

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

[2023] SGIPOS 5

Trade Mark Nos. 40201709794W and 40201709795R

IN THE MATTER OF TRADE MARK APPLICATIONS BY

NORWEGIAN BRAND LTD.

... Applicant

AND OPPOSITION THERETO BY

NCL CORPORATION

... Opponent

FOUNDATIONS OF DECISION

TABLE OF CONTENTS

INTRODUCTION	1
BACKGROUND OF PARTIES	4
PROCEDURAL HISTORY	5
 GROUNDS OF OPPOSITION	5
OPPONENT’S EVIDENCE	5
APPLICANT’S EVIDENCE	6
APPLICABLE LAW AND BURDEN OF PROOF	6
GROUND OF OPPOSITION UNDER SECTION 8(4)(B)(I)	6
APPLICATION OF SECTION 8(4)(B)(I) TO THE FACTS	8
REQUIREMENT OF REAL AND EFFECTIVE COMMERCIAL ESTABLISHMENT	9
<i>Parties’ position and submissions</i>	<i>9</i>
<i>Background to “real and effective ... commercial establishment”</i>	<i>11</i>
<i>Conclusion on “real and effective commercial establishment”</i>	<i>13</i>
WHETHER THE OPPONENT’S MARKS ARE WELL KNOWN	14
<i>The Opponent’s evidence</i>	<i>14</i>
<i>The Opponent’s “non-evidence”</i>	<i>19</i>
<i>Contextual points</i>	<i>20</i>
<i>Relevant sector of the public in Singapore</i>	<i>22</i>
<i>The Opponent’s Marks are not well known</i>	<i>22</i>
CONCLUSION ON OPPOSITION UNDER SECTION 8(4)(B)(I)	24

GROUND OF OPPOSITION UNDER SECTION 8(7)(A)	24
APPLICATION OF SECTION 8(7)(A) TO THE FACTS	24
GOODWILL	25
MISREPRESENTATION.....	25
<i>Preliminary issue</i>	25
<i>Distinctiveness of “NORWEGIAN CRUISE LINE”</i>	29
<i>Similarity of get-up and likelihood of confusion</i>	30
DAMAGE	38
CONCLUSION ON OPPOSITION UNDER SECTION 8(7)(A)	39
UNDERLYING POLICY CONSIDERATIONS	41
OVERALL CONCLUSION	41

NCL Corporation
v
Norwegian Brand Ltd.

[2023] SGIPOS 5

Trade Mark Nos. 40201709794W and 40201709795R
Principal Assistant Registrar See Tho Sok Yee
9 November 2022

9 February 2023


Principal Assistant Registrar See Tho Sok Yee:

Introduction


1 This case involves two parties with established businesses in the global travel industry. One provides air travel services and the other operates cruises. The decision looks at the requirement of a “real and effective commercial establishment” in a Convention country when it comes to well known marks. It also demonstrates how considerations in an opposition based on the ground of passing off under Section 8(7)(a) differ from considerations in a civil action for passing off. In addition, it illustrates how it may be the case that goodwill is sufficiently associated with an opponent’s mark with relatively low inherent distinctiveness, and, at the same time, because of the low inherent distinctiveness of that mark, the opposed mark is more readily assessed to be sufficiently different from the former.

2 Norwegian Brand Ltd. (“the Applicant”) seeks to protect International Registration Nos. 1273311 and 1273316 in Singapore. NCL Corporation (“the Opponent”) opposes the protection of these International Registrations in Singapore. The details of the opposed International Registrations designating

Singapore (collectively, “the Application Marks”) are as follows:

Trade Mark No.	Mark
40201709794W (IR No. 1273311)	
Class	Specification
35	Advertising; business management; business administration; office functions; organization, operation and supervision of sales promotion incentive programs, frequent flyer programs and customer loyalty programs; retail services, in-flight retail services and Internet retail services for tobacco, cosmetics, clothing, watches, wine and liquor, jewelry and sunglasses.
39	Airline services; travel services; air transport services; transport of passengers and goods by automobiles, trains, ships and airplanes; travel booking agency services; travel arrangement services for individuals and groups; travel booking, reservation or information services relating to travel; vehicle rental services; vehicle parking services; courier services; cargo storage and handling services; aircraft chartering services; arranging travel for package holidays; booking and reservation services for travel tours; information services relating to all the aforementioned services.
43	Services for providing food and drink; temporary accommodation; accommodation booking agency services; arranging holiday accommodation; reservation of temporary accommodation, hotel rooms and restaurants; tourist agency and travel agency services for booking

	accommodation; bar, cafe, snack-bar, cocktail lounge services, provision of food and drinks in airport waiting lounge and restaurant services.
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Trade Mark No.	Mark ¹
40201709795R (IR No. 1273316)	
Class	Specification
35	Advertising; business management; business administration; office functions; organization, operation and supervision of sales promotion incentive programs, frequent flyer programs and customer loyalty programs; retail services, in-flight retail services and Internet retail services for tobacco, cosmetics, clothing, watches, wine and liquor, jewelry and sunglasses.
39	Airline services; travel services; air transport services; transport of passengers and goods by automobiles, trains, ships and airplanes; travel booking agency services; travel arrangement services for individuals and groups; travel booking, reservation or information services relating to travel; vehicle rental services; vehicle parking services; courier services; cargo storage and handling services; aircraft chartering services; arranging travel for package holidays; booking and reservation services for travel tours; information services relating to all the aforementioned services.

¹ A larger graphical representation of this mark is found at the Annex

43	Services for providing food and drink; temporary accommodation; accommodation booking agency services; arranging holiday accommodation; reservation of temporary accommodation, hotel rooms and restaurants; tourist agency and travel agency services for booking accommodation; bar, cafe, snack-bar, cocktail lounge services, provision of food and drinks in airport waiting lounge and restaurant services.
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Background of parties

3 The Opponent operates cruise ships and has been in this field of business for more than 50 years. It was organized in Bermuda.

4 The Opponent claims to be a leader in the cruise ship and travel industry, winning awards over the years. Accolades include being named “World’s Leading Large Ship Cruise Line” by the World Travel Awards for six consecutive years.

5 The Applicant has operated international air travel routes for 16 years since 2006. It was organised in Ireland, with its parent company headquartered in Norway.

6 The Applicant has won numerous awards over the past decade. Accolades include the “World’s Best Low-Cost, Long-Haul Airline” at the Skytrax World Airline Awards for five consecutive years from 2015 to 2019. The Applicant explained in its statutory declaration at [4] that Skytrax awards result from travellers’ votes, and are widely considered an industry benchmark for excellence.

Procedural history

7 The Applicant sought protection for its International Registration Nos. 1273311 and 1273316 in Singapore on 20 January 2017 in Classes 16, 35, 38, 39 and 43. For the purposes of this opposition, 20 January 2017 is the relevant date for determining whether the registrability criteria is met (the “Relevant Date”).

8 The Opponent opposed the protection of International Registration Nos. 1273311 and 1273316 in Singapore on 4 September 2018. The opposition pertained only to Classes 35, 39 and 43 (and not Classes 16 and 38). The Applicant filed its counter-statements on 14 March 2019.

9 The Opponent subsequently filed amended notices of opposition on 8 March 2022 to clarify its grounds of opposition. In turn, the Applicant filed amended counter-statements on 7 July 2022.

Grounds of opposition

10 The Opponent relies on Section 8(4)(b)(i) and Section 8(7)(a) of the Trade Marks Act 1998 (“the Act”) in this opposition. It had earlier pleaded Section 8(4)(b)(ii) of the Act as well, but confirmed in its letter to the Registrar on 24 July 2020 that it would no longer pursue this ground of opposition.

Opponent’s evidence

11 The Opponent’s evidence comprises the following:

- (a) a Statutory Declaration made by Lincoln M. Vidal, Vice President and Assistant General Counsel of the Opponent, on 16 September 2019 in Miami, Florida, USA (“OSD1”);

- (b) a Statutory Declaration made by the same Lincoln M. Vidal on 10 December 2019 in Miami, Florida, USA;
- (c) a Statutory Declaration in Reply made by the same Lincoln M. Vidal on 3 June 2020 in Miami, Florida, USA (“OSDR”); and
- (d) a Supplementary Statutory Declaration made by the same Lincoln M. Vidal on 11 July 2022 in Miami, Florida, USA (“OSSD”).

Applicant’s evidence

12 The Applicant’s evidence comprises a Statutory Declaration made by M. Clohosey, Managing Director of the Applicant, on 13 January 2020 in Whiting, Vermont, USA.

Applicable law and burden of proof

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

Ground of opposition under Section 8(4)(b)(i)

14 Section 8(4)(b)(i) 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;

...

Section 2(1) of the Act, in relation to “well known trade mark”, reads:

“well known trade mark” means —

- (a) any registered trade mark that is well known in Singapore; or
- (b) any unregistered trade mark that is well known in Singapore and that belongs to a person who —
 - (i) is a national of a Convention country; or
 - (ii) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in Singapore;

Section 2(1) of the Act, in relation to “Convention country”, reads:

“Convention country” means —

- (a) in section 10 and paragraph 13 of the Third Schedule, a country or territory, other than Singapore, which is —
 - (i) a party to the Paris Convention; or
 - (ii) a member of the World Trade Organisation; and
- (b) in any other provision of this Act, a country or territory which is —
 - (i) a party to the Paris Convention; or
 - (ii) a member of the World Trade Organisation;

Section 2(7) to (9) of the Act reads:

(7) Subject to subsection (8), in deciding, for the purposes of this Act, whether a trade mark is well known in Singapore, it is 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 is 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.

Application of Section 8(4)(b)(i) to the facts

15 The Opponent states at [4] of its amended grounds of opposition:

The Opponent has owned trade mark registrations in numerous countries worldwide comprising or incorporating the distinctive element “**NORWEGIAN**” in relation to services under Classes 35, 39 and 43, ownership of which has since been transferred

to related entities for the sole purpose of holding its intellectual property registrations, and for the purposes of this Opposition the said trade marks are **“NORWEGIAN”, “NORWEGIAN CRUISE LINE”, “NORWEGIAN STAR”, “NORWEGIAN EPIC”, “NORWEGIAN PEARL”, “NORWEGIAN JEWEL”, “NORWEGIAN JADE”** and **“THE HAVEN BY NORWEGIAN”** ...

16 By letter dated 9 May 2022, and again at the hearing, the Opponent confirmed that the primary focus under this ground would be on the two marks **“NORWEGIAN”** and **“NORWEGIAN CRUISE LINE”** (“the main NORWEGIAN Marks”). The marks listed in the preceding paragraph from the amended grounds of opposition are collectively referred to as “the Opponent’s Marks”.

17 I consider whether the Opponent succeeds in its opposition under Section 8(4)(b)(i) of the Act, and address the relevant issues in turn.

Requirement of real and effective commercial establishment

Parties’ position and submissions

18 In the present case, the Opponent relies on what it claims as “well known marks” in support of its ground of opposition under Section 8(4). These marks are unregistered in Singapore, and thus, paragraph (b) of the definition of “well known trade mark” under Section 2(1) of the Act comes into play. The provision has been set out above and requires such unregistered trade marks, claimed to be well known, to belong to a person who is a national of a Convention country, or is domiciled in a Convention country, or has a real and effective industrial or commercial establishment in a Convention country.

19 The Applicant took the position that the Opponent could not rely on unregistered well known marks here. The Opponent is organized under the laws

of Bermuda, and Bermuda is neither a party to the Paris Convention nor a member of the World Trade Organisation. Hence, it is not a Convention country.

20 The Opponent did not dispute this but submitted that it had a real and effective commercial establishment in the USA, which is a Convention country (the USA being both a party to the Paris Convention and a member of the World Trade Organisation). The Opponent drew my attention to its OSSD, where it exhibited, in evidence, its annual reports filed with the United States Securities and Exchange Commission for the fiscal years ended 2017 and 2018. Bearing in mind the Relevant Date, I focus on the annual report for the fiscal year ended 2017. The Opponent highlighted that the address of its principal executive offices was expressly stated in the annual report. It reads “7665 Corporate Center Drive, Miami, Florida 33126”. When asked at the hearing, the Opponent, through its counsel, responded that “principal executive offices” referred to its headquarters.

21 The Opponent also referred me to Part 1 of the annual report under “Additional Information”, where the difference between “registered offices” and “principal executive offices” was highlighted, as this extract demonstrates:

We are incorporated under the laws of Bermuda. Our registered offices are located at Walkers Corporate (Bermuda) Limited, Park Place, 3rd Floor, 55 Par-la-Ville Road, Hamilton HM 11, Bermuda. Our principal executive offices are located at 7665 Corporate Center Drive, Miami, Florida 33126.

22 The Applicant submitted that the Opponent’s documents show, at the very most, that it is allowed to conduct business in the USA, but do not show that the Opponent does in fact conduct business out of that country. The Applicant suggested taking guidance from IPOS’ Filing Guide for Online Form

MM2(E)², where a basic application or registration exists in Singapore, and the filer seeks to register the same mark overseas through the Madrid Protocol using Form MM2(E). Page 8 of this guide elaborates how the condition of “real and effective commercial establishment” may be met:

The term “real and effective industrial or commercial establishment” is taken to mean an establishment at which some industrial or commercial activities take place. The presence of a parent company, subsidiary company or a branch office in Singapore staffed with sales personnel and conducting actual sales transactions in Singapore would likely meet this requirement. However the following establishments would not qualify as “real and effective”:

- a mere warehouse
- a letter box or an address for correspondence
- the address of a legal or professional representative
- fake, temporary, fraudulent or fictitious establishments.

23 The Opponent’s OSD1 also exhibits, at page 13, a listing on its website at www.ncl.com of its international offices in North America, where the details of the Opponent’s USA and Canada offices are set out. The address of the USA office is the same as the address of the principal executive offices stated in the Opponent’s annual report for the fiscal year ended 2017.

Background to “real and effective ... commercial establishment”

24 The term “real and effective industrial and commercial establishment” is used in Article 3 of the Paris Convention for the Protection of Industrial Property and was borrowed by the World Intellectual Property Organization (“WIPO”) for its international filing systems such as those under the Madrid

² This is a World Intellectual Property Organization form entitled “Application for International Registration under the Madrid Protocol”.

Protocol (for trade marks), Patent Co-operation Treaty (for patents) and Hague Agreement (for designs). WIPO states on its website:

The expression “real and effective industrial and commercial establishment” is taken from Article 3 of the Paris Convention, to which it was added at the first conference for the revision of the Convention... It was felt that the original provision, which referred simply to “an establishment”, was too broad and should be restricted. The intention was that, by using the French term “sérieux” (“real” in English), fraudulent or fictitious establishments would be excluded. The term “effective” makes it clear that, while the establishment must be one at which some industrial or commercial activity takes place (as distinct from a mere warehouse), it need not be the principal place of business...

25 Another document, the IPOS Guidelines for the Determination of a Real and Effective Industrial or Commercial Establishment (“IPOS Guidelines”), also helps shed light on this requirement (it is couched in the context of Singapore, but can be considered in relation to the relevant jurisdiction):

The test of whether an applicant has a real and effective industrial or commercial establishment in Singapore is a question of fact, based on an assessment of all the relevant factors on a case-by-case basis. To assist applicants in determining if the condition of a “real and effective industrial or commercial establishment” is met, the following non-exhaustive factors may be taken into consideration:

1. Whether there is establishment of a place in Singapore from which the business of the applicant is conducted. The premises should be one where some industrial or commercial activity is conducted, as opposed to, for example a mere storage facility or P.O. box;
2. Whether the applicant conducts industrial or commercial activities and transactions from the establishment in Singapore on a regular basis;
3. Whether the applicant is involved in the solicitation or advertising/promotion of its business;
4. Whether the applicant has employees in Singapore to look after the applicant’s affairs; and
5. Where the applicant employs an agent to conduct the applicant’s business in Singapore:

- a. whether the agent has the authority to enter into binding contracts on behalf of the applicant;
- b. degree of control the applicant exercises over the running of the business conducted by the agent;
- c. level of contribution the applicant makes to the financing of the business carried on by the agent; and
- d. whether the agent displays the applicant's name at his premises or on his marketing materials, and if so, whether the agent does so in such a way as to indicate that he is representing the applicant.

26 The IPOS' Filing Guide for Online Form MM2(E) cited by the Applicant at [22] above appears to be a condensation of the above IPOS Guidelines.

Conclusion on "real and effective commercial establishment"

27 The Opponent's evidence shows sailings from locations in the USA, e.g. Tampa, a city in Florida, a state of the USA (at OSD, Annex 1, page 25 exhibiting a press release from the Opponent's Miami office dated 3 August 2015). The same media release also profiles its ship "Norwegian Breakaway", saying "Known as New York's ship, Norwegian Breakaway is the largest vessel to homeport year-round in the city." Given that the Opponent clearly runs a cruise business on some scale, on a balance of probabilities, I have no reason not to think that the Opponent indeed carries out business in the USA, including from its headquarters in Miami, Florida, the United States of America. The establishment also does not appear to fall within any of the excluded examples in IPOS' Filing Guide for Online Form MM2(E) (and the IPOS Guidelines), to use the Applicant's suggestion. I therefore conclude that the Opponent has fulfilled the criteria of having a real and effective commercial establishment in the USA, a Convention country.

28 Accordingly, the Opponent is entitled to rely on unregistered well known marks in this opposition.

Whether the Opponent's marks are well known

29 The primary marks on which the Opponent relies under this ground are the main NORWEGIAN Marks, namely “**NORWEGIAN**” and “**NORWEGIAN CRUISE LINE**”. The Opponent does rely on the other Opponent's Marks as well in its pleadings and written submissions, but on a secondary basis. This recognises that the main NORWEGIAN Marks are thought to be the closest (among all the Opponent's Marks) to the Application Marks and are the basis of the Opponent's strongest case. If the Opponent does not make out its case based on the main NORWEGIAN Marks, it would likewise not do so based on the remaining Opponent's Marks.

The Opponent's evidence

30 The Opponent's evidence in support of its claim that the Opponent's Marks are well known is as follows:

(a) Revenue figures in Singapore

The Opponent's revenue in Singapore in relation to services bearing the Opponent's Marks, as well as its number of bookings from Singapore and number of guests tied to these bookings, are set out below:

Year	Revenue (in approximate US\$)	No. of Bookings	No. of Guests
2012	2 million	700 +	1450 +

2013	1.85 million	500 +	1100 +
2014	1.6 million	550 +	1050 +
2015	1.35 million	450 +	900 +
2016	1.35 million	550 +	950 +

There are no supporting invoices to corroborate the above figures.

(b) Advertising and promotion through business partners

The Opponent claimed that its services were extensively marketed in Singapore through travel agency partners from as early as 2000, and that it had devoted substantial efforts and financial resources into promoting the Opponent's Marks. These promotional efforts generally take the form of brochures, newspaper advertisements and roadshows (by the Opponent's travel agency partners). In support of its claim, the Opponent exhibited, in its OSD1, at Annex 4, the following:

(i) A tax invoice from Chan Brothers Travel Pte Ltd to Norwegian Cruise Line dated 26 August 2016, where the particulars state "Being subsidy for Norwegian Cruise Line & Chan Brothers Travel / Worldwide Cruise Centre Joint Marketing Campaign". The numerical figures in this tax invoice have been redacted. A fair inference I can make from this is that in 2016, the Opponent and its travel agency partner, Chan Brothers, planned for a joint marketing campaign on some cost-sharing basis. However, the extent of this campaign is not known because the numerical figures have been redacted.

(ii) Cut-outs of newspaper advertisements in July and August 2016 for one tour programme, namely, “14D Hawaii Island Hopping + Seoul Sojourn Cruise Tour” with departure dates on 17 November 2016, 24 November 2016 and 1 December 2016. The vessel name is “Pride of America”, and not a “NORWEGIAN-formative” name such as “NORWEGIAN STAR” (see [15]). The advertisements were placed in Lianhe Zaobao and The Straits Times. The words “Norwegian Cruise Line” can be seen beneath the logo “NCL” in the top left corner of these advertisements.

(iii) A Chan Brothers advertisement of the “Travel Revolution Fair 2016” held at Marina Bay Sands Expo and Convention Centre from 19 to 21 August 2016, featuring the same tour programme as (ii) above. Appearing below this advertisement is a photograph of a Norwegian Cruise Line booth, presumably taken at the “Travel Revolution Fair”; and a colour print-out of a Norwegian Cruise Line brochure featuring the same tour programme as (ii) above. The words “Norwegian Cruise Line” beneath the logo “NCL” appear prominently in the photo of the travel booth as well as in the brochure.

(c) Marketing through websites

The Opponent claimed that its services were directly marketed and made available through its website at www.ncl.com. Its services are also marketed through websites such as www.cruisecritic.com and www.cruises.com. In support of its claim, the Opponent exhibited, in its OSD1, at Annex 5, printouts from the websites www.cruisecritic.com, www.cruises.com, and www.ncl.com. The printouts from

www.cruisecritic.com show the result when a search command “Find Norwegian (NCL) Cruises” is executed. A list of cruises taking place between August 2019 and November 2020 is reflected in the result. These cruises depart from various ports in North America and Europe, such as Miami, Vancouver and Barcelona. Likewise, the printouts from www.cruises.com show the results where “Norwegian Cruise Line” is used as a search term, and list the Opponent’s cruises that sail between August 2019 and December 2020, with a short marketing write-up on the Opponent at the end of the list of cruises entitled “About Norwegian Cruise Line”. Finally, the Opponent’s own website www.ncl.com showed a promotion (“Buy One, Get One Half Price”) and an invitation to “Explore 454 Cruise Holidays”. The printouts also show a marketing write-up on the Opponent’s services.

In all of the above website printouts in the Opponent’s OSD1, at Annex 5, as well as in the website extracts at [52] below, there is no link to Singapore or Singapore consumers to be seen. When asked at the hearing, the Opponent, through its counsel, confirmed that it could not identify to me the Singapore-specific webpages or otherwise demonstrate how these related to the relevant sector of the public in Singapore e.g. through website analytics. Neither is there evidence of sales of the Opponent’s cruises actualizing from these websites. The website printouts also post-date the Relevant Date.

(d) Social media campaigns

The Opponent also claimed that there had been considerable publicity of the Opponent’s services under the Opponent’s Marks on social media. It exhibited, in its OSD1, at Annex 6, printouts in 2019 under its accounts from social media sites Facebook (Norwegian Cruise Line;

@norwegiancruiselineinternational), Instagram (Norwegian Cruise Line; @norwegiancruiseline) and Twitter (Cruise Norwegian; @CruiseNorwegian).

There is no link to Singapore or Singapore consumers on the face of these printouts, which also post-date the Relevant Date.

(e) Email and direct mail campaigns

The Opponent exhibited, in its OSD1, at Annex 6, its records showing 6,347 email subscribers and 10,137 direct mail subscribers in Singapore. These subscribers receive updates on the Opponent's cruise services. The number of emails and direct mail sent over the years is tabulated below:

Year	Emails Sent	Direct Mail Sent
2011	-	44
2012	73	59
2013	17,133	38
2014	22,504	28
2015	37,652	112
2016	335,042	167
2017	569,801	102

(f) Trade mark registrations

The Opponent adduced evidence showing that the Opponent's Marks are registered around the world. Most of these registrations are in respect of the "NORWEGIAN-formative" names of the Opponent's vessels, and a very small minority (6 out of the approximately 140 registered marks then) are in respect of the main NORWEGIAN Marks, "NORWEGIAN" and "NORWEGIAN CRUISE LINE".

According to the Opponent's OSDR, at Annex 7, the word mark "NORWEGIAN" is only registered in Mexico. The word mark "NORWEGIAN CRUISE LINE" is registered in Brazil, Canada, China, the European Union (as a Community Trade Mark) and USA.

The Opponent's "non-evidence"

31 The Opponent also sought to rely on its worldwide market share in its written submissions. At the hearing, the Opponent was asked and confirmed that this information was not adduced in evidence. The Applicant also pointed out that the information was dated 2021 and related to revenue in 2021, which post-dates the Relevant Date. Accordingly, I do not take this into consideration.

32 The Opponent, at [14] of its OSD1, claimed that the Opponent's Marks have appeared on popular travel and lifestyle magazines and national publications such as *asiaone* and *lifestyleasia*, from as early as 2016. This was a bare assertion, unsupported by any documentary exhibits.

33 In its written submissions, the Opponent referred to the above assertion and provided website links to *asiaone* and *lifestyleasia* (<https://www.asiaone.com/singapore/norwegian-cruise-line-opens-spore-office-regional-market>) (<https://www.lifestyleasia.com/sg/travel/destinations/asias-spectacular->

[cruise/](#)). This information and the specific webpages relevant to the Opponent's claim were not adduced in evidence.

34 *Bigfoot Internet Ventures Pte. Ltd. v Athleta (ITM) Inc.* [2018] SGIPOS 10 at [32] expressed that it was not tenable to claim that, just because a website's link has been stated in evidence, and specific printouts from the same website have been adduced in evidence, the website *as a whole* had therefore been adduced in evidence. If a party desired to rely on specific content on a webpage from a website, it had to adduce that very webpage in evidence. All the more, in the present case where the Opponent had not even provided the website links in its evidence should it not be allowed to rely on the links (let alone any specific webpages) in its written submissions. As with the Opponent's reference to information on its market share above, I likewise do not take the claimed appearance of the Opponent's Marks in *asiaone* and *lifestyleasia* into consideration.

Contextual points

35 In the context, the Opponent also claimed at [11] of its OSD1 that its services have been available and marketed through its Singapore representative office since as early as 2015; and at page 14 of its OSDR, the Opponent exhibited a printout from the webpage www.superadrianme.com/travel/norwegian-cruise-line-office-singapore/ bearing an article dated 13 April 2016 by an "Adrian" entitled "Norwegian Cruise Line Holdings Opens Office in Singapore". At [11] of its OSD1, the Opponent further claimed that it has provided cruise services out of Singapore since 2016; in a similar vein at [125] of its OSDR, the Opponent claimed that its cruise ships have docked in Singapore from end-2016 onwards.

36 As regards the first claim above pertaining to the Opponent's Singapore office, such an office would have been reflected in its OSD1, at Annex 1 page 14 (where the Opponent's offices in Asia Pacific were listed on its website). However, this was not the case, and at the hearing, the Opponent's counsel was not able to explain this omission. As for the discrepancy in the year (2015 or 2016), the Opponent's counsel submitted that minimally, it could be said that there was a Singapore representative office in 2016. Nonetheless, given that this information hinges on the article described in the immediately preceding paragraph, written by an unidentified "Adrian", who is not a deponent of the Opponent's statutory declaration and who, judging from the url www.superadrianme.com, appears to be an independent writer rather than an official representative of the Opponent, I am reluctant to accept this claim based on hearsay, and furthermore in the absence of corroborating evidence from the Opponent's own website listing its offices in Asia Pacific.

37 As regards the second claim, the Opponent's counsel confirmed at the hearing that the only supporting evidence is found at Annex 1, page 24, of its OSDR. This is a press release from the Opponent's website at www.ncl.com. The penultimate paragraph on that page reads "Throughout December 2016 and January 2017, Norwegian Star will do a series of 11- and 14-day sailings in Southeast Asia, departing from Singapore and Hong Kong respectively. Norwegian Star's 11-day Southeast Asia itineraries *departing from Singapore on December 11, 2016* and January 5, 2017 feature ports of call in ..." (emphasis mine). It is not clear, in relation to the "well known" claim, what the Opponent would have me conclude from the fact that its cruises started departing from Singapore from December 2016. As regards use, minimally, as deposed at [11] of its OSD1, it can be said that the Opponent has provided cruise services out of Singapore since 2016 (which is just before the Relevant Date).

38 The Opponent’s counsel also submitted at the hearing that the Opponent provides travel-related services with an international element (cruises that cross national boundaries) and these international services should count towards the marks being well known in Singapore.

Relevant sector of the public in Singapore

39 Applying Section 2(7)(a), (8) and (9) of the Act, the Opponent submitted that the relevant sector would be actual and potential tourists, distributors of travelling services (such as travel agencies and cruise agencies), and related tourism service providers (such as hotels), in Singapore. The Applicant is of similar view in its written submissions, stating that the relevant sector of the public would be travel agents and individuals or groups looking to vacation by sea.

The Opponent’s Marks are not well known

40 I have considered the Opponent’s evidence above. The relevant evidence would be that described at [30(a), (b), (e)]. The rest of the evidence, at [30(c), (d), (f)], falls short of showing whether, how and to what extent it impacts the relevant sector of the public in Singapore such that the Opponent’s Marks, or at least the main NORWEGIAN Marks, are well known to it. With specific regard to the Opponent’s overseas trade mark registrations, I am mindful of what the Court of Appeal in *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 (“*Ceramiche Caesar*”) said at [113]:

... although the overseas registrations of the mark and the successful enforcement of rights are relevant factors under s 2(7)(c) and (d) of the TMA, the language of s 2(7) of the TMA makes it abundantly clear that the ultimate inquiry is whether a trade mark is well known *in Singapore*. The crucial point, therefore, is that the Appellant has to show how the overseas registrations of the Appellant’s CAESAR Mark and the successful enforcement of its rights has *led to* its mark being

well known *in Singapore*. In our judgment, this has not been done. These factors therefore do not go towards establishing that the Appellant's CAESAR Mark is well known in Singapore.

41 The burden lies on the Opponent to show that the Opponent's Marks, or at least the main NORWEGIAN Marks, are well known in Singapore. The relevant evidence at [30(a), (b), (e)] is, on the whole, weak. The Opponent's revenue figures, advertising and promotion, and email and direct mail campaigns, show that it has a tangible business in Singapore which is promoted to an inconclusive extent. However, this alone does not establish that the Opponent's Marks are *well* known in Singapore. For example, there is no context on how much in dollar terms the cruise market in Singapore is worth, and the size of the group of actual and potential consumers in the Singapore market. The Court of Appeal in *Ceramiche Caesar* opined at [114] that "*The fact that a trader has some business within Singapore will generally be insufficient in itself to establish that the mark is well known.*"

42 I am mindful that a "well known trade mark" as defined in Section 2(1) of the Act does not require its proprietor to carry on business in Singapore or to have goodwill in Singapore. Nonetheless, since the Opponent has adduced evidence of its use, revenue, advertising and promotion in support of the claimed well known nature of the Opponent's Marks, I have dealt with the evidence accordingly in the foregoing. The underlying deficiency is still that the Opponent's evidence does not show how and to what extent it impacts the relevant sector of the public in Singapore such that the Opponent's Marks, or at least the main NORWEGIAN Marks, are *well known* to it (as opposed to being merely *known*). As stated at the outset at [13], the burden of proof rests on the Opponent, including the burden of adducing relevant and admissible evidence that establishes the well known nature of the Opponent's Marks in Singapore. The Opponent has control over its own records and autonomy over the evidence

it chooses to adduce. As the evidence before me falls short as described in the foregoing analysis, it is not possible to conclude that the Opponent's Marks are well known to the relevant sector of the public in Singapore.

Conclusion on opposition under Section 8(4)(b)(i)

43 My conclusion that the Opponent's Marks are not well known makes it unnecessary to consider the remaining elements under Section 8(4)(b)(i). The ground of opposition under Section 8(4)(b)(i) fails.

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

44 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

...

Application of Section 8(7)(a) to the facts

45 The Court of Appeal in *Singsung Pte Ltd v LG 26 Electronics Pte Ltd* [2016] 4 SLR 86 ("*Singsung*") summarised, at [28], that:

... the main elements of the tort of passing off are encapsulated in the classical trinity of goodwill, misrepresentation and damage (see for example, *Novelty* at [37] and *Nation Fittings (M) Sdn Bhd v Oystertec plc* [2006] 1 SLR(R) 712 ("*Nation Fittings*") at [148]).

46 I consider the elements of goodwill, misrepresentation and damage in turn.

Goodwill

47 The Applicant accepts that the Opponent has goodwill in its business as on the Relevant Date. I have also found, at [41], that the Opponent’s evidence of use, advertising and promotion shows that it has a tangible business in Singapore. The Opponent’s goodwill in Singapore is therefore not in issue.

Misrepresentation

Preliminary issue

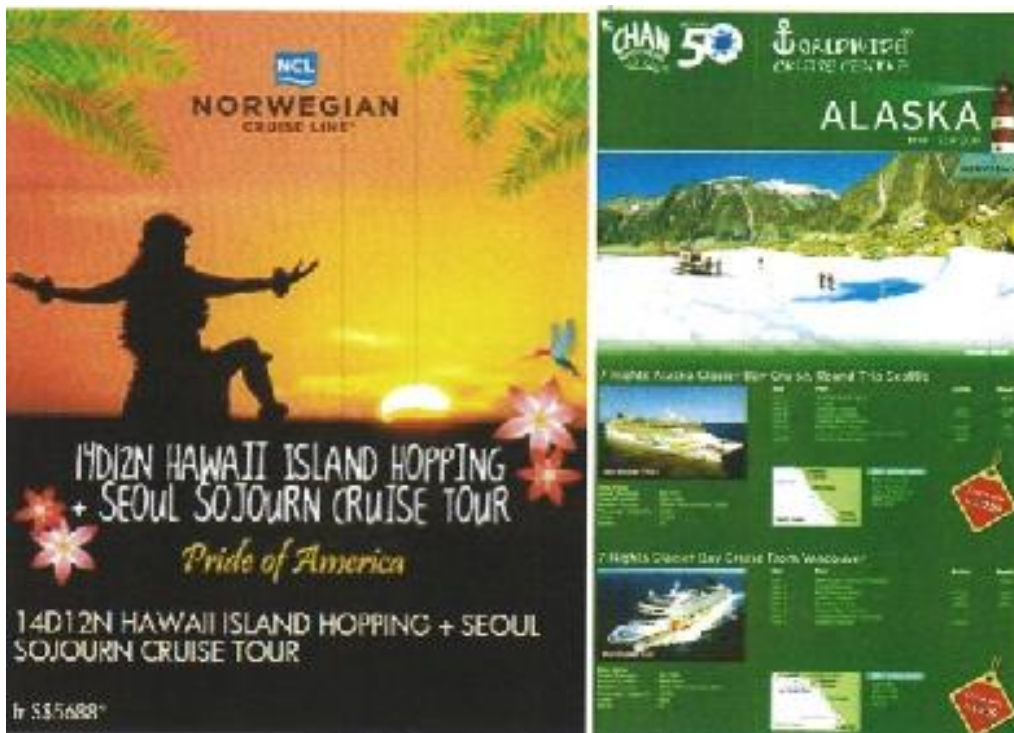
48 Under this element, the preliminary issue to be considered is whether the Opponent’s goodwill is sufficiently associated with the marks it relies on, primarily “**NORWEGIAN**” and “**NORWEGIAN CRUISE LINE**”: see *Singsung* at [70]. Put another way, the issue here is whether the main NORWEGIAN Marks are distinctive of the Opponent’s cruise services.

49 “*Distinctiveness is generally considered in relation to the class of consumers of the goods in question (ie, the relevant public)*”: see *Singsung* at [71]. Here, therefore, whether the main NORWEGIAN Marks are distinctive is considered from the perspective of consumers of tour / travel services in Singapore.

50 The Opponent’s position is that the word element “**NORWEGIAN**” has acquired distinctiveness through use. Its evidence on the acquired distinctiveness of the main NORWEGIAN Marks is the same evidence it relied on to support its claim that the Opponent’s Marks are well known in Singapore; and this has been described above in the consideration under Section 8(4)(b)(i).

51 The evidence that is most relevant, and closest to consumers of tour / travel services in Singapore would be the evidence of advertisement and

promotion at [30(b)(ii), (iii)]. These are newspaper advertisements, a photograph of a Norwegian Cruise Line booth (presumably taken at the “Travel Revolution Fair”) and a Norwegian Cruise Line brochure. The words “Norwegian Cruise Line” can be seen beneath the logo “NCL” in these items of evidence, but not the standalone word “Norwegian”. An example of this is seen in the Norwegian Cruise Line brochure extract below:



52 In addition, at the hearing, the Opponent pointed me to printouts from its website www.ncl.com where the word “Norwegian” is used on its own. Examples include:

Norwegian’s new itineraries will be available for booking later this month.

Norwegian is taking guests to their dream destinations...

(from Opponent’s press release in

OSDR, Annex 1, page 24) (2015)

MORE REASONS TO CRUISE NORWEGIAN

(from OSDR, Annex 5, page 103) (2016)

Ocean Blue – Norwegian’s first-ever seafood restaurant.

...

Piazza-style environment, casual, family-style services and Tuscan cuisine all come with the territory with Norwegian’s take on Italian.

(from OSDR, Annex 5, page 114) (year not reflected)

The *Norwegian* Difference

...

Norwegian’s Free at Sea

Enjoy the most inclusive cruise holidays with *Norwegian’s* Free at Sea. Choose up to 5 Free Offers, like Free Unlimited Beverage Package, and Specialty Dining Package, to customise your holiday to any destination, any time of year.

Go Your Own Way

With one-of-a-kind onboard experiences like a race track at sea, an idyllic private island with white sand beaches and plenty to do, and itineraries exclusive to *Norwegian*, we’ll take you places in ways no other cruise line can.

(emphasis in italics mine)

(from OSD1, Annex 5, page 186) (2019)

WHY CRUISE NORWEGIAN

(from OSD1, Annex 5, page 189) (2019)

THE NORWEGIAN DIFFERENCE

(from OSD1, Annex 5, page 190) (2019)

53 Counsel for the Applicant submitted at the hearing that the above examples of “**NORWEGIAN**” being used standalone all emanate from the

Opponent itself (from its press release and its own website marketing spiels) and does not reflect that others have come to associate “**NORWEGIAN**” with the Opponent.

54 I am inclined to agree. It is probably true that with repeated and effective marketing and promotion, certain commercial messages can be ingrained in some minds among the consuming public. However, here, the Opponent has not given evidence on the impact of the marketing messages on its website on the consuming public in Singapore. It could not demonstrate how these website printouts related to the consuming public in Singapore e.g. through website analytics. It is not known how many members of the consuming public in Singapore are likely to have been exposed to the appearance of the word “Norwegian” on its own, on these pages at the Opponent’s website. It is also not known what the impact on the Singapore consumer’s impression is, given that the Opponent’s website also uses the words “**NORWEGIAN CRUISE LINE**” (as elaborated below). Further, only 2 out of the 6 examples cited by the Opponent from its website printouts are shown to pre-date the Relevant Date. The remaining 4 examples are either undated or post-date the Relevant Date.

55 I also have regard to other extracts from the Opponent’s website which pre-date the Relevant Date. These contain marketing and promotion text which refer to “Norwegian Cruise Line” in the plain word format (e.g. OSDR, Annex 3, pages 39, 41, 47, 49; media release in OSDR, Annex 4, page 87).

56 Taking into account the totality of the evidence, I conclude that the Opponent’s goodwill in Singapore is associated with the mark “**NORWEGIAN CRUISE LINE**” and not with the standalone word “**NORWEGIAN**”.

Distinctiveness of “NORWEGIAN CRUISE LINE”

57 I am mindful that the degree of distinctiveness of “**NORWEGIAN CRUISE LINE**” is also a factor when determining likelihood of confusion once the preliminary issue under the “Misrepresentation” element of passing off is resolved. The Court of Appeal in *The Singapore Professional Golfers’ Association v Chen Eng Wye* [2013] 2 SLR 495 (“SPG”), at [34], cited with approval Christopher Wadlow, *The Law of Passing-Off: Unfair Competition by Misrepresentation* (Sweet & Maxwell, 4th Ed, 2011) (“*The Law of Passing-Off*”):

But, as observed by the learned author of *The Law of Passing-Off* at para 8-003, the distinctiveness of a name or mark is just one aspect of the wider question of whether there has been a misrepresentation. He puts it thus at para 8-003:

...

Distinctiveness is a matter of degree, and marks of low inherent distinctiveness may be protected against precise copying but not against slight variations.

58 Here, the starting point is that “NORWEGIAN” itself is a known English word which may appear descriptive to the average consumer in Singapore. As considered above, the Opponent has not demonstrated, on the evidence, that “NORWEGIAN” has acquired distinctiveness. The words “CRUISE LINE” are also descriptive of the services offered by the Opponent. Overall, the combination of these word elements to form the mark “**NORWEGIAN CRUISE LINE**” as a whole is of low distinctiveness (for avoidance of doubt, based on how it has been used before the Relevant Date, this does not detract from my finding above that the Opponent’s goodwill in Singapore is associated with the mark “**NORWEGIAN CRUISE LINE**”).

59 I also consider distinctiveness in a non-technical sense, that is, what is outstanding and dominant in the mark “**NORWEGIAN CRUISE LINE**” from the perspective of the average consumer.

60 Perceiving the mark, the consumer is more likely than not to identify “NORWEGIAN” as the more dominant element (compared to “CRUISE LINE”) which lends to the mark *as a whole* its ability to distinguish from other traders’ offerings. This assessment is based on the vantage point of an average consumer of travel services, and not because I agree with the Opponent’s submission, at [50], that “NORWEGIAN” has in fact acquired distinctiveness through use – this had not been established on the evidence.

Similarity of get-up and likelihood of confusion

61 Having found that (i) the Opponent’s goodwill is associated with the mark “**NORWEGIAN CRUISE LINE**” and not “NORWEGIAN” as such, and (ii) the word “NORWEGIAN” is the more dominant element within the mark (in contrast to “CRUISE LINE”), I am to consider whether there will be a misrepresentation by the Applicant if the Application Marks were used in relation to the services claimed, such that a sufficient likelihood of confusion arises from such use: *Singsung* at [70]. The Court of Appeal elaborates at the same place that “*The quintessential misrepresentation in this variety of the tort of passing off is a misrepresentation as to trade source or the trade origin of goods, the classic form being a false representation by the defendant that his goods or services emanate from the plaintiff or an entity connected to or associated with the plaintiff.*”


62 The Court of Appeal in *SPG* also said at [20], of this stage under the element of “misrepresentation” in the tort of passing off, that “*It will then be necessary to consider, amongst other factors, whether there is such a similarity*

between the corresponding element that is being used by the defendant on the one hand and by the claimant on the other such that in all the circumstances, it is sufficiently likely to result in the relevant segment of the public being deceived or confused into thinking that the defendant’s goods or services are, or emanate from a source that is linked to, the claimant’s.”

63 The Court of Appeal in *Singsung* adds, at [40], that “*This is ultimately a matter for the court’s judgment and it is not to be determined on a visual side-by-side comparison. Rather it is to be assessed from the vantage point of a notional customer with imperfect recollection.*”

64 I compare “**NORWEGIAN CRUISE LINE**” on the one hand, with

each of TM No. 40201709794W  and TM No.

40201709795R  on the other hand. I also bear in mind the respective services of the parties: the Opponent’s cruise and ancillary services on the one hand, and the Applicant’s claimed services in Classes 35, 39 and 43 below:

Class	Specification
35	Advertising; business management; business administration; office functions; organization, operation and supervision of sales promotion incentive programs, frequent flyer programs and customer loyalty programs; retail services, in-flight retail services and Internet retail services for tobacco, cosmetics, clothing, watches, wine and liquor, jewelry and sunglasses.
39	Airline services; travel services; air transport services; transport of passengers and goods by automobiles, trains, ships and airplanes; travel booking agency services; travel arrangement

	services for individuals and groups; travel booking, reservation or information services relating to travel; vehicle rental services; vehicle parking services; courier services; cargo storage and handling services; aircraft chartering services; arranging travel for package holidays; booking and reservation services for travel tours; information services relating to all the aforementioned services.
43	Services for providing food and drink; temporary accommodation; accommodation booking agency services; arranging holiday accommodation; reservation of temporary accommodation, hotel rooms and restaurants; tourist agency and travel agency services for booking accommodation; bar, cafe, snack-bar, cocktail lounge services, provision of food and drinks in airport waiting lounge and restaurant services.

65 Here lies a difference between the application of Section 8(2)(b)/Section 8(4) and Section 8(7)(a) of the Act. In the former, particularly Section 8(2)(b), *“Under the step-by-step approach, the three requirements of similarity of marks, similarity of goods or services, and likelihood of confusion arising from the two similarities, are assessed systematically. The first two elements are assessed individually before the final element which is assessed in the round.”* (see the Court of Appeal in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and anor* [2014] 1 SLR 911 (*“Staywell”*) at [15]). Hence, the comparison of the competing marks is a distinct step from the analysis of the other requisite elements (the same sequential, step-by-step approach can be said to apply to Section 8(4) in respect of the relevant elements of that provision). Further, this comparison is to be carried out as between the marks themselves: *“the assessment of marks similarity is mark-for-mark without consideration of any external matter”* (at [20] of *Staywell*). On the other hand, under Section 8(7)(a), with which we are presently concerned, the

analysis of misrepresentation and likelihood of confusion permits the consideration of similarity of marks and services concurrently, in coming to a determination whether there is a likelihood of confusion. Therefore, it is not assumed here that the outcome under Section 8(7)(a) would necessarily be the same outcome under Section 8(4) had the Opponent been able to establish that the main NORWEGIAN Marks were well known in Singapore.

66 The Applicant, in its submissions, emphasized that the parties were in separate and distinct fields of industry, and were in no way direct competitors. The Opponent operates in the cruise industry and the Applicant operates in the air travel industry. However, the considerations in an opposition based on the ground of Section 8(7)(a), as opposed to the considerations in a civil action for passing off, differ. Here, in the context of an opposition, the use of the Application Marks is notional, and is in relation to the claimed (and opposed) specifications. The reference point is therefore the scope of the specifications claimed by the Applicant, and not the scope of actual use by the Applicant. There may well be an overlap between the two (notional and actual use), but the inquiry will be conducted on the basis of the Applicant’s claimed specifications and the Opponent’s actual services.

67 The Opponent’s cruise-related and ancillary services have been set out in its OSDR. These are summarised below and compared with the Applicant’s specifications. The overlaps (the “Overlapping Services”) are set out in the right column of the table below:

Class	Opponent’s Services	Overlap with Applicant’s Specifications
35	<ul style="list-style-type: none"> • “Latitudes Rewards Loyalty Program” • onboard retail services e.g. duty-free shops 	<ul style="list-style-type: none"> • organization, operation and supervision of sales promotion incentive programs ... and

	<p>selling cosmetics, clothing, jewelry etc.</p> <ul style="list-style-type: none"> • online retail services for customers to purchase wine, food packages and spa packages for onboard use 	<p>customer loyalty programs</p> <ul style="list-style-type: none"> • retail services ... and Internet retail services for tobacco, cosmetics, clothing, watches, wine and liquor, jewelry and sunglasses
39	<ul style="list-style-type: none"> • cruise services • travel booking agency services • travel booking, reservation or information services relating to travel • arranging travel for package holidays e.g. land tours at cruise destinations and ports of call • booking and reservation services for travel tours 	<ul style="list-style-type: none"> • travel services • transport of passengers ... by ... ships ... • travel booking agency services • travel arrangement services for individuals and groups • travel booking, reservation or information services relating to travel • arranging travel for package holidays • booking and reservation services for travel tours • information services relating to all the aforementioned services
43	<ul style="list-style-type: none"> • provision of lodging, drink and food services for the duration of the cruise 	<ul style="list-style-type: none"> • services for providing food and drink • temporary accommodation • arranging holiday accommodation • reservation of temporary accommodation ... and restaurants • bar, cafe, snack-bar, cocktail lounge services

		<ul style="list-style-type: none"> • restaurant services
--	--	---

68 I go on to consider how a member of the consuming public in Singapore would perceive the respective marks when used on the respective services.

69 As regards “**NORWEGIAN CRUISE LINE**” on the one hand, and TM

No. 40201709794W



on the other, an average consumer of travel services in Singapore with imperfect recollection is likely to take especial note of the commonality of “NORWEGIAN/norwegian” between the marks. As I have found at [60] above, the word element “NORWEGIAN” is rather more dominant than the word element “CRUISE LINE”. As for the Applicant’s TM No. 40201709794W, I now also find that the more dominant element is the word “norwegian”, rather than the aeroplane device and the red rectangular background. This is because of the size and central positioning of the former. The other elements in the competing marks, namely the words “CRUISE LINE” and the aeroplane device and red rectangular background, are more descriptive and/or decorative elements which leave a shallower impression. Hence, the average consumer is likely to connect the competing marks when both are used in respect of the Overlapping Services. These observations do not detract from the fact that “NORWEGIAN” itself is not particularly distinctive.

70 The Opponent, in its OSDR at [9]-[10], also referred to Singapore travel agencies who sell both cruises and flights, such as Chan Brothers and WTS Travel. The Opponent’s own offering described at [30(b)(ii)] above is itself a Fly-Cruise programme (“14D Hawaii Island Hopping + Seoul Sojourn Cruise Tour”) which includes “Return Airfare to Honolulu by Korean Air” and a land tour element “3N Accommodation in Seoul with Tours”. Given the generality and breadth of the Applicant’s specifications of services, it is clear that there is

an overlap between the services claimed by the Applicant, such as “travel services”, “travel arrangement services”, “travel booking, reservation or information services relating to travel” etc. and the services offered by the Opponent, including through its travel agent partners and through websites online (which consumers can access on their own without a salesperson). The circumstances of the sale of cruises and flights are such that a consumer may obtain both from a brick-and-mortar Singapore travel agency, or from a website, and possibly even within one travel package (such as the Fly-Cruise programme described above).

71 The foregoing considerations in [69] and [70] are such that an average consumer may be confused into thinking that the Applicant’s services emanate from a source that is linked to the Opponent.

72 As regards “**NORWEGIAN CRUISE LINE**” on the one hand, and TM

No. 40201709795R



on the other, my difficulty is that

the two appearances of the word “norwegian” in the latter mark are miniscule. In fact, they are not visible to the naked eye here, and can only just be discerned from the greatly magnified representation in the Annex. The overwhelming impression of the mark to an average consumer of travel services is that of a red-and-white aeroplane. One would struggle to find a common element between “**NORWEGIAN CRUISE LINE**” on the one hand, and



under ordinary circumstances. In an opposition, it is notional use of the opposed mark that is taken into account, and not extreme instances of use (e.g. use of the mark magnified one thousand times). As such, it can hardly be said that there is “*such a similarity between the corresponding*

element that is being used by the defendant on the one hand and by the claimant on the other such that in all the circumstances, it is sufficiently likely to result in the relevant segment of the public being deceived or confused” (SPG at [20]).

73 However, for the purposes of analysis, I also considered the following.

74 Within the combination of “NORWEGIAN” with “CRUISE LINE” (i.e. “**NORWEGIAN CRUISE LINE**”), I have found, at [60] above, that “NORWEGIAN” was the more dominant element than “CRUISE LINE”. However, this does not mean that “NORWEGIAN” is of high distinctiveness; it is simply more dominant than “CRUISE LINE” relatively speaking in the perception of the average consumer. Overall, both the word element “NORWEGIAN” and the mark “**NORWEGIAN CRUISE LINE**” are of relatively low distinctiveness. On the other hand, the dominant component of

TM No. 40201709795R



is *not* the word “norwegian”.

As such, even if one proceeds on the basis that the word element “norwegian” can be seen in the two occurrences of “norwegian.com” in TM No.

40201709795R



, given that their size relative to the rest

of the mark is tiny, the other differences – especially the overwhelmingly dominant representation of a red-and-white aeroplane with the portrait of a person on its tail fin – in the Applicant’s mark are more memorable and would suffice to distinguish it from “**NORWEGIAN CRUISE LINE**”. In Wadlow’s words, “**NORWEGIAN CRUISE LINE**”, which is of “... *low inherent distinctiveness may be protected against precise copying but not against slight*


variations”, such as against the use of




where the

dominant and memorable components of the competing marks also differ markedly. The outcome may be different if “**NORWEGIAN CRUISE LINE**” and the word element “**NORWEGIAN**” were proven to be of a high level of inherent or acquired distinctiveness; and if the dominant component of TM No. 40201709795R were “norwegian” in a much larger font size as to be “outstanding” within the mark, as opposed to being “overwhelmed” by the impression of the red-and-white aeroplane.

75 In summary, as regards “**NORWEGIAN CRUISE LINE**” on the one hand, and TM No. 40201709794W  on the other, there is a likelihood of confusion that the Applicant’s claimed services (in particular, the Overlapping Services) emanate from a source that is linked to the Opponent. However, as regards “**NORWEGIAN CRUISE LINE**” and TM No.

40201709795R , the average consumer in Singapore is not likely to be deceived or confused, mainly because what is memorable about the competing marks differs significantly enough.

Damage

76 In respect of TM No. 40201709794W , the Opponent submits that goodwill would be adversely affected through a diversion of custom. On the other hand, the Applicant submits that the parties are in different fields of industry and are not direct competitors; hence, there can be no damage.

77 As elaborated at [66] above, in the context of an opposition, the use of the Application Marks is notional, and is in relation to the scope of the specifications claimed by the Applicant, and not the scope of actual use by the Applicant. Since there is an overlap between the services claimed by the Applicant and the services offered by the Opponent (see [67] and [70] above), diversion of custom, and therefore damage to the Opponent’s goodwill, is notionally possible when TM No. 40201709794W is used in relation to the Overlapping Services.



78 In respect of TM No. 40201709795R, as I have found no misrepresentation above, it follows that there will be no damage arising from misrepresentation.

Conclusion on opposition under Section 8(7)(a)

79 Section 8(7)(a) of the Act provides that “A trade mark shall not be registered ... **to the extent that** ... its use in Singapore is liable to be prevented ... by virtue of ... the law of passing off ...” (emphasis in bold mine).



80 In respect of TM No. 40201709794W, the opposed specifications should be qualified with the phrase “none of the aforesaid related to cruise services”. This results in restricted specifications for TM No. 40201709794W as set out below.

Class	Specification
35	Advertising; business management; business administration; office functions; organization, operation and supervision of sales promotion incentive programs, frequent flyer programs and customer loyalty programs; retail services, in-flight

	retail services and Internet retail services for tobacco, cosmetics, clothing, watches, wine and liquor, jewelry and sunglasses; <u>none of the aforesaid related to cruise services.</u>
39	Airline services; travel services; air transport services; transport of passengers and goods by automobiles, trains, ships and airplanes; travel booking agency services; travel arrangement services for individuals and groups; travel booking, reservation or information services relating to travel; vehicle rental services; vehicle parking services; courier services; cargo storage and handling services; aircraft chartering services; arranging travel for package holidays; booking and reservation services for travel tours; information services relating to all the aforementioned services; <u>none of the aforesaid related to cruise services.</u>
43	Services for providing food and drink; temporary accommodation; accommodation booking agency services; arranging holiday accommodation; reservation of temporary accommodation, hotel rooms and restaurants; tourist agency and travel agency services for booking accommodation; bar, cafe, snack-bar, cocktail lounge services, provision of food and drinks in airport waiting lounge and restaurant services; <u>none of the aforesaid related to cruise services.</u>

81 With the above qualification to the opposed specifications, the use of TM No. 40201709794W in relation to the qualified services would accordingly not be liable to be prevented by the law of passing off, given the concerns in [70] above.



82 In respect of TM No. 40201709795R, the ground of opposition under Section 8(7)(a) fails. No restriction to the specifications is needed.

Underlying policy considerations

83 In coming to the above conclusions, I had these policy considerations in mind. On the one hand, one should generally be mindful against the overprotection of “Norwegian Cruise Line” because of its low inherent distinctiveness. On the other, because of the scope of the Applicant’s claimed specifications which include the Overlapping Services, and the commonality of the dominant element “Norwegian” in “NORWEGIAN CRUISE LINE” and TM No. 40201709794W, the public should be protected against confusion that the sources are economically linked when TM No. 40201709794W is used in respect of the notional Overlapping Services. Qualifying the Applicant’s specifications above is a solution which addresses the above considerations without sacrificing either one.

Overall conclusion

84 Having considered all the pleadings and evidence filed and the submissions made in writing, I find that the opposition fails under Section 8(4)(b)(i), and, in respect of TM No. 40201709794W, partially succeeds under Section 8(7)(a) but only with the outcome that the opposed specifications are qualified. Protection in Singapore is conferred on TM No. 40201709794W in respect of the restricted specifications set out above and on TM No. 40201709795R in respect of the specifications as claimed.

85 The parties are to bear their own costs.

See Tho Sok Yee
Principal Assistant Registrar

Ms Vicki Heng (Vicki Heng Law Corporation) as instructed, and
Grace Alcasid (Alpha & Omega Law Corporation) for the Applicant;
Mr Kevin Wong and Mr Zhu Yujia (Ella Cheong LLC) for the
Opponent.

ANNEX

