

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

Trade Mark No. 40201821074P-02
4 August 2021

IN THE MATTER OF A TRADE MARK APPLICATION BY

HUMAN HORIZONS HOLDING (SHANGHAI) CO., LTD.

AND

OPPOSITION THERETO BY

LOUIS VUITTON MALLETIER

Hearing Officer: Adrian Tan Gim Hai
IP Adjudicator

Representation:

Mr Jon Chan Wenqiang (Ravindran Associates LLP) for the Opponent

The Applicant is represented by Ms Gillian Tan (Viering, Jentschura & Partner LLP) in these proceedings but elected to only rely on written submissions and did not attend the hearing

GROUND OF DECISION

1 If a trade mark does not appear on a product, can it be said to be used in relation to the product? How would a consumer associate a trade mark with a party's product, if the consumer cannot see the trade mark on it? This case considers such a situation, where issues of well known-ness and distinctiveness under passing off are assessed.

2 Human Horizons Holdings Co., Ltd., which transferred its trade mark ownership to Human Horizons Holding (Shanghai) Co., Ltd. on 24 June 2021 ("the Applicant"),

applied to register the trade mark **HUMAN HORIZONS** (“the Application Mark”) in Singapore on 15 October 2018 under Trade Mark No. 40201821074P-02 in Classes 18 and 25. The specifications of goods relevant to this opposition are set out below:

Class 18

Leather laces; Walking sticks; Backpacks; Travelling trunks; Key cases; wallets incorporating card holders; Umbrellas; Luggage tags; Tool bags, empty; Leather, unworked or semi-worked.

Class 25

Clothing; Headgear for wear; Gloves [clothing]; Sashes for wear; Scarfs; Girdles; Footwear; Hosiery; Neckties; Masquerade costumes.

3 The application was accepted and published on 22 February 2019 for opposition. Louis Vuitton Malletier (“the Opponent”), filed its Notice of Opposition to oppose the registration of the Application Mark on 24 June 2019. The Applicant filed its Counter-Statement on 22 August 2019.

4 The Opponent filed its evidence in support of the opposition on 20 August 2020. The Applicant filed its re-executed evidence in support of the application on 28 January 2021. The Opponent filed its evidence in reply on 27 March 2021. Following the close of evidence, a Pre-Hearing Review was held on 22 April 2021. The opposition was heard on 4 August 2021. The Applicant did not appear for the hearing, but both parties tendered written submissions.

Grounds of Opposition

5 The Opponent relies on Sections 8(2)(b), 8(4) and 8(7)(a) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”) in this opposition.

Opponent’s Evidence

6 The Opponent’s evidence comprises the following:

- (i) a Statutory Declaration made by Laura Charnay (“Charnay SD”), Intellectual Property In-House Lawyer of the Opponent, on 18 August 2020 in France; and
- (ii) a Statutory Declaration in Reply made by Sophie Regisser (“Regisser SD”), Head of Trade Marks and Designs Portfolio of the Opponent, on 24 March 2021 in France.

Applicant’s Evidence

7 The Applicant’s evidence comprises a re-executed Statutory Declaration made by Qu Shengnan (“Qu SD”), IP Counsel of the Applicant, on 15 January 2021 in Shanghai, China.

Applicable Law and Burden of Proof

8 As the applicable law is the Act, there is no overall onus on the Applicant either before the Registrar during examination or in opposition proceedings. The undisputed burden of proof in the present case falls on the Opponent.

Background

9 The Applicant has its headquarters in China. It is involved in the field of new energy vehicles and smart transportation. According to the Applicant, it has numerous partnerships with governmental and business entities around the world, including with Microsoft, Bosch and Dow Chemical, to develop products for use in vehicles. The Applicant has adduced media reports of the Applicant’s activities, to support the Applicant’s contention that it is “well-known and well-regarded around the world”.

10 The Applicant seeks to register the Application Mark as part of its effort “to protect its company name”.

11 The Opponent is incorporated in France. It states that it is a leading global brand of luxury goods, with product lines including luggage, handbags, leather goods, ready-to-wear fashion, footwear, jewellery, writing instruments and sunglasses.

12 The Opponent states that, in 2016, it launched its “HORIZON” brand in respect of luggage, and “swiftly achieved impressive sales worldwide and in Singapore”.

13 The Opponent relies on the following earlier registered mark (“Opponent’s Mark”) in this opposition.

TM No.	Registration Date	Class
40201616906T	10 October 2016	18
Mark		
HORIZON		
Specification		
Luggage; straps for luggage; straps for handbags; vanity cases, not fitted; leather cases; key cases of leather and skins; trunks and suitcases; small clutches [handbags]; pouches of leather; credit card holders [wallets]; business card holders; wallets; saddle bags adapted for use with briefcases; bags; rucksacks; handbags; wheeled bags; travelling bags; bags for sport; garment bags for travel; briefcases; travelling sets [leatherware].		

MAIN DECISION

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

14 Section 8(2)(b) of the Act reads:

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

...

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

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

Decision on Section 8(2)(b)

Similarity of Marks

15 The marks under comparison are reproduced below only for ease of reference. I am mindful that visual comparison is done through the lens of imperfect recollection of the average consumer, and that the analysis itself should not be conducted with the marks side by side.

Application Mark	Opponent's Mark
HUMAN HORIZONS	HORIZON

16 The Opponent contends that the marks in question are similar.

17 To begin with, the Opponent argues that the Opponent's Mark enjoys a high degree of technical distinctiveness, both inherent and acquired, such that it "enjoys a high threshold before a competing sign would be considered dissimilar to it", citing *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another and another appeal* [2014] 1 SLR 911 ("*Staywell*") at [23].

18 The Opponent accepts that "HORIZON" is an ordinary English word as opposed to an invented word. Nevertheless, the Opponent contends that the word "has no meaning and/or descriptive nexus in relation to the Opponent's claimed goods in Class 18. In support of its contention, it relies on the findings made in two related cases:

- (i) *Louis Vuitton Malletier v Human Horizons Holdings Co., Ltd* (2020) (B 3 073 758) ("**EUIPO Decision**") at 6, where the Opposition Division of the European Union Intellectual Property Office ("**EUIPO**") found that "In the present case, the [Opponent's Mark] as a whole has no meaning for any of the goods in question from the perspective of the public in the relevant territory. Therefore, the distinctiveness of the [Opponent's Mark] must be seen as normal."

- (ii) *Louis Vuitton Malletier v Human Horizons Holdings Co., Ltd* (2019) (O-700-19) (“**UKIPO Decision**”) at [39], where the UK Intellectual Property Office (“**UKIPO**”) found that “The [Opponent’s Mark] consists of an ordinary dictionary word which does not describe the goods for which it is registered. I find it has a medium degree of inherent distinctive character.”

19 The Applicant did not appear for the hearing. It tendered skeletal submissions where it submits that “when used in relation to goods in class 18 such as luggage, travelling bags, travelling sets, garment bags for travel, the word ‘horizon’ evokes the exhilarating emotion as one ‘sails into the horizon’.” The Applicant argues that the Opponent’s Mark has a low level of technical distinctiveness and therefore does not enjoy any greater protection in the sense that any differences in the Application Mark, however slight, would be sufficient to render the marks dissimilar.

20 I have some doubt as to whether the word “horizon”, in relation to luggage and travel products, is as distinctive as the Opponent contends. When one travels, one can be understood to be heading into the distance, towards a horizon. There are common sayings in the English language which associate the concept of “travel” with “horizon”, such as “travel broadens your horizons”. It is therefore not difficult to see how travel would be associated with the word “horizon”. One might consider “horizon” to belong to the family of words that are typically associated with travel, such as “passport”. I am prepared to consider that “horizon” would have a low (rather than medium or normal) degree of inherent distinctive character.

21 The Opponent submits that the Opponent’s Mark has come to acquire a high degree of distinctiveness by reason of the extensive marketing and promotion of the Opponent’s “HORIZON” brand of products in Singapore and worldwide.

22 The Opponent submits that evidence of acquired distinctiveness may be considered at the marks-similarity stage.

23 In so doing, the Opponent accepts that there are differences of view as regards this approach. In *GCIH Trademarks Limited v Hardwood Private Limited* [2021] SGIPOS 6 (“*GCIH*”), Principal Assistant Registrar of Trade Marks Ong Sheng Li, Gabriel observed that there were two opposing approaches on this issue:

- (i) the decisions in *Monster Energy Company v NBA Properties, Inc.* [2018] SGIPOS 16 and *Swatch AG v Apple Inc.* [2019] SGIPOS 1 favoured considering acquired distinctiveness at the marks-similarity stage (PAR Ong referred to this as the “contextual approach”);
- (ii) whereas the decisions in *Damiani International BV v Dhamani Jewels DMCC* [2020] SGIPOS 11 and *Valentino S.p.A. v Matsuda & Co* [2020] SGIPOS 8 (which PAR Ong referred to as the “mechanical approach”) declined to do so.

24 PAR Ong preferred the mechanical approach over the contextual approach. He explained that the mechanical approach is “unquestionably right” in saying that what is required is a common sense overall comparison of mark-for-mark. He also agreed with the need, at the marks-similarity stage, to guard against “much irrelevant evidence”. He

also considered that evidence of enhanced distinctiveness acquired through use should be reserved for the likelihood of confusion. He expressed one reservation, saying “I am not sure how the mechanical approach would operate in cases where the evidence sought to be considered is contextual evidence that is independent of the trader’s public activities”.

25 In conclusion, PAR Ong declined to consider the issue of acquired distinctiveness at the marks-similarity stage. That conclusion was arrived at after meticulous examination of the authorities and the reasons expressed therein. In particular, strong reliance was placed on *Staywell* [14]-[19], with its emphasis on a comparison of “mark for mark without consideration of any external added matter”.

26 In contrast, in *Combe International Ltd. v Dr. August Wolff GmbH & Co. Kg Arzneimittel* [2021] SGIPOS 10, the IP Adjudicator deciding the matter took a different view from that expressed in *GCIH*.

27 In the present case, the Opponent submits that the approach in *GCIH* ought not to be followed. The Opponent submits that the issue of acquired distinctiveness may be considered at the marks-similarity stage, relying on the following:

- (i) *Monster Energy Company v Glamco, Ltd* [2021] 3 SLR 319 (“*Monster*”) at [50]-[52], where Chan Seng Onn J considered evidence of acquired distinctiveness at the marks-similarity stage;
- (ii) *Polo/Lauren Co LP v United States Polo Association* [2016] 2 SLR 667 (“*Polo*”) at [28]-[32] where Lee Seiu Kin J said that he was prepared to consider acquired distinctiveness at the marks-similarity stage; and
- (iii) *Han’s (F&B) Pte Ltd v Gusttimo World Pte Ltd* [2015] 2 SLR 825 (“*Han’s*”) at [110] where George Wei JC (as he then was) indicated that it made sense to consider acquired distinctiveness at the marks-similarity stage “as similarity is examined from the perspective of the average consumer”.

28 The Applicant does not address this issue in its skeletal submissions. It simply disputes the fact that there has been acquired distinctiveness of the Opponent’s Mark. In so doing, the Applicant appears to accept, implicitly, that it is appropriate to consider acquired distinctiveness at the marks-similarity stage.

29 In my view, the decisions in *Monster* and *Polo* are less helpful, as the court may not have had the benefit of arguments on this issue.

30 The decision in *Han’s* was made on the basis of *Polo/Lauren Co, LP, The v Shop In Department Store Pte Ltd* [2006] 2 SLR(R) 690, which is a Court of Appeal decision that has been superseded by *Staywell*. Therefore, *Han’s*, too, may be of limited assistance.

31 In my view, it is inappropriate to consider acquired distinctiveness at the marks-similarity stage. Such a consideration is inconsistent with the reasoning of the Court of Appeal in *Staywell* at [20], as well as with the rest of the decision. The Court of Appeal

in *Staywell* focused on an examination of the marks in question, and did not leave room to consider any other material. It was a straightforward comparison of the two marks in question. The Court of Appeal’s finding of similarity, without discussion of any external matter, constituted the entire *ratio* of its decision to dismiss CA 147/2013 (which was the applicant’s appeal against the High Court’s finding of similarity). In light of the approach in *Staywell*, there is no basis for arguments to be considered on acquired distinctiveness at the marks-similarity stage.

32 For completeness, I add that I share the reservations expressed in *GCIH* concerning the “contextual approach”, where consideration is given of matters which do not pertain to the marks themselves, but to the knowledge or perceptions of consumers. Such matters are difficult to determine, as a matter of evidence, and ought to be evaluated at other stages, if appropriate, such as the likelihood of confusion stage.

33 We now turn to the question: is the Application Mark similar to the Opponent’s Mark?

34 The Applicant argues that there is no visual similarity because:

- (i) the Opponent’s Mark comprises one word, the Application Mark has two; and
- (ii) the Application Mark contains the word “human” at its beginning.

35 The Opponent argues that the marks are visually similar because:

- (i) the “horizons” component of the Application Mark has a stronger capacity to function as a badge of origin, whereas “human” may very well be perceived as a descriptive nexus to the claimed goods; and
- (ii) “human” is more common than “horizons”, and so the consumer would be more likely to accord significance to the “horizons” component.

36 The Opponent relies also on the fact that the UKIPO Decision and the EUIPO Decision both found visual similarity.

37 In my view, there is a low degree of visual similarity between the two marks:

- (i) The Application Mark contains the entirety of the Opponent’s Mark. The fact that the Application Mark uses the plural, and the Opponent’s Mark uses the singular, form of “horizons” would not be highly significant to the reader.
- (ii) I accept that the “human” component of the Application Mark is as prominent as the “horizons” component. I take into account the fact that the word “human” appears first, and therefore has prominence. I also acknowledge that the word “horizons” is somewhat longer, and would also attract attention. I do not think that either component dominates the other.

38 We turn next to aural similarity.

39 The Opponent relies on the Court of Appeal’s approach in *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 (“*Ceramiche*”) in evaluating aural similarity by assessing the dominant component of the marks (“Dominant Component Approach”), as well as by assessing whether the competing marks have more syllables in common than not (“Quantitative Approach”). On either approach, the Opponent submits that aural similarity had been established.

40 The Applicant argues that the Quantitative Approach shows that the marks are dissimilar, in that the Application Mark has five syllables, whereas the Opponent’s Mark has only three.

41 The Applicant does not employ the Dominant Component Approach.

42 In my view, the Dominant Component Approach favours the Opponent. In the Opponent’s Mark, the word “horizon” is dominant. In the Application Mark, it might be argued that the word “human” is dominant, given that it is the first word. But I think it slightly more probable that “horizons” is dominant, given that it is the longer word, and would take a longer time to pronounce, and therefore would form the greater aural impression.

43 One thing is certain, in that whichever view one takes, the word “horizons” in the Application Mark is not aurally insignificant. In natural speech, it would be reasonable to assume that a speaker, in saying “human horizons”, would not neglect to pronounce “horizons”. In this context, when dealing with words in the English language, “human” acts as an adjective, and “horizons” is the noun, and it would be natural in most situations to give reasonable, if not greater, emphasis on the noun. It would be hard to imagine any situation where a speaker stresses “human” over “horizons”, speaking in such a way would sound contrived, unnatural and atypical.

44 As for the Quantitative Approach, I find that all the syllables in the Opponent’s Mark are found in the Application Mark. The majority of the syllables in the Application Mark (three out of five, or sixty percent) are found in the Opponent’s Mark.

45 Using the above approaches seems to be a mechanistic process. But ultimately, these approaches serve as tools to assist us in assessing whether one mark sounds like the other. Given that a good part of the Application Mark consists of the entire Opponent’s Mark, it is hard to disagree that the two marks sound alike. There are sufficient grounds to find aural similarity.

46 Before I leave this point, I would add that, in employing either of the two approaches, I am mindful that the singular word “horizon” (in the Opponent’s Mark) is aurally similar to the plural word “horizons” (in the Application Mark) to a very high degree. In everyday speech, I would not be surprised if a listener would mistake “horizon” for “horizons” or vice versa. In the circumstances, I think it is fair to treat the words “horizon” and “horizons” as aurally almost identical.

47 Finally, we consider conceptual similarity.

48 The word “horizon” can bear different meanings. The Opponent suggests that it means “the limit range of a person’s knowledge, perception or experience”. The Applicant makes the more obvious point that the word “horizon” refers to the faraway line where the sky seems to touch land or sea.

49 The Applicant’s meaning is the typical first meaning that is found in dictionaries. It refers to the apparent junction of the earth and the sky. It would, in my opinion, be the most common meaning applied to the word. The Opponent’s meaning is less common, and appears as the second meaning of “horizon” that is found in dictionaries. This is borne out by the Opponent’s own exhibit LC-8, which show extracts from three dictionaries concerning the definition of the word “horizon”. In each case, the first meaning of horizon is that of the line where the sky seems to touch the land or sea, whereas the second meaning is concerned with the limits of a person’s knowledge or experience.

50 Having said that, I would accept that the Opponent’s meaning is nonetheless frequently used, and that the word “horizons” can be understood by many to refer to “limits”.

51 In addition, I do find that, when used in this second sense, it is more common to use the word in plural, rather than singular. For example, it is unusual to say that one should “broaden one’s horizon”. The typical expression would be to “broaden one’s horizons”.

52 Conversely, when used in the first sense, it is rare for the word “horizon” to be in the plural form. When used in this sense, examples of usages in the singular form are common. One might say, “look at the evening sun descending below the horizon”, or “can you see a ship on the horizon?” Examples of usages in the plural form are hard to come by.

53 Therefore, when the word is “horizons” (plural), it may be argued that the word tends to suggest the Opponent’s meaning. When the word is “horizon” (singular), it might tend to suggest the Applicant’s meaning.

54 In the circumstances, conceptually, the Opponent’s Mark (being the singular “horizon”) would tend to evoke the meaning of the imaginary junction between earth and sky, rather than the meaning concerned with the limits of a person’s knowledge or experience.

55 The Applicant makes the point that the word “human” in the Application Mark serves as a qualifier. By adding the word “human”, it reinforces the point that the “horizons” in the Application Mark is a reference to the limits of a human being’s knowledge or experience.

56 In a nutshell, because the Application mark uses “horizons” in plural, and has the adjective “human” to qualify it, it tends to suggest the concept of the limits of a human being’s knowledge or experience. On the other hand, the Opponent’s Mark uses “horizon” in the singular form. This tends to suggest the imaginary junction between earth and sky.

57 This leads me to conclude that the conceptual similarity between the two marks is less than compelling.

58 We therefore have a situation where there is some visual and aural similarity between the two marks, whereas the conceptual similarity is somewhat arguable. This issue presents difficulties, and I can see how another objective person might take a different view from me. But, on balance, I would hold that the marks are similar. Visually and aurally, they share a major, striking component that is memorable. Conceptually, the marks may stray towards slightly different concepts, but not to any great extent. When considered with the attention of a typical consumer, who may have imperfect recollection, and who may not be unduly fastidious, I would conclude that there is sufficient overall similarity to warrant some concern.

Similarity of Goods

59 The Opponent submits that there is clear identity and/or close similarity in the respective goods claimed by the Application Mark and the Opponent's Mark. The Applicant does not deny this.

60 In respect of Class 18, it is apparent that the Applicant's Class 18 goods are similar to those claimed by the Opponent in its Class 18 registration, being luggage, travelling trunks, wallets and the like.

61 The Applicant claims goods in Class 25, while the Opponent has no Class 25 registration. The Opponent argues that the Class 25 goods claimed by the Application Mark, being clothing and footwear, are nonetheless similar to the "Luggage;... trunks and suitcases;... bags; rucksacks; handbags" as claimed in the Opponent's Class 18 registration. The Opponent relies on *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 553 ("*Festina*") for the proposition that, in the modern context, it is reasonable to regard goods in Classes 18 and 25 as complementary, and are likely to be of similar uses, targeting almost identical end users and employing similar if not identical trade channels by which goods reach the market. I accept that point, and I do find the requisite level of similarity exists between the Class 25 goods claimed by the Application Mark, and the Class 18 goods claimed by the Opponent's Mark.

Likelihood of Confusion

62 The Opponent relies on the Court of Appeal's summary of applicable principles in *Ceramiche* [56] – [57] as regards the confusion inquiry, and I agree with such reliance.

63 The Opponent contends that there is a tangible risk that the average consumer with imperfect recollection of the marks will be confused into thinking that goods sold or marketed under the Application Mark originate from the Opponent or from sources economically linked to or associated with the Opponent.

64 The Opponent relies on *Fox Racing, Inc. v Fox Street Wear Pte Ltd* [2014] SGIPOS 13 for the proposition that Class 18 and Class 25 goods "could notionally be sold at a low price" and that "consumers will take some care but not an undue degree

of care when purchasing the goods in question”, citing the words used by the Principal Assistant Registrar adjudicating the decision.

65 I accept the general proposition that, if goods are sold at relatively low prices, consumers would exhibit a low degree of attention during the purchasing process, whereas if the goods are sold at relatively high prices, then the degree of attention would be raised in commensurate fashion.

66 I also accept that not all goods and services are susceptible to an easy and natural pricing classification of low, medium or high. Having said that, I do think that for Class 18 goods, it will not be problematic to distinguish between high-priced goods, on the one hand, and low- or medium- priced goods, on the other.

67 In the present case, it may occur to one at first blush that the Opponent’s goods are luxury goods, ones that are not exactly sold at “a low price”. However, I am reminded that “in opposition proceedings the inquiry must take into account the full range of the competing monopoly rights that are already enjoyed on the one hand, namely the actual and notional fair uses to which the incumbent proprietor has or might fairly put his registered trade mark, and compare this against the full range of such rights sought by the applicant”: *Staywell* at [60]. In other words, the relevant price is not determined by how the Opponent has in fact priced its goods, but what the general price is, of goods of the sort claimed in the Opponent’s and Applicant’s specifications.

68 Employing this approach, we shall then need to consider the actual and notional fair uses to which the Opponent has or might fairly put the Opponent’s Mark, and compare that against the full range of such rights sought by the Applicant.

69 The Opponent currently uses the Opponent’s Mark on luxury luggage products: its actual usage is therefore on high-priced products. A person who is buying luxury or high-priced luggage products would pay a higher degree of attention during the purchasing process, as compared to when that person is buying a non-luxury luggage product. In addition, persons who are interested in buying luxury products would, it is fair to say, pay attention to the qualities of the product, as well as the origin of the product. Such behaviour, therefore, may militate against a person mistaking one mark for another.

70 However, that is not the end of the story. The notional fair use of both marks includes use on bags and wallets (among others in the specifications) in general i.e. in the larger non-luxury market. Where the prices of bags and wallets are lower in the mass market, consumers would exercise a lower degree of fastidiousness in their selection and purchase, and the likelihood of confusion would increase. In the present case, I conclude that the notional fair use of the Opponent’s Mark on medium-priced products would result in the consumer paying less attention to quality and origin. But even so, I am not entirely convinced that there is a likelihood of confusion whereby the consumer might mistake the Application Mark with the Opponent’s Mark, or vice versa.

71 I turn now to a slightly different analytical approach. In *Rolex S.A. v FMTM Distribution Ltd* [2020] SGIPOS 6, the parties to the opposition both sold luxury watches. However, the IP Adjudicator in that case was “very mindful that in much the

same way that the Court of Appeal in *Staywell* considered that the notional fair use of a luxury hotel operator's mark encompassed potential future use of that mark in relation to business hotels, it cannot be discounted that the Opponent and the Applicant may one day decide to apply their marks to non-luxury watches", at [83]. The IP Adjudicator went on to conclude that "The same considerations mean that the watches to be properly considered – watches in general – are not necessarily as expensive as the luxury watches in respect of which the Applicant made its submissions. Similarly, while I would agree that consumers tend to be somewhat attentive and fastidious while purchasing watches, I do not think that they would be quite so invested as to preclude a likelihood of confusion", at [84].

72 The *Rolex S.A.* approach is consistent with the principles outlined in *Staywell* and may be a helpful countercheck in some situations. Employing such an approach, we would then simply consider luggage, travelling trunks, wallets and the like in general. The question to be asked is simply this: if the Opponent's Mark and the Application Mark were applied on such products in general, would there be likelihood of confusion on the part of the consumer? Even under this approach, I find myself unable to answer the question in the affirmative.

73 In short, I am not entirely persuaded that consumers would mistake one mark for the other, whether under a *Rolex S.A.* type of analysis, or under an analysis which considers the actual and notional uses of the mark (as set out by the Court of Appeal in *Staywell*).

74 The Opponent's stronger argument is this: the relevant segment of the public may well perceive that the contesting marks are different, but may yet remain confused as to the origin which each mark signifies, and may perceive that goods bearing the two marks emanate from the same source or from sources that are economically linked or associated. This type of confusion was recognised by the Court of Appeal in *Ceramiche* [57]. The Court of Appeal also said, in the same case at [77], that "the reference to a 'likelihood of confusion' in s 8(2) of the TMA refers really to a likelihood that the public will be *unable to differentiate* between the trade origins of the goods or services bearing the competing marks."

75 The Opponent says that there will be a "strong possibility" that the average consumer will mistakenly perceive the Applicant's "HUMAN HORIZONS" goods to be a product line under the Opponent's "HORIZON" brand. The Opponent relies on the *EUIPO Decision* which states (at [49]) that it is "conceivable that the targeted public may regard the goods designated by the conflicting signs as belong to two, admittedly distinct, ranges of products, originating, none the less, from the same manufacturer".

76 The Opponent argues that it is common for traders of goods from Classes 18 and 25 to create and use "sub-brands" whereby goods are sold under trade marks that are variations of the main brand. The Opponent cites examples from other traders such as Samsonite, Chrome, Osprey and Adidas, who also market Class 18 and Class 25 goods by means of sub-brands.

77 I find this to be a reasonable contention. Given that (a) the goods in question are similar, (b) the marks have some degree of aural and visual similarity, and (c) a

consumer may not be unduly fastidious, and may lack the opportunity to carry out a side-by-side comparison of the marks, there is a reasonable likelihood that the consumer may incorrectly perceive that the marks originate from the same business, or from sources that are linked or associated commercially. I also accept that, when considering Class 18 and Class 25 goods, it is not out of the ordinary for sub-brands to be used. The main brand would indicate the manufacturer, whereas the sub-brand would indicate the individual model or item type.

78 The Applicant did not address this argument, except to say briefly that the consumer is unlikely to be confused as to the origin of the goods bearing the respective marks. Without elaboration, the Applicant's argument is unconvincing. In the circumstances, I find it conceivable that the public may mistakenly perceive goods bearing the Application Mark to be goods bearing a sub-brand of the Opponent.

Conclusion under Section 8(2)(b)

79 In the circumstances, I find that the Application Mark should not proceed to registration as it contravenes Section 8(2)(b) of the Act.

Ground of Opposition under Section 8(4)

80 Section 8(4) of the Act reads:

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

- (a) the earlier trade mark is well known in Singapore; and
- (b) 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;
 - (ii) if the earlier trade mark is well known to the public at large in Singapore —
 - (A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or
 - (B) would take unfair advantage of the distinctive character of the earlier trade mark.

Decision on Section 8(4)

Similarity of Marks

81 As stated by the High Court in *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] 5 SLR 618, there is no difference in the test for marks-similarity under Sections 8(2)(b) and 8(4) of the Act. In the circumstances, I will not repeat the analysis carried out above, under the discussion pertaining to Section 8(2)(b) of the Act.

Is the Opponent's Mark well known to the relevant sector of the public in Singapore?

82 Section 2(7) to (9) of the Act states:

(7) Subject to subsection (8), in deciding, for the purposes of this Act, whether a trade mark is well known in Singapore, it shall be relevant to take into account any matter from which it may be inferred that the trade mark is well known, including such of the following matters as may be relevant:

- (a) the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;
- (b) the duration, extent and geographical area of —
 - (i) any use of the trade mark; or
 - (ii) any promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied;
- (c) any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application;
- (d) any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory;
- (e) any value associated with the trade mark.

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

(9) In subsections (7) and (8), “relevant sector of the public in Singapore” includes any of the following:

- (a) all actual consumers and potential consumers in Singapore of the goods or services to which the trade mark is applied;
- (b) all persons in Singapore involved in the distribution of the goods or services to which the trade mark is applied;
- (c) all businesses and companies in Singapore dealing in the goods or services to which the trade mark is applied.

83 The Opponent contends that the Opponent's Mark is well known in Singapore to the relevant sector of persons who are actual and potential consumers of its luggage, bags, clothing and footwear products. In the circumstances, the Opponent relies on Section 2(7)(a), 2(8) and 2(9) to say that the mark is well known to a relevant sector of the public in Singapore, that sector being actual and potential consumers in Singapore of the goods to which the Opponent's Mark is applied.

84 To substantiate the contention, the Opponent alleges extensive use, promotion and recognition of the Opponent's Mark. It refers to publicity material and articles covering the quality, innovation and expert craftsmanship of the Opponent's "HORIZON" products, and claims annual sales of at least SGD 2.2 million in Singapore from 2017 to 2018 in respect of the Opponent's Mark.

85 But there is more than meets the eye. The issue is not so much about sales figures as it is about usage of the Opponent's Mark.

86 At the hearing, I pointed out to the Opponent's counsel that the Opponent's "HORIZON" products do not display the Opponent's Mark. I noted that in the Opponent's online store ("Opponent's Webstore", as shown in Exhibit LC-3 of the Charnay SD, and as identified in the Charnay SD at [16]), the Opponent's Mark was used in relation to the goods (e.g. a product was described as "Horizon Platform Sandal"). But, in the exhibits tendered, the goods seemed to display only the marks "Louis Vuitton" or "LV". The Opponent's Mark was absent from the goods themselves.

87 The Opponent's counsel responded that, based on the evidence tendered, the Opponent's Mark is not applied to the goods themselves.

88 I then asked how consumers could associate "Horizon" with the Opponent's bags, if the word "HORIZON" does not appear on the said bags. The Opponent's counsel referred to articles that described the Opponent's "HORIZON" products by reference to the word "Horizon". For example, in an article by Bagaholicboy, the Opponent's bag is described as "the Horizon".

89 I also asked the Opponent's counsel to explain how consumers would know, like Bagaholicboy appeared to know, that the Opponent's bag is "the Horizon" when the word "Horizon" does not appear on the bag. The Opponent's counsel referred to advertising and articles which referred to the Opponent's new product line marketed under the Horizon trade mark. The Opponent's counsel contended that, although the consumer might not physically see the trade mark applied on the goods, the consumer would know that the "Horizon" is a particular line belonging to the Opponent, and would know to ask for it at the Opponent's store.

90 I asked to see examples of other goods sold under the "Horizon" brand and the Opponent referred to screenshots of the Opponent's Webstore, where a number of products, such as footwear, luggage, and a watch, were sold by reference to the word "Horizon".

91 The Applicant did not address this point in any great detail, saying merely that the Opponent's evidence of use "primarily shows use of the Opponent's other marks, such as 'LOUIS VUITTON' and the 'LV' symbol/monogram, and not the 'HORIZON' mark".

92 It appears to me that a consumer would not know that the Opponent's products are sold under the Opponent's Mark, unless that consumer has read certain articles which say this, or shopped in the Opponent's Webstore. In that regard, it would have been helpful if information had been provided as to the Singapore readership of those articles.

93 I am assisted, however, by the fact that from 2017 to 2019, there were some 170,000 to 567,000 unique page visits to the Opponent’s Webstore every month that are geolocated in Singapore: Charnay SD at [24]. These figures, while impressive, must take into account two factors.

- (i) First, the relevant date is 15 October 2018, being the date of the application, therefore unique page visits occurring after that relevant date ought to be discounted.
- (ii) Second, it is possible that some of the unique page visits are carried out by the same persons, perhaps using different devices to access the website.

94 Even after taking these two factors into account I am nonetheless prepared to accept that there is a very high number of Singapore-based visitors to the Opponent’s Webstore every month. Those visitors may be assumed to be familiar with the Opponent’s products, and would, I think, come across the Opponent’s Mark as used in relation to bags and other products.

95 The present case has some similarity with *Florian Mack v Golden Cala Trading EST* [2020] SGIPOS 5. In that case, the opponent (“Mack”) opposed the application by the applicant (“Golden Cala”) to register the LENS.ME trade mark for contact lenses. An issue arose as to whether Mack was able to establish the requisite goodwill to sustain an action for passing off under Section 8(7)(a) of the Act. This was because while Mack had sold contact lenses through an online store at www.lens.me, those contact lenses did not bear Mack’s trade mark. Golden Cala argued that Mack’s trade mark was merely the name of the online store, rather than the brand associated with particular types of contact lenses.

96 Principal Assistant Registrar Ong Sheng Li, Gabriel analysed the evidence and found the requisite goodwill. He held that while Mack’s trade mark was not used as a specific brand of contact lenses, it had been used in connection with Mack’s online business. There were customers in Singapore who made purchases from Mack’s online store. Some of those customers would have noticed the trade mark used on the online store. On balance, sufficient goodwill had been established.

97 While *Florian Mack* dealt with a situation under Section 8(7)(a), I find its analytical approach persuasive when considering how to deal with a similar fact pattern under Section 8(4). In the present case, the Opponent’s Mark is not used on the goods in question, but it is used in the Opponent’s Webstore itself. The word “Horizon” appears adjacent to or below the goods in question, such that the visitor to the Opponent’s Webstore would associate “Horizon” with the goods.

98 Viewing the Opponent’s Webstore, I form the impression that its visitors would comprise consumers who are interested to purchase bags, scarves, shoes and the like. Even if the visitors would merely be browsing the items in the Opponent’s Webstore, with no immediate plans to make a buying decision, those visitors would nonetheless be exposed to the “Horizon” name. I regard those persons as all actual consumers and potential consumers in Singapore of the goods to which the trade mark is applied, within the meaning of Section 2(7) to (9) of the Act.

99 In the circumstances, I understand the situation to be as follows. There may be an appreciable number of consumers who regard the Opponent’s “Horizon” bags as “LV” or “Louis Vuitton” products, because those are the only marks which the Opponent has applied to the bags. But there would also be an appreciable number of consumers who, having been educated by articles and especially by the Opponent’s Webstore, would understand the Opponent’s “Horizon” bags as being products sold under or by reference to the Opponent’s Mark. The presence of these consumers (to whom the Opponent’s Mark is well known) would be sufficient for me to make a finding that the Opponent’s Mark is well known to a relevant sector of the public, within the meaning of Section 2(7) to (9) of the Act.

100 Given that I have found that the Opponent’s Mark is well known to the relevant public, and given my earlier findings on the similarity between the two marks, I accept that use of the Application Mark would indicate a connection between the goods of the Applicant and the Opponent, thereby raising a likelihood of confusion.

101 The heads of damage that are recognised under Section 8(4)(b)(i) of the Act are essentially the same as those for the element of damage under the tort of passing off: *Monster Energy Company v Mixi Inc* [2017] SGIPOS 12 (“*Mixi*”) at [168].

102 As will be seen below, I have found the element of damage under passing off to be made out in respect of the proposed use of the Application Mark. In the circumstances, I find that there would be a likelihood of damage to the Opponent’s goodwill.

103 In the circumstances, on the basis of Section 8(4)(b)(i) of the Act, the Application Mark should not be registered.

Is the Opponent’s Mark well known to the public at large?

104 The Opponent also relies on Section 8(4)(b)(ii) of the Act to allege that the Application Mark should not be registered as the Opponent’s Mark is well known to the public at large in Singapore, and use of the Application Mark would cause dilution in an unfair manner or take unfair advantage of the distinctive character of the Opponent’s Mark.

105 To that end, the Opponent emphasizes that its status as a leading and world-famous global luxury brand would result in the launch of its new “HORIZON” brand attracting intense media coverage and attention of the public at large. The Opponent points again to its sales figures, and submits that the Opponent’s Mark has “crossed the requisite threshold and will be recognised by most sectors of the Singaporean public, thereby becoming well known to the public at large”.

106 I am not persuaded. The articles and “intense media coverage” that the Opponent refers to appear to be limited to a sector of the market that has interest in luxury bags and shoes. The evidence tendered by the Opponent does not extend to general media coverage, and appears to be confined to specialist media and blogs. Based on the available materials, I am unable to form the impression that the Opponent’s Mark is well known to the public at large in Singapore.

107 I therefore do not accept the Opponent’s contention in relation to Section 8(4)(b)(ii) of the Act.

Conclusion on Section 8(4)

108 Based on the available evidence, I find that the ground of opposition has been made out under Section 8(4)(b)(i), but not under Section 8(4)(b)(ii).

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

109 Section 8(7)(a) of the Act reads:

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

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

Decision on Section 8(7)(a)

Goodwill

110 Both parties rely on the leading Court of Appeal decision in *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 (“*Singsung*”) to provide the law concerning the elements of passing off, namely goodwill, misrepresentation and damage.

111 The Opponent contends that it has goodwill in Singapore, in that it has sold SGD 2.2 million of its “Horizon” products in Singapore from 2017 to 2018. It also relies on the arguments advanced under the earlier grounds.

112 The Applicant does not dispute that the Opponent has goodwill in Singapore, but the Applicant submits that the goodwill in question is related to the Opponent’s “LOUIS VUITTON” or “LV” marks. As the element of goodwill “is concerned with goodwill in the business *as a whole*, and not specifically in its constituent elements, such as the mark” (*Singsung* at [34]), I will deal with this point of contention under “Misrepresentation” below.

113 Suffice it to say that, in light of the sales figures, articles and numerous unique page visits to the Opponent’s Webstore, I find that the Opponent has established the element of goodwill in Singapore.

Misrepresentation

114 The Opponent submits it has satisfied the threshold requirement of distinctiveness, whereby the Opponent’s Mark will be recognised as an indicator of trade origin designating the goods of the Opponent and none other.

115 The Applicant disagrees, because the Opponent's Mark is not the trade mark by reference to which the Opponent's goods are primarily marketed and sold in Singapore. The Applicant contends that the Opponent's goods are primarily marketed and sold under the "Louis Vuitton" or "LV" marks. I do not find this point to be compelling. It appears, on the basis of the evidence adduced, that the Opponent's Mark may be regarded as a sub-brand. In other words, the Opponent's goods are marketed and sold under both the "Louis Vuitton" and "LV" Marks, as well as under the Opponent's Mark. That being so, the Opponent is entitled to claim distinctiveness in the Opponent's Mark, i.e. it has crossed the threshold inquiry, that the Opponent's Mark is distinctive of its goods.

116 The Opponent argues that there is a "strong degree of similarity between the competing marks", and that there is a likelihood of confusion. The Opponent submits that the use of the Application Mark will constitute an actionable misrepresentation against the Opponent.

117 The Applicant argues that the Opponent has not submitted evidence of actual confusion. In my view, it is well-established that evidence of actual confusion, while helpful, may not always be easily available, and that it is sufficient for the Opponent to show a likelihood of confusion.

118 I have found that there is some similarity between the competing marks. I am satisfied that, in practical terms, if bags are sold by reference to the Application Mark, there would be likelihood of confusion in that some consumers might mistake them for bags originating from the Opponent. In that situation, the use of the Application Mark would constitute an actionable misrepresentation.

Damage

119 At the outset, I observe that the Opponent has made detailed submissions that the proposed use of the Application Mark is likely to cause damage. The Applicant has not addressed the Opponent's submission in any meaningful way, except to make the assertion that the Opponent has shown no proof of actual damage or likelihood thereof.

120 It is in this context that I turn to the Opponent's detailed arguments on damage.

121 The Opponent says that the use of the Application Mark would lead to damage in three ways: (a) blurring, (b) a restriction on the Opponent's expansion, and (c) tarnishment.

122 As to blurring, the Opponent contends that there is identity in the Class 18 goods claimed by the competing marks, which places both parties in direct competition for bag and wallet products. Thus, the proposed use of the Application Mark on such goods will lead to a real risk of the diversion of sales to the Applicant due to the close similarity of the competing marks.

123 This argument has force.

124 It has been succinctly observed that blurring takes place when A uses a confusingly similar sign to B and as a result, consumers buy A's goods thinking that

they originate from B. The distinctiveness of B's sign becomes blurred in that it is no longer indicative only of B's goods, and consequently B's goodwill is "spread over" A's goods. This head of damage is essentially about loss of sales because custom meant for B is diverted to A: *Mixi* at [170].

125 In the present case, if both parties sell their goods online, then there is a likelihood that someone who intends to buy a "Horizon" wallet may end up with a "Human Horizons" wallet instead. There is therefore an appreciable risk of blurring and diversion of sales in relation to the Opponent's Class 18 goods.

126 The Opponent alleges that the proposed use of the Application Mark on clothing and footwear will prevent the Opponent from expanding the use of the Opponent's Mark on related or similar goods in Class 25. The Opponent argues that the Class 25 goods claimed by the Application Mark, being clothing and footwear, are also similar to the Class 18 items claimed under the Opponent's Mark, particularly luggage, trunks and suitcases, bags, rucksacks and handbags. In fact, the Opponent is already using the Opponent's Mark on footwear and scarves. In the circumstances, the proposed use of the Application Mark would prevent the Opponent from expanding the use of the Opponent's Mark on related or similar goods in Class 25.

127 I perceive the danger that the proposed use of the Application Mark on, for example, sandals and other forms of footwear, may tend to have the effect of restricting the Opponent's ability to expand into the same area. I think that there is some justification in thinking that traders who sell footwear may branch into bags, and vice versa. I agree that there those may be naturally related fields, and therefore it would be reasonably foreseeable that traders of Class 18 goods would expand into Class 25.

128 I am reinforced in this view by *Festina*, where it was observed that, in the modern context, it is reasonable to regard goods in Classes 18 and 25 as complementary. This supports the notion that there is an innate relationship among the goods of those classes.

129 I conclude that, if the Application Mark is used on Class 25 goods, it would tend to restrict the ability of the Opponent to expand into goods of the same class.

130 Finally, the Opponent argues that usage of the Application Mark on the goods in question would result in tarnishment of the Opponent's goodwill.

131 The Opponent relies on the Court of Appeal's pronouncement in *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) at [98] that "tarnishment occurs when the business, goods or services of the defendant are of a worse quality than those of the plaintiff".

132 In the present case, the Opponent submits that it is well known as a luxury brand, and especially renowned for the high quality and design of its products. On the other hand, the Applicant has no experience or expertise whatsoever in the field of luggage, bags, clothing and footwear. The Opponent submits that "it is highly unlikely that the Applicant's goods in Classes 18 and 25 would even begin to approach the absolute quality, expert craftsmanship, uncompromising attention to detail and status of luxury which consumers have come to associate with the Opponent's 'HORIZON' trade mark and brand."

133 I accept the submission. The Opponent has adduced sufficient evidence to show that its products are known and admired for their quality. There are articles (from e.g. the *Wise Traveller*, *Wallpaper* and *Alphaluxe* online magazines) that laud the craftsmanship and design of its goods. The Opponent's products appear to occupy an enviable position among other competitors. Compared to the Opponent, the Applicant, being a smart vehicle and smart transportation provider, has not shown expertise in providing Class 18 or Class 25 goods. The bulk of the evidence submitted on behalf of the Applicant, comprising the Qu SD, is concerned with the Applicant's electric vehicle achievements. The Applicant says merely that "it is of utmost importance to the Applicant to protect its company name and trade mark 'HUMAN HORIZONS' in Singapore": Qu SD at [18]. There is no information about the Applicant's intention to use the Application Mark on the goods applied for. There is no evidence to support the view that, should the Applicant venture into those areas, its goods would be of the same or higher quality than those of the Opponent. In that eventuality, there is a reasonable likelihood of tarnishment of the Opponent's goodwill.

134 In the face of an Opponent's quality standards, where a party applies to register a mark, without adducing any evidence of usage or proposed usage on the goods or services applied for, and where that party has not displayed any history or expertise with respect to such goods or services, then it is impossible to conclude that the party will be able to produce goods or services of any quality. In such a scenario, it would be difficult for such a party to resist a tarnishment argument brought by an opponent who trades in high quality goods or services.

135 In the present case, the Opponent has satisfied me that it has high quality standards. The Applicant's complete lack of expertise in producing the goods in question mean that, should the Applicant venture into that arena, there is no assurance that the Applicant would produce goods of any reasonable standard, let alone the high standards already shown by the Opponent. Should the Applicant use the Application Mark in that scenario, there is every chance that the Opponent's goodwill would be tarnished.

Conclusion on Section 8(7)(a)

136 The ground of opposition under Section 8(7)(a) therefore succeeds.

Overall Conclusion

137 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition succeeds on all grounds except Section 8(4)(b)(ii). The application to register the Application Mark is refused. The Opponent is also entitled to 90% of costs to be taxed, if not agreed.

Date of Issue: 3 November 2021