marks appended. These snacks were sold in Korean supermarkets in Singapore. It also presented a receipt showing that such snacks were purchased in Singapore *before* 5 April 2012, presumably to prove that these snacks are indeed being sold in Singapore.

170 The Applicant, on the other hand, submits that the Opponent only has goodwill *in relation to computer games*. [\[note: 171\]](#) There is insufficient evidence to show that the Opponent's goodwill extends to snack foods.

171 Both *Staywell* at [131] and *Amanresorts* at [39] cite the definition of goodwill in *The CIR Muller & Co's Margarine Ltd* [1901] AC 217 at 223-224 as an authoritative statement of the meaning of goodwill. There, the House of Lords defined goodwill as "the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom...". Following the House of Lords, the court in *Amanresorts* at [39], identified two essential features of

goodwill:

First, it is the association of a good, service or business on which the plaintiff's mark, name, labelling, etc (referred to generally as the plaintiff's "get-up") has been applied with a particular source. Second, this association is "an attractive force which brings in custom".

172 In order to succeed in a passing off action in Singapore, the court in *Staywell* at [130] emphasised that "goodwill must exist *in Singapore*" [emphasis added]. The first step to proving goodwill in a passing off action is therefore to demonstrate that the claimant has a business in Singapore. Thereafter, what is necessary is to establish that the claimed *indicia* of origin (*ie*, the brand, name, logo, or get-up) enjoys a reputation in Singapore. Establishing a reputation requires proof that the claimed mark is known to the public in Singapore as a mark associated exclusively with goods or services of a particular origin. In short, the public must view the claimed mark as an indicator of origin. The PAR rightly notes at [186] that passing off protects goodwill, and not the mark used to promote it. The passage cited by the PAR (at [186] of the PAR's GD) from Ng-Loy Wee Loon, *Law of Intellectual Property in Singapore* (Sweet & Maxwell, 2009) at para 17.1.3 bears repeating:

Passing off protects the plaintiff's business or goodwill, and not the mark used to promote it. The mark is merely a tool used by the plaintiff to educate their customers to identify which goods or services originate from his business. Although it is important to bear in mind that the proper subject matter of protection in an action for passing off is the plaintiff's business or goodwill, and not the mark, the role of the mark is crucial when proving the element of goodwill. This is because the test which has been used by the courts to determine whether the plaintiff's business has goodwill is this: has the mark adopted by the plaintiff become distinctive of his goods or services in the sense that it is associated or identified exclusively with his goods or services.

173 In this way, assuming that the plaintiff in a passing off action is able to establish a business in Singapore, he must go on to prove that the claimed mark is a badge of recognition upon which the reputation is founded so as to *generate* goodwill: William Cornish *et al*, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (Sweet & Maxwell, 8th Ed, 2013) at para 17-08.

#### *How goodwill may be proven in practice*

174 I now consider how goodwill may be proven in practice. The first case that arises for consideration is *Amanresorts*. In concluding that the "Aman" name has goodwill which is limited in scope (see [58]–[59] of *Amanresorts*), the court in *Amanresorts* took into account the following factors (amongst others):

- (a) The extensiveness of the marketing of the "Aman" name, which was relevant to determining the extent to which the Singapore public had been exposed to the "Aman" name: *Amanresorts* at [51].
- (b) How frequently Internet users in Singapore visited the Amanresorts website: *Amanresorts* at [54].
- (c) Sales revenue from customers in Singapore: *Amanresorts* at [56].
- (d) Whether the Amanresorts had actual or potential customers in light of the high price of the resorts: *Amanresorts* at [60], [63].
- (e) Type of business in respect of which the goodwill in the "Aman" name exists, namely, the

high end hotel and resort market, and not residential accommodation: *Amanresorts* at [65].

175 At this juncture, I must point out that *Amanresorts* (at [44]) clearly establishes that goodwill is not an all-or-nothing attribute. Goodwill could be limited to particular sections of the public provided that the section of the public was not so small as to be negligible. Once goodwill is established among a section of the public in Singapore, goodwill subsists in Singapore. By this, what was meant is that if the plaintiff can show that he has a business in Singapore, it does not matter that the business targets and has dealings with only a section of the Singapore public. If the claimed mark is a badge of recognition to those customers in Singapore, it is a generator of goodwill in Singapore.

176 The next relevant case is *Staywell*. The Court of Appeal had to decide if the St. Regis hotel chain had goodwill in Singapore before it had an actual hotel in Singapore. It ultimately concluded that the "ST REGIS" brand had no goodwill in Singapore as of the relevant date. It considered (amongst others) the following factors in reaching that conclusion:

(a) Pre-trading activity can establish goodwill, and revenue-generating activity is not always necessary to establish goodwill. The key question is whether valuable demand for the good or service exists: *Staywell* at [141].

(b) How widespread the advertising efforts were, and whether marketing efforts were sufficient to generate demand in Singapore for the St Regis hotel chain: *Staywell* at [146]–[147].

177 The brief findings on goodwill in *Hai Tong* at [112]–[114] are also instructive. The Court of Appeal found that the appellant's business had "undoubtedly acquired goodwill" on the basis that customers were exposed to the trade mark in question, and the appellant has been trading and running a sustainable business for more than four decades. Moreover, the court took into account the appellant's annual sales figures for the relevant range of products in Singapore.

178 Finally, I mention in passing a recent High Court decision, which briefly discusses what is required to prove goodwill in an action for passing off. In *Jamal Abdulnaser Mahmoud Al Mahamid v Global Tobacco Manufacturers (International) Sdn Bhd* [2015] SGHC 42 ("*Jamal*") at [62], Aedit Abdullah JC recognized that goodwill may be shown through various means, such as sales figures. The court also noted that sales or evidence of marketing *alone* does not establish goodwill. It must be proven that the sales were *a result* of consumers being attracted to the plaintiff's brand or product (as opposed to an accidental purchase of the product, for instance): *Jamal* at [63]–[64].

179 The decision in *Jamal* was only released post-submissions in the present case. Given that the parties have not addressed the decision, I will confine myself to making only brief observations on the decision. The expression "attractive force" in the definition of goodwill does not mean that the brand must be popular or desirable. The question is whether the plaintiff has customers (business) within jurisdiction and whether the customers recognise the claimed mark as a badge of recognition. With respect to the comments in *Jamal*, it is not immediately apparent why it must be shown that the customers made a deliberate decision to acquire the specific product in question. Indeed, the fact that no alternative product was available does not mean that (i) the plaintiff did not have customers, and (ii) that the mark does not have a reputation in that it is recognised by the public as a badge of recognition. That said, it is quite right and accepted that the mere proof of a few occasional sales to a very limited group of people such as staff of a foreign embassy is unlikely to be enough to prove that the mark is recognised as a badge of recognition by the public or a section of the public (see *Anheuser-Busch v Budejovicky Budvar* [1984] FSR 413, where sales to American military bases in the UK was not counted). Whether the sales and marketing efforts are sufficient to establish goodwill (at the relevant time) is a question that must depend on the circumstances and facts as a whole.

180 Bringing together the authorities mentioned above, it appears to me that the existence of goodwill is normally established with the following evidence:

(a) Figures on sales in Singapore: *Actual* sales figures must often be adduced to demonstrate the volume of sales in Singapore. It stands to reason that the greater the volume of sales and proven demand, the greater the likelihood that the claimed mark will be found to be a badge of recognition in the minds of the public.

(b) Marketing and advertising efforts in Singapore: These show the extent of public exposure of the particular brand or business in Singapore. The court will scrutinise the nature, extent and effectiveness of advertising in determining if the business in question has achieved some degree of notoriety (in the sense of recognition) in the minds of Singapore consumers.

*Whether goodwill has been proven on the facts of the present case*

181 The Opponent asserts goodwill in the Opponent Marks. By this, what the PAR at [165] understood the claim to refer to was the registered Red Bird Mark and the Angry Bird Word Mark.

182 In the present case, there is evidence of some marketing of the “Angry Bird” brand in Singapore. However, the evidence is thin especially as to the *scale or extent* of the marketing efforts. No statistics on marketing expenditure in Singapore were produced in evidence. No statistics were provided on the volume of sales of Angry Bird merchandise (or snack foods specifically) in Singapore before 5 April 2012.

183 The fact that “Angry Birds” as a mobile-game or computer application is well known and popular in Singapore does not mean that goodwill in the Opponent Marks subsists in Singapore. Despite the PAR’s comments at [198]–[199], the Opponent did not ask for leave to adduce further evidence on sales figures and marketing expenditure *specific to Singapore* on appeal. Whilst there is some evidence of the promotion of the Red Bird Mark and Angry Bird Word Mark (*eg* at the 2011 Formula 1 Singtel Singapore Grand Prix and the Takashimaya Department Store in November 2011), the evidence as to just what was being promoted and what merchandise was being sold was unclear.

184 In the Statutory Declaration of Harri Koponen (for the Opponent) at para 3, it is stated that “*Angry Birds* was first released in December 2009 as an iPhone game on Apple’s *App Store*”. By October 2011, it was claimed that there were more than one million downloads in Singapore alone. Whilst there was no independent evidence to support this claim, I note that the Applicant in its written submissions accepts that the Opponent’s business and hence goodwill were in computer games. [\[note: 18\]](#)

185 It is not entirely clear what the Applicant meant by this submission. If the Opponent has established a business in computer games in Singapore, and if the Opponent Marks have acquired a reputation in Singapore as badges of origin, goodwill will subsist in Singapore. The fact that the business and recognition is in respect of computer games does not affect the finding of goodwill. That said, the fact that the Applicant’s business (goods or services) does not relate to computer games, but relates to snack food products, may be relevant in deciding whether the Applicant’s use of the Angry Bite Mark constitutes a misrepresentation such as is likely to damage that goodwill.

186 In the present case, whilst the evidence that the Opponent or its licensees had established business activities for snack food products on or before 5 April 2012 in Singapore is thin, I am of the view that there is clear evidence that there were substantial downloads of the Angry Bird game in Singapore by that date. This, in my view, constitutes business activity in Singapore. To establish that



one has business activity in Singapore, it is not of course necessary to establish a brick and mortar shop in Singapore. A business established on an Internet website hosted in Singapore is still a business in Singapore. Where the website is hosted outside of Singapore, the question whether there is sufficient nexus to Singapore to constitute a business in Singapore (or business activity in Singapore) can be tricky. English cases such as *800-Flowers Trade Mark* [2000] FSR 697 and *Euromarket Designs Inc v Peters* [2001] FSR 20 stress the importance of questions such as the purpose of the website and advertisement, and who are the intended customers. Just because individuals in country X can access the website in country Y does not mean that the owner of the website has business activities in country X. The position may well be different where it is established that the proprietor took active steps to promote the goods or services in country X.

187 Whilst these English cases concerned registered trade marks and what constitutes “use”, the general point is that just because a person in Singapore can access a website overseas on which goods and services are offered does not mean that the website owner has a business in Singapore. The mere presence of customers in the UK for services provided elsewhere is not sufficient to establish business activity in the UK: *Kerly’s on Trade Marks* at para 18-053. It is at least necessary to show that some form of commercial activity is carried out in the relevant jurisdiction, which could include customers making telephone or online bookings in that jurisdiction for services overseas: *Starbucks (HK) Ltd v British Sky Broadcasting Group PLC* [2015] UKSC 31 at [52].

188 In the present case, it appears that members of the public in Singapore were able to access and download copies of the Angry Bird game over the Internet. In *Amanresorts*, the Court of Appeal (at [54]) was cautious as to whether the existence of a domain name and website was sufficient to establish goodwill, but held that proof that active steps were taken to reach customers in Singapore could make a difference. Proof of active steps included evidence of how many “hits” on the website came from Internet users in Singapore.

189 Whilst very little detail was provided (for example, as to whether the downloads were free or paid), it appears that the Angry Bird game thus downloaded (within the terms of the website) were provided to *users in Singapore*. There is nothing to suggest that the website was intended to target only users in Europe or elsewhere. That being so, whilst the evidence could have been much clearer, given that the Applicant appears to acknowledge that the Opponent had goodwill in respect of computer games, I accept the Opponent has established goodwill in Singapore in the Red Bird Mark and the Angry Bird Word Mark.

190 In coming to this view, I make clear that even if all one million downloads from individuals in Singapore were free for the customer, this does not mean that there is no business activity in Singapore sufficient to support a finding of goodwill. Monetising goods and services provided online can come in many different forms, including advertisements and development of merchandising. As the Court of Appeal in *Staywell* held at [141], pre-trading activity need not be revenue generating because “goodwill does not focus on the income of the trader *per se* but the response of the customer. The fact that income is generated is only a proxy for the attractive force of the business.” Indeed, the Court of Appeal in *Staywell* went on at [141] to cite its earlier decision in *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR(R) 975 as acknowledging that a “valuable demand may be created in a product or business prior to its being monetised.”

### **Misrepresentation**

191 The PAR found at [207] of her grounds of decision that there is no misrepresentation in the Applicant using the Angry Bite Mark for broadly the same reasons which she found that there is no “likelihood of confusion” under s 8(2)(b) of the TMA and no “confusing connection” under s 8(4)(b)(i)

of the TMA.

192 On this, I note that the Court of Appeal in *Amanresorts* stated at [234]:

... [T]he tests to be adopted for the purposes of the “connection” requirement and the “likely to damage the [plaintiff’s] interests requirement” in s 55(3)(a) of the current TMA would yield the same results as those obtained from applying the corresponding tests vis-à-vis the Respondent’s claim for passing off...

193 While *Amanresorts* was concerned with s 55(3)(a) of the TMA, the language used in that provision is substantially similar to that in s 8(4)(b)(i) of the TMA. It therefore applies equally in the context of s 8(4)(b)(i).

194 As stated by Lord Oliver in *Reckitt & Coleman Products Ltd v Borden* [1990] RPC 341 at 406, to succeed in passing off, aside from goodwill, it is necessary to show:

- (a) a misrepresentation by the defendant (whether intentional or not) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff; and
- (b) damage or the likelihood of damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff.

195 A comparison of the Applicant’s Angry Bite Mark, and the Red Bird Mark and Angry Bird Word Mark, has already been made for the purposes of the objections raised under ss 8(2) and 8(4) of the TMA. The significant differences between the marks led to the holding that the marks were dissimilar. Indeed, I would add that even if the Red Bird Mark and Angry Bird Word Mark were treated as a composite mark (for the purposes of the passing off issue), there are still significant differences between the Angry Bite Mark and a combined version of the Red Bird Mark and the Angry Bird Word Mark such as the absence of a bird.

196 While my previous finding on dissimilarity is sufficient to dispose of the question of misrepresentation (*ie*, to justify a finding that there is no misrepresentation), I would like to make a few comments on two further issues related to misrepresentation that arise in the present case: first, I consider whether it is relevant that the Applicant was inspired by “Angry Birds” in designing the Angry Bite Mark, and second, I consider whether the parties were in the same field of business, and the relevance of that fact to the misrepresentation inquiry, if any.

#### *Relevance of inspiration*

197 The fact that the Applicant accepts that the Angry Bite Mark was inspired by “Angry Birds” is not in itself evidence of an intention to deceive. The law of passing off does not in general prevent one trader from being inspired by the business model of another trader. Indeed, even if there was an intention to deceive, it does not mean that the court is bound to find misrepresentation and confusion, although the burden on the plaintiff in a passing off action will be much lessened.

198 Thus, the fact that the Angry Bite Mark may have been inspired by the “Angry Birds” designs does not, on its own, contribute to a finding that there is or is likely to be misrepresentation.

#### *Common fields of business activity*

199 Whilst the law of passing off no longer requires that the parties are competing in the same or common field of activity, a relevant factor in deciding whether any misrepresentation is likely to cause confusion is how close or far apart are the fields of activity. Much will depend on the actual facts and circumstances. As was said in *Ng-Loy Wee Loon* at para 18.3.28:

The closer the defendant's field of business activity is to that of the plaintiff, the greater is the risk of confusion. However, it does not automatically follow from this, that confusion cannot arise if the parties are in completely different fields of activity.

200 In general, the fact that the defendant used a similar mark in a wholly unrelated field will lessen the likelihood of confusion, and indeed, damage. But equally, where the plaintiff's mark is well-established and the fields of activity (whilst not identical) are close or related, a likelihood of confusion and damage may still be found. Other relevant factors in determining misrepresentation and confusion include whether the plaintiff has already started using the mark in that different field of activity.

201 In the present case, there is arguably some evidence that the Opponent Marks were not merely used in the unrelated field of computer or mobile phone games, but were also used in relation to snack food products. The PAR (at [203]–[206] of the PAR's GD) discussed the evidence available on the use of the Opponent Marks on sweets, chips, cakes and moon cakes. In my view, the evidence as to when the Opponent started to use (or licence the use) of the Opponent Marks on these goods was unclear, and some of the evidence clearly related to events after the relevant date (5th April 2012). However, I accept that Polar cup cakes with the marks had been served on a Finnair Helsinki–Singapore flight on 21 September 2011.

202 The Opponent further asserts that its merchandise (such as soft toys, stationary and t-shirts) were available in Singapore from April 2011. For example, plush toys modelled after the red bird with angry eyes (and other angry bird characters) were apparently available in Singapore. In the statutory declaration of Harri Koponen at [12], it is stated that these merchandise were "extremely popular in Singapore". First, I point out that the Applicant's business does not relate to such merchandise. Second, even if it is accepted that these merchandise relate more closely to snack food products, no invoices or accounts were provided to substantiate the claim that such merchandise was sold in Singapore from April 2011.

203 For the reasons stated above, I find that there is no reason to disturb the PAR's finding that misrepresentation and likelihood of confusion have not been demonstrated. Any use of the earlier marks in Singapore on sweets and cakes *etc* prior to 5 April 2012 appears to have been intermittent and slight. In addition, the Angry Bite Mark and the Opponent Marks are significantly different. Even if the Opponent Marks were combined, there would still be many points of differences as pointed out by the PAR at [209] and [210] of the PAR's GD.

### **Damage**

204 Given my conclusion that there is no misrepresentation, nothing more can be usefully said on the issue of damage to goodwill pursuant to a misrepresentation.

205 Thus, I conclude that the opposition on the ground of s 8(7)(a) of the TMA fails.

### **Issue 4: s 8(7)(b) of the TMA**

206 The final ground of opposition invoked by the Opponent is s 8(7)(b) of the TMA. The Opponent

submits that the use of the Angry Bite Mark is liable to be prevented by virtue of the law of copyright.

207 In particular, the Opponent submits that the Angry Bite Mark is said to infringe the copyright in two of the Opponent's designs. [\[note: 19\]](#)

(a) The first is the Red Bird Mark as depicted above at [3].

(b) The second is the Fancy Word Mark, which, as described at [5] above, consists of a stylised version of the "Angry Birds" words.

(collectively, "the Artistic Works")

208 Two sub-issues arise in relation to the possibility of copyright infringement. First, the Opponent must prove the subsistence and its ownership of copyright in the Artistic Works. Second, the Opponent must prove that the Angry Bite Mark is a copy of a substantial part of the Artistic Works.

### ***Subsistence and ownership of copyright***

209 The relevant statutory provision on the subsistence of a copyright is s 27(2) of the Copyright Act (Cap 63, 2006 Rev Ed) ("CA"). It states:

(2) Subject to the provisions of this Act, where an *original* literary, dramatic, musical or artistic work has been published —

(a) copyright shall subsist in the work; or

(b) if copyright in the work subsisted immediately before its first publication, copyright shall continue to subsist in the work,

if, but only if —

(c) the *first publication of the work took place in Singapore*;

(d) the author of the work was a qualified person at the time when the work was first published; or

(e) the author died before that time but was a qualified person immediately before his death.

(emphasis added)

210 The PAR found that the Red Bird Mark and the Fancy Word Mark satisfied the requirement in s 27(2)(c) of the CA read with Regulation 3(1)(a) of the Copyright (International Protection) Regulations (see the PAR's GD at [235]–[236]). On appeal, the parties did not dispute that the "first publication" requirement in s 27(2)(c) of the CA is satisfied. The Red Bird Mark and the Fancy Word Mark were first published in Finland on 1 December 2009 and 21 October 2010 respectively. [\[note: 20\]](#) As the PAR correctly stated at [236]–[237] of her grounds of decision, since Finland is a party to the Berne Convention, copyright will subsist in Singapore if the two marks are in fact original artistic works. If they are original works, the further questions are whether copyright belongs to the Opponent, and if so, whether it is likely that the Angry Bite mark infringes the copyright.

211 The PAR held that the Opponent had not proven the subsistence of copyright in the Artistic Works because originality was not proven. Neither evidence nor submissions were made by the Opponent to demonstrate originality in the Designs (see [238]–[239] of the PAR’s GD). The PAR also held that on the evidence, there was insufficient proof of substantial copying by the Applicant. Before the PAR, opposition under s 8(7)(b) thus failed.

212 While the Opponent referred to certificates of registration of copyright from China and the United States, the PAR found that the registration certificates *on their own* do not show that the substantial requirements of registration, including originality, are satisfied. The PAR was of the view that what was needed was evidence and submissions on what is required for registrations of copyright in those jurisdictions. In particular, the PAR noted that there were some jurisdictions where there may not be a formal examination of the work before a registration certificate is issued.

213 On appeal, the Applicant furthered the attack with the following submissions:

(a) The certificates of registration were not adduced as evidence by way of a statutory declaration, which is required under Rule 69 of the Trade Marks Rules.

(b) Even accepting the certificates as evidence, the owner of the mark on the US certificate is “Rovio Mobile Oy, dba Rovio Mobile Oy”. *Prima facie*, that stated entity is not the Opponent. No evidence has been given as to the relationship of that entity with the Opponent.

214 In support of its position, the Opponent submits the following:

(a) Section 130 of the CA allows the subsistence and ownership of copyright in the Designs to be presumed in favour of the Opponent.

(b) Even if s 130 of the CA does not apply, the requirements for proving originality are not high. All that needs to be proven is that some skill or labour had been expended in the creation of the Artistic Works, and that they have not been copied. There is no evidence that the Artistic Works have been copied. Therefore, copyright subsists in the Artistic Works.

215 The first issue that arises from the parties’ submissions on appeal is the applicability of s 130 of the CA. If the presumptions in s 130 of the CA apply, the Opponent submits that the absence of direct proof of copyright subsistence is irrelevant.

216 It is useful to set out s 130 of the CA in full:

Presumptions as to subsistence and ownership of copyright

130. —(1) In an action brought by virtue of this Part —

(a) *copyright shall be presumed to subsist in the work or other subject-matter to which the action relates if the defendant does not put in issue the question whether copyright subsists in the work or other subject-matter; and*

(b) *where the subsistence of the copyright is established — the plaintiff shall be presumed to be the owner of the copyright if he claims to be the owner of the copyright and the defendant does not put in issue the question of his ownership.*

(1A) Where the defendant puts in issue the question of whether copyright subsists in the work or

other subject-matter or whether the plaintiff is the owner of the copyright, but does not satisfy the court that he does so in good faith, the presumption as to the subsistence or ownership of copyright under subsection (1)(a) or (b), as the case may be, shall apply notwithstanding that the defendant puts that question in issue.

(1B) Where the defendant, in good faith, puts in issue the question of whether copyright subsists in the work or other subject-matter or whether the plaintiff is the owner of the copyright, an affidavit made on behalf of the plaintiff in which the plaintiff makes assertions of facts relevant to showing —

(a) that copyright subsists in the work or other subject-matter; and

(b) that he is the owner of the copyright,

shall be admitted in evidence and *shall be prima facie proof of the matters stated therein until the contrary is proved, unless the court directs that oral evidence be adduced to prove those matters.*

(2) Where a defendant, without good faith, puts in issue the questions of whether copyright subsists in a work or other subject-matter to which the action relates, or the ownership of copyright in such work or subject-matter, thereby occasioning unnecessary costs or delay in the proceedings, the court may direct that any costs to the defendant in respect of the action shall not be allowed to him and that any costs occasioned by the defendant to other parties shall be paid by him to such other parties.

217 Section 130 of the CA, as enacted in 1987, was modelled on similar provisions in s 126 of Australia's Copyright Act 1968. In 2004, protection given to copyright owners was strengthened such that where a defendant challenges the subsistence and ownership of copyright without good faith, the presumptions in s 130 still operates (s 130(1A) of the CA). Further, even where the defendant does challenge the subsistence and ownership of copyright in good faith, the plaintiff under the amended provisions was permitted to file an affidavit to show that copyright subsists and that he is the owner (s 130(1B) of the CA).

218 Before going into the substance of s 130 of the CA, a prior question that must be determined is whether s 130 of the CA can be invoked by a litigant in *trade mark opposition proceedings*. The Applicant argues that it cannot, because the presumptions in s 130 of the CA only apply where there is a copyright infringement action.

219 In relation to this submission, the crucial part of s 130 of the CA which merits our attention is the phrase "[i]n an action brought by virtue of this Part...". From this, the Applicant submits that it follows that the presumptions in s 130 of the CA only apply to actions brought under "Part V Remedies for infringements of copyright" in the CA.

220 While I agree that s 130 of the CA only applies in actions brought under Part V of the CA, this does not mean that s 130 of the CA is irrelevant in deciding whether opposition under s 8(7)(b) of the TMA may succeed. Just like opposition under s 8(7)(a), opposition under s 8(7)(b) requires the court to consider a notional action for copyright infringement. The Opponent must at the very least establish a *prima facie* case of copyright infringement. This arises from the language of the provision and the need to show that the use of the applicant mark is *liable to be prevented* by the law of copyright. It follows that this requires a determination, on the materials before the court, of whether an *action for copyright infringement* is likely to succeed (at least on a *prima facie* basis) should the

applicant use the Angry Bite Mark on its products. Indeed, it bears repeating that it may be preferable simply to use the words of the section in formulating the test. Has the Opponent established that an action for copyright infringement is likely to succeed? If the plaintiff in the notional copyright infringement action is able to invoke the presumptions in s 130 of the CA, a court assessing opposition under s 8(7)(b) of the TMA should be permitted, and indeed, required, to consider the likely success of any copyright infringement proceeding in light of s 130 of the CA.

221 There is, however, still the question of whether the substantive requirements of s 130 of the CA are satisfied such as to entitle the Opponent to invoke the presumptions therein. Before moving there, I pause to note the Registrar's comments in *PT Lea Sanent v Levi Strauss & Co.* [2006] SGIPOS 6 at [69]–[72]. In commenting on the phrase "liable to be prevented" by the law of copyright in s 8(7)(b) of the TMA, the registrar held that "the placement of the word "liable" sets the level of inquiry at a speculative level". The Registrar voiced the apprehension at [72] that the Registry was essentially determining the same issue as a court would have to determine in an action for copyright infringement, minus the advantage of a strong discovery process and a full trial. These are salutary points to bear in mind. Section 8(7)(b) requires that an opponent establishes that the use of the applicant mark is *liable* to be prevented by copyright law. One view is that this requires an opponent to prove that there is a "prima facie" case, on the materials before the court, that there would be copyright infringement if the applicant mark were to be reproduced or used by the applicant. The other view is that it is preferable to simply ask whether on the material before the court, the Opponent has established (or proved) that the use of the mark is liable to be prevented. Either way, this undeniably involves some speculation given that the court is considering a notional action for copyright infringement, a court in trade mark opposition proceedings is unfortunately required to make the determination in the broad context of determining whether to grant an applicant proprietary rights over a particular mark given the earlier right that has been asserted

222 I now return to consider the specific requirements under s 130 of the CA. Broadly, under s 130(1) of the CA, a court must consider the following:

- (a) Is the defendant putting into question the subsistence and/or plaintiff's ownership of the copyright?
- (b) If so, is that done in good faith?
- (c) If it is done in good faith, is there an affidavit filed by the plaintiff stating the facts relevant to the subsistence and its ownership of the copyrights in question?
- (d) If so, has the defendant adduced enough evidence to rebut the *prima facie* proof that copyright belongs to the plaintiff?

223 Keeping in mind that the presumptions in s 130(1) of the CA do not apply in trade mark opposition proceedings *per se*, but is a *relevant factor* in light of s 8(7)(b) of the TMA, the question before me is whether the presumptions therein are likely to be successfully invoked in potential copyright infringement proceedings. Thus, it is *not* for me to decide if the Applicant has, in good faith, "put into question" the subsistence or the Opponent's ownership of copyright in *the present opposition proceedings*. Also, there is also no need for the affidavit mentioned in s 130(1B) of the CA to be filed in opposition proceedings. This is because the court is not concerned with actually invoking the presumptions in such proceedings. Instead, a court in my position is asked to determine whether, on a balance of probabilities, the defendant is likely to put into question the subsistence and the plaintiff's ownership of the relevant copyright *in copyright infringement proceedings*, and whether it is likely to have good grounds to do so. If so the question that arises next is whether the plaintiff is

likely to be able to produce the affidavit required in s 130(1B) of the CA. Again, I acknowledge that this is a rather speculative exercise. However, the court is unfortunately required by statute and the nature of trade mark opposition proceedings to engage in some degree of speculation.

224 In the present case, I find that the Applicant will in all likelihood put into question the subsistence and/or the Opponent's ownership of the Designs if copyright infringement proceedings were to be commenced between the parties. Assuming that this is done in good faith (for I have no reason to believe otherwise on the material before me), and bearing in mind the concerns that the Applicant and the PAR have about the evidence adduced by the Opponent in support of their claim to copyright, the question which arises is whether there is a basis for the conclusion that the Opponent will likely be able to produce an affidavit or indeed otherwise prove subsistence of copyright in and ownership of the Artistic Works. Whilst the evidential gaps are, of course, theoretically surmountable, this is a decision that I must take *based on the material before the court*.

225 At this juncture, I would emphasise again the practical difficulties a court faces in determining issues of copyright subsistence, ownership, and infringement in trade mark opposition proceedings. Reference to the decision of the UK Trade Mark Registry in *Campbell's Trade Mark* [2008] ETMR 56 is helpful. The registered trade mark in question was the title "The Official Guide to International Women's Month" in the form of a figurative, stylised trade mark. An application for a declaration of invalidity was brought by the applicant under, *inter alia*, s 5(4)(b) TMA UK on the ground that the use of the trade mark was liable to be prevented by virtue of copyright. The question was whether copyright subsisted in the registered mark, and if so, whether the applicant was the owner of the copyright. The registered proprietor's position was that she, rather than the applicant, was the owner of the copyright. After considering the relevant authorities on originality and artistic works, the Hearing Officer came to the view that the configuration and typeface used in the logo (the figurative mark) was such that copyright subsisted in the registered trade mark. What remained was the issue as to who was the owner of the copyright. The UK Copyright, Designs and Patents Act 1988 does not have a provision equivalent to s 130 of the TMA. In deciding to prefer the evidence of the registered proprietor as to how the trade mark was created, and hence finding that the registered proprietor owned the copyright in the trade mark, the Hearing Officer noted that there had not been any cross examination, and that the Registry was caught between "Scylla and Charybdis" in making the decision. The necessity of making a decision however meant that the Hearing Officer had to choose which version of the truth he/she steered closer to.

226 So too in the present case, the PAR had to assess the available evidence (such as it was) and reach a decision on ownership and subsistence of copyright in the Artistic Works on the basis of that limited evidence. In addition, there is the further need to reach a decision on whether the use of the trade mark is liable to be prevented by copyright law.

227 I mention briefly that in *The Modern Law of Trade Marks* at para 6.91, *Re Team Lotus Mark Application* [1999] ETMR 669 is cited as an example of a successful copyright opposition. In that case, the opponent succeeded in opposing the registration of the applicant mark. The opponent claimed ownership of the copyright in various marks, and the applicant did not question his assertion of ownership. The opponent's and applicant's marks were found to be strikingly similar. The objection based on an earlier copyright accordingly succeeded.

228 Having considered a few authorities on the matter, I now turn to the evidence the Opponent placed before the court. These include:

- (a) Copyright registration certificates;



(b) Statutory declaration of Harri Koponen; and

(c) Statutory declaration of Kati Kevoranta.

229 I start by considering the legal and evidential value, if any, of the copyright registration certificates. The Opponent's copyright registration certificates were set out in Exhibit D of the Amended Grounds of Opposition. The ten registration certificates relied on by the Opponent were tabulated and referred to at [17] of the Amended Grounds of Opposition. [\[note: 21\]](#) One registration was in the USA, whilst the remainder were registrations in China. The USA registration was described as "Angry Bird (red bird)". The registrations in China were for "Red Bird", "Mighty Eagle", "Green Bird", "White Bird", "Black Bird", "Red Bird", "Yellow Bird", "Big Red Bird", and "Blue Bird". The Fancy Word Mark is referred to in Exhibit C and [10] of the Amended Grounds of Opposition.

230 The copyright registrations were briefly referred to at [6] of the statutory declaration of Harri Koponen as well. [\[note: 22\]](#) However, no other evidence was before the court as to the authorship and origination of the drawings and logo.

231 The USA copyright certificate for the work titled "Angry Bird" exhibited before the court in Exhibit D of the Amended Grounds of Opposition, sets out, *inter alia*, (i) the place and date of first publication (Finland, December 10, 2009), (ii) the author (Rovio Mobile Oy), (iii) the nature of the work created (2-D artwork made for hire), and (iv) the copyright claimant (Rovio Mobile Oy, dba Rovio Mobile Oy). [\[note: 23\]](#)

232 The Chinese certificates of registration as set out in the Bundle of Documents before me on appeal do not contain translations of the Chinese statements that appeared on the certificates. However, I am assisted by [240] of the PAR's GD, where she noted that the documents were filed by "Rovio Entertainment Ltd".

233 At this juncture, I must make clear that whilst evidence on copyright registration in over ten designs was adduced before this court, in its submissions on appeal, the Opponent only relies on the Red Bird Mark and the Fancy Word Mark to pursue their objection under s 8(7)(b) of the TMA. [\[note: 24\]](#)

234 What is the legal or evidential value of these copyright certificates in proving that the relevant designs enjoy copyright *in Singapore*? At [240]–[241] of the PAR's GD, the PAR noted that no submissions were made as to whether there had been any substantive examination of the claimed works by the authorities in the USA and China before copyright registration was granted. She held that the copyright certificates, on their own, do not show that the requirement of originality has been satisfied (PAR's GD at [239]).

235 I agree with the PAR that the mere fact that copyright has been claimed and registered for the Artistic Works in the USA and China does not mean that copyright does in fact and law subsist in the Artistic Works in Singapore. While copyright registration certificates from other jurisdictions may have some persuasive value if evidence is adduced on the processes undertaken to obtain such registration, the issue at hand is ultimately whether the Opponent will be able to establish that it owns copyright in the Artistic Works *in Singapore* in notional copyright infringement proceedings. It is to this I now turn.

236 To establish a case that copyright does subsist in Singapore, the CA requires proof of the following:

(a) That the material in question is copyright subject-matter, *ie* a literary, dramatic, musical, artistic work or a sound recording, cinematograph film, broadcast, cable programme or published edition of works.

(b) That if what is claimed is a literary, dramatic, musical or artistic work, the work is original.

(c) If the above requirements are satisfied, it must also be shown that the connecting factors have been satisfied in respect of the nationality, residence and/or place of first publication.

237 In the present case, there is no dispute that the connecting factors have been established. What is necessary is some evidence from which the court can make an assessment of whether the material in question is an original artistic work. In a copyright infringement action where subsistence and ownership is in dispute, evidence and submissions are often required on, *inter alia*, (i) who is the author, (ii) whether the work is original to the author, (iii) whether the material falls into one of the nine types of copyright subject-matter, and (iv) the basis for the claim to copyright if the claimant is not the author (such as an employment relationship, or assignment).

238 Having considered the materials before me, I am of the view that the Opponent may well be able to establish a sufficient chain of title whether by assignment or exclusive license or otherwise. However, it is less clear whether the Red Bird Mark and Fancy Word Mark is an *original artistic work* under the CA. There can be no doubt that the Red Bird Mark is an artistic work. Whilst more doubt may exist as to whether the Fancy Word Mark is also an artistic work, I am prepared to accept that there is sufficient visual stylization in the Fancy Word Mark such that it can properly be treated as an artistic work.

239 What remains is the question of originality. Put broadly, did the author(s) originate the Artistic Works, or were they slavish copies of existing works? There is neither evidence on the process by which the Artistic Works were created, nor is there any evidence which suggests that the works were slavish copies. This being the state of the evidence, and bearing in mind that the Applicant has not raised any argument or evidence which suggests that the artistic works lacked originality, I find that, on a balance of probabilities the Opponent would likely be able to demonstrate that the Red Bird Mark and the Fancy Word Mark are original works in copyright infringement proceedings. Hence, I find that the Opponent is, on a balance of probabilities, likely to be able to satisfy the requirement in s 130(1B) of the CA in potential copyright infringement proceedings. Of course, my decision here is not to be taken as a conclusive decision on the subsistence and ownership of copyright in the works should an actual copyright infringement action be litigated between the parties.

### **Copying**

240 Given my conclusion that the subsistence and ownership of copyright in the Artistic Works are likely to be sufficiently proven by the Opponent in potential copyright infringement proceedings, it leaves me to consider whether “copying” has taken place and if so, whether the Angry Bite Mark does reproduce a substantial part of the claimed works.

241 At the outset, I affirm the PAR’s finding (at [245] of the PAR’s GD) that the fact that the designer of the Angry Bite Mark may have been inspired by the Opponent’s *Angry Birds* brand does not mean that copying has taken place.

242 The evidence of the Applicant as set out in the Statutory Declaration of Huang Len Len at [6] was that its in-house designer designed the Angry Bite Mark after he was inspired when he saw his

nephew playing the *Angry Bird* game. The design was modified so as to make the face “human and matched it with lips and a row of white teeth biting into a snack”. [\[note: 25\]](#)

243 Copyright protects original *expression* from copying. What has to be copied is the original expression, not the underlying idea or concept behind the work. Whilst the expression/idea dichotomy can be tricky to apply, there is no doubt that this dichotomy is well known and deeply entrenched in copyright law.

244 The first question that arises is what, if anything, did the Applicant’s designer copy from the copyright works? Thereafter, it is necessary to compare the part copied with the copyright works in order to decide whether the part copied was substantial. Substantiality depends more on the quality of the part taken rather than the quantity with reference to the copyright works.

245 In the present case, the Applicant accepts that the designer was aware of the *Angry Birds* game and that the game was the inspiration for Angry Bite Mark. Whilst it is clear that the concept or idea of an angry figure was borrowed, the detailing of the Angry Bite Mark is quite different from the Red Bird Mark. The Angry Bite Mark shows a face head on. The face is not “bird-like”, and does not resemble the depiction in the Red Bird Mark. Indeed, whilst angry eyes are depicted in the Angry Bite Mark, there is really no clearly defined face at all. Further, there is no beak. Instead, what is depicted in the Angry Bite Mark are distorted lips, teeth and what appears to be a cone-like snack in the process of being crushed between the teeth. There are no clear feathers in the Angry Bite Mark, although the Opponent does assert that there is a very small representation of feathers emerging from the letter “B” in “BITE”.

246 On the basis of the evidence before me, it appears that what was taken (by way of inspiration) was the concept of an angry character. In the Red Bird Mark, the impression of anger (an angry bird) flows from the fierce eyes, eyebrows and the sharp, fierce looking beak. In the Angry Bite Mark, whilst angry eyes and accented eyebrows are used, very little else appears to have been taken. Indeed, the eyes and eyebrows whilst showing anger are not the same as the angry eyes or eye brows in the Red Bird Mark. The message of “anger” in the Angry Bite Mark is predominantly to be found in the eyes and the words “Angry Bite” that appears between the eyes and the mouth of the creature.

247 I emphasise that the expression and idea dichotomy applies to all copyright subject-matter, including simple artistic works. In *King Features Syndicate, Inc v O and M Kleeman, Ltd* [1941] AC 417, a dispute arose over whether the defendant had infringed the copyright in cartoon drawings of “Popeye the Sailor Man.” Whilst liability was found, it is noted that one of the issues raised was whether the defendant had merely borrowed the idea of a “muscular sailor-man”, or whether the particular expression of the idea had been copied. Even though the claim succeeded, the remarks of Lord Porter at 448 bear repeating:

... [T]he idea created by a picture or drawing does not necessarily form an element in the original work or its design which is protected by copyright. The same idea which is suggested by the copyright work may be expressed by another painting or drawing which is in no sense a copy and does not borrow its design. No doubt, if the learned judge had asked himself whether the essential idea of “Popeye” had been utilized in the dolls and brooches, instead of asking whether one or more of the material sketches had been copied, he would have applied the wrong test.

248 The House of Lords found infringement because the defendant did more than just take or use the same idea: the defendant’s brooches sufficiently resembled the figures relied on, the salient features being practically identical in each.

249 It does not follow of course that a finding of taking of a substantial part requires proof that the defendant's work is "practically identical" in the salient features. Substantiality is always a question of fact and degree. That said, where the author's expression over and above the underlying idea is simple, this can affect the assessment of substantiality as is demonstrated and discussed by cases such as *Kenrick & Co v Lawrence & Co* (1890) 25 QBD 99 and *Politechnika Ipari Szovetkezet v Dallas Print Transfers Ltd* [1982] FSR 529.

250 This brings me to the decision in *Spectravest Inc v Aperknit Ltd* [1988] FSR 161 (*"Spectravest"*). Whilst this case was not cited in argument, a brief reference to it is helpful. The case concerned copyright in drawings (design) of cats sitting in various positions, all wearing boots. The design was referred to as "Puss-N-Boots." The defendants produced drawings (design) of dogs in a variety of positions also in boots. Millett J stated that it was permissible to use another person's work as inspiration to make a new work so long as the essential features and substance is not taken with minor or inconsequential variations. In deciding infringement, the attention should be on the parts reproduced, and not the part which were not. On this basis, infringement was found even though there were differences such as the fact that all the cats were shown full-face whereas many of the dogs were in profile. What was important was the depiction of the boots: the basic shape, outline, angles, perspectives, arrangement of the tongues and laces were identical. The colours were also nearly identical. The drawings of the boots were found to be a substantial part of the copyright works (on both a quantitative and qualitative basis). Accordingly, liability was established with Millett J holding at p 172 that the defendant had done more than just copy the theme of animals in footwear. The essential features had been taken.

251 In the present case, the PAR's conclusion was that there was *no* copying because there was no "substantial similarity" between the Red Bird Mark (drawing) and the Angry Bite Mark (drawing). Whilst I agree that a case for copyright infringement has not been made out, this is because the Opponent has not been able to make out a case that the Applicant had copied a substantial part of the Red Bird Mark. Whilst the Applicant's designer was inspired and did use the theme of anger or angry characters, this is not something that is prohibited by the copyright in the Red Bird Mark (drawing). The Red Bird Mark (drawing) is a simple cartoon drawing. The colour theme was red. Unlike *Spectravest*, where many aspects of a key feature (boots) were taken (as well as colour), I am unable to conclude that the Applicant's designer has taken sufficient details of any key features of the Red Bird Mark such as to amount to substantial copying. Whilst the Red Bird Mark and the Angry Bite Mark depict characters with angry eyes and accented eyebrows, the details and colours are different. The beak element also has not been taken.

252 I turn now to consider the Fancy Word Mark, which appears to have been the subject matter of a copyright registration in China. What is depicted here are the words "ANGRY BIRDS" in a heavily stylised form, different from the plain font used in the Angry Birds Word Mark. I am of the view that any claim for copyright infringement on the basis of the Fancy Word Mark will fail. The visual appearance and stylization used by the Applicant in the Angry Bite Mark is quite different. The words "ANGRY BITE" (as opposed to "ANGRY BIRDS") are depicted in outline block letters. The stylization and detailing used in each work also differs significantly. I therefore find that the Fancy Word Mark has not been substantially copied by the Applicant in its Angry Bite Mark.

253 For the above reasons, the objection on the ground of s 8(7)(b) of the TMA fails.

## **Conclusion**

254 In conclusion, I affirm the PAR's conclusions on s 8(2)(b), s 8(4)(b)(i) read with s 8(4)(a), s 8(7)(a) and s 8(7)(b) of the TMA, and dismiss the appeal in full.

255 Costs are awarded to the Applicant (*ie* the respondent in the appeal), to be agreed or taxed.

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[\[note: 1\]](#) Plaintiff's submissions at [1]

[\[note: 2\]](#) ABOD vol 1, p118–119

[\[note: 3\]](#) Plaintiff's submissions at [132]

[\[note: 4\]](#) Plaintiff's submissions at [140]

[\[note: 5\]](#) Harri Koponen's statutory declaration dated 25.04.2013, [10]-[15]

[\[note: 6\]](#) Plaintiff's submissions at [7]

[\[note: 7\]](#) Defendant's submissions at [18]-[43]

[\[note: 8\]](#) Plaintiff's submissions at [22]

[\[note: 9\]](#) Plaintiff's submissions at [16]-[18]

[\[note: 10\]](#) Defendant's submissions at [10]

[\[note: 11\]](#) Vol 2 of Plaintiff's BOD, p598 (to be deleted, just for ref.)

[\[note: 12\]](#) Defendant's submissions at [47]

[\[note: 13\]](#) Defendant's submissions at [48]

[\[note: 14\]](#) Plaintiff's submissions at [104]; Defendant's submissions at [46]

[\[note: 15\]](#) [http://www.fta.gov.sg/ussfta/chapter\\_16\\_us.pdf](http://www.fta.gov.sg/ussfta/chapter_16_us.pdf)

[\[note: 16\]](#) Plaintiff's submissions at [106]-[108]; Defendant's submissions at [49]

[\[note: 17\]](#) Defendant's submissions at [58]

[\[note: 18\]](#) Defendant's submissions at [56]

[\[note: 19\]](#) Plaintiff's submissions at [132]

[\[note: 20\]](#) See Opponent's written submissions at [134] and PAR decision at [218] and [221]

[\[note: 21\]](#) ABOD vol 1, pp120–121

[\[note: 22\]](#) ABOD vol 1, p 179

[\[note: 23\]](#) ABOD vol. 1 at p158

[\[note: 24\]](#) Plaintiff's submissions at [132]

[\[note: 25\]](#) ABOD, vol 2 at p544

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