

Case Summary: In The Matter Of A Trade Mark Application By A-Star-Education Discovery Camp Pte Ltd And Opposition Thereto By Discovery Communications LLC

Overview

In what might be termed as a veritable “David and Goliath” clash, Gateway Law Corporation had the opportunity to represent A-Star Education Discovery Camps Ltd (“the Applicant”), a small Singapore incorporated company against Discovery Communication LLC (“the opponent”), a corporate giant in the media world. Just as how David manages to overcome his much bigger and stronger adversary, the Applicant was able to defend its trade mark registration from the Opponent’s opposition, showing that even smaller companies can prevail in protecting their intellectual property from larger multinational corporations.

The Parties

The Opponent is one of the world’s largest mass media companies, with over a billion subscribers in over 170 countries and territories, including Singapore.

On the other hand, the Applicant is a small private limited company incorporated in Singapore. It is a growing education company that focuses on educational development, improvement, innovation and growth for its students. “Discovery Camps” is one of the Applicant’s brand that offers a wide range of enrichment camps for kids of all ages in Singapore daily.

Background

The Opponent has registrations of many “DISCOVERY” AND “DISCOVERY” formative trade marks in many classes in Singapore (“Opponent’s Earlier Trade Marks”).

On 26 July, the Applicant¹ applied to register the trade mark “Discover Camps” (“Applicant’s Mark”) in Singapore on 26 July 2017 in Classes 9, 16 and 43; the classes relate mainly to educational resources. The trade mark application was accepted and published on 18 September 2017 for opposition purposes.

¹ Ownership in the mark was transferred from Changededu Holdings Pte. Ltd to Cedu Discovery Camps Pte. Ltd. on 2 November 2017. Cedu Discovery Camps Pte. Ltd. then filed notices to change its name to A-Star-Education Holdings Pte. Ltd. and A-Star-Education Discovery Camps Pte. Ltd. respectively on 22 February 2019 and 13 May 2019.

On 30 November 2004, the Opponent filed a Notice of Opposition to oppose the registration of the Applicant's Mark, relying on the following grounds:

- (a) The Applicant's Mark was similar to the Opponent's Earlier Trade Marks and for identical or similar goods and services;
- (b) The Opponent's Earlier Trade Marks were well known in Singapore and the Applicant's Mark would imply a connection between the Applicant and Opponent and thus would likely damage the interests of the Opponent.
- (c) The Opponent's Earlier Trade Marks were well known to the public at large in Singapore and the Applicant's mark would cause dilution in an unfair manner to the earlier trade mark or take unfair advantage of the distinctive character of the Opponent Earlier Trade Mark.
- (d) By virtue of any rule of law (in particular, the law of passing off).
- (e) Applicant's Mark was registered in bad faith.

Decision

(a) Ground of Opposition 1: The Applicant's Mark was similar to the Opponent's Earlier Trade Marks and for identical or similar goods and services

The Principal Assistant Registrar ("PAR") applied the three-step test established in the Court of Appeal's decision in *Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide* [2014] 1 SLR 911:

- i) The first element is to assess whether there is identity or similarity of the respective marks;
- ii) The second element is to assess whether there is identity or similarity between the goods and services for which registration is sought as against the goods and services for which the earlier trade mark is protected; and
- iii) The third element is to consider whether there exists a likelihood of confusion arising from the two similarities.

With regards to the first element, the PAR found that the Opponent's Earlier Marks and the Applicant's Mark ("the Competing Marks") are visually dissimilar due to the difference in their presentation. Although the Competing Marks are aurally and conceptually more similar than dissimilar, any similarity resides in the word "DISCOVERY", which is of low distinctiveness.

With regards to the second element, the PAR found that there was some similarity between the goods of the Competing Marks in Classes 9 and class 16, and that there was also meaningful and complementary overlap between the Applicant's class 43 services and the Opponent's class 39 services.

However, in relation to the last element, notwithstanding that the Competing Marks are more similar than dissimilar (due to the inclusion in the marks of the word "DISCOVERY", which as noted is of low distinctiveness), and that there were similarities between the goods and services, the similarities did not give rise to a likelihood of confusion. This was because the Opponent's strong reputation *reduced* the likelihood of a consumer associating the goods and services of the Opponent's with that of the Applicant's. Moreover, the PAR also found that consumers will exercise fastidiousness in selecting the types of goods and services covered by the Application Mark, further lowering the likelihood of confusion. As such, the ground of opposition under this section failed.

The Opponent's "Family of Marks" argument whereby members of the public in Singapore have come to associate trade marks containing the "DISCOVERY" word with the Opponent was ultimately rejected due to the lack of evidence.

(b) Ground of Opposition 2: The Opponent's Earlier Trade Marks were well known in Singapore and the Applicant's Mark would imply a connection between the Applicant and Opponent and thus would likely damage the interests of the Opponent.

In order to succeed under this ground of opposition, the Opponent had the burden of establishing the following:

- i) The whole or an essential part of the Application Mark is identical with or similar to the Opponent's earlier mark

- ii) The Opponent's earlier mark is well known in Singapore

- iii) The use of the Application Mark in relation to the goods claimed would indicate a connection between the Applicant's goods/service with the Opponent

- iv) The use of the Application Mark would damage the interests of the Opponent

As established above, the Competing Marks are more similar than dissimilar. Based on the evidence tendered, the PAR found that the Opponent's Earlier Trade Marks are well known in Singapore. However, since the use of the Applicant's Mark in relation to the goods claimed will not indicate a connection between the Applicant's goods/services with that of the Opponent's (i.e. no likelihood of confusion), the PAR concluded that the use of Applicant's mark will not damage the Opponent's interests. The ground of opposition under this section thus also failed

- (c) Ground of Opposition 3: The Opponent's Earlier Trade Marks were well known to the public at large in Singapore and the Applicant's mark would cause dilution in an unfair manner to the earlier trade mark or take unfair advantage of the distinctive character of the Opponent Earlier Trade Mark.**

The PAR held that the status of a mark that is "well known to the public at large in Singapore" is rare and exclusive and its coveted exclusive membership cannot be extended to aspiring members that fall short of showing extensive use and extensive promotion of their marks. Since the Opponent's evidence lacked precision in showing the extent to which the Opponent's Earlier Trade Marks were used, the ground of opposition under this section failed.

- (d) Ground of Opposition 4: By virtue of any rule of law (in particular, the law of passing off).**

In order to succeed under this ground of opposition, the Opponent must establish the classical trinity of goodwill, misrepresentation and damage. While the Opponent has goodwill in Singapore, there was no likelihood of confusion and therefore no misrepresentation. Accordingly, there could be no damage. The ground of opposition under this section therefore failed.

- (e) Ground of Opposition 5: Applicant's Mark was registered in bad faith.**

The onus was on the Opponent to show that the Applicant acted in bad faith. However, the Opponent failed provide sufficient evidence to substantiate this, and as such the ground of opposition under this section failed.

Summary

The PAR found that the opposition failed on all grounds. The Applicant's trade mark registration was allowed to proceed.

Closing remarks

Gateway Law Corporation is proud to have successfully represented the Applicant. Should you have any queries with regards to your intellectual properties or as to how this case may affect you or your organisation, please do not hesitate to reach out to us.



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