

MediaCorp News Pte Ltd v Astro All Asia Networks PLC
[2009] SGHC 176

Case Number : OS 1192/2008
Decision Date : 03 August 2009
Tribunal/Court : High Court
Coram : Lee Seiu Kin J
Counsel Name(s) : Wun Rizwi and Su Yunwen (KhattarWong) for the appellant; Max Ng and Colin Phan (Gateway Law Corporation) for the respondent
Parties : MediaCorp News Pte Ltd — Astro All Asia Networks PLC

Trade Marks and Trade Names – Grounds for refusal of registration – Whether applicant's trade mark similar to opponent's earlier registered mark – Whether likelihood of confusion on the part of the public – Whether opponent's earlier trade mark was distinctive – Section 8(2) Trade Marks Act (Cap 332, 1999 Rev Ed)

Trade Marks and Trade Names – Grounds for refusal of registration – Whether earlier trade mark well known in Singapore – Whether use of later trade mark would indicate connection between services that later trade mark sought to register for and proprietor of earlier trade mark – Whether likelihood of confusion on the part of the public – Section 8(3) Trade Marks Act (Cap 332, 1999 Rev Ed)

3 August 2009

Judgment reserved.

Lee Seiu Kin J:

1 This is an appeal by Mediacorp News Pte Ltd ("Mediacorp") against the decision of the principal assistant registrar of trade marks (the "PAR"). The respondent, Astro All Asia Networks PLC ("Astro") made (*inter alia*) two trade mark applications as follows^{[\[note: 1\]](#)}:

(a) Trade Mark application number T03/12742A in Class 16, for:

Mark	Class	Specification
Image 1	16	Calendars; folders (stationery); greeting cards; magazines; photographs; posters; printed publications; office requisites (except furniture); letterheads; envelopes; complimentary slips; mailing labels; business cards; pamphlets; catalogues; charts; signboards of paper and cardboard; printed products for packaging purposes; advertising circulars.

[LawNet Admin Note: Image 1 is viewable only by [LawNet](#) subscribers via the PDF in the Case View Tools.]

(b) Trade Mark application number T03/12744H in Class 35 (the "Astro Mark") for:

Mark	Class	Specification
Image 2	35	Consultancy and advisory services relating to business; industrial and business management assistance; business enquiries; business investigations; business management and organisation consulting; business research; business appraisals; publicity; business risk assessment and management; accounting services; business administration services; compilation of business statistics; compilation and provision of commercial information; consultancy and advisory services relating to business mergers and acquisitions.

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2 Mediacorp did not have any registration in respect of Class 16, but was registered under T00/06342B in Class 35 (the "CNA Mark") (on 15 April 2000) for [\[note: 21\]](#):

Mark	Class	Specification
Image 3	35	Advertising material (updating of-); advertising matter (dissemination of-); advertising space (rental of-); artists (business management of performing-); business information; commerce and marketing information; publication of publicity texts; television advertising; television commercials; all included in Class 35.

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3 The PAR dismissed Mediacorp's opposition to both applications with costs and allowed Astro's applications to proceed to registration: see *Astro All Asia Networks Plc v Mediacorp News Pte Ltd* [2008] SGIPOS 13 at [107] (the "Judgment"). Mediacorp's appeal before me is only in relation to Astro's Class 35 application.

4 In its notice of opposition, Mediacorp relied on s 8(1), s 8(2), s 8(3) and s 8(4) of the Trade Marks Act (Cap 332, 1999 Rev Ed) ("the Act"). In response, Astro relied on s 28(1) of the Act in its counter-statement. At the proceedings below, Mediacorp and Astro did not proceed under s 8(1) or s 28(1) of the Act respectively. In the appeal before me, Mediacorp proceeded only on two grounds, viz s 8(2)(b) and s 8(3) of the Act.

Background Facts

5 The PAR set out the following background facts in her Judgment (at [7]-[23]):

7 The Opponents' evidence was declared by Han Chuan Quee, the Opponents' Senior Assistant Vice President (Corporate Services) in 2 statutory declarations dated 20 April 2005 and 7 July 2006 respectively.

8 Mr Han declares that the Opponents own and manage Channel NewsAsia, an English TV news channel established in March 1999 in Singapore. Its second feed, Channel NewsAsia (International), a satellite channel beamed via Asiasat 3S, was launched in September 2000. Channel NewsAsia is headquartered in Singapore and has an extensive network of journalists in 12 Asian cities and key Western capitals, including London, New York, Washington D.C., Paris and Moscow. It provides a staple of news on politics, business and social issues and also features lifestyle programmes.

9 Channel NewsAsia was established with the aspiration to become the authoritative voice of Asia, originating from Asia, covering news from Asia with Asian perspectives. At the time it was established, an Asian-owned all news channel in English did not exist and Channel NewsAsia filled that void. Much publicity was generated locally and overseas before and during the launch of Channel NewsAsia via promotional materials, advertisements and articles in the newspapers and in other local and overseas publications as shown in the exhibits lodged in the statutory declaration.

10 The Opponents are owners of the trade mark "**CHANNEL NEWSASIA**" and "**A**" device in Singapore in classes 35, 36, 38, 41 and 42; and have applications and registrations in other jurisdictions including Australia, Brunei, China, Hong Kong, Indonesia, India, Japan, Korea, Malaysia, Philippines, Thailand, United Kingdom, the United States of America and Vietnam.

11 The deponent states that the Opponents' "**CHANNEL NEWSASIA**" mark has been substantially used in Singapore and other countries in respect of the services covered by the registrations. Channel NewsAsia is viewed by 16.3 million homes and hotels in 19 territories across Asia and has consistently enjoyed a high viewership especially amongst the public in Singapore. The channel is also online at www.channelnewsasia.com and www.cna.tv (Chinese website).

12 The Opponents exhibited materials and feature articles evidencing the use and recognition of the Opponents' mark in Singapore and other countries. They also exhibited the landmark speeches and "live" news conferences from the region that Channel NewsAsia has covered since its inception in March 1999, as well as the prestigious international awards and accolades received for their highly acclaimed documentaries, current affairs and analysis programmes. Channel NewsAsia has also been extensively promoted and advertised over television, the local newspapers and both the local as well as overseas publications, and have actively raised their profile through the organisation of interactive games and tournaments.

13 The Opponents have expended a substantial sum in the advertising and promotion of their Channel NewsAsia mark and the annual expenses for the period between 2000 and 2005 as

extracted from the Opponents' accounting records which have been subjected to statutory audit are:

<u>For Financial Year ended</u>	<u>Singapore \$</u>
31 March 2001	3,886,753
31 March 2002	1,652,261
31 March 2003	1,390,759
31 March 2004	1,021,822
31 March 2005	934,294

14 The annual turnover figures for the period between 2000 and 2005 as extracted from the Opponents' accounting records which have been subjected to statutory audit are as set out:

<u>For Financial Year ended</u>	<u>Singapore \$</u>
31 March 2001	17,254,371
31 March 2002	27,144,565
31 March 2003	21,356,418
31 March 2004	26,315,130
31 March 2005	28,626,685

15 In the statutory declaration in reply filed on 7 July 2006, the Opponents stressed that the Opponents' mark have been used extensively in Singapore and elsewhere over 7 years such that the public have come to recognise the Opponents as the established and authoritative voice of Asian news.

The Applicant's Evidence

16 The Applicants evidence was lodged by Lim Meng Leong, Head Counsel of the Applicants. He states that the Applicants are the region's leading cross-media operator with Direct-To-Home ("DTH") satellite television services in Malaysia and Brunei. It is also the leading commercial radio broadcaster and a major publisher of TV guides and lifestyle magazines in Malaysia.

17 The Applicants are the parent company of the Astro Group of companies and were registered as a foreign company in Malaysia on the 16 September 2003; and operate out of the All Asia Broadcast Centre, a fully-integrated digital broadcast and production complex in Kuala Lumpur. The Applicants have many subsidiary companies operating out of the same complex in

Kuala Lumpur, such as Celestial Pictures, owns the world's largest Chinese film library and its digitally remastered films are released internationally through theatrical, video, television and new media distribution, and the Celestial Movies channels. The Applicants also wholly own MEASAT Broadcast Network Systems Sdn Bhd, which holds a 20-year exclusive licence for direct-to-home ("DTH") satellite transmission in Malaysia.

18 The Applicants derive a greater part of its revenue from subscriptions to its pay-TV services and to a lesser extent, from advertisements through its TV and radio services and distribution of its content assets. The Applicants' services have also extended into interactive and multimedia services including provision of content for mobile telephony. The Applicants' subscription TV service broadcasts 55 channels to more than 1.6million subscribers, or to some 31% of television homes in Malaysia. The Applicants through a joint venture also distribute these services in Brunei; and intend to significantly expand its services to the region in the future with the launch of the MEASAT-3 satellite.

19 The Astro Group operates eight FM terrestrial radio stations in Malaysia, which include the top-ranking stations in key Malay, Chinese, Indian and English vernacular demographics. These stations cumulatively reach over 10 million listeners a week or 62% of all radio listeners in Malaysia, and command over 79% of the radio industry's advertising expenditure. In addition, the Astro Group also packages 17 music channels in 6 languages for distribution over its DTH platform. The Group has also won awards for these services.

20 The Astro Group provides studio infrastructure and airtime sales and programming services for two radio stations in Kolkatta, India. The Group is also active in content origination and during the financial year 2005, it produced 1,300 hours of in-house content in the key Malay, Chinese, English and Indian languages; with further 5,000 hours of subtitling and dubbing.

21 The Group publishes entertainment and lifestyle magazines in Malaysia and produces animated content through its subsidiary, Philippine Animation N.V Group, Philippine's leading animation studio and reportedly one of the world's top animated service providers over the past years. The Astro Group provides interactive TV services and distributes multimedia content to a variety of users through the many communication and mobile devices available today. The Group also offers broadband content through its portal Astro.tv and have 25% stake in a joint venture with MAXIS Communications, an affiliate company and one of Malaysia's leading mobile operators to own 3G spectrum and provide 3G services.

22 The Applicants gave a brief chronology of their significant milestones:

- 2005**
 - Launches broadband portal **Astro.tv**
 - Acquires **Thr.fm**
 - Announces proposed investment in Indonesia Pay-TV Multimedia venture
 - Launches first Bahasa Malaysia publication – **In Trend**
- 2004**
 - Launches iFEEL entertainment magazine
 - Commences broadcast of **Sinar FM** and **XFresh.fm**

- 2003** - Undertakes SE Asia's largest IPO
 - Acquires Celestial Pictures and Philippines Animation Studio Inc
 - Establishes MAESTRO
 - Provides airtime management for India FM radio stations
- 2002** - Launches **VMAG** leisure and lifestyle magazine
- 2001** - First telecast of **Astro** News
- 2000** - **Kristal-Astro** begins transmission in Brunei
- 1999** - Begins production of first Malay feature film
 - Launches Astro Digital Multimedia System
- 1997** - Radio **commences** operations with 5 FM stations
 - Achieves Multimedia Super Corridor status
- 1996** - Completes state-of-the-[art] digital All Asia Broadcast Centre
 - **Astro** commences broadcast with 22 TV channels and 8 themed music channels

23 The Applicants completed their listing on the Kuala Lumpur Stock Exchange on the 23 October 2003. The Applicants are also proprietors of applications and registrations in Malaysia, Brunei, Indonesia and the United Kingdom in classes 16, 25, 35, 36, 38 and 41.

The Decision Below

6 The PAR held that the burden of proof was on Mediacorp to make out the objections raised (Judgment at [\[24\]](#)).

Findings with respect to s 8(2) of the Act

7 Section 8(2) of the Act states:

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

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

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

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

8 With respect to Mediacorp's opposition under s 8(2) of the Act, the PAR observed that Mediacorp had to satisfy the following criteria to make out an objection under that section (Judgment at [\[39\]](#)):

- a) the Opponents have earlier registration which satisfies the definition in section 2 of the Act - this criteria is satisfied for the Opponents have earlier trade marks;
- b) [for section 8(2)(a)] the application mark and the earlier trade marks are identical and the goods of the application mark and of the earlier trade marks are similar;
- c) [for section 8(2)(b)] the application mark and the earlier trade marks are similar and goods of the application mark and of the earlier trade marks are identical or similar;
- d) and there is a likelihood of confusion by virtue of the similarity of the marks and the goods.

9 The PAR found that the marks were not identical as required by s 8(2)(a) of the Act. She did not agree that the CNA Mark and the Astro Mark, when viewed as a whole, contained differences that were so insignificant that they may go unnoticed by an average and reasonably well-informed, observant and circumspect consumer. In arriving at her decision, she took two factors into account. The first was that the presence of words on both marks, though small relative to the size of the devices, was clearly modifications or additions that were not insignificant. The second was that the words in both marks spelt out the corporate names of Astro and CNA and were not insignificant differences that would pass the notice of the consumer (Judgment at [\[45\]](#)).

10 The PAR went on to consider whether the two marks were "similar" within the meaning of s 8(2) (b) of the Act. She found that there was no aural similarity in respect of the two marks (Judgment at [\[50\]](#)). She found that the marks were visually similar because (Judgment at [\[51\]](#)):

What strikes the eye first when looking at the Opponents' and the Applicants' marks are these triangular devices for in both the marks, the devices are much larger in size relative to the words. The Applicants' triangular device is presented in a bold red colour, and the evidence lodged by the Opponents shows that their device is always used in a similarly bold red hue. The words in relation to the devices are placed in a less prominent position - below the devices - giving them a lower visual impact compared to the devices.

The PAR also found the marks to be conceptually similar because (Judgment at [\[54\]](#)):

Visually, the marks have in common a triangular device which looks similar in form and in colour, when in actual use. Many different descriptions have been coined by the Applicants and the Opponents to describe the device: "an incomplete inverted "V", an "A" device, a triangle (being the name of the musical percussion instrument), an incomplete "A", etc. However described or named by the parties, the device in each of the marks is undisputedly a triangular device. Both the Opponents' and the Applicants' marks plainly described might read: "marks with red triangular devices which sit above the corporate name of the respective entity". Conceptually therefore, the marks are quite similar in form and presentation.

11 The PAR also found that there was similarity in respect of the Class 35 services specified by CNA and Astro. The PAR first observed that in the samples exhibited in the statutory declaration made by Han Chuan Quee (senior assistant vice president (corporate services) of Mediacorp), the mark was 'more often than not co-branded with the mark "MEDIACORP News". The "MEDIACORP News" mark appear[ed] more prominently, usually positioned above the "**CHANNEL NEWSASIA**" and device

mark' (Judgment at [57]). Applying the guidelines stated in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 ("*British Sugar*"), the PAR found that Astro's Class 16 goods were not similar to Mediacorp's services. With respect to Astro's Class 35 application, the PAR found that "*there [were] clearly some areas of overlap between [Mediacorp] and [Astro's] Class 35 specifications, especially the services relating to normal commercial activities that businesses engage in, such as provision and preparation of business, commerce and marketing information, production or publication of publicity texts*" (Judgment at [60]).

12 The PAR next considered whether there was a likelihood of confusion on the part of the public in respect of Astro's and Mediacorp's Class 35 services. As Astro had not made use of their mark in Singapore, the PAR considered notional use by Astro of the mark in assessing the likelihood of confusion (Judgment at [66]). The PAR first found that the services offered by Astro and Mediacorp were close with areas of overlap, as Astro derived a part of its revenue from (*inter alia*) distribution of its content assets, which included a news channel (*viz* Astro News) and was involved in content origination (Judgment at [68]). Next the PAR considered the impression given by the marks. She found that the CNA Mark in actual use was 'almost always co-branded with the words "MEDIACORP News" or "MEDIACORP"', citing as examples the exhibits in Mediacorp's statutory declaration in reply of screenshots of news programmes, a motor vehicle presumably belonging to Mediacorp, print matter, note pads, paper and pages from its website (Judgment at [69]-[70]). In the PAR's view, the way the CNA Mark was actually used could give rise to the impression that the CNA Mark included the words "MEDIACORP News" or "MEDIACORP", thus lessening the similarity between the CNA Mark and the Astro Mark (Judgment at [71]). In light of the strong co-branding of the two signs or marks, the PAR found that Mediacorp gave the impression that both marks inevitably had to be used together always, and that therefore, it was unlikely that the average consumer would be confused into thinking that the CNA Mark and Astro Mark emanated from the same source (Judgment at [76]). The PAR further observed that the consumers who read or watched the news were likely to be "quite discerning of the source of news and would have their own preferences as to which channel they would watch (or read)", and that this was particularly true for the consumers which Mediacorp targeted, *ie*, the professionals, managers, executives and businessmen ("PMEBs") (Judgment at [75]).

13 As a result, the PAR held that Mediacorp's opposition under s 8(2)(b) of the Act failed.

Findings with respect to s 8(3) of the Act

14 The PAR held that Mediacorp had to show that all four requirements of s 8(3) of the Act were satisfied. Section 8(3) states:

(3) A trade mark which —

(a) is identical with or similar to an earlier trade mark; and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if —

(i) the earlier trade mark is well known in Singapore;

(ii) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered would indicate a connection between those goods or services and the proprietor of the earlier trade mark;

(iii) there exists a likelihood of confusion on the part of the public because of such use; and

(iv) the interests of the proprietor of the earlier trade mark are likely to be damaged by such use.

15 The PAR held that ss 8(3)(a) and 8(3)(b) were satisfied as the Astro Mark was similar to the earlier CNA Mark, and Astro's Class 16 goods were not similar to Mediacorp's Class 35 services (Judgment at [86]). It was implicit from the Judgment that the PAR's findings with respect to s 8(3) of the Act were only in relation to Mediacorp's opposition to Astro's Class 16 application, and as a result, the PAR's findings with respect to s 8(3) of the Act were not directly relevant for the purposes of the present proceedings. However, for completeness, I will briefly state her findings for the remaining elements of s 8(3) of the Act.

16 The PAR held that the CNA Mark was not a well-known mark in Singapore. She considered two cases, *Mobil Petroleum Company Inc v Hyundai Mobis* ("Mobil Petroleum") [2008] 4 SLR 427 and *Amanresorts Limited v Novelty Pte Ltd* [2008] 2 SLR 32 ("Amanresorts") in arriving at her decision. First, the PAR considered that in *Mobil Petroleum*, the "MOBIL" mark there had attained a well-known status. The opponent there had a presence in Singapore for over a century and had used the "MOBIL" mark since the 1960s. In addition, the opponent there had sales of hundreds of millions of dollars each year and promotional expenditure of more than \$1m per year (Judgment at [92]). Next, the PAR considered that in *Amanresorts* (Judgment at [93]):

[T]he [opponent's] mark enjoyed 2 decades of history, huge sales revenue worldwide (of which more than a third was attributable to the Singapore office), substantial promotional and marketing through travel agents, collaboration with airlines and credit card companies targeting the rich, that they had 20 plus domain names over the internet. There was also evidence led to show the fact that the plaintiff (owners of the **Aman** and **Amanusa** marks) were acknowledged in two domain name dispute decisions before the Administrative panels of the World Intellectual Property Organisation ('WIPO') as being well known as Amanresorts, and that the Aman group was well known in the premium end of the hotel and resort market. [emphasis in original]

On the facts of the case, the PAR opined that although Mediacorp had shown that its services were recognised by a large sector of the relevant population, she was not able to conclude that the CNA Mark was a well-known mark in Singapore "based on the thresholds that have been set in ... *Hyundai Mobis* and *Amanresorts*" (Judgment at [94]). As this test was not satisfied, the PAR did not consider whether the remaining requirements of s 8(3) of the Act were satisfied.

17 The PAR further held that Mediacorp's opposition based on s 8(4) of the Act had no merit, as since there was no confusing similarity between the CNA Mark and the Astro Mark, for the same reasons, there could be no misrepresentation by Astro (if their mark was used) leading or likely to lead the public to believe that the goods or services offered by Astro were that of Mediacorp's (Judgment at [105]).

Mediacorp's Arguments on Appeal

18 Mediacorp raised two main arguments in this appeal to contend that the PAR had erred in arriving at her conclusion.

19 First, Mediacorp argued that the PAR had erred in concluding that there was no likelihood of confusion as she had based her finding on 'an irrelevant consideration of "co-branding"'. It highlighted that the issue was not raised during the hearing below and that therefore, it was not given an

opportunity to submit on this issue.[\[note: 3\]](#) Mediacorp argued the CNA Mark should be viewed as a whole and that there was no basis to include any other element to ascertain whether the relevant public would be confused.[\[note: 4\]](#) Further, in respect of Class 35 services, the "MEDIACORP" logo was positioned at the top right hand corner of the screen during its news broadcast and was not prominent or in close proximity to the CNA Mark (which was at the lower left corner).[\[note: 5\]](#) In any case, Mediacorp argued that even if "MEDIACORP News" was branded together with the CNA Mark, it did not lessen the possibility that some members of the relevant public would assume that the Astro Mark was from the same source as the CNA Mark, due to the confusing similarity between the two marks.[\[note: 6\]](#)

20 Second, Mediacorp argued that the PAR had misapplied the law in determining whether the CNA Mark was well-known in Singapore. Again, Mediacorp highlighted that this issue (as to whether the mark was deemed well-known) was not raised by counsel for either party or the PAR, and stressed that counsel for Astro did not dispute the well-known status of the CNA Mark.[\[note: 7\]](#) Mediacorp highlighted that the facts in *Mobil Petroleum* and *Amanresorts* did not constitute the threshold and that the PAR had failed to consider the considerations laid out in s 2(7) of the Act.[\[note: 8\]](#)

Astro's Arguments on Appeal

21 Astro contended that the marks were not identical or similar. It highlighted that the stylised "A" device in the Astro Mark was a re-worked and updated version of the two earlier versions of the "A logo", both of which were previously registered in Singapore. It also highlighted that the CNA Mark had a hook at the bottom right hand corner, which it argued, was the dominant element of its device as it made the device look like a triangle, and was indeed described by the Intellectual Property Office of Singapore database reports as being a triangle or "triangle angled band"[\[note: 9\]](#). The words beneath the devices were also completely distinct.[\[note: 10\]](#) Both marks were also visually dissimilar because the Astro Mark had two curves on its right limb (derived from the ellipse found in its previous 1996 version) whereas the CNA Mark did not have such curves, but only had a hook on the bottom right hand corner.[\[note: 11\]](#) The CNA Mark also had a flattened top while the Astro Mark had a pointed top. Astro further pointed out that the ordinary consumer would exercise some care and intelligence in the selection of their merchandise, citing *McDonald's Corp v Future Enterprises Pte Ltd* ("*McDonald's Corp*") [2005] 1 SLR 177 at [\[60\]](#).

22 Astro next contended that the services for which it sought to be registered were dissimilar to those which Mediacorp were registered for, taking a line-by-line comparison of the services claimed by Astro and services registered by Mediacorp.[\[note: 12\]](#)

23 As to the issue of confusion, Astro highlighted that there was no evidence filed by Mediacorp to show that there existed a likelihood of confusion and argued that this was a factor to be taken into account.[\[note: 13\]](#) It further highlighted that when Astro applied to register the Astro Mark in respect of Classes 16, 25, 35, 36, 38 and 41, the PAR had never raised the CNA Mark as citation.[\[note: 14\]](#) Furthermore, Mediacorp did not oppose Astro's application to register the Astro Mark in Classes 25, 36, 38 and 41 or oppose Astro's earlier applications in 1996 and 2002.[\[note: 15\]](#) Astro further relied on the PAR's analysis and finding that the CNA Mark was co-branded with "MEDIACORP News" or "MEDIACORP", and argued that the PAR was entitled to consider such fact in arriving at her findings.[\[note: 16\]](#)

24 With respect to s 8(3) of the Act, Astro submitted that the PAR's findings were only in relation

to its Class 16 application to register the Astro Mark. Since the court is only concerned with Astro's Class 35 application here, s 8(3) of the Act was not relevant. However, even if this Court held that the Class 35 services were not similar, Astro argued that the CNA Mark was not well-known, for reasons (*inter alia*) stated by the PAR. Even if the CNA Mark was found to be well-known, Astro argued that use of the Astro Mark in relation to the Class 35 services could not indicate a connection between those services and Mediacorp because the Astro Mark clearly indicated the words "ASTRO ALL ASIA NETWORKS PLC". There could be no confusion, and Mediacorp had not shown that their interests were likely to be damaged by Astro's use of its mark, apart from a bare assertion in Mediacorp's statutory declaration.[\[note: 17\]](#) As such, Astro submitted that Mediacorp did not satisfy the requirements of s 8(3) of the Act.[\[note: 18\]](#)

Issues in this Appeal

25 As alluded to earlier, Mediacorp only proceeded under s 8(2)(b) and s 8(3) of the Act in the appeal before me. I pause to observe the standard of review applicable in the present proceedings. In *Future Enterprises Pte Ltd v McDonald's Corp* [2007] 2 SLR 845 ("*Future Enterprises*"), the Court of Appeal held (at [5]–[7]):

5 On issues (a) [whether the applicant's mark was similar to the opponent's mark] and (b) [whether the goods specified for the applicant's mark were similar to that for which the opponent's mark was registered such that a likelihood of confusion would exist on the part of the public], having regard to the general principles applicable to appeals against findings of fact in trade mark applications, we see no reason why we should disturb the dual findings of fact by the PAR and the trial judge of similarity and likelihood of confusion between the two word marks "MacCoffee" and "McCAFÉ". In *Reef Trade Mark* [2003] RPC 5, Robert Walker LJ considered the function of an appellate tribunal in relation to appeals from the UK Trade Mark Registry, and concluded (at [28]) that "an appellate court should ... show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle". In *SC Prodal 94 SRL v Spirits International NV* [2003] EWHC 2756 (Ch), Laddie J expressed the same sentiments (at [19]) as follows:

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

6 This prudent approach has been unequivocally endorsed in the recent case of *Sunrider Corporation v Vitasoy International Holdings Ltd* [2007] EWHC 37 (Ch) (at [10]). *Such an approach is consistent with established principles relating to appeals from tribunals that are not in the nature of a rehearing, such as an appeal from a decision of the PAR.*

7 The smorgasbord of trade mark cases which has reached the appellate courts demonstrates the innumerable (and subjectively perceived) similarities and differences that can be conjured up and persuasively articulated by an imaginative and inventive legal mind. Expert and experienced judges, such as Laddie J, have described trade mark infringement as "more a matter of feel than science" (in *Wagamama Ltd v City Centre Restaurants plc* [1995] FSR 713 at 732), and Chao Hick Tin JA (as he then was) similarly alluded to it as a matter of "perception" (in *The Polo/Lauren Co, LP v Shop-In Department Store Pte Ltd* [2006] 2 SLR 690 at [35]). *In the light of the highly subjective nature of assessing similarity and the likelihood of confusion, we agree with the*

approach that an appellate court should not disturb the findings of fact of a trade mark tribunal unless there is a material error of principle.

[Emphasis added]

26 It can be seen from the foregoing that the Court of Appeal in *Future Enterprises* held that this court should not disturb the PAR's findings of fact unless there is a "material error of principle". I note however, that the proceedings in *Future Enterprises* was an appeal against the decision of the Registrar of Trade Marks pursuant to s 75(2)(a) of the Act. Rules for such appeals have been promulgated in the form of O 87 of the Rules of Court (Cap 322, R5, 2007 Rev Ed) ("ROC") and r 4(2) thereof provides that an appeal to the court from such a decision shall be "by way of rehearing". The Court of Appeal in *Future Enterprises* did not appear to have considered the effect of this provision. Nevertheless, the fact that such proceedings are "by way of rehearing" does not necessarily mean that the appeal court's decision is unfettered. An appeal from the High Court to the Court of Appeal is similarly by way of rehearing under O 57 r 3(1) of the ROC. However, the Court of Appeal will be slow to upset an exercise of discretion by the trial judge (*Golden Shore Transportation Pte Ltd v UCO Bank* [2004] 1 SLR 6 at [44]). Further, with respect to finding of facts, the Court of Appeal is generally reluctant to interfere because the trial judge is in a better position to assess the veracity and credibility of the witnesses (*Seah Ting Soon trading as Sing Meng Co Wooden Cases Factory v Indonesian Tractors Co Pte Ltd* [2001] 1 SLR 521 at [22]). On the other hand, a distinction is drawn between perception of facts and evaluation of facts, the latter of which an appellate court is in as good a position as the trial court to make an evaluation from primary facts (*Ho Soo Fong v Standard Chartered Bank* [2007] 2 SLR 181 at [20]). However the authorities are clear that the law pertaining to trade mark infringement is unique in that the final analysis is "more a matter of feel than science" (*Future Enterprises* at [7]).

27 Be that as it may, in view of the findings that I have made as set out below, it does not make a difference whether or not the appeal is to be by way of a rehearing. As mentioned earlier, Mediacorp proceeded only on two grounds in this appeal, viz ss 8(2)(b) and 8(3) of the Act, which I now turn to consider.

Opposition Under s 8(2)(b)

28 In relation to the opposition under s 8(2)(b) of the Act, the main issues for determination are:

- (a) whether the Astro Mark is similar to the CNA Mark;
- (b) if so, whether the Astro Mark is to be registered for goods or services identical with or similar to those for which the CNA Mark is protected; and
- (c) if so, whether there exists a likelihood of confusion on the part of the public.

29 As alluded to above, Mediacorp bears the burden of establishing the requirements under s 8(2)(b) of the Act. Further, in *The Polo/Lauren Co, LP v Shop-In Department Store Pte Ltd* ("*Polo/Lauren*") [2006] 2 SLR 690, the Court of Appeal held (at [8]):

[I]f either of the first two conditions is not satisfied there will not be any need to go into the third question of determining whether there exists a likelihood of confusion. Neither does it mean that if the mark and the sign are similar, and they are used on similar goods, that there will *ipso facto* be confusion in the minds of the public. If that was intended, s 27(2)(b) would have been phrased differently. As presently worded, there is no presumption of confusion once the two

aspects of similarity are present.

30 Therefore, it is pertinent for me to consider the first two conditions of similarity before I turn to consider the third condition, as to whether there is a likelihood of confusion in the minds of the public.

Similarity of marks

31 In deciding whether the two marks are similar, the observations of Parker J in *In the Matter of an Application by the Pianotist Company Ltd for the Registration of a Trade Mark* (1906) 23 RPC 774 at 777 (lines 26-33) are apposite:

You must take the two words. You must judge of them, both by their *look* and by their *sound*. You must consider the *goods to which they are to be applied*. You must consider the *nature and kind of customer who would be likely to buy those goods*. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. [emphasis added]

32 The court will therefore consider whether there is conceptual, visual and aural similarity between the registered mark and the applicant's mark. However, the law does not require all three similarities to be made out before the finding that the marks are similar can be made. Instead, the relative importance of each factor will depend on the circumstances at hand, in particular, the goods and the types of marks involved (Bently and Sherman, *Intellectual Property Law* (Oxford University Press, 2009, 3 ed) ("*Bently*") at p 864). Conversely, the fact that one similarity is made out does not necessarily mean that the marks are similar. Instead, regard should be had to the type of marks concerned. In the present case, given that both marks are device marks, visual similarity will usually be the most important factor (*Bently* at p 865; Tan Tee Jim, *Law of Trade Marks and Passing Off in Singapore* (Sweet & Maxwell, 2003) at p 119).

33 When comparing the two marks, what is relevant is the "imperfect recollection" of the customer (*Nautical Concept Pte Ltd v Jeffery Mark Richard* [2007] 1 SLR 1071 at [30]). The court will not compare the two marks side by side and examine them in detail, because "the person who is confused often makes comparison from memory removed in time and space from the marks" (*Caterpillar Inc v Ong Eng Peng (formerly trading as Catplus International)* [2006] 2 SLR 669 at [55]). Further, in examining whether or not there is similarity, the court will not take into account "any external added matter or circumstances", as the comparison is mark for mark (*id*).

Visual similarity

34 With respect to visual similarity, the similarities between the two marks are: (a) the positioning of a triangular or "A" device above the name; (b) the prominence (in size) of the triangular device compared to the name; and (c) the red colour of the device. The main differences are that: (a) the CNA Mark has a *red hook* on the *bottom* part of its right limb whereas the Astro Mark has *two swirls (in blue and yellow)* in the *middle* portion of its right limb; (b) the CNA Mark has a flat top while the Astro Mark has a pointed top; (c) the name in the CNA Mark is proportionately bigger (compared to the device) and protrudes beyond the base of the triangular device whereas the name in the Astro Mark is proportionately smaller and does not protrude beyond the base of its triangular device; and (d) the name in the CNA Mark is distinct from that in the Astro Mark. Indeed, it would seem that the strongest distinguishing feature between the two marks is the presence of two swirls, one blue and one yellow, on the Astro Mark as compared to the presence of a red hook on the CNA Mark.

35 Taking into account that what is relevant is the consumer's "imperfect recollection" and that the marks are not to be compared side-by-side, there seems to be some visual similarity between the two marks, especially since both shared the same general layout (of having an "A" device above their names), colour (red) and have added features on the right limb of the device (the swirls for the Astro Mark and the hook for the CNA Mark). It is quite unlikely that a consumer with imperfect recollection, and further, who is not comparing the two marks side-by-side, will be able to recall the relevant distinguishing features. In light of the above, I agree with the PAR that there was some degree of visual similarity between the two marks.

Aural and conceptual similarity

36 First, it is clear that no aural similarity exists between "Channel NewAasia" and "Astro All Asia Networks Plc".

37 With respect to conceptual similarity, the PAR had summarised how each party had derived their marks. For the CNA Mark (Judgment at [\[52\]](#)):

The Opponents have in their evidence stated how their mark is derived and describe it thus:

Channel NewsAsia's symbol reads as a single red letter "A" in order to heighten the word "Asia" in its name. Both the letter-form and the space within it have been reshaped to form a delta, the symbol for change that aims to capture the profound nature of the Channel's business of capturing change, particularly within Asia. Lowering the crossbar of the "A" to sit at its base creates a unique and distinctive "A". This gives the impression of it rising from the horizon of its base, reflecting in abstraction an emerging Asia. Red was chosen as the symbol's colour because it is striking and bold. Red is also considered an auspicious colour in many Asian cultures.

38 In the case of the Astro Mark (Judgment at [\[53\]](#)):

The Applicants' evidence is that their mark is a stylised "A" device which was derived from its name "ASTRO ALL ASIA NETWORK plc" and the Applicants state that it is an evolved form from the earlier versions of their marks, in particular a 1996 version and a 2002 version which has achieved registration in Singapore. The marks however are registered in the name of Measat Broadcast Network Systems Sdn. Bhd, a wholly owned subsidiary of the Applicants. The Applicants' present mark has two curves which were derived from the ellipse found in the 1996 version and which had been stylized as two bands on the right limb of 2002 version of the mark. The present mark is a product of a re-branding exercise that the Applicants undertook in 2003 to commemorate its public listing.

39 However, the analysis of conceptual similarity will have to be done from the viewpoint of the consumer. It is unlikely that consumers will be able to appreciate the genesis of either mark as stated by the parties (above). Instead, what the consumers will likely conceptualise from seeing both marks is, as the PAR found, "a triangular device ... similar in form and colour" (Judgment at [\[54\]](#)). Furthermore, both marks were devoid of any semantic or symbolic content or meaning that could lead the consumer to distinguish the two marks conceptually. Therefore, I agree with the PAR that the two marks can be said to be conceptually similar, though I should add that I do not think that such conceptual similarity in the present case was a strong factor in the overall analysis of whether the two marks were similar.

40 Given (especially) the visual similarities and the conceptual similarities, I therefore find that the

Astro Mark and the CNA Mark are similar.

Similarity of services

- 41 The relevant factors for assessing similarity of goods and services are (*British Sugar* at 296):
- (a) the respective uses of the respective goods or services;
 - (b) the respective users of the respective goods or services;
 - (c) the physical nature of the goods or acts of service;
 - (d) the respective trade channels through which the goods or services reach the market;
 - (e) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves; and
 - (f) the extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

The above factors were adopted in *Johnson & Johnson v Uni-Charm Kabushiki Kaisha (Uni-Charm Corp)* [2007] 1 SLR 1082 at [14]. These factors need not be all satisfied before the goods or services can be treated as similar (*id* at [\[18\]](#)). In the present proceedings, the fifth factor is not relevant.

42 Here, it cannot be said that the services sought by Astro were dissimilar to those that Mediacorp had registered for. Class 35 services are generally those that “directly assist in the operation or management of the commercial enterprise of another entity” (Marshall, *Guide to the Nice Agreement Concerning the International Classification of Goods and Services* (Oceana Publications Inc, 2000) at p 168). There are clearly similarities between the services which Astro sought to be registered for and those which Mediacorp was already registered for. For example, Astro applied to be registered for “Publicity” services when Mediacorp was already registered for (*inter alia*) “advertising matter (dissemination of)”, “television advertising/commercials” and “advertising space (rental of)”. In another example, Astro applied to be registered for “business research”, “compilation of business statistics” and “compilation and provision of commercial information” when Mediacorp was registered for providing the services of “business information” and “commerce and marketing information”. For both examples, it is likely that the respective end users are similar, and that the services will be used in a similar fashion. As such, I agree with the PAR that the Class 35 services which Astro seeks to be registered are similar to those which Mediacorp had been registered for.

Likelihood of confusion on the part of the public

43 The following principles as to what constitutes “likelihood of confusion” can be distilled from the cases:

- (a) The court is entitled to look outside the mark and the sign, as well as the articles, to assess whether there exists a likelihood of confusion (*Polo/Lauren* at [8]).
- (b) The question of likelihood of confusion has to be looked at globally taking into account all the circumstances including (*Polo/Lauren* at [28]):

- (i) the closeness of the goods;
 - (ii) the impression given by the marks;
 - (iii) the possibility of imperfect recollection;
 - (iv) the risk that the public might believe that the goods come from the same source or economically-linked sources;
 - (v) the steps taken by the defendant to differentiate the goods from those of the registered proprietor; and
 - (vi) the kind of customer who would be likely to buy the goods of the applicant and opponent.
- (c) One should not determine the likelihood of confusion based on the man in a hurry, and the test should be the "ordinary, sensible members of the public" (*Polo/Lauren* at [31]). The average consumer is someone who would exercise some care and good sense in making his purchases (*Polo/Lauren* at [34]). However, the "average consumer" need not necessarily mean the general public, as more specialised products might be purchased by a more specific cross-section of the public (*Nation Fittings (M) Sdn Bhd v Oystertec Plc* [2006] 1 SLR 712 at [97]).
- (d) The ambit of the protection offered by the Act to a registered proprietor of a trade mark should be guided by the underlying aim of the trade marks regime, which is to ensure that consumers do not confuse the trade source of one product with another (*Polo/Lauren* at [32]). The policy of s 8 of the Act is to protect the public against deception. In *Weir Warman Ltd v Research & Development Pty Ltd* [2007] 2 SLR 1073, V K Rajah JA observed that (at [41]):

It is plain that the trade mark register is intended to be a comprehensive and accurate record of trade marks currently in use. As such, it is crucial to maintain the accuracy of the register and to ensure that undeserving and invalid trade marks are removed from the register without undue delay and complication. *In addition, the register is meant to assure and endorse the function of registered trade marks as badges of origin ... so as to protect the public against deception. Hence marks that are misleading or likely to cause confusion or no longer serve their function should not be accepted or allowed to remain on the register, as the case may be.*

[Emphasis added]

To this end, mere association which the public may make between two trade marks because of their semantic content is not in itself a sufficient basis for concluding that there is a likelihood of confusion, in the absence of any possibility of a misapprehension as to the origin of the goods and services (*Richemont International SA v Da Vinci Collections Pte Ltd* ("*Richemont*") [2006] 4 SLR 369 at [20]).

- (e) The greater the exposure and use of a particular registered mark, the greater its reputation is likely to be, and therefore the greater the protection likely to be afforded to it (*Polo/Lauren* at [34]).

Mark was used in a manner whereby it would be remembered as “MEDIACORP News” + “CHANNEL NEWSASIA” + the red triangular device’. Such strong co-branding meant that the average consumer would unlikely be confused into thinking that the Astro Mark and the CNA Mark originated from the same source. However, in the screenshots of Mediacorp’s news programmes, the “MEDIACORP” logo was placed as a *translucent watermark* on the top right hand corner of the screen, whereas the “CHANNEL NEWSASIA” logo and its “A” device were placed on the bottom right hand corner of the screen *in bold*. In addition, the “MEDIACORP” logo was absent from Mediacorp’s website (as reflected in statutory declaration in reply filed by Mediacorp’s employee) between year 1999 and 2000.[\[note: 19\]](#) Given the distance between the two logos, the translucent nature of the “MEDIACORP” logo in the television medium, and the fact that the “MEDIACORP” logo was absent from its website for a period of time, I do not think that the PAR was correct to rely on the fact of co-branding to find that there did not exist a likelihood of confusion.

45 As the PAR had, in my view, applied the wrong test in considering confusion, I turn to consider the relevant circumstances which may affect the likelihood of confusion amongst the public. I would first observe that the present proceedings were in relation to Class 35 services only, that is to say, the issues (and consequently my findings of confusion or otherwise) should be seen in the context of Class 35 services claimed by Astro or registered by Mediacorp only. This is, in my view, an important distinction. If an opposition had been brought under Class 41 (which the CNA Mark is registered under) for the provision of education or entertainment related services, the considerations (such as the users of the goods and their respective trade channels) and result could differ from the present case.

46 Mediacorp’s submissions on the issue of confusion were three-fold. First, it highlighted that its target crowd of PMEBS would not have the luxury of engaging in a minute analysis of the marks when reading or watching the news. Similarly, a large proportion of the channel’s viewers would be of other backgrounds and educational levels. Applying the principle of imperfect recollection and taking into account that the average consumer normally perceives a mark as a whole, the two marks were therefore confusingly similar.[\[note: 20\]](#)

47 Second, Mediacorp submitted that given the similar nature of goods and services from both parties, the similar trade channels utilised (mass media, print and television), and the fact that Astro was a direct competitor of Mediacorp, the likelihood of confusion was very real.[\[note: 21\]](#)

48 Third, Mediacorp submitted that its CNA Mark was inherently distinctive because: (a) the mark was unique and devoid of any descriptive elements; (b) the word “NEWSASIA” was an invented word; and (c) the “CHANNEL NEWSASIA” words did not describe the services which it had registered for under Class 35.[\[note: 22\]](#) Further, Mediacorp submitted that the CNA Mark had acquired a distinctive reputation through extensive use in Singapore over the years, given that it was a free-to-air channel which had been used for almost ten years.[\[note: 23\]](#) Given its distinctive nature, there was a greater likelihood of confusion because the CNA Mark is well-known and immediately recognisable in Singapore and the public would assume that the Astro Mark belonged to Mediacorp given the lack of any significant differentiating aspects in the Astro Mark. Further, Mediacorp highlighted that the average consumer would rarely have the chance to compare the two marks directly, and that when the marks are presented to them through the medium of television, the average consumer would not have an opportunity to analyse the marks in detail and discern the differences between the marks.

49 I now consider the *Polo/Lauren* factors (see above at [43(b)]). I have already found that the services sought by Astro and registered by Mediacorp are similar and that the two marks are similar visually. However, the fact that the marks and services are similar does not necessarily mean that

there exists a “likelihood of confusion”. In *Polo/Lauren*, the Court of Appeal held (at [8]):

In a broad sort of sense, the greater the similarity between a mark and a sign, the greater will be the likelihood of confusion ... [It does not] mean that if the mark and the sign are similar, and they are used on similar goods, that there will *ipso facto* be confusion in the minds of the public. If that was intended s 27(2)(b) [in *pari materia* with s 8(2)(b)] would have been phrased differently. *As presently worded, there is no presumption of confusion once the two aspects of similarity are present.* To determine the existence of confusion, the court is entitled to look outside the mark and the sign, as well as the articles, to assess whether there exists a likelihood of confusion ...

[emphasis added]

50 Therefore, I turn to consider who the “average consumer” of these Class 35 services would be. In this respect, both Astro and Mediacorp agreed that these Class 35 services would be provided to businesses and organisations and not ordinary or retail customers^[note: 24]. As such, the average consumer(s) is not the general population at large, but are commercial enterprises seeking publicity services and/or business organisation services. Even though the marks and services are similar, in my view, there is no real likelihood that these average consumers will be confused if the Astro Mark is allowed to be registered. In this respect, it is important to note that the distinguishing features (yellow and blue swirls against a red limb versus a red hook, pointed top versus flat top) are easily recognisable, especially to an observer who takes care in his purchases. The Astro Mark has not been put in use within Singapore thus far and I am entitled to consider the notional use of the mark by Astro in the context of Class 35 services. Although the words in the Astro Mark are small in relation to the device mark, it is in my view highly unlikely that Astro will, in providing Class 35 services, rely on a miniscule Astro Mark (which will render the name of Astro under the “A” device too small to be read), or will not include other features which would clearly identify the service as being provided by Astro. In Astro’s statutory declaration, the screenshot of the website shows the name “ASTRO ALL ASIA NETWORKS plc” clearly displayed on the top^[note: 25], while its corporate stationery had suitably-sized Astro Marks which allowed any person who comes across it to easily observe the words “ASTRO ALL ASIA NETWORK plc” under the “A” device.^[note: 26] Indeed, on these stationery, the words appear to have been enlarged, for they stretch beyond the base of the “A” device. Furthermore, and most importantly, these business enterprises are discerning in making their choices and will be careful especially when it comes to choosing their service provider for services relating to publicity and/or business-related information. As a result, it is highly unlikely that these consumers will confuse one for the other. In this regard, it is noteworthy that the test is not satisfied if it is only a person in a hurry who would be misled. The question is whether there is a *real prospect* that “ordinary sensible members of the public” will be confused (*Richemont* at [25]). The issue of confusion must be decided in the context of the purpose of providing such statutory protection, which is to ensure that consumers do not confuse the trade source of one with the other. For the reasons given above, I do not think that such protection is warranted in the present case, in respect of the Class 35 services. I therefore hold that there will not be a likelihood of confusion on the part of the public.

51 I will deal briefly with Mediacorp’s argument that its mark was distinctive on its own, or by its use, and therefore warranted extra protection. It would seem to me that whether a mark is distinctive (or not) is a relevant consideration. In *Polo/Lauren*, one of the considerations which the Court of Appeal took into account in assessing whether there was confusion was this issue of distinctiveness. The Court of Appeal opined (at [34]):

It stands to reason that the greater the exposure and use of a particular registered mark, the

greater its reputation is likely to be, and therefore the greater the protection likely to be afforded to it.

52 This is in contrast to the decision in *McDonald's Corp* where the Court of Appeal held (at [64]-[65]):

With widespread education and a public which is constantly exposed to the world, either through travel or the media, one should be slow to think that the average individual is easily deceived or hoodwinked. In fact, the very success of the appellant, which is inseparable from its logo, is also the very reason why confusion is unlikely. We would stress that the things that lead a consumer to a restaurant of the appellant's and its products are its unique logo and its main mark "McDonald's". Here, we would like to reiterate what this court said in *Super Coffeemix Manufacturing Ltd v Unico Trading Pte Ltd* [2000] 3 SLR 145 at [46] as to the sense of an ordinary purchaser:

In the case of an educated consumer he would be able, without difficulty, to differentiate one from the other. In the case of an illiterate consumer ... who goes by what he sees on the packaging, then as the graphic designs of the two packaging are quite distinct, it is doubtful that he is likely to be misled. We would further say that the fact that a consumer is Chinese educated does not mean that he does not possess the usual faculties to differentiate.

While we recognise that in oral communications the public will refer to FE's products as "MacTea" rather than the "tea with the eagle device", we think whatever impression that may arise will evaporate immediately upon seeing the product in a supermarket. That is the critical moment. This is because a person with "MacTea" in mind will be seeing the actual product at the time of purchase and at that point he would not have failed to see the entire trade mark. If at all he had any thought that "MacTea" might be related to "McDonald's", that impression would have been dispelled by then.

53 Even if I accept that the CNA Mark is distinctive by use, for reasons I gave above (at [0]), and further since the present opposition is only in relation to Astro's Class 35 services only, I do not think that the fact of distinctiveness will lead to any real likelihood of confusion in the present case and I so find.

54 Therefore, Mediacorp fails in its opposition to the registration of the Astro Mark under s 8(2) of the Act. I now turn to consider Mediacorp's opposition under s 8(3) of the Act.

Opposition under s 8(3)

55 An opposition under s 8(3) of the Act pertains to the situation where the trade mark is to be registered for goods and services which are not similar to those for which the earlier trade mark is protected. The protection regime in s 8 of the Act of the 2005 revised edition (the "Amended Act") covers the following categories:

- (a) identical trade marks for identical goods or services – s 8(1);
- (b) identical trade marks for similar goods or services, or similar trade marks for identical or similar goods or services – s 8(2);
- (c) where an application for registration of trade mark is made before 1 July 2004, identical or similar trade marks for dissimilar goods or services – s 8(3); and

(d) where an application for registration of a trade mark is made on or after 1 July 2004, the whole or an essential part of the trade marks are identical or similar with no restriction on goods and services – s 8(4).

56 The greater the similarities between the trade marks in question and the stronger the connection between the nature of the goods or services registered or to be registered for, the lower is the threshold for opposition. Hence, under s 8(1), the registration of a later identical trade mark will be prohibited if it is for identical goods or services, without any requirement to show connection or confusion. In that sense, it can be said that confusion is presumed. Where an identical trade mark is to be registered for similar goods or services, or a similar trade mark for identical or similar goods or services, s 8(2) prohibits registration only if “*there exists a likelihood of confusion on the part of the public*”. The threshold rises when it concerns identical or similar trade marks for *dissimilar* goods or services and all the factors set out in s 8(3) have to be satisfied, in particular, that the earlier mark is well-known in Singapore and that the interests of the proprietor of the earlier mark are likely to be damaged by such use. The fourth category deals with the situation where the whole or an essential part of the trade marks are identical or similar, without limitation in respect of the goods or services for which they are, or are to be registered.

57 Under s 8(4) of the Amended Act, there are two alternate ways in which an opposition to registration of a trade mark may succeed. The first limb, under s 8(4)(b)(i), is where use of the later trade mark for goods or services for which it is sought to be registered 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 mark. At first glance, it would appear that while both ss 8(3) and 8(4)(b)(i) require the opponent to show “connection” and “damage”, there is no express requirement for confusion to be shown under s 8(4)(b)(i). Therefore, it may be argued that s 8(4)(b)(i) imposes a lower threshold than s 8(3), taking a literal view of the provisions. However, it should be noted that ss 8(3) and 8(4) are not cumulative provisions: the former applied to applications made before 1 July 2004 and the latter applies to applications made on or after 1 July 2004. Further, in *Novelty Pte Ltd v Amanresorts Ltd* [2009] SGCA 13, the Court of Appeal took the view that (at [226]):

The “damaging connection” condition in s 8(4)(b)(i) and s 55(3)(a) of the current TMA will be satisfied only where there is a confusing connection between the plaintiff and the defendant’s goods or services (*ie*, only where there is confusion) because non-confusing connection is covered by the “unfair dilution” condition in s 8(4)(b)(ii)(A) and s 55(3)(b)(i).

For the purposes of this present proceedings, it is not necessary to discuss whether and how the implicit requirement of “confusion” under s 8(4)(b)(i) differs from that expressly required under s 8(3).

58 The second limb, under s 8(4)(b)(ii) imposes a higher threshold by requiring the earlier trade mark to be “well-known to the *public at large* in Singapore” (not just being “well-known in Singapore”), and further, to show “dilution” or “unfair advantage”.

59 In the present case, I have found that the goods or services pertaining to the Astro Mark and CNA Mark are similar. However in the event that the finding is that they are dissimilar, CNA submits that registration ought to be prohibited under s 8(3). The main issues for determination are:

- (a) whether the CNA Mark is well-known in Singapore;
- (b) if so, whether use of the Astro Mark in relation to the goods and services for which it is sought to be registered would indicate a connection between those goods and services and

Mediacorp;

(c) if so, whether there exists a likelihood of confusion on the part of the public because of such use; and

(d) if so, whether Mediacorp's interests are likely to be damaged by such use.

60 The PAR relied on the facts of *Amanresorts* and *Mobil Petroleum* and took the facts of the two cases as thresholds for well-known marks. In my view, the PAR was mistaken, as nowhere in either judgment was it suggested that the facts in those cases were to be regarded as the threshold for a well-known mark. Section 2(7) of the Act (which is different from that (the Amended Act) applied in *Amanresorts*) states:

[I]n deciding, for the purposes of this Act, whether a trade mark is well known in Singapore, one shall take into account the extent to which the trade mark is known within the relevant sector of the public, whether as a result of the promotion of the trade mark or any other reason.

61 On the facts of the present case, it would seem to me that the CNA Mark would qualify as a "well-known mark" within the meaning of the Act. In Mediacorp's statutory declaration, there was an article on "Cable Quest" (October 2001) titled "12 Million Viewership, Two Years Ahead of Plan", in which it was stated that^[note: 27]:

According to Taylor Nelson Sofres, an independent market research company, in the current US Crisis, Channel NewsAsia reached up to 46% of PMEBs a day, or 35% (1.3 million) of the total population in Singapore. Also, the programme ratings of Channel NewsAsia are three-and-a-half times higher than its closest competitor, among the various news channels available on Cable. [Emphasis added]

62 Indeed, Astro did not seriously contend that the CNA Mark was not well-known in its submissions below. In its submissions before me, Astro relied on the reasons given by the PAR (which I have rejected) to argue that the CNA Mark was not well-known. Astro did not dispute the evidence found in Mediacorp's statutory declaration as to its viewership and penetration within the Singapore market. Furthermore, the evidence showed that Mediacorp had expended considerable amounts of money in advertising and promoting the CNA Mark, especially in its initial years (see Judgment at ^[13]), and that the CNA Mark has been used extensively in Singapore since its inception. In light of the above undisputed evidence, it seems to me that the CNA Mark has satisfied the requirements of being 'well-known' under the Act, and I decide accordingly.

63 The second factor is whether the use of the Astro Mark would indicate a "connection" between the Astro goods and services and Mediacorp. Before the PAR, Mediacorp's submission was that^[note: 28]:

[S]ince the services provided by [Astro] covered under the subject application *overlaps* with [Mediacorp's] services, we submit that there would be a connection drawn by the public between the services covered under the [Astro] Mark and the [CNA] Mark.

[Emphasis added]

I pause to observe what appears to be a fallacy in this submission. If the services sought by Astro overlaps with that of Mediacorp's, the services of both organisations would be similar and this would bring the matter out of the situation envisaged in s 8(3)(b) of the Act, which pertains to goods or

services that are “*not similar to* those for which the earlier trade mark is protected”.

64 On the assumption that the goods or services are not similar, the question is whether the use of the Astro Mark in relation to the goods and services in Class 35 would indicate a connection between those goods or services and Mediacorp. In my view, on the basis that although the Astro Mark and CNA Mark are similar, the degree of similarity in the context of the intended consumers of the goods or services are such that a connection would not be indicated.

65 In any event, even if I were wrong in relation to the “connection” factor, in view of my holding at [50] above that there is no likelihood of confusion on the part of the public, the same holding must obtain in relation to the opposition under s 8(3). As such, Mediacorp also fails in its opposition to the registration of the Astro Mark under s 8(3) of the Act.

Conclusion

66 Accordingly, I dismiss Mediacorp’s appeal. Unless there is any other reason to order otherwise (in which case I will hear counsel on the question of costs), the costs of this appeal will follow the outcome, to be taxed on the standard scale if not agreed.

[\[note: 1\]](#)Applicant’s bundle of documents (“ABOD”), vol 1 at p 26

[\[note: 2\]](#)ABOD vol 1 at p 6

[\[note: 3\]](#)Appellant’s Written Submissions (“AWS”) at [4]

[\[note: 4\]](#)AWS at [5]

[\[note: 5\]](#)AWS at [6]

[\[note: 6\]](#)AWS at [7]

[\[note: 7\]](#)AWS at [9]

[\[note: 8\]](#)AWS at [10]

[\[note: 9\]](#)AWS at [30]

[\[note: 10\]](#)AWS at [31]

[\[note: 11\]](#)AWS at [32]

[\[note: 12\]](#)AWS at [38]-[39]

[\[note: 13\]](#)AWS at [43]

[\[note: 14\]](#)AWS at [44]

[\[note: 15\]](#) AWS at [46]

[\[note: 16\]](#) Respondent's Written Submissions ("RWS") at [47]-[48]

[\[note: 17\]](#) RWS at [60]

[\[note: 18\]](#) RWS at [61]

[\[note: 19\]](#) ABD vol 2 at pp 616-622

[\[note: 20\]](#) Opponent's Submissions ("OS") at [11] (ABD vol 3 at 632)

[\[note: 21\]](#) OS at [16] (ABD vol 3 at 634)

[\[note: 22\]](#) AWS (dated 20 April 2009) at [29]

[\[note: 23\]](#) AWS (dated 20 April 2009) at [30]

[\[note: 24\]](#) AWS (dated 20 April 2009) at [24]-[25]; Respondent's Written Submissions ("RWS") (dated 17 April 2009) at p 12

[\[note: 25\]](#) ABD vol 2 at p 285

[\[note: 26\]](#) ABD vol 2 at pp 395-398

[\[note: 27\]](#) ABD vol at 164

[\[note: 28\]](#) ABD vol 3 at 639 (at [32])

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Image 1



Image 2



Image 3