

## THE EXTRANEOUS FACTORS RULE IN TRADEMARK LAW: AVOIDING CONFUSION OR SIMPLY CONFUSING?

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The Singapore Court of Appeal's recent decision in *Staywell* clearly signalled a rejection of the European "global appreciation approach" when evaluating trademark infringement. By adopting a pro-mark ethos, the Court had chosen to ignore certain factors that might affect the consumers' purchasing decision by excluding extraneous factors that could potentially negate the finding of likelihood of confusion based solely on marks-similarity and goods-similarity. This article argues that Singapore courts could consider American jurisprudence when examining "likelihood of confusion" under trademark infringement claims, such as an evaluation of the *Polaroid* factors, to discern factors which have an impact and effect on the consumers' purchasing decision in order to better illuminate whether the average consumer is likely to be confused. It proposes a four-stage test which integrates the US likelihood of confusion factors into the autochthonous approach advanced in *Staywell*. Not only is this formulation consistent with the wording of the *Trade Marks Act*, it would strike a better balance between protecting the proprietary right of the registered mark owner and promoting entrepreneurship and business certainty in a manner that is consonant with consumer purchasing behaviour.

### I. INTRODUCTION

The recent Singapore Court of Appeal ("SGCA") decision in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc*<sup>1</sup> concerning trademark opposition under section 8(2)(b) of the *Trade Marks Act*<sup>2</sup> is a significant departure from the English, as well as European, approach to determining trademark infringement. This article discusses the question of whether the likelihood of confusion factors as applied in the US Circuit Courts could be considered in Singapore under the "extraneous factors rule". This question is especially relevant as: first, the current state of the law is unsatisfactory as the definition of "extraneous factors" is vague and thus causes uncertainty; and second, the *Staywell* decision is problematic as it does not accord sufficient weight to the conditions under which consumers make

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<sup>1</sup> *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 (CA) [*Staywell*].

<sup>2</sup> *Trade Marks Act* (Cap 332, 2005 Rev Ed Sing) [*TMA*].

their purchasing decisions. Additionally, the current predicament is compounded by the dearth of critical academic analysis in the three leading local textbooks in Singapore.<sup>3</sup> It is thus the authors' aim to present an alternative model to the "extraneous factors" rule to resolve the present difficulties.

Part II briefly outlines the functions of trademarks and the role of trademark law. It will be shown that the main policy objective of trademark law is to protect the function of trademarks by preventing consumer confusion in the marketplace. Further, this article will dissect a classic trademark infringement case to illustrate how the law achieves its objectives. This entails a discussion of the definition of trademark infringement and how courts interpret damage in relation to the harm caused to businesses and consumers.

Part III analyses the present Singapore approach in trademark infringement and opposition, focusing particularly on the *Staywell* decision. Beginning with the Singapore framework laid down in the SGCA decision of *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd*,<sup>4</sup> the authors will then provide a discussion and critique of what the "extraneous factors" rule entails.

Part IV examines the multi-factor approach of determining whether confusion is likely in trademark infringement and opposition in the United States ("US") under sections 32(1)(a) and 2(d) of the *Lanham Act* respectively.<sup>5</sup> This part seeks to establish a common denominator between the Circuits and to evaluate the merits of the US approach.

Part V advances a four-stage test that incorporates the US approach into the *British Sugar* "step-by-step" framework.<sup>6</sup> This model will be evaluated to determine whether it is likely to be a meaningful contribution to Singapore trademark law which furthers its main purpose of preventing consumer confusion, and whether the proposed approach would promote certainty for the business community. The test will be applied to the facts of two SGCA decisions—*Staywell* and *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier*<sup>7</sup>—to demonstrate that while the more nuanced approach might not yield a different result, it could improve how future cases are decided by providing better insights into the consumer purchasing decision-making process, and more importantly, bring consumer confusion to the foreground of the inquiry.

Part VI concludes that by rejecting the use of extraneous factors to negate a finding of confusion, this approach creates a virtually irrebuttable presumption of

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<sup>3</sup> See Susanna Leong, *Intellectual Property Law of Singapore* (Singapore: Academy Publishing, 2013) (Chapter 28 mainly discusses the Singapore framework in the context of section (8)(2) with only a brief analysis of what extraneous factors entail); Ng-Loy Wee Loon, *Law of Intellectual Property of Singapore* (Singapore: Sweet & Maxwell, 2014) [Ng-Loy, *Law of IP*] (Chapter 21 discusses the ambit of s 8(2) briefly and chapter 23 only touches fleetingly on the confusion inquiry under trademark infringement pursuant to ss 27(2), 27(3)); and Tan Tee Jim SC, *Law of Trade Marks and Passing Off In Singapore*, 3rd ed (Singapore: Sweet & Maxwell, 2014) (Chapter 12 deals with trademark infringement, focusing on "likelihood of confusion on the part of the public", but it merely sets out the legal position in Singapore rather than critically evaluate the correctness of the *Staywell* approach) [Tan, *Law of Trade Marks*].

<sup>4</sup> *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2006] 2 SLR (R) 690 (CA) [*Polo (CA)*].

<sup>5</sup> *Lanham Act*, 15 USC §§1051-1141n.

<sup>6</sup> *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 (Ch) [*British Sugar*].

<sup>7</sup> *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 (CA) [*City Chain*].

confusion once marks-similarity and goods-similarity are found. As trademark law serves to avoid consumer confusion so as to enable trademarks to perform its source-identification function, it is crucial that the likelihood of confusion test is focused primarily on the consumer. One should be careful that a pro-mark ethos does not translate into an anti-competitive environment for businesses.

## II. THEORETICAL UNDERPINNINGS OF TRADEMARK LAW

Section 2(1) of the *TMA* defines a “trade mark” as “any sign capable of being represented graphically and which is *capable of distinguishing goods or services*”.<sup>8</sup> This definition is consonant with a trademark’s primary function of serving as a source identifier to distinguish between competing products in the market, so that consumers would be able to recognise the origin of the product when they encounter a particular mark.<sup>9</sup> A corollary of a trademark’s traditional source-identification function is that as a guarantee of quality and shorthand for product information in the marketplace.<sup>10</sup> Companies today also use trademarks extensively in brand development, creating a multi-billion dollar industry built on cultivating consumer desire and loyalty, as “[t]rade marks and branding now are recognised as key components in a company’s business strategy.”<sup>11</sup>

Given how trademarks are used, the obvious injury trademark owners would suffer if competitors were allowed to use confusingly similar marks was elegantly summarised by Professor Ng-Loy Wee Loon who observed that “[t]he presence in the marketplace of a junior mark that is confusingly similar to the senior mark destroys the badge-of-origin and badge-of-quality functions of the senior mark.”<sup>12</sup> Trademark law is widely accepted as operating to protect “both the trademark or trade dress owner and the public by avoiding confusion”.<sup>13</sup> This fundamental goal of avoiding confusion is enshrined in the *TMA*<sup>14</sup> and was emphasised by the SGCA in *Mobil Petroleum Inc v Hyundai Mobis*,<sup>15</sup> where Chao JA cautioned that “[w]e ought not to lose sight of the fact that a trade mark law is aimed at preventing confusion and deception, *i.e.*, to ensure that consumers do not confuse the trade source of one product with another.” It is therefore unsurprising that the likelihood

<sup>8</sup> *TMA*, *supra* note 2, s 2(1). See also the definition of “sign” under the same section, which “includes any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape, colour, aspect of packaging or any combination thereof”.

<sup>9</sup> Leong, *supra* note 3 at paras 27.025-27.027.

<sup>10</sup> *Ibid* at paras 27.028, 27.029. See also *Scandecor Developments AB v Scandecor Marketing AB and Others* [2001] UKHL 21 at para 18.

<sup>11</sup> *Singapore Parliamentary Debates, Official Report* (15 June 2004) vol 78 at col 110 (Professor S Jayakumar, Minister for Law); See also *O2 Holdings Ltd (formerly O2 Ltd) v Hutchinson 3G Ltd* [2006] EWHC 534 (Ch) at para 4; David Tan, “The Semiotics of Alpha Brands: Encoding/Decoding/Recoding/Transcoding of Louis Vuitton and Implications for Trademark Laws” (2013) 32 *Cardozo Arts & Ent L J* 225 at 226-228.

<sup>12</sup> Ng-Loy Wee Loon, “The Sense And Sensibility In The Anti-Dilution Right” (2012) 24 *Sing Ac LJ* 927 at para 3. See also Keith M Stolte, “How Early did Anglo-American Trademark Law Begin? An Answer to Schechter’s Conundrum” (1998) 8 *Fordham IP Media & Ent LJ* 505.

<sup>13</sup> *I.P. Lund Trading ApS v Kohler Co*, 163 F.3d 27 at 36 (1st Cir 1998).

<sup>14</sup> *TMA*, *supra* note 2, ss 8(2), 27(2).

<sup>15</sup> *Mobil Petroleum Co, Inc v Hyundai Mobis* [2010] 1 SLR 512 at para 33 (CA) [*Mobil*]. See also *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 at para 61 (CA) [*Sarika*].

of confusion inquiry is the cornerstone of trademark opposition and infringement under sections 8(2) and 27(2) of the *TMA*. This test, which unfortunately has been described as “highly subjective”,<sup>16</sup> “a matter of perception”,<sup>17</sup> and “more a matter of feel than science”,<sup>18</sup> seeks to determine whether consumers are likely to confuse the origin of the plaintiff’s and defendant’s goods or assume some of economic link or connection between the goods by virtue of marks-similarity and goods-similarity.<sup>19</sup> Indeed contemporary trademark law in Commonwealth jurisdictions lacks a well-developed theory of the consumer and, specifically, of consumer sophistication.<sup>20</sup> However, this article does not seek to interrogate the coherence of a consumer-centric theoretical framework for trademark law, but instead makes a modest suggestion that the fields of “cognitive and consumer psychology” have “much to offer those interested in trademark law”,<sup>21</sup> and that the evaluation of the extraneous factors rule is conducted in the shadows of such influences.

### III. LIKELIHOOD OF CONFUSION IN SINGAPORE

#### A. The Singapore Framework

In order to succeed in an action for trademark infringement, the plaintiff must show that there is a likelihood of confusion on account of the similarity in marks and goods and services in accordance with section 27(2) of the *TMA*:

A person infringes a registered trade mark if, without the consent of the proprietor of the trade mark, he uses in the course of trade a sign where because —

(a) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered;

or

(b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered,

there exists a likelihood of confusion on the part of the public.<sup>22</sup>

It is clear from the legislative text that under Singapore law, the two threshold requirements for successfully establishing liability for infringement are similarity of the marks *and* similarity of the services. This legislative wording is similar to the provision for infringement in the *Trade Marks Act 1994 (UK)*.<sup>23</sup>

<sup>16</sup> *Future Enterprises Pte Ltd v McDonald’s Corp* [2007] 2 SLR (R) 845 at para 7 (CA) [*Future Enterprises*].

<sup>17</sup> *Polo (CA)*, *supra* note 4 at para 35.

<sup>18</sup> *Wagamama Ltd v City Centre Restaurants* [1995] FSR 713 at 732 (Ch).

<sup>19</sup> *Eg, Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 at para 73 (CA) [*Hai Tong*].

<sup>20</sup> But see Barton Beebe, “Search and Persuasion in Trademark Law” (2005) *Mich L Rev* 2020 at 2025. Beebe has advanced a theoretical framework in which “search sophistication... bears upon the likelihood of consumer confusion in search, persuasion sophistication bears upon the likelihood of consumer delusion in preference formation.” *Ibid* at 2025, 2026.

<sup>21</sup> Thomas R Lee, Glen L Christensen and Eric D DeRosia, “Trademarks, Consumer Psychology, and the Sophisticated Consumer” (2007) 57 *Emory LJ* 575 at 577.

<sup>22</sup> *TMA*, *supra* note 2, s 27(2).

<sup>23</sup> *Trade Marks Act 1994 (UK)*, c 26, s 10(2) [*Trade Marks Act 1994 (UK)*].

In view of the almost identical legislative wording in section 27(2) of the *TMA* and section 10(2) of the *Trade Marks Act 1994 (UK)*, and the shared history of trademark jurisprudence between Singapore and the UK, the SGCA in *Staywell* affirmed the three-step approach adopted in *British Sugar* for establishing trade mark infringement: “Once these threshold criteria have been met, the issue of the likelihood of confusion arises and this in our view directs the court to look at (a) *how* similar the marks are; (b) *how* similar the services are; and (c) given this, how likely the relevant segment of the public will be confused.”<sup>24</sup> However, it is important to note that the *British Sugar* approach is presently *not* followed by English courts, which have instead adopted the European “global appreciation” approach.<sup>25</sup>

According to Jacob J in *British Sugar*, it was not legitimate to “elide the questions of confusion and similarity”.<sup>26</sup> Hitherto, it was permissible to take into account extraneous factors at the confusion stage—the third step—provided that marks-similarity and goods-similarity have been established. Previous cases in Singapore have taken a more liberal approach to the consideration of extraneous factors.<sup>27</sup> However, the SGCA in *Staywell* has “reigned in the extent of extraneous factors that may be permissibly considered”<sup>28</sup> and has confined the consideration of extraneous factors only “to the extent that they inform the court as to how the similarity of marks and goods will likely affect the consumer’s perception as to the source of the goods.”<sup>29</sup>

One must however pause to note that *Staywell* concerned opposition to registration and not infringement, and the SGCA highlighted that a different but related approach should be taken in the context of opposition proceedings from that taken in infringement actions. The Court held that it was “satisfied [that] there *is* a difference between the approach to the confusion inquiry in opposition and infringement proceedings, although there are considerable overlaps as well.”<sup>30</sup> In an opposition proceeding where the applicant is seeking to register a trade mark to acquire monopoly rights that may encroach on the rights of a registered proprietor, the court would have regard to the full range of actual and notional uses of the marks. Whereas in an infringement proceeding, there is no question of the alleged infringer seeking to establish monopoly rights, and the court evaluates whether the actual use of a similar or identical sign encroaches on the registered proprietor’s rights and would compare the full range of notional fair uses of the incumbent mark against the actual use to which the allegedly infringing mark had been put.<sup>31</sup> These distinctions, however, would not fundamentally affect the adoption of the *British Sugar* “step-by-step” approach and would not be discussed further in this article.

Interestingly, Professor Ng-Loy Wee Loon in her *amicus curiae* submission to the SGCA in *Staywell*, asserts that the *British Sugar* “step-by-step” approach and the European “global appreciation” approach are “not fundamentally different” as they

<sup>24</sup> *Staywell*, *supra* note 1 at para 55.

<sup>25</sup> See notes 52-56 below and the accompanying text.

<sup>26</sup> *British Sugar*, *supra* note 6 at 294.

<sup>27</sup> *Eg, Hai Tong*, *supra* note 19 at paras 85, 94, 95; *Sarika*, *supra* note 15 at para 66; *City Chain*, *supra* note 7 at para 59; *Polo (CA)*, *supra* note 4 at para 34.

<sup>28</sup> *Han’s (F&B) Pte Ltd v Gusttino World Pte Ltd* [2015] 2 SLR 825 at para 157 (HC) [*Han’s*].

<sup>29</sup> *Staywell*, *supra* note 1 at para 83.

<sup>30</sup> *Ibid* at para 56 [emphasis in original]

<sup>31</sup> *Ibid* at paras 56-62.

both contain the same three essential elements.<sup>32</sup> Professor Ng-Loy explains that:

Given that the first element of marks-similarity and the second element of goods/services-similarity must be satisfied in the global appreciation approach, the tribunal in the EU/UK applying this approach invariably embarks on a comparison between the parties' trademarks and between the parties' goods/services (just like the tribunal in Singapore applying the step-by-step approach).<sup>33</sup>

She further emphasises that there is another common feature between the Singapore "step by step" and European "global appreciation" approach; both jurisdictions had adopted the principle of "interdependence of relevant factors".<sup>34</sup> However, the present authors note that the approaches are nonetheless significantly different in the way certain factors are evaluated—or excluded—in the likelihood of confusion analysis.

In an earlier article, Professor Ng-Loy argues that the "extraneous factors" rule have no place in the *TMA* because the registration system was put in place to promote certainty,<sup>35</sup> but her view was rejected in *Staywell* as the court recognised that the primary objective of the *TMA* is to protect against origin-based confusion, notwithstanding the competing policy consideration of promoting business certainty.<sup>36</sup> The SGCA reasoned that the consideration of *certain narrowly circumscribed "extraneous factors"* is nevertheless justified on a literal reading of sections 8(2) and 27(2) since the wording "[does] not have the effect of making a finding of confusion automatic upon the establishment of similarity of marks and goods or services",<sup>37</sup> but it eschewed a more general examination of extraneous factors in the third step as such an approach more appropriately belonged in the province of the passing off action. In essence, *Staywell* declined to admit all extraneous factors that could operate to dispel consumer confusion; instead, only factors *intrinsic to the goods themselves, and which impact the consumers' motivation and ability to exercise care in their purchase of goods, are to be considered under the goods-similarity step* of the infringement analysis. The SGCA noted that:

If the marks or the goods or services in question are not similar, and confusion stems from other factors, an action might lie in the tort of passing off but not in trade mark infringement... In our judgment, the plain words and the scheme of [the *TMA*] do not preclude the court's discretion to consider extraneous factors to the extent that these inform the assessment of the *effect* of the required similarity on consumer perception, but... there are significant limits,

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<sup>32</sup> Ng-Loy Wee Loon, Amicus Curiae's Submissions: *Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide Inc* (Civil Appeal No 147 of 2012/B) at paras 28, 29.

<sup>33</sup> *Ibid* at para 31.

<sup>34</sup> *Ibid* at para 38 (citing *Hai Tong*, *supra* note 19 at para 97).

<sup>35</sup> Ng-Loy Wee Loon, "Developments in Singapore Trade Mark Law 2006-2010: Confusion-based Protection and Beyond" in Yeo Tiong Min, Hans Tjio & Tang Hang Wu, eds, *SAL Conference 2011: Developments in Singapore Law Between 2006 and 2010* (Singapore: Academy Publishing, 2011) 349 at 354-362 [Ng-Loy, "Developments in Singapore Trade Mark Law"].

<sup>36</sup> *Staywell*, *supra* note 1 at paras 78, 95; *Sarika*, *supra* note 15 at para 61; *Mobil*, *supra* note 15 at para 33.

<sup>37</sup> *Staywell*, *ibid* at para 64; *Polo (CA)*, *ibid* at para 25; *Sarika*, *ibid* at para 60.

more than we may previously have acknowledged as to the extraneous factors that may be considered.<sup>38</sup>

In relation to the admissibility of extraneous factors in the evaluation of likelihood of confusion, the SGCA in an earlier decision had stated that on a proper construction of section 27(2) of the *TMA*:

[W]hile it is permissible to have regard to ‘extraneous factors’, this should not be taken as a reference to such factors ‘at large’ and still less to those that are inconsistent with the legislative framework because they impermissibly curtail the rights granted to the registered proprietor of a trade mark.<sup>39</sup>

In rejecting the consideration of one specific extraneous factor from the confusion inquiry—the packaging of goods—in *Hai Tong*, the Court there observed that taking account of the packaging of a product when assessing for confusion, would “curtail the right of the proprietor of the registered mark to use his mark with packaging of that colour”.<sup>40</sup> Clara Tung notes that “[i]t should be no real surprise that in *Staywell*, the court widened the rule against packaging into a more general principle—that any factor which was ‘susceptible to change by a trader from time to time’ would not be admissible in the confusion inquiry.”<sup>41</sup> The *Staywell* Court clarified that extraneous factors do not refer to factors “at large”, but the *TMA* contemplates the interplay amongst:

(a) the degree of similarity between the contesting marks; (b) the degree of similarity between the goods or services in relation to which these are to be used; and (c) the effect of the foregoing on the relevant segment of the public... Therefore, those factors that bear upon these elements in combination or upon the similarity of the goods or services in question and the characteristics, nature and likely responses of the relevant segment of the public *can and should be considered*...<sup>42</sup>

According to the extraneous factors rule, the extraneous factors that may be examined include:

- (i) Factors relating to the impact of *marks-similarity* on consumer perception. These include the degree of similarity, the reputation of the marks, the impression given by the marks and the possibility of imperfect recollection.<sup>43</sup>
- (ii) Factors relating to the impact of *goods-similarity* on consumer perception. These include:
  - (A) the nature of the goods;
  - (B) the normal way or circumstances under which consumers would purchase goods of that type;
  - (C) whether the goods are expensive or inexpensive items;

<sup>38</sup> *Staywell*, *ibid* at para 65 [emphasis in original].

<sup>39</sup> *Hai Tong*, *supra* note 19 at para 87.

<sup>40</sup> *Hai Tong*, *ibid* at para 85(c)(iv).

<sup>41</sup> Clara Tung, “Staying Well Out of Confusion” (2014) 26 Sing Ac LJ 309 at 312.

<sup>42</sup> *Staywell*, *supra* note 1 at para 79, citing *Hai Tong*, *supra* note 19 at para 87 [emphasis added].

<sup>43</sup> *Ibid* at para 96(a).

- (D) whether the goods would tend to command fastidiousness and attention on the part of prospective purchasers; and
- (E) the characteristics of the consumer and whether they are likely to be specialists.<sup>44</sup>

(iii) The *impermissible factors* are those differences between the competing marks and goods which are created by a trader's differentiating steps, or factors which are not inherent in the goods, but are susceptible to changes that can be made by a trader from time to time, in particular, pricing differentials, packaging and other superficial marketing choices which could possibly be made by the trader.<sup>45</sup>

More importantly, impermissible factors include "extraneous factors [which] are advanced in the attempt to *negate* a finding of likely confusion on the grounds that the marks are being deployed in such a way as to target different types of consumers or to notionally differentiate the goods in question."<sup>46</sup> These factors were described as being "wrong in principle"<sup>47</sup> since they undermine the proprietary rights of the trademark holder as "a subsequent trader would be able to enter the market using a trade mark that was very similar to the senior mark, applied to similar if not identical goods and yet avoid liability by... saying that because of these [differentiating] steps, there is no likelihood of confusion".<sup>48</sup>

In essence, the SGCA claims that it has endorsed the "step-by-step" *British Sugar* test,<sup>49</sup> as opposed to the European "global appreciation approach", because it is "conceptually neater and more systematic and more importantly... more aligned with the requirements imposed under our statute".<sup>50</sup> Under the *EU Trade Mark Directive*, the trade mark proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:

[A]ny sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark.<sup>51</sup>

Thus, the language in article 5(1)(b) of the *EU Trade Mark Directive* clearly requires the existence of similarity or identity of marks *and* goods for a finding of likelihood of confusion; this means that a comparison between marks-similarity and goods-similarity is carried out before assessing any other factors (including the likelihood

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<sup>44</sup> *Ibid* at para 96(b).

<sup>45</sup> *Ibid* at para 95.

<sup>46</sup> *Ibid* at para 85 [emphasis added].

<sup>47</sup> *Ibid* at paras 88 and 89.

<sup>48</sup> *Ibid* at para 90.

<sup>49</sup> The third stage of the *British Sugar* test is seen to be synonymous with the "extraneous factors" rule. See *Staywell*, *supra* note 1 at para 63; *Polo (CA)*, *supra* note 4 at para 32; *Sarika*, *supra* note 15 at para 60.

<sup>50</sup> *Staywell*, *ibid* at para 15; *Polo (CA)*, *ibid* at para 8; *Sarika*, *ibid* at para 14.

<sup>51</sup> Art 5(1)(b) of the EC, *Directive 2008/95/EC of the European Parliament and of the Council of Oct 22, 2008 to Approximate the Laws of the Member States Relating to Trade Marks*, 2008 OJ L 299/25 (entered into force on 28 November 2008, and repealed Directive 84/104/EEC, 12 December 1988) [*EU Trademark Directive*].



of confusion), and only after at least some degree of similarity between the marks and the goods has been found can an assessment of the likelihood of confusion begin.<sup>52</sup> Although the text is similar to that of section 10(2) of the *Trade Marks Act 1994 (UK)*, the European Court of Justice (“CJEU”) departs from the *British Sugar* approach, by requiring that:

[L]ikelihood of confusion must be assessed globally, in the light of the perception of the signs and the goods or services in question on the part of the relevant public and, taking into account all factors relevant to the case, in particular the interdependence of the similarity of the signs and that of goods or services identified.<sup>53</sup>

Under this “global appreciation” approach (also known as the “global assessment” approach), the CJEU would first define the relevant public, and then, in the following order, determine the proximity between goods, similarity between marks, examine any other additional factors, and finally, globally assess the existence of likelihood of confusion;<sup>54</sup> more importantly, the CJEU endorses the applicability of the principle of interdependence of factors to the analysis of likelihood of confusion.<sup>55</sup> Essentially, the global appreciation approach established by the CJEU focused the inquiry on a “single composite question”<sup>56</sup> whether there would be a likelihood of confusion, a question which must be “appreciated globally, taking into account all factors relevant to the circumstances of the case”.<sup>57</sup>

The irony of *Staywell* is that while the Court justifies the premise of its extraneous factors rule on the textual similarity between the Singapore and English legislative provisions, and hence the adoption of the *British Sugar* test, it fails to note that a majority of post-1994 English decisions have in fact applied the global appreciation approach. The *British Sugar* “step-by-step” test has never really been followed in the likelihood of confusion jurisprudence in the UK. In 1999, the English Court of Appeal in *Phillips Electronics v Remington Consumer Products* already observed that the *Trade Marks Act 1994 (UK)* ought to be interpreted in light of the *EU Trade Mark Directive* and “[c]ases decided under the old law are no longer authoritative.”<sup>58</sup> Although the most recent English decisions still appear to assess trademark infringement and/or opposition according to a systematic approach, the cases do

<sup>52</sup> Eg, *Vedial v OHIM*, 2004 ECR I-09573 (Case C-106/03).

<sup>53</sup> *New Look Ltd v OHIM*, 2004 ECR II-03471 (Case T-117/03). See also Recital 11 of the *EU Trademark Directive*:

The likelihood of confusion, the appreciation of which depends on numerous elements and, in particular, on the recognition of the trade mark on the market, the association which can be made with the used or registered sign, the degree of similarity between the trade mark and the sign and between the goods or services identified, should constitute the specific condition for such protection.

<sup>54</sup> See generally Alejandro Mejías, “The Multifactor Test for Trademark Infringement from a European Perspective: A Path to Reform” (2014) 54 *IDEA* 285 at 315-318.

<sup>55</sup> *Canon Kabushiki Kaisha v Metro-Goldwin-Mayer Inc* [1998] ECR I-5525 (Case C-39/97) [*Canon*].

<sup>56</sup> *Balmoral TM* [1999] RPC 297 at 301.

<sup>57</sup> *Sabel BV v Puma AG* (Case C-251/95) [1998] RPC 199 at 224 [*Sabel*]. However, taking into account “all the factors relevant to the circumstances of the case” does not necessarily mean taking into consideration all “extraneous factors”. See Tan, *Law of Trade Marks*, *supra* note 3 at [12.066]-[12.078] (tracing a line of UK and CJEU decisions).

<sup>58</sup> *Phillips Electronics v Remington Consumer Products (No 1)* [1999] RPC 809 at 815 (EWCA), cited with approval in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd* [2000] FSR 267 at 272, 273 (EWHC).

not mention that the first two steps are threshold requirements but instead apply the “global appreciation approach” established in *Sabel* and *Canon*.<sup>59</sup>

Under the third step of the *British Sugar* test, courts are also required to consider how likely the relevant segment of the public will be confused, in the light of the similarity of marks (first step) and similarity of goods (second step).<sup>60</sup> However, the English approach requires an exclusion of certain factors deemed “extraneous” from the consideration of the existence of likelihood of confusion. The purpose of the third step is to establish “the *impact* of these similarities on the relevant consumers’ ability to understand where those goods and services originate”<sup>61</sup> and “the *effect* of the required similarity on consumer perception”.<sup>62</sup> Furthermore, it is well established that the test involves a factual inquiry and requires the court to approach the question holistically in light of all the circumstances of the case.<sup>63</sup> In summary, the *Staywell* extraneous factors rule does not prohibit a consideration of extraneous factors *per se*; it only restricts the circumstances under which a court may refer to such factors. In contrast, the European Court’s “global appreciation approach” is “less restrictive”<sup>64</sup> and requires the likelihood of confusion to “be appreciated globally, taking into account all factors relevant to the circumstances of the case”.<sup>65</sup> However, the European approach has been criticised to be an “awkward fit” with the traditional goals of trademark law,<sup>66</sup> and was held by the SGCA to be inconsistent with the text of the *TMA*.<sup>67</sup>

### B. Problems with the Staywell Approach

The decision in *Staywell* follows the trajectory of an earlier decision in *Hai Tong*<sup>68</sup> handed down the preceding year, perhaps signalling that the SGCA is determined to adhere to this new path away from the UK/EU jurisprudence. Some problems with this “pro-mark stance” have been adroitly highlighted by *Tung*, and they include: removing trade mark law too far from the realms of commercial reality;<sup>69</sup> an artificial line being drawn between which extraneous factor would be considered as inherent in the goods (therefore admissible) and which would be a superficial marketing choice

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<sup>59</sup> See *Specsavers International Healthcare v Asda Stores Ltd* [2012] ETMR 17 at paras 51, 52 (CJEU) [*Specsavers*], followed in *Hearst Holdings Inc v AVELA Inc* [2014] ETMR 34 at para 57 (EWHC).

<sup>60</sup> *Staywell*, *supra* note 1 at para 55, citing *Hai Tong*, *supra* note 19 at para 85(c).

<sup>61</sup> *Ibid* at para 64.

<sup>62</sup> *Ibid* at para 65.

<sup>63</sup> *Sarika*, *supra* note 15 at paras 57, 62; *City Chain*, *supra* note 7 at paras 54-56.

<sup>64</sup> *Staywell*, *supra* note 1 at para 67.

<sup>65</sup> *Sabel*, *supra* note 57 at 223, 224; *Canon*, *supra* note 55 at para 40; *Marca Mode CV v Adidas AG* [2000] ECR I-4861 (Case C-425/98); *TMR Restaurants Ltd v Societe Anonyme des Bains de Mer et du Cercle des Etrangers* [2013] ETMR 37 at para 44.

<sup>66</sup> William Robinson, Giles Pratt & Ruth Kelly, “Trademark Law Harmonization in the European Union: Twenty Years Back and Forth” [2013] *Fordham IP Media & Ent LJ* 731 at 742. See also Andrew Griffiths, “A Law-and-Economics Perspective on Trade Marks” in L Bently, J Davis & J Ginsberg, eds, *Trade Marks and Brands: An Interdisciplinary Critique* (Cambridge University Press, 2007) 241 at 262.

<sup>67</sup> See note 50 above and the accompanying text.

<sup>68</sup> [2013] 2 SLR 941.

<sup>69</sup> *Tung*, *supra* note 41 at 313, 314.

(and therefore inadmissible);<sup>70</sup> and moving too far from the UK/EU positions.<sup>71</sup> In *Staywell*, the SGCA correctly identified the purpose of the “extraneous factors” rule, *ie* to determine the impact and effect of the similarities between the marks and goods on consumer perception.<sup>72</sup> However, the court’s construction of factors affecting the consumer’s purchasing decision and perception is misconceived as the limits placed on the extraneous factors rule render its purpose nugatory. First, the ruling that “it would not be permissible to have regard to yet further extraneous considerations that might have the effect of diminishing the likelihood of confusion”<sup>73</sup> is akin to creating an almost irrebuttable presumption of confusion once the two similarities are found. This is contrary to the SGCA’s earlier ruling that Parliament intended that there should be an examination of whether confusion is likely notwithstanding marks-similarity and goods-similarity.<sup>74</sup>

Second, “impermissible” factors such as the subsequent trader’s marketing strategies, including advertising and price differentials, are clearly factors that impact the consumer’s purchasing decision.<sup>75</sup> As Mark McKenna observes, “the evidence now shows beyond reasonable dispute that advertising creates emotional or psychological product differentiation that is often unrelated to observable product differences”.<sup>76</sup> Furthermore, a study on brand preference showed that price differentials and the manner in which the products were displayed had a direct impact on consumers’ purchasing decisions.<sup>77</sup> McKenna comments that “it is remarkable that there is even a debate about this in the legal literature.”<sup>78</sup> Indeed, consumers fall along a spectrum of persuasion sophistication, and the purchasing practices and the degree of care paid by consumers are significantly influenced by adroit marketing strategies.<sup>79</sup> In view of the empirical research conducted in this area, albeit in an American context, perhaps the SGCA could revisit its labelling of such factors as “unnecessary, unworkable and impermissible”.<sup>80</sup>

Conversely, factors “intrinsic to the very nature of the goods” which were held to be permissible is similarly problematic. At its broadest interpretation, examining the intrinsic nature of a particular type of goods would often be a futile exercise leading to inconclusive answers and may create a false impression of the marketplace, as the inquiry fails to recognise the existence of the range of products within each type of goods that is targeted at different market segments.<sup>81</sup> On a narrower interpretation,

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<sup>70</sup> *Ibid* at 314, 315.

<sup>71</sup> *Ibid* at 315-320.

<sup>72</sup> *Staywell*, *supra* note 1 at paras 64, 65.

<sup>73</sup> *Ibid* at para 86.

<sup>74</sup> *Ibid* at para 64; *Polo (CA)*, *supra* note 4 at para 25; *Sarika*, *supra* note 15 at para 61.

<sup>75</sup> *Polo (CA)*, *ibid* at para 21.

<sup>76</sup> Mark P McKenna, “A Consumer Decision-Making Theory of Trademark Law” (2012) 98 *Virginia L Rev* 67 at 115.

<sup>77</sup> D I Padberg, F E Walker & K W Kepner, “Measuring Consumer Brand Preference” (1996) 49 *Journal of Farm Economics* 723.

<sup>78</sup> McKenna, *supra* note 76 at 115.

<sup>79</sup> Barton Beebe, “Search and Persuasion in Trademark Law” (2005) 103 *Mich L Rev* 2020 at 2025.

<sup>80</sup> *Staywell*, *supra* note 1 at para 95.

<sup>81</sup> For example, it is impossible to generalise the “intrinsic nature” of watches. Is the intrinsic nature of watches to display the time of the day, or does it extend to an ornamental purpose? In *City Chain*, the court attempted to discern different levels of sophistication of the part of consumers depending on the market segment that the Louis Vuitton and Solvil watches targeted. Even within the so-called luxury watches segment, there is a high degree of differentiation as brands like Audemars Piguet, Rolex, Patek

factors such as the technical or aesthetic features of the goods, which are intrinsic to the goods, are also tools that traders use to differentiate their products on the market. It appears contradictory that the court would allow such factors to be considered while rejecting factors that are “susceptible to changes... from time to time”,<sup>82</sup> as there is no compelling reason as to why the permanence (or lack thereof) in a differentiating step is relevant in determining whether that step taken is a permissible or impermissible extraneous factor. It also ignores the fact that certain technical or aesthetic features which are inherent in the goods may also be susceptible to changes.<sup>83</sup>

Third, as a corollary of the earlier points, the decision in *Staywell* arguably represents a normative shift in the purpose of trademark law from preventing confusion to protecting proprietary rights in registered trademarks. While the tightening of the range of admissible extraneous factors at the confusion-inquiry stage in *Staywell* “represents a definite shift in judicial philosophy towards more robust protection of registered trade marks”, Tung was critical that this approach “removes trade mark law too far from the realms of commercial reality and represents an unwarranted expansion of the registered proprietor’s rights with no corresponding reduction of confusion to society.”<sup>84</sup> Despite the observation that “the risk of origin-based confusion is the primary interest sought to be protected by trade mark law”,<sup>85</sup> the court’s numerous qualifications to the extraneous factors rule distract the court from the realities of the consumer decision-making process. If true, this normative shift in granting additional rights over and above that conferred by section 26 is contrary to well-established principles and the scheme of the *TMA*.<sup>86</sup> A registered trademark confers perpetual monopoly. For a well-known brands like Apple and Louis Vuitton, there may be a case made for adopting a strict “extraneous factors” rule in protecting the millions of dollars invested in brand and product development (assuming the anti-dilution right is inadequate). On the other hand, a new business could simply create an inherently distinctive sign overnight with minimum resource expenditure and register that as a mark, thereby also enjoy a high level of perpetual monopoly protection under the infringement analysis.

However, the SGCA clearly did not intend to depart from the established principle that trademark law’s primary concern is to avoid confusion since it emphasised repeatedly that the purpose of the extraneous factors rule is to establish the impact and effect of the similarities of marks and goods on the consumers’ perception, and that the primary interest in trademark law is to avoid confusion.<sup>87</sup> Instead, the Court possibly erred in its construction of the realities of the purchasing process. An earlier decision of the Singapore High Court in *The Polo/Lauren Co v Shop In Department Store* appears to be on the right track when it suggested that extraneous factors should be considered in the final analysis of whether in the light of all the circumstances, including marks-similarity and goods-similarity:

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Philippe, Rolex distinguish themselves from each other and from fashion brands like Hermes, Louis Vuitton and Gucci. See also notes 209 and 210 below and the accompanying text.

<sup>82</sup> *Ibid* at para 95.

<sup>83</sup> *Ibid*.

<sup>84</sup> Tung, *supra* note 41 at 313.

<sup>85</sup> *Staywell*, *supra* note 1 at para 95.

<sup>86</sup> See notes 14 and 15 above and the accompanying text.

<sup>87</sup> *Staywell*, *supra* note 1 at paras 55, 64, 65, 78 and 95.

The protection that the law offers to a registered proprietor of a trade mark is wide but it is not infinite. The ambit of that protection should be guided by *the underlying aim of a trade marks regime, which is to ensure that consumers do not confuse the trade source of one product with another*. For instance, where the consideration of other matters can assist the court in drawing the line at cases where the likelihood of confusion is merely imaginary, there is no reason not to do so. Otherwise, the law will end up extending protection where none is needed.<sup>88</sup>

Tung argues that the *Polo* approach to the confusion inquiry was “much more rooted in the reality of whether consumers, considering all the information available to them at the point of purchase, would likely be confused.”<sup>89</sup> The present authors agree. It is proposed that a study of the multi-factor likelihood of confusion test currently used by the US courts for determining trademark infringement would shed light on the factors which most accurately capture the essence of the consumer purchasing process. Furthermore, it will be shown that the “extraneous factors” rule pre-*Staywell* is similar to the US approach and ought to be followed.

#### IV. LIKELIHOOD OF CONFUSION IN THE UNITED STATES

##### A. Survey of US Cases

The likelihood of confusion test is applied in the US for trademark opposition under section 2(d), trademark infringement under section 32(1)(a), and unregistered marks infringement under section 43(a)(1)(A) of the *Lanham Act*. Unlike the *TMA*, the test for trademark infringement under section 32(1)(a) of the *Lanham Act* is stated in a general manner and does not prescribe a step-by-step analysis of marks-similarity and goods-similarity. It states:

Any person who shall, without the consent of the registrant... *use in commerce* any reproduction, counterfeit, copy or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive [shall be liable in a civil action by the registrant].<sup>90</sup>

Within each Circuit, courts apply a standard set of factors to determine likelihood of confusion regardless of the context in which the question arises.<sup>91</sup> Similar to the *Staywell* approach,<sup>92</sup> the multi-factor test is applied differently when dealing with

<sup>88</sup> *The Polo/Lauren Co v Shop In Department Store Pte Ltd* [2005] 4 SLR (R) 816 at para 19 (HC) [emphasis added].

<sup>89</sup> Tung, *supra* note 41 at 314.

<sup>90</sup> *Lanham Act*, 15 USC §1114(1)(a) [emphasis added].

<sup>91</sup> *Eg, Frisch's Restaurants v Elby's Big Boy, Inc*, 670 F.2d 642 (6th Cir 1982) [*Frisch's's*]; *Maker's Mark Distillery, Inc v Diageo, NA*, 679 F.3d 410 (6th Cir 2012) [*Maker's Mark*]; *Homeowners Group, Inc v Home Marketing Specialists, Inc*, 931 F.2d 1100 (6th Cir 1991) [*Homeowners*]. It should be noted that some commentators are less enthusiastic with this approach, *eg*, Robert G Bone, “Taking the Confusion Out of ‘Likelihood of Confusion’: Toward a More Sensible Approach to Trademark Infringement” (2012) 106 NW U L Rev 1306 at 1308.

<sup>92</sup> *Staywell*, *supra* note 1 at paras 56-61.

opposition and infringement because the former context considers theoretical uses of the marks, whereas the latter context is concerned only with actual uses.<sup>93</sup>

The first formulation of the likelihood of confusion test appeared in the seminal case of *Polaroid Corp v Polaroid Electronics Corp* which considered eight factors:<sup>94</sup> (1) the strength of the plaintiff's mark; (2) the degree of similarity between the two marks; (3) the proximity of the products; (4) the likelihood that the prior owner will bridge the gap; (5) actual confusion; (6) the reciprocal of defendant's good faith in adopting his own mark; (7) the quality of the defendant's product; and (8) the sophistication of the buyers. Despite the differences in terminology, the five factors of strength of the plaintiff's mark, similarity of the marks, proximity of the goods, evidence of actual confusion and the intent of the defendant are applied throughout all Circuits.<sup>95</sup> Additionally, while Circuit Courts emphasise that no one factor is dispositive and that the weight attributed to each factor varies according to the circumstances of each case,<sup>96</sup> it is noteworthy that the Second and Ninth Circuit Courts of Appeals, two of the most influential Circuit Courts in the area of federal trademark and copyright litigation, regard the similarity of marks and proximity of goods as two of the three "controlling troika" of factors.<sup>97</sup> Crucially, the first factor corresponds to marks-similarity and the second relates to goods-similarity under our TMA.

While some factors such as the similarity of marks and evidence of actual confusion are self-explanatory and directly relevant to the likelihood of confusion inquiry,<sup>98</sup> other factors warrant a closer look.

### 1. Strength of the Mark

The strength of the plaintiff's mark is measured by both its conceptual and commercial strength.<sup>99</sup> Conceptual strength refers to the distinctiveness of the mark and stronger protection is afforded to marks that are more distinctive since such marks are more likely to perform a source-identifying role in the minds of the public.<sup>100</sup> On the other hand, commercial strength relates to the fame or prominence of the mark in the market which results in a high degree of consumer recognition and requires

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<sup>93</sup> See Jane C Ginsberg, Jessica Litman & Mary Kevlin, *Trademark and Unfair Competition Law: Cases and Materials*, 5th ed (US: LexisNexis, 2013) at 239.

<sup>94</sup> *Polaroid Corp v Polaroid Electronics Corp*, 287 F.2d 492 at 495 (2nd Cir 1961) [*Polaroid*]. See also J Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, 4th ed (2009) vol 4 at §24:32.

<sup>95</sup> See Annex A. See also Barton Beebe, "An Empirical Study of the Multifactor Tests for Trademark Infringement" (2006) 94 Cal L Rev 1581 at 1589, 1590.

<sup>96</sup> *Kelly-Brown v Winfrey*, 717 F.3d 295 at 307 (2nd Cir 2013) [*Kelly-Brown*]; *Xtreme Lashes, LLC v Xtended Beauty, Inc*, 576 F.3d 221 at 227 (5th Cir 2009) [*Xtreme Lashes*]; *Autozone, Inc v Strick*, 543 F.3d 923 at 929 (7th Cir 2008) [*Autozone*]; *Sally Beauty Co v Beautyco, Inc*, 304 F.3d 964 at 972 (10th Cir 2002) [*Sally Beauty*].

<sup>97</sup> See *Mobil Oil Corp v Pegasus Petroleum Corp*, 818 F.2d 254 at 258 (2nd Cir 1987) [*Pegasus*] (the three factors of strength of the plaintiff's mark, similarity of marks and proximity of goods are most important); *GoTo.com, Inc. v Walt Disney Co*, 202 F.3d 1199 at 1205 (9th Cir 2000) (the three factors of similarity of marks, proximity of goods and similarity of marketing channels are the controlling troika).

<sup>98</sup> Eg, *Banfi Products Corp v Kendall-Jackson Winery Ltd.*, 74 F. Supp. 2d 188 (EDNY 1999) [*Banfi*]; *Virgin Enterprises v Nawab*, 335 F.3d 141 at 151 (2nd Cir 2003) [*Virgin Enterprises*]; *Frisch's*, *supra* note 91 at 648.

<sup>99</sup> *Virgin Enterprises*, *ibid* at 147; *Maker's Mark*, *supra* note 91 at 419.

<sup>100</sup> *Virgin Enterprises*, *ibid* at 148.

the consideration of market factors.<sup>101</sup> However, third-party use of the mark in the relevant market may weaken the strength of the mark.<sup>102</sup>

Although there is a correlation between the conceptual strength of the plaintiff's mark and successful litigation,<sup>103</sup> it is observed in practice that the mark's commercial strength tends to trump its conceptual strength.<sup>104</sup> This over-protection of the mark's commercial strength is perhaps more apparent in Singapore where *Staywell* referred to "the reputation of the marks"<sup>105</sup> as a permissible extraneous factor, as opposed to earlier cases where the courts maintained a distinction between commercial and conceptual strength when deciding the extent of protection a mark deserves.<sup>106</sup> As it is the mark's conceptual strength that performs its source-identification function, placing undue weight on the mark's commercial strength is problematic since it deviates from trademark law's underlying rationale of preventing consumer confusion.

Although the strength inquiry has been criticised as being "needlessly opened"<sup>107</sup> and unprincipled,<sup>108</sup> this inquiry is nonetheless important as it determines the scope of protection afforded to the mark. Thus, it is proposed that in considering commercial strength, a flexible and commonsensical approach should be taken where it is possible for a commercially strong mark to be afforded weak protection precisely because it is so widely known to the public such that confusion is unlikely.<sup>109</sup>

## 2. Proximity of the Products, Marketing and Advertising Channels Used

Proximity of products is directly relevant to whether confusion is likely as consumers are more likely to assume an association between two similar marks used on related products.<sup>110</sup> The considerations undertaken to determine proximity of products are broad-ranging and includes a comparison of the product itself, an analysis of the relevant market, and of potential consumers.<sup>111</sup> While the factor of proximity of products and the factors of marketing and advertising channels may seem distinct, courts have often relied on considerations for one factor in support of the other.<sup>112</sup> Moreover, in Circuits where these three factors are considered separately, the analysis

<sup>101</sup> *Eg. Tana v Dantanna's*, 611 F.3d 767 at 776 (11th Cir 2010) [*Tana*]; *Tiffany & Co v Fabriques de Tabac Reunies SA* [1999] 2 SLR (R) 541 at para 47 (CA) [*Tiffany*].

<sup>102</sup> *Eg. Homeowners Group*, *supra* note 91 at 110; *Amstar Corp v Domino's Pizza, Inc*, 615 F.2d 252 at 259, 260 (5th Cir 1980) [*Amstar*].

<sup>103</sup> *Beebe*, *supra* note 95 at 1637.

<sup>104</sup> *Ibid* at 1635.

<sup>105</sup> *Staywell*, *supra* note 1 at para 96.

<sup>106</sup> *Polo (CA)*, *supra* note 4 at para 34; *Sarika*, *supra* note 15 at para 36; *Hai Tong*, *supra* note 19 at para 103(f); *Ozone Community Corp v Advance Magazine Publishers Inc* [2010] 2 SLR 459 at paras 69, 70, 110(b) (HC) [*Ozone*].

<sup>107</sup> Timothy Denny Greene & Jeff Wilkerson, "Understanding Trademark Strength" (2013) 16 *Stan Tech L Rev* 535 at 582.

<sup>108</sup> *Beebe*, *supra* note 95 at 1633.

<sup>109</sup> *Eg. Nation Fittings (M) Sdn Bhd v Oystertec plc* [2006] 1 SLR (R) 712 at para 113 (HC) [*Nation Fittings*] (Phang JA similarly advocates balancing all factors in a commonsensical and fair manner). See also *McDonald's Corp v Future Enterprises Pte Ltd* [2005] 1 SLR (R) 177 at para 64 (CA) [*McDonald's*].

<sup>110</sup> *Virgin Enterprises*, *supra* note 98 at 150; *AMF, Inc v Sleekcraft Boats*, 599 F.2d 341 at 350 (9th Cir 1979) [*Sleekcraft*].

<sup>111</sup> *Eg. Best Cellars, Inc v Grape Finds at Dupont, Inc*, 90 F. Supp. 2d 431 at 456 (SDNY 2000) [*Best Cellars*]; *Sleekcraft*, *supra* note 110 at 350.

<sup>112</sup> *Eg. Tana*, *supra* note 101 at 778; *Clinton Detergent Co v Procter & Gamble Co*, 302 F.2d 745 at 748 (CCPA 1962) [*Clinton Detergent*].

of each factor was found to be repetitive and redundant.<sup>113</sup> Hence, the conceptually neater approach is to abandon the narrow construction of proximity and to interpret the factor broadly to encompass the factors of marketing and advertising channels used.

The various facets of the proximity factor such as the sales and marketing channels used,<sup>114</sup> the overlap in the target consumers,<sup>115</sup> and steps taken by the subsequent user in distinguishing his product such as price differentials,<sup>116</sup> were indeed factors considered in Singapore as part of the second stage of goods-similarity<sup>117</sup> and also the “extraneous factors” rule pre-*Staywell*.<sup>118</sup> The recognition in Singapore and the US that these factors had an *impact* and *effect* on a consumer making his purchasing decision is significant, and the reasons for departing from this approach in *Staywell* were neither apparent nor convincing.

### 3. Defendant’s Intent

Where the defendant “knowingly adopts a mark similar to another’s, reviewing courts presume that the defendant can accomplish his purpose: that is, that the public will be deceived.”<sup>119</sup> A similar reasoning is adopted in Singapore, where it was said that a plaintiff faces only a “short step” to prove that the intent is successful.<sup>120</sup> The inclusion of this factor in the multi-factor likelihood of confusion test is controversial as it has little or no bearing on consumers in the marketplace.<sup>121</sup> This factor also is loaded against the alleged infringer as intent is presumed upon the showing that the junior user had knowledge of the senior user’s mark,<sup>122</sup> and the factor works only to the senior user’s benefit.<sup>123</sup> To complicate matters, US courts apply this factor in a schizophrenic manner; with some courts attributing “great weight” while others observing that it is “largely irrelevant”.<sup>124</sup> Furthermore, it was found that the intent

<sup>113</sup> Beebe, *supra* note 95 at 1643.

<sup>114</sup> *Polo (CA)*, *supra* note 4 at paras 28, 34; *City Chain*, *supra* note 7 at paras 59, 77; *Sarika*, *supra* note 15 at para 66; *Nautical Concept Pte Ltd v Jeffery Mark Richard* [2007] 1 SLR (R) 1071 at para 34 (HC) [*Nautical Concept*].

<sup>115</sup> *Eg, Hai Tong*, *supra* note 19 at para 103(g); *Polo (CA)*, *ibid* at paras 28, 34; *Kellogg Co v Pacific Food Products Sdn Bhd* [1998] 3 SLR (R) 904 at para 34 (CA) [*Kellogg*].

<sup>116</sup> *Eg, Polo (CA)*, *supra* note 4 at paras 28, 34 (steps taken by the defendant to differentiate his goods are pertinent to the inquiry since it may render the likelihood of confusion merely hypothetical or speculative); *City Chain*, *supra* note 7 at para 59; *Doctor’s Associate v Lim Eng Wah (t/a Subway Niche)* [2012] 3 SLR 193 at paras 45(a), 51 (HC) [*Doctor’s Associate*]; *Nation Fittings*, *supra* note 109 at paras 96, 106-108.

<sup>117</sup> *Eg, Clinique Laboratories, LLC v Clinique Suisse Pte Ltd* [2010] 4 SLR 510 at 28 (HC); *Intuition Publishing Ltd v Intuition Consulting Pte Ltd* [2012] SGHC 149 at paras 71-75.

<sup>118</sup> *Eg, Sarika*, *supra* note 16 at para 66; *Valentino Globe BV v Pacific Rim Industries Inc* [2010] 2 SLR 1203 at para 19 (CA).

<sup>119</sup> *Sleekcraft*, *supra* note 110 at 354.

<sup>120</sup> *Saga Foodstuffs Manufacturing v Best Food Pte Ltd* [1994] 3 SLR (R) 1013 at para 40 (HC) [*Saga*].

<sup>121</sup> *Virgin Enterprises*, *supra* note 98 at 151; *Sleekcraft*, *supra* note 110 at 354. See also Robert G Bone, “Taking the Confusion Out of ‘Likelihood of Confusion’: Toward a More Sensible Approach to Trademark Infringement” (2012) 106 NW U L Rev 1307 at 1351-1353.

<sup>122</sup> *Eg, Pegasus*, *supra* note 97 at 259. See also Beebe, *supra* note 95 at 1630.

<sup>123</sup> *Maker’s Mark*, *supra* note 91 at 424.

<sup>124</sup> *Eg, Kendall-Jackson Winery Ltd v E & J Gallo Winery*, 150 F.3d 1042 at 1048 (9th Cir 1998) [*Kendall-Jackson*]; *Frehling Enters v International Select Group, Inc.*, 192 F.3d 1330 at 1340 (11th Cir 1999) [*Frehling*]. *Contra Lois Sportswear, USA, Inc v Levi Strauss & Co.*, 799 F.2d 867 at 875 (2nd Cir 1991) [*Lois Sportswear*].



factor stampedes the other factors<sup>125</sup> notwithstanding the normative disconnect and practical insignificance between the defendant's intent and consumer confusion.<sup>126</sup> Hence, the better view, consistent with the primary goals of trademark law, is to limit the impact of this factor.

#### 4. Consumer Sophistication

The factor of consumer sophistication is important in the multi-factor test as the characteristics of the relevant segment of the purchasing public reflects the amount of care that they will exercise in searching for and purchasing a product.<sup>127</sup> The relevant segment of the purchasing public refers to those who are likely to purchase from the senior mark user since the harm sought to be avoided in trademark law is the confusion among likely purchasers of the senior user's goods and services.<sup>128</sup> Under this factor, the courts generally hold that if a consumer can be expected to exercise a high degree of care, he/she will be less likely to be confused by any connection between a senior and junior trademark.

Courts in the US and Singapore have developed two clear rules: first, highly trained professionals or businesses are less likely to be confused; and second, consumers are likely to exercise a greater degree of care when products are expensive.<sup>129</sup> When the relevant purchasing public is the general public, courts view consumer sophistication from the lens of the "reasonably prudent purchaser". While this was termed a "legal fiction" by Graeme Dinwoodie,<sup>130</sup> the concept of a reasonably prudent purchaser is no different from that of a reasonable man.<sup>131</sup> Hence, this factor represents a malleable concept which not only deals directly with the likelihood of confusion, but could also reflect policy objectives which may better serve the community and should be retained. In a detailed analysis of the relevance of consumer psychology to the likelihood of confusion evaluation, the conclusion was "the principal strands of analysis in the case law... include the assertion that consumer care or sophistication correlates positively with price, length and complexity of the purchase transaction; infrequency of purchase; education, age, gender, and income; and the notion that professional buyers, avid hobbyists, and (sometimes) women are more sophisticated."<sup>132</sup>

It has been noted that some US courts have gone so far as to suggest that "a high degree of consumer sophistication in a target market may trump all other factors, virtually eliminating the likelihood of consumer confusion in the case of a professional

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<sup>125</sup> Beebe, *supra* note 95 at 1621. See also Ng-Loy Wee Loon, "An Interdisciplinary Perspective on the Likelihood of Confusion: Consumer Psychology and Trade Marks in an Asian Society" (2008) 98 Trademark Reporter 912 [Ng-Loy, "An Interdisciplinary Perspective"].

<sup>126</sup> See generally, Bone, *supra* note 121.

<sup>127</sup> *Virgin Enterprises*, *supra* note 98 at 151. See also Beebe, *supra* note 20 at 2035-2042.

<sup>128</sup> *Abercrombie & Fitch Co v Moose Creek, Inc*, 486 F.3d 629 at 634 (9th Cir 2007).

<sup>129</sup> For US position, see *Sleekcraft*, *supra* note 110 at 353; *Maker's Mark*, *supra* note 91 at 423. For Singapore position, see *Hai Tong*, *supra* note 19 at para 103(h); *McDonald's*, *supra* note 109 at para 64; *MediaCorp News Pte Ltd v Astro All Asia Networks plc* [2009] 4 SLR (R) 496 at para 50 (HC) [*MediaCorp*].

<sup>130</sup> Graeme B Dinwoodie, "What Linguistics Can Do for Trademark Law" in L Bently, J Davis & J Ginsberg, eds, *Trade Marks and Brands: An Interdisciplinary Critique* (Cambridge University Press, 2007) 140.

<sup>131</sup> *Hall v Brooklands Auto Racing Club* [1933] 1 KB 205 at 224.

<sup>132</sup> Lee, Christensen & DeRosia, *supra* note 21 at 580, 581 (internal citations omitted).

or highly sophisticated buyer.”<sup>133</sup> These findings are significant as they suggest that a high degree of consumer care or sophistication can possibly negate a likelihood of confusion that may arise from marks-similarity and goods-similarity. It appears that consumer sophistication is an “extraneous factor” that may be considered only when determining goods-similarity,<sup>134</sup> but it would be more instructive to consider this factor in the light of all of the circumstances in which the purchasing decision would be made.

### 5. *Bridging the Gap*

The likelihood of the senior user bridging the product gap and entering the market of the junior user is a factor considered in four Circuits.<sup>135</sup> The basis for this factor is the idea that the senior user’s trademark rights are not limited to preventing his mark from being used on identical goods, but extends to encompass related goods. Cases considering this factor have split two ways: the Second Circuit has held that the factor is satisfied if the senior user proves that it has the intent to bridge the gap, while the Third and Fifth Circuits have held that the question is one of consumer perception and whether they perceive that the trademark owner is likely to expand.<sup>136</sup> In this regard, the Fifth Circuit’s approach should be preferred since it is targeted directly at consumer confusion in the marketplace, whereas the Second Circuit’s approach is not only out of touch with reality, but also has the undesired effect of allowing senior users to reserve a future market on related goods.<sup>137</sup>

### B. *Evaluating the US Likelihood of Confusion Test*

Over the years, the US multi-factor test has come under much academic criticism. Barton Beebe in his empirical study criticised the test’s inconsistent formulation and application between Circuits, where a few factors or a combination of factors prove decisive while others remain redundant or irrelevant.<sup>138</sup> Mark Lemley argues that the present test fails to appreciate the harms caused and that the over-protection of trademarks is responsible for increased costs.<sup>139</sup> The test has also been described as a “fiction” where judges are expected to perform a “Vulcan mind meld” with consumers in the marketplace<sup>140</sup> and even judges themselves admit to their different interpretations on the application of the test.<sup>141</sup>

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<sup>133</sup> *Eg, Sara Lee Corp v Kayser-Roth Corp*, 81 F.3d 455 at 467 (4th Cir 1996).

<sup>134</sup> *Staywell*, *supra* note 1 at para 95.

<sup>135</sup> See Annex A.

<sup>136</sup> *Eg, Interpace Corp v Lapp, Inc*, 721 F.2d 460 at 464 (3rd Cir 1983) [*Lapp*]; *Westchester Media v PRL USA Holdings, Inc*, 214 F.3d 658 at 666 (5th Cir 2000).

<sup>137</sup> *McDonald’s*, *supra* note 109 at paras 54, 59 (Chao JA expressed concerned over McDonald’s monopolistic intentions of securing the prefix “Mc” for all food and beverages).

<sup>138</sup> Beebe, *supra* note 95.

<sup>139</sup> See Mark A Lemley & Mark McKenna, “Irrelevant Confusion” (2010) 62 *Stan L Rev* 413.

<sup>140</sup> See William E Gallagher & Ronald C Goodstein, “Inference Versus Speculation in Trademark Infringement Litigation: Abandoning the Fiction of the Vulcan Mind Meld” (2004) 94 *Trademark Rep* 1229 at 1230.

<sup>141</sup> *Centaur Communications, Ltd v A/S/M Communications, Inc*, 830 F.2d 1217 at 1219 (2nd Cir 1987) [*Centaur*].

While there are some inconsistencies in the law between the Circuits, the law is nonetheless internally clear and consistent within each Circuit.<sup>142</sup> The US approach is arguably more favourable to the business community than the European Court's "global assessment approach"<sup>143</sup> or Singapore's "extraneous factors" rule<sup>144</sup> because there is a concrete set of factors to be considered, which imparts a significant degree of certainty, predictability and coherence. Indeed, any uncertainty in the test's application may not necessarily be due to incoherence in the judges' reasoning but may instead be attributed to the "fact-intensive" nature of the test.<sup>145</sup> Of course the authors do not advocate an importation of the US approach as it would be clearly inconsistent with the text of the *TMA*. Instead the authors contend that, with some modifications, the US multi-factor test can be adapted to operate effectively within the Singapore legislative framework; the US factors may be mapped in a useful manner to elucidate the *British Sugar* test.

## V. THE WAY FORWARD

### A. Formulating a Four-Stage Test

The present state of the likelihood of confusion test in Singapore is unsatisfactory following the *Staywell* decision, where the court has deemed certain factors affecting consumer purchasing decision and perception in the marketplace as "extraneous", and had excluded them from consideration even if they could have negated confusion,<sup>146</sup> thus resulting in an over-protection of registered trademarks. To redress this imbalance, it is desirable to turn to the US multi-factor test and the Singapore cases pre-*Staywell* to discern the factors that would in reality have an *impact and effect* on the consumers' purchasing decision.

This would realign the "extraneous factors" rule with the underlying rationale of confusion-based protection under sections 8(2) and 27(2) the *TMA*. In this regard, the step-by-step framework of the *British Sugar* test could be retained as the applicable test under sections 8(2) and 27(2), and it is "aligned with the requirements imposed under our statute".<sup>147</sup> However, due to the changes the authors propose, it would be more accurate to describe this test as a four-stage test.

Under this approach, the allegedly infringing mark must *first* be shown to be similar to the registered mark pursuant to the mark similarity requirement under sections 8(2)(b) and 27(2)(b) of the *TMA*.

*Second*, the mark must be used in relation to goods or services that are similar as mandated under sections 8(2)(b) and 27(2)(b).<sup>148</sup> Following the *British Sugar* approach, these two requirements are cumulative and must be satisfied before the

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<sup>142</sup> Beebe, *supra* note 95 at 1594.

<sup>143</sup> See note 65 above and the accompanying text.

<sup>144</sup> *Staywell*, *supra* note 1 at para 15 affirming *Polo (CA)*, *supra* note 4.

<sup>145</sup> *Kelly-Brown*, *supra* note 96 at 307.

<sup>146</sup> It is noted that this issue did not arise in a recent decision which applied *Staywell* as the court did not find a likelihood of confusion based on a lack of marks-similarity. *Eg, Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] SGHC 216.

<sup>147</sup> *Staywell*, *supra* note 1 at para 16; *Polo (CA)*, *supra* note 4 at para 8; *Sarika*, *supra* note 15 at para 14; *Hai Tong*, *supra* note 19 at para 15.

<sup>148</sup> *Polo (CA)*, *supra* note 4 at para 8.

third stage arises, *ie* whether “there exists a likelihood of confusion on the part of the public” under sections 8(2) and 27(2) which would result in either refusal of registration or the imposition of liability for trademark infringement respectively.<sup>149</sup> To clarify, the similarity of goods or services requirement at this stage is confined to a comparison between the allegedly infringing product and the registration specification of the registered proprietor’s product, since the first two stages are to be considered “without consideration of any external matter”.<sup>150</sup> Hence, as Chao JA observed in *Sarika*,<sup>151</sup> many of the *British Sugar* factors<sup>152</sup> such as the uses and users of the product, its physical nature and trade channels are inapplicable and the “proper comparison” is between the registration specifications of both products. This method of assessing goods similarity is consistent with the analysis of marks-similarity, where the SGCA in *Staywell* rightly observed that there is a distinction between the similarity inquiry and the *effect* of that similarity on consumers’ perception, which should be reserved for the “extraneous factors” stage.<sup>153</sup>

In the *third* stage, the authors propose a list of mandatory factors to be considered in place of the present “extraneous factors” rule. These factors, gleaned from the US multi-factor test and local cases pre-*Staywell*, include: (1) the strength of the plaintiff’s mark; (2) the proximity of the products; (3) consumer sophistication; and (4) evidence of actual confusion. These four factors were chosen because, as shown earlier, they are directly relevant to the confusion analysis.

Under the strength of the plaintiff’s mark, greater protection should be accorded to marks that are conceptually strong or inherently distinctive. Commercial strength, on the other hand, could be considered in a such a manner where a strong mark might not necessarily entail heightened protection, but could instead render confusion unlikely because the mark is simply so well-known. As an illustration, a conceptually and commercially strong mark such as “STARBUCKS”<sup>154</sup> would generally favour the registered proprietor as opposed to a weak mark such as “GLAMOUR”,<sup>155</sup> except insofar as the mark’s overwhelming success or concurrent third-party uses would render confusion improbable.<sup>156</sup>

The proximity of products factor must be distinguished from the second stage of goods-similarity on the basis that the former is concerned with the extent of product similarity based on market factors, while the latter is concerned only with the similarity in specifications on the trademark register. The proximity factor takes into account three sub-factors: (1) the trade and marketing channels used; (2) steps taken by the defendant to distinguish his products, including price differentials and product packaging; and (3) users of the product and overlap in target consumers. These sub-factors are included under proximity of products since the analysis of

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<sup>149</sup> *Staywell*, *supra* note 1 at para 15; *Polo (CA)*, *supra* note 4 at para 8; *City Chain*, *supra* note 7 at para 44; *Hai Tong*, *supra* note 19 at para 16.

<sup>150</sup> *Staywell*, *ibid* at paras 15, 20.

<sup>151</sup> *Sarika*, *supra* note 15 at para 53.

<sup>152</sup> *British Sugar*, *supra* note 6 at 297 (Jacob J).

<sup>153</sup> *Staywell*, *supra* note 1 at para 20; *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2013] 1 SLR 489 at paras 32, 33 (HC) [*Staywell (HC)*].

<sup>154</sup> *Starbucks Corp v Wolfe’s Borough Coffee*, 588 F.3d 97 at 115, 116 (2nd Cir 2009) [*Starbucks*].

<sup>155</sup> *Ozone*, *supra* note 106 at paras 69, 70, 110(b).

<sup>156</sup> *McDonald’s* *supra* note 109 at para 66. See also *Homeowners Group*, *supra* note 91 at 1108; *Amstar*, *supra* note 102 at 259, 260.

the factors applied in the US multi-factor test and the Singapore cases pre-*Staywell* show that these sub-factors have a bearing on the confusion inquiry.<sup>157</sup> In other words, these sub-factors seek to achieve what *Staywell* intended, *ie* to determine the *impact* and *effect* of the marks and goods similarity on consumer perception.<sup>158</sup> As understood from the US approach, the three sub-factors under proximity of products are balanced internally to determine if the factor of proximity of product weighs in favour or against a finding of confusion.<sup>159</sup>

The consumer sophistication factor takes into account the characteristics of the plaintiff's consumers such as their level of sophistication, the manner in which the goods are purchased and the likely degree of care such customers would exercise. The more sophisticated the consumer and when the products in question are typically purchased after some deliberation, the likelihood of confusion would be lowered.<sup>160</sup> Where the plaintiff's consumers refer to the general public, the characteristics of the average individual, one who is educated and not easily hoodwinked, will be considered.<sup>161</sup>

In the last factor of actual confusion, it is widely acknowledged that such evidence is difficult to obtain and therefore unnecessary,<sup>162</sup> but where present, would generally be strong evidence that a likelihood of confusion exists on the part of the public.<sup>163</sup> As succinctly put by McMillian J,<sup>164</sup> "actual confusion is not essential to a finding of trademark infringement, although it is positive proof of likelihood of confusion". Thus, while the lack of such evidence would not prejudice the plaintiff's case, the presence of actual confusion would be highly probative of a likelihood of confusion.

In the *fourth* and final stage, the factor of marks-similarity in Stage 1, the factor of goods-similarity in Stage 2, and the four other factors in Stage 3 are *all assessed together* to determine whether *in toto* there exists a likelihood of confusion among the public. This is akin to the "global appreciation" approach, but with a defined list of factors to be considered in every scenario, and in a step-by-step progression in the *British Sugar* tradition. This exercise involves "no mathematical precision"<sup>165</sup> and "is not a numbers game",<sup>166</sup> but requires the court to decide whether each individual factor weighs in favour of or against a likelihood of confusion and attribute an appropriate weight to each factor depending on the facts of the case.<sup>167</sup>

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<sup>157</sup> For US cases, see *Virgin Enterprises*, *supra* note 98 at 146, 147; *Tana*, *supra* note 101 at 778; *Clinton Detergent*, *supra* note 101 at 748. For Singapore cases, see *Polo (CA)*, *supra* note 4 at paras 28, 34; *Hai Tong*, *supra* note 19 at para 103(g); *City Chain*, *supra* note 7 at paras 59, 77; *Sarika*, *supra* note 15 at para 66.

<sup>158</sup> *Staywell*, *supra* note 1 at paras 55, 64, 65, 78 and 95.

<sup>159</sup> *Eg*, *Sally Beauty*, *supra* note 96 at 974, 975; *Virgin Enterprises*, *supra* note 98 at 149-151.

<sup>160</sup> Ng-Loy, "An Interdisciplinary Perspective", *supra* note 125 at 950 (observing that "the scope of trademark protection is inversely related to the law's estimation of the sophistication of the consumers of the goods and services in question"); Beebe, *supra* note 20 at 2034.

<sup>161</sup> *McDonald's*, *supra* note 109 at para 64.

<sup>162</sup> *City Chain*, *supra* note 7 at para 79; *Hai Tong* *supra* note 19 at paras 99, 100; *Lois Sportswear*, *supra* note 124 at 875.

<sup>163</sup> *Virgin Enterprises*, *supra* note 98 at 151; *Sally Beauty*, *supra* note 96 at 974.

<sup>164</sup> *SquirtCo v Seven-Up Co*, 628 F.2d 1086 at 1091 (8th Cir 1980).

<sup>165</sup> *Homeowners*, *supra* note 91 at 1107.

<sup>166</sup> *Sarika*, *supra* note 15 at para 51.

<sup>167</sup> *Eg*, *Best Cellars*, *supra* note 111 at 454-458.

Acknowledging the possibility of the odd case where the factors are finely balanced, it is proposed that courts may consider the defendant's intent or bad faith in selecting the mark. This factor is an extraneous factor under the Singapore approach and also a factor in the US multi-factor test.<sup>168</sup> The rationale for only allowing the consideration of bad faith in difficult cases is to strike a balance between the fact that bad faith is not directly relevant in a confusion-based analysis<sup>169</sup> and the notion that trademark law should also seek to prevent unfair competition by prohibiting junior users from taking unfair advantage of a registered proprietor's mark where bad faith is shown.<sup>170</sup>

Moreover, consistent with the *Staywell* and US approaches, a distinction should be drawn when applying the test in an opposition or infringement context where notional fair uses are considered in the former while the latter is concerned only with actual uses.<sup>171</sup>

### B. Applicability of the Proposed Test under the TMA

There are two potential concerns with the four-stage test, namely, whether it is consonant with the wording of sections 8(2)(b) and 27(2)(b) of the *TMA*, and whether it conflicts with the rights conferred by the *TMA* to registered trademark proprietors.

Addressing the first concern, the framework of the four-stage test is consistent with existing case law interpreting sections 8(2)(b) and 27(2)(b) since it is merely a restatement of the *British Sugar* test endorsed by the SGCA in *Polo (CA)*, and *Staywell*. In these cases, courts have refused to read the sections narrowly such that "there exists a likelihood of confusion on the part of the public"<sup>172</sup> once marks-similarity and goods-similarity are shown, and have held that certain extraneous factors merit consideration.<sup>173</sup> The proposed list of factors in the third stage is similarly compatible with the language of the statute since it merely restates in a more coherent and categorical manner the pre-*Staywell* approach with a focus on the reality of the consumer purchasing process that is intimately connected to a finding of confusion.

In respect of the second concern, the *Staywell* court, in deciding to restrict the permissible extraneous factors, was persuaded by Professor Ng-Loy's argument that the consideration of factors apart from marks-similarity and goods-similarity renders the protection promised to registered trademark proprietors illusory.<sup>174</sup> However, this argument does not address the precise scope of the registered proprietor's rights, as section 36 and the scheme of Part IV of the *TMA* merely describes the ownership and alienability of a registered trademark,<sup>175</sup> and is contrary to the underlying purposes of trademark law. Although proprietors who trade on the exclusivity or fame

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<sup>168</sup> For Singapore cases, see *Saga*, *supra* note 120. For US cases, see generally Annex A.

<sup>169</sup> *Virgin Enterprises*, *supra* note 98 at 151; *Sleekcraft*, *supra* note 110 at 354. See also Bone, *supra* note 121 at 1351-1353.

<sup>170</sup> *Eg, Pernod Ricard SA v Allswell Trading Pte Ltd* [1993] 3 SLR (R) 817 at para 52 (HC).

<sup>171</sup> *Staywell*, *supra* note 1 at paras 56-62; Ginsberg, Litman & Kevlin, *supra* note 93 at 239.

<sup>172</sup> *TMA*, *supra* note 2, ss 8(2), 27(2) [emphasis added].

<sup>173</sup> *Polo (CA)*, *supra* note 4 at para 8; *Sarika*, *supra* note 15 at para 62.

<sup>174</sup> *Staywell*, *supra* note 1 at para 92.

<sup>175</sup> *TMA*, *supra* note 2, s 36

of their marks might conceivably be affected,<sup>176</sup> it is otherwise unclear what harm the plaintiffs or their consumers may suffer in consequence of the defendant using a similar mark on similar goods if consumers are unlikely to be confused. Presently, the *TMA* already recognises a category of protection for well-known marks<sup>177</sup> and it would be erroneous to expand the scope of confusion-based protection to catch those who fall between the gaps. Doing so not only creates a normative gap, but also causes confusion in the dogma of trademark law which essentially seeks to avoid confusion.

Furthermore, the *Staywell* approach contradicts the wording of sections 8(2)(b) and 27(2)(b) which requires that “there *exists* a likelihood of confusion on the part of the public” and does not require that this likelihood of confusion be exclusively a result of marks-similarity and goods-similarity. It is therefore submitted that registered trademark proprietors are adequately protected under the *TMA* and should have the confidence to invest in brand building in Singapore notwithstanding the apparent difficulty in successfully pursuing a confusion-based action.<sup>178</sup>

### C. Advantages of the Four-Stage Test

Comparing the four-stage likelihood of confusion test with the pre- and post-*Staywell* approaches, the test is arguably an improvement as it provides trademark practitioners and judges alike with a comprehensive list of factors to be considered as opposed to an amorphous set of overlapping factors from which judges can pick and choose. This lends greater certainty and predictability to legal practice and the business community as the four-stage likelihood of confusion test defines each factor precisely and mandates the consideration of all factors.<sup>179</sup> Such an approach is also supportable as a logical and permissible interpretation of section 27(2) of the *TMA*.

The combined effect of *Hai Tong* and *Staywell* may be counter-productive since the starting point is that there is a non-exhaustive list of permissible extraneous factors which are then subject to “significant limits”.<sup>180</sup> While this approach allows the court more flexibility in selecting relevant factors to suit the particular circumstances of the each case, such flexibility is unnecessary in light of the US experience with a fixed-list test. The lesson learnt from the US Circuits is that a well-delineated list of factors is adequate for judges to dispose of the overwhelming majority of cases, and it is therefore unnecessary to afford judges additional flexibility at the expense of certainty and predictability.<sup>181</sup>

Aligning with the *sine qua non* of preventing consumer confusion,<sup>182</sup> but at the same time recognising the value of certainty by propounding a fixed list of factors and

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<sup>176</sup> Ng-Loy, “Developments in Singapore Trade Mark Law”, *supra* note 34 at 355.

<sup>177</sup> *TMA*, *supra* note 2, s 55

<sup>178</sup> Ng-Loy, “An Interdisciplinary Perspective”, *supra* note 125 at 966 (observing that rising literacy levels corresponded with a decrease in the number of cases where confusion was found); Ng-Loy, “Developments in Singapore Trade Mark Law”, *supra* note 35 at 354 (noting that there is a general decreasing trend in the number of cases where confusion is found).

<sup>179</sup> *Contra* Ng-Loy, “Developments in Singapore Trade Mark Law”, *supra* note 35 at 359, 360 (the extraneous factors rule undermines the registration system by introducing uncertainty to business communities).

<sup>180</sup> *Hai Tong*, *supra* note 19 at para 87; *Staywell*, *supra* note 1 at paras 65, 80-96.

<sup>181</sup> Beebe, *Empirical Study*, *supra* note 95 at 1594.

<sup>182</sup> *Sarika*, *supra* note 15 at para 61.

respecting the rights of registered proprietors by formulating the test in consonance with the *TMA*, the four-stage test strikes a fair balance between these competing policy concerns. This is in contrast to the present approach where there is a lack of certainty in the application of the “extraneous factors” rule.<sup>183</sup>

#### D. Applying the Four-Stage Test

Having concluded that the four-stage test compares favourably to the *Staywell* approach in theory, it is apposite to illustrate its application to the facts of decided cases to determine if the test presents a departure from existing law both in reasoning and in result. Two cases decided by the SGCA—*Staywell*, an opposition action, and *City Chain*, a trademark infringement case—are considered below.

##### 1. *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide*

In *Staywell*, the applicants, Staywell Hospitality Group, sought to register the mark “PARK REGIS” in Classes 35 (advertising) and 43 (hospitality services). The opponents, Starwood Hotels, opposed the registration alleging, *inter alia*, that the mark was likely to cause confusion under section 8(2)(b) with its registered “ST. REGIS” mark in Classes 41, 42 (the predecessor of the current Class 43), 36 and 37. The SGCA held that because of marks- and goods-similarity, taking into account the notional fair uses of the marks, there exists a likelihood of confusion.<sup>184</sup> The holding is unsatisfactory since the result was that confusion was caused solely by marks- and goods-similarity, without a consideration of how these similarities might have an *impact* and *effect* on the consumers. Moreover, despite the discussion on the permissible and impermissible factors, the SGCA did not apply any of these factors in disposing of the case.

In contrast, the four-stage test addresses the *impact* and *effect* of those similarities. Accepting that the first two stages of marks-similarity and goods-similarity are satisfied,<sup>185</sup> the third stage arises for consideration to determine the extent of those similarities.

Considering the first factor of strength of the applicant’s mark, the “ST. REGIS” mark is inherently distinctive as “that name when applied to a hotel is as fanciful as ‘Regis’ on its own since a saint is not generally associated with a hotel of any sort”.<sup>186</sup> With respect to acquired distinctiveness, although the opponents operate 17 hotels bearing the “ST. REGIS” brand worldwide, “there is no evidence of advertising expenditures or consumer studies linking the [mark] to a source”<sup>187</sup> and considering the short amount of time the opponents had operated in Singapore, it is unlikely that the mark would have a high degree of consumer recognition.<sup>188</sup> Hence, this factor weighs against a finding of confusion.

Considering the notional fair uses of the applicant’s services under the second factor of proximity of the products, the SGCA was correct in holding that there is

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<sup>183</sup> Ng-Loy, “Developments in Singapore Trade Mark Law”, *supra* note 35 at 359, 360.

<sup>184</sup> *Staywell*, *supra* note 1 at paras 100-102.

<sup>185</sup> *Ibid* at paras 38, 42, 43; *Staywell (HC)*, *supra* note 153 at paras 29, 33.

<sup>186</sup> *Staywell (HC)*, *supra* note 153 at para 20.

<sup>187</sup> *Best Cellars*, *supra* note 111 at 455.

<sup>188</sup> The St. Regis Singapore only opened in April 2008. See *Staywell (HC)*, *supra* note 153 at para 3.



little distinction between hotel services. Hence, there would be a significant overlap between the trade and marketing channels used as well as target consumers.<sup>189</sup> Thus, on balance, this factor would weigh in favour of confusion notwithstanding the steps taken by the applicants to differentiate their brand.<sup>190</sup>

Third, under consumer sophistication, the degree of purchaser care likely to be exercised by the consumers of the opponent's product, who in this case refer to the general public,<sup>191</sup> would likely be high since the opponent operates luxury hotel services which are expensively priced. Furthermore, luxury hotel services are not purchases made on impulse or on a routine basis,<sup>192</sup> but generally requires "a quick internet search or seek clarification from the travel agent or hotel" before making a booking.<sup>193</sup> Hence, the well-educated Singapore public<sup>194</sup> exercising a high degree of care is unlikely to be confused.

Considering the fourth factor of evidence of actual confusion, it was observed that the "evidence in the present case is sparse... and impossible to tell... whether the confusion was caused by the similarity between the marks and goods, or whether it resulted from other factors which ought not to be taken into account".<sup>195</sup> Thus, this factor is of low probative value and is neutral.<sup>196</sup>

In the final stage, three factors—marks-similarity (Stage 1), goods-similarity (Stage 2) and proximity of products—weigh in favour of confusion, two factors—strength of the opponent's mark and consumer sophistication—weigh in favour of confusion and one factor—actual confusion—is neutral. Although the balancing is "not a numbers game",<sup>197</sup> it is observed that the three crucial *Polaroid* factors weigh in favour of confusion.<sup>198</sup> Thus, confusion is likely on the facts without the need for considering the defendant's intent and the result is identical to that reached by the SGCA.<sup>199</sup>

## 2. *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier*

In *City Chain*, Louis Vuitton ("LV") brought an action against City Chain ("CC") alleging, *inter alia*, infringement under section 27(2)(b) of the *TMA*. Accepting again that the first two stages of the four-stage test are satisfied,<sup>200</sup> the focus turns to the third stage of the test.

Considering the first factor of the strength of LV's Quatrefoil mark, the mark is inherently distinctive as it is "conspicuous in design and each element is clearly

<sup>189</sup> *Staywell*, *supra* note 1 at para 100.

<sup>190</sup> *Staywell (HC)*, *supra* note 153 at para 47.

<sup>191</sup> *Ibid* at para 48 ("it is not possible to state categorically that only rich Singaporeans would patronise The St. Regis Singapore").

<sup>192</sup> *Cf Frisch's*, *supra* note 91 at 648 (fast food products only draw a "casual" degree of care since it is not likely to be the object of intensive consumer research).

<sup>193</sup> *Staywell (HC)*, *supra* note 153 at para 48.

<sup>194</sup> *McDonald's*, *supra* note 109 at para 64.

<sup>195</sup> *Staywell (HC)*, *supra* note 153 at para 45.

<sup>196</sup> See notes 162-164 above and the accompanying text.

<sup>197</sup> *Sarika*, *supra* note 15 at para 51.

<sup>198</sup> See note 97 above and the accompanying text.

<sup>199</sup> *Staywell*, *supra* note 1 at para 103.

<sup>200</sup> *City Chain*, *supra* note 7 at paras 46, 50.

and repeatedly set out in the whole”.<sup>201</sup> Assessing acquired distinctiveness, the Quatrefoil mark is weak since, applying the considerations in *Tana v Datanna’s*,<sup>202</sup> there is no evidence of advertising and promotion of the Quatrefoil mark or evidence that LV had made an effort to promote a conscious connection between the Quatrefoil mark and its business.<sup>203</sup> Therefore, LV has not shown that this factor weighs in its favour.

The second factor of proximity of the products clearly weighs strongly against a finding of likelihood of confusion since: (1) the trade and marketing channels used were different;<sup>204</sup> (2) the watches were priced differently;<sup>205</sup> and (3) while the users of the product refers to the general public since watches are widely available,<sup>206</sup> there is relatively little overlap in target consumers.<sup>207</sup>

Third, under consumer sophistication, the likely degree of care exercised by LV’s customers is higher than that of the average Singaporean since LV’s watches are expensively priced, and customers “are likely to be more sophisticated and of a high income level”.<sup>208</sup> Given that consumers of the LV’s watches would likely be more discerning, this factor weighs against a finding of confusion.

The last factor of evidence of actual confusion is neutral since neither party adduced any evidence.

Assessing marks-similarity, goods-similarity and all the other factors together in the fourth stage, two factors—marks-similarity and goods-similarity—weigh in favour of confusion, two factors—strength of the plaintiff’s mark and consumer sophistication—weigh against confusion, one factor—proximity of products—weigh strongly against confusion and the final factor—actual confusion—is neutral. Therefore, it is sufficiently clear that there is no likelihood of confusion on the facts.

In contrast, problems arise when applying the *Staywell* extraneous factors rule. First, the factors of “the normal way in or the circumstances under which consumers would purchase goods of that type”, “whether the products are expensive or inexpensive items” and “whether they would command a greater or lesser degree of fastidiousness and attention” are inconclusive on the facts of *City Chain*.<sup>209</sup> As the facts illustrate, these factors depend entirely on the sales and marketing techniques of parties, since LV only sells its watches at three upmarket boutiques at prices above S\$4,000, whereas CC sells its watches island-wide at prices below S\$200.<sup>210</sup> Thus,

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<sup>201</sup> *Louis Vuitton Malletier v City Chain Stores (S) Pte Ltd* [2009] 2 SLR (R) 684 at para 83 (HC).

<sup>202</sup> *Tana*, *supra* note 101 at 776.

<sup>203</sup> *City Chain*, *supra* note 7 at para 98. *Cf Maker’s Mark*, *supra* note 91 at 420 (commercial strength of the plaintiff’s red dripping wax mark was strong as it was the main focus of the plaintiff’s advertising budget).

<sup>204</sup> *Ibid* at para 59 (the defendant’s watches were sold at its stores across Singapore while the plaintiff only sold its watches only at three boutiques located at upmarket areas and the defendant’s watches were marketed in a way that closely associates them with its mark).

<sup>205</sup> *Ibid* at para 59 (the defendant’s watches were generally priced below S\$200 while the plaintiff’s watches were priced between S\$4,000 and S\$6,000).

<sup>206</sup> *Ibid* at para 56 (because watches are commonly available and purchased by the general public, the average consumer would be the general public).

<sup>207</sup> *Ibid* at para 59 (“the target consumers of the Solvil watch are likely to be young and trendy consumers looking for a bargain, whereas the target consumers of the Respondent’s watch are likely to be more sophisticated and of high income level”).

<sup>208</sup> *Ibid* at para 59.

<sup>209</sup> *Staywell*, *supra* note 1 at para 96.

<sup>210</sup> *City Chain*, *supra* note 7 at para 59.

it is impossible to make generalisations on the “normal way” watches are purchased, whether watches are expensive or inexpensive, or whether watches would command a greater or lesser degree of care.

Second, the *Staywell* approach is internally inconsistent because it is impossible to divorce the trader’s differentiating steps from factors such as the reputation of the marks, the manner in which the products are purchased, and the price of the products since these are all tools used by traders in commerce as part of their business strategy. Moreover, because these factors may only be used to support a finding of confusion since “attempts to negate a finding of likely confusion... must be avoided”,<sup>211</sup> the effect of the *Staywell* approach is to reduce the test into an inquiry of whether there are marks-similarity and goods-similarity and upon showing these two factors, a strong presumption of confusion arises.

## VI. CONCLUSIONS

Barton Beebe has noted exasperatingly that “[t]rademark law is arguably the most difficult of the intellectual property laws to contemplate, and its outcomes when applied to facts are the most difficult to predict. This is because it requires a form of what John Keats called “negative capability,” the capability, more specifically, to think through the consumer and see the marketplace only as the consumer sees it.”<sup>212</sup> Since trademark law serves to avoid consumer confusion so as to enable trademarks to perform its source-identification function, it is crucial that the likelihood of confusion test is focused primarily on the consumer. Lemley and McKenna succinctly note that “[c]onsumers are pretty good in most circumstances at figuring out what they want to buy. But their perceptions are shaped by the environment in which they find themselves.”<sup>213</sup> The English Court of Appeal recently held that:

... in assessing the likelihood of confusion arising from the use of a sign the court must consider the matter from the perspective of the average consumer of the goods or services in question and must take into account *all the circumstances of that use that are likely to operate in that average consumer’s mind* in considering the sign and the impression it is likely to make on him.<sup>214</sup>

Despite the *Staywell* court subscribing to the view that the underlying function of trademark law is to prevent confusion and that the focus of the likelihood of confusion inquiry is on the *impact* and *effect* of the marks and goods similarity on the consumer,<sup>215</sup> the *Staywell* “extraneous factors” rule does not unequivocally achieve these objectives. As Tung observes, “the limitation of admissible extraneous factors in *Staywell* was *not* the inevitable result of applying the step-by-step approach, but rather a specific policy direction taken to strengthen the protection given to registered trade marks.”<sup>216</sup> Besides the lack of certainty in the “extraneous factors” rule, the *Staywell* approach misconstrues the construction of the consumers’ purchasing

<sup>211</sup> *Staywell*, *supra* note 1 at para 85.

<sup>212</sup> Beebe, *supra* note 20 at 2022 (internal citations omitted).

<sup>213</sup> Lemley & McKenna, *supra* note 139 at 438, 439.

<sup>214</sup> *Specsavers*, *supra* note 59 at para 87 [emphasis added].

<sup>215</sup> *Staywell*, *supra* note 1 at paras 64, 65.

<sup>216</sup> Tung, *supra* note 41 at 319.

decision by excluding the consideration of factors which directly influence their purchasing decisions, such as the price differentials or other trader's differentiating steps.

Indeed, the *Staywell* approach preserves the "sanctity" of the register of trade marks and the registration system—a point previously noted by Professor Ng-Loy.<sup>217</sup> While the *Staywell* court observed that "the plain words of ss 8(2) and 27(2) do not have the effect of making a finding of confusion automatic upon the establishment of similarity of marks and goods or services",<sup>218</sup> a rejection of the use of extraneous factors to negate a finding of confusion effectively creates a virtually irrebuttable presumption of confusion once marks-similarity and goods-similarity are found.<sup>219</sup> This is contrary to the wording of sections 8(2) and 27(2) of the *TMA* since the statutory language requires that "there exist[] a likelihood of confusion on the part of the public" and does not require that this confusion be exclusively a result of marks-similarity and goods-similarity. The *TMA* permits a finding of a lack of confusion notwithstanding the presence of both marks-similarity and goods-similarity. Besides the conceptual difficulties of the *Staywell* "extraneous factors" rule, the application of this approach to the facts of *City Chain* further highlights its practical shortcomings.

The proposed four-stage test better balances the goals of certainty and consumer and registered proprietor protection enunciated in *Staywell* by considering factors gleaned from the US multi-factor test and the pre-*Staywell* cases. For example, an investigation of the proximity of the products look to market factors such as the target consumers of the particular product, the trade and marketing channels used, and differences in the product such as price and packaging, all of which directly affect the consumer's decision. As Tung perceptively points out, "[an] emphasis on viewing the marks and products from the consumer's point of view is entirely in line with what is required under Singapore, English and European legislation. The relevant sections in each of these statutes invite the court to consider confusion arising from the *perception of the marks and products in the mind of the average consumer*."<sup>220</sup> Consumers in making a purchasing decision do not behold marks and goods *in vacuo*; it does not make sense to preclude a consideration of factors that may otherwise reduce the likelihood of confusion in the minds of average consumers. Perhaps at the end of the day, this four-stage test bears much similarity to the "global appreciation" approach, but with the benefit of a clearly articulated set of factors to be considered rather than a more open-ended inquiry. Moreover, with the four-stage test, the litigation process—whether in opposition or infringement proceedings—is aided by a more predictable reference to a fixed-list of mandatory factors to be examined in contrast to a range of possible extraneous factors (which under the *Staywell* rule may be considered *only* when evaluating marks-similarity or goods-similarity).

In conclusion, the likelihood of confusion test in Singapore should focus on avoiding confusion and not cause more confusion. Thinking of trademark law in terms of the consumer decision-making process should make the likelihood of confusion analysis itself much more sensitive to the entire factual matrix in which the consumer makes the decision to purchase. This proposal hopefully serves as a useful reference

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<sup>217</sup> Ng-Loy, *Law of IP*, *supra* note 3 at para 21.0.1.

<sup>218</sup> *Staywell*, *supra* note 1 at para 64.

<sup>219</sup> *Staywell*, *supra* note 1 at para 85.

<sup>220</sup> Tung, *supra* note 41 at 319 [emphasis in original].

for potential reconsideration of the new path that Singapore law has embarked upon, as the US multi-factor approach offers a highly organised and carefully delineated list of factors that may be adapted to the Singaporean context. A pro-mark ethos should not result in an anti-competitive environment for businesses. Moreover, the present infringement analysis in Singapore does not appear to be counterbalanced by considerations of parody, satire or lampoon—that may arguably manifest themselves in factors not intrinsic to the goods—which are likely to dispel consumer confusion.<sup>221</sup> We should be careful not to allow trademark protection to “[expand] to the point where it now prohibits conduct by companies that seems unlikely to confuse consumers in any material way.”<sup>222</sup>

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<sup>221</sup> *Eg., Louis Vuitton Malletier SA v Haute Diggity Dog LLC*, 507 F.3d 252 (4th Cir 2007) (Chewy Vuitton dog toy that lampoons Louis Vuitton trademarks is unlikely to cause confusion to Louis Vuitton’s customers); *Mattel Inc v MCA Records Inc*, 296 F.3d 894 (9th Cir 2002) (identical Barbie mark used in parody song does not cause confusion); *Hormel Foods Corporation v Jim Henson Productions*, 73 F.3d 497 (2nd Cir 1996) (SPA’AM Muppet pig character that pokes fun at Spam trademark for luncheon meat does not confuse).

<sup>222</sup> Lemley & McKenna, *supra* note 139 at 453.

## Annex A

	Similarity of Marks / Degree of Similarity between Marks	Similarity of Goods / Proximity of Products	Strength of the Plaintiff's Mark	Actual Confusion	Defendant's intent in selecting the mark / Bad Faith	Marketing Channels Used / Area and manner of concurrent use	Degree of Purchaser Care / Sophistication of the Buyers	Likelihood that prior owner will bridge the gap	Similarity of Advertising	Quality of the infringer's products	Concurrent use of the mark without actual confusion	Extent to which target audience are the same
1 <sup>st</sup> Cir – “Pignons” <sup>vi</sup>	✓	✓	✓	✓	✓	✓	✓		✓			
2 <sup>nd</sup> Cir – “Polaroid” <sup>vii</sup>	✓	✓	✓	✓	✓		✓	✓		✓		
3 <sup>rd</sup> Cir – “Lapp” <sup>viii</sup>	✓	✓	✓	✓	✓	✓	✓	✓			✓	✓
4 <sup>th</sup> Cir – “Pizzeria Uno” <sup>ix</sup>	✓	✓	✓	✓	✓	✓	✓		✓			
5 <sup>th</sup> Cir – “Digits of Confusion” <sup>x</sup>	✓	✓	✓	✓	✓	✓	✓		✓			
6 <sup>th</sup> Cir – “Frisch’s” Factors <sup>xi</sup>	✓	✓	✓	✓	✓	✓	✓	✓				
7 <sup>th</sup> Cir – “AutoZone” Factors <sup>xii</sup>	✓	✓	✓	✓	✓	✓	✓					
8 <sup>th</sup> Cir – “SquirrCo” Factors <sup>xiii</sup>	✓	✓	✓	✓	✓	✓	✓					
9 <sup>th</sup> Cir – “Sleekcraft” <sup>xiv</sup>	✓	✓	✓	✓	✓	✓	✓	✓				
10 <sup>th</sup> Cir – “Sally Beauty Co.” <sup>xv</sup>	✓	✓	✓	✓	✓	✓	✓					
11 <sup>th</sup> Cir – “Likelihood of Confusion” <sup>xvi</sup>	✓	✓	✓	✓	✓	✓	✓		✓			
<b>No of Circuits Applying the Factor</b>	<b>11</b>	<b>11</b>	<b>11</b>	<b>11</b>	<b>11</b>	<b>10</b>	<b>8</b>	<b>4</b>	<b>4</b>	<b>1</b>	<b>1</b>	<b>1</b>

- i *Pignons SA de Mecanique de Precision v Polaroid Corp*, 657 F.2d 482 at 487 (1st Cir 1981); *I.P. Lund v Kohler Co.*, 163 F.3d 27 at 43 (1st Cir 1998); *Peoples Federal Savings Bank v People's United Bank*, 672 F.3d 1 at 10 (1st Cir 2012).
- ii *Polaroid Corp v Polaroid Electronics Corp*, 287 F.2d 492 at 495 (2nd Cir 1961); *Louis Vuitton Malleier v Dooney & Bourke, Inc*, 454 F.3d 108 at 116 (2nd Cir 2005); *Kelly-Brown v Winfrey*, 717 F.3d 295 at 307 (2nd Cir 2013).
- iii *Interspace Corp v Lapp, Inc*, 721 F.2d 460 at 463 (3rd Cir 1983); *KOS Pharmaceuticals, Inc v Andrx Corp*, 369 F.3d 700 at 709 (3rd Cir 2004); *Sabsinia Corp v Creative Compounds, LLC*, 609 F.3d 175 at 180 (3rd Cir 2010).
- iv *Pizzeria Uno Corp v Temple, Inc*, 721 F.2d 1522 at 1527 (4th Cir 1984); *CareFirst of Md, Inc v First Care, O.C.*, 434 F.3d 263 at 267, 268 (4th Cir 2006); *Ray Communications, Inc v Clear Channel Communications*, 673 F.3d 294 at 302 (4th Cir 2011).
- v *Roto-Rooter Corp v O'Neal*, 513 F.2d 44 at 45 (5th Cir 1975); *Marathon Manufacturing Co v Enerlite Products Corp*, 767 F.2d 214 at 217, 218 (5th Cir 1985); *Xtreme Lashes, LLC v Xtended Beauty, Inc*, 576 F.3d 221 at 226, 227 (5th Cir 2009).
- vi *Frisch's Restaurants v Elby's Big Boy*, 670 F.2d 642 at 648 (6th Cir 1982); *Homeowners Group, Inc v Home Marketing Specialists, Inc*, 931 F.2d 1100 at 1106 (6th Cir 1991); *Maker's Mark Distillery, Inc v Diageo North America, Inc*, 679 F.3d 410 at 419 (6th Cir 2012).
- vii *Packman v Chicago Tribune Co*, 267 F.3d 628 at 643 (7th Cir 2001); *Autozone, Inc v Strick*, 543 F.3d 923 at 929 (7th Cir 2008); *Board of Regents v Phoenix International Software*, 653 F.3d 448 at 454 (7th Cir 2011).
- viii *SquirtCo v Seven-Up Co*, 628 F.2d 1086 at 1091 (8th Cir 1980); *Davis v Walt Disney Co*, 430 F.3d 901 at 903 (8th Cir 2005); *B & B Hardware, Inc v Hargis Industries*, 716 F.3d 1020 at 1025 (8th Cir 2013).
- ix *AMF, Inc v Sleekcraft Boats*, 599 F.2d 341 at 348, 349 (9th Cir 1979); *Brookfield Communications v West Coast Entertainment Corp*, 174 F.3d 1036 at 1053, 1054 (9th Cir 1999); *Network Automation, Inc v Advanced Systems Concepts, Inc*, 638 F.3d 1137 at 1145 (9th Cir 2011).
- x *Sally Beauty Co v Beautyco, Inc*, 304 F.3d 964 at 979 (10th Cir 2002); *Australian Gold, Inc v Hatfield*, 436 F.2d 1228 at 1239, 1240 (10th Cir 2006); *Utah Lighthouse Ministry v Foundation for Apologetic Information and Research*, 527 F.3d 1045 at 1055 (10th Cir 2008).
- xi *AnnBrit, Inc v Kraft, Inc*, 812 F.2d 1531 at 1538 (11th Cir 1986); *Dippin' Dots, Inc v Frosty Bites Distribution, LLC*, 369 F.3d 1197 at 1207 (11th Cir 2004); *Tana v Dantanna's*, 611 F.3d 767 at 775 (11th Cir 2010).