



2019 Study Question

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Consumer survey evidence

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I. Current law and practice

Please answer the below questions with regard to your Group's current law and practice.

1.a Is consumer survey evidence in principle admissible in trademark proceedings? Please answer YES or NO.

Yes

Please Explain

1.b Are there specific statutory provisions in your law governing consumer survey evidence?

If YES, what do they state and do they specifically concern trademark matters or do they have a more general nature?

No

Please Explain

If you have answered NO to Q1)a), please skip Q2)-Q5) and proceed to Q6); If you have answered YES to Q1)a), please proceed to Q2).

2.a Is consumer survey evidence admitted in all types of trademark proceedings (see also para. 13 in the full text of the Study Guidelines which can be found at the top of this webpage)?

Yes

Please Explain

2.b If consumer survey evidence is not admitted in all types of trademark proceedings, in which types is it admitted and in which types is it not (e.g. opposition proceedings, revocation, proceedings, infringement proceedings)?

N/A

3.a What can consumer survey evidence prove or help prove (e.g. confusion, acquired distinctiveness; see also para. 14 in the full text of the Study Guidelines which can be found at the top of this webpage)?

Singaporean case-law supports the use of survey evidence to help prove a likelihood of confusion, whether a mark is distinctive, whether the mark is well-known or "well-known to the public at large", the extent of goodwill that attached to a mark, and whether a registered mark has become generic through use.

3.b What is consumer survey evidence most used for in practice to prove or help prove (e.g. confusion, acquired distinctiveness; see also para. 14 in the full text of the Study Guidelines which can be found at the top of this webpage)?

It is most often used to prove the distinctiveness of a mark and the likelihood of confusion that may be caused by a similar mark, and to a slightly lesser extent, whether a mark is "well-known".

4.a Are there specific requirements for surveys, e.g. as to the way of conducting the survey (e.g. internet or email survey, telephone survey, shopping mall interrupt surveys), the number and selection of respondents, the appropriate form and order of survey questions and the use or nature of controls? If so, which?

Yes

Please Explain

Yes. The Trade Marks Work Manual, published by Intellectual Property Office of Singapore, provides the following factors that are considered when examining survey evidence to support the distinctiveness of a mark during registration:

- (a) The survey must disclose the criteria for selecting interviewees, and whether they are actual and/or potential customers;
- (b) The survey must disclose the number of persons approached to participate in the survey;
- (c) The survey should confirm that the number of responses submitted to the Registrar corresponds with the total number of those who had responded to the survey;
- (d) Survey questions should be phrased in an open-ended manner;
- (e) The survey should include a copy of the mark used in the survey, which should also correspond to the mark as-filed;
- (f) The survey should disclose the exact answers from the respondents, and not rephrase or reinterpret them;
- (g) The survey should disclose where it was conducted as well as the exact instructions given to the people who administered the survey;
- (h) The strength of the evidence in support of a mark's distinctiveness must be proportionate to the strength of the objections raised by the Registrar;
- (i) Where the survey evidence discloses that a fair percentage of people associate the applicant's mark with another trade, it may reveal that other traders are also using the same mark, which diminishes the mark's distinctiveness;
- (j) The date of when the survey is administered should be reported, as care will be exercised where the evidence reveals a substantial increase in the mark's use only after the date of application; and
- (k) The survey participants should be the relevant public, defined as average consumers of the particular category of products concerned and

the average consumer is deemed to be "reasonably well informed and reasonably observant and circumspect".

However, case law also provides guidance for survey evidence to be used to determine likelihood of confusion. In particular, in *Ferrero SPA v Sarika Connoisseur Café Pte Ltd* [2011] SGHC 176 and again in *Societe Des Produits Nestle SA v Petra Foods Ltd* [2014] SGHC 252, the Singapore High Court endorsed guidelines on survey evidence in *Imperial Group Ltd v Philip Morris & Co* [1984] RPC 293 as follows:

- (a) the interviewees in the survey must be selected so as to represent a relevant cross-div of the public;
- (b) the size of the survey must be statistically significant;
- (c) the survey must be conducted fairly;
- (d) all the surveys carried out must be disclosed, including the number of surveys carried out, how they were conducted and the totality of the persons involved;
- (e) the totality of the answers given must be disclosed and made available to the other party;
- (f) the questions must neither be leading, nor should they lead the person answering into a field of speculation he would never have embarked upon had the question not been put;
- (g) the exact answers and not some abbreviated form should be recorded; and

the instructions to the interviewers as to how to carry out the survey must be disclosed; and where the answers are coded for computer input, the coding instructions must be disclosed.

4.b If your answer to Q4a) is NO, what characteristics do surveys generally have, e.g. as to the way of conducting the survey, the number and selection of respondents, the appropriate form and order of survey questions and the use or nature of controls?

N/A

5.a Are specific percentages of respondents answering certain questions required or sufficient to prove certain items? If so, which?

No

Please Explain

5.b What percentages of respondents answering certain questions are typically deemed insufficient?

This falls within the contemplation of (a) and (b) of the Survey Guidelines. There has been some guidance as to what constitutes the "relevant cross-div of the public": for example, in considering whether there was confusion between a Nestle Kit-Kat wafer and another chocolate-covered wafer, the High Court held in *Societe Des Produits Nestle SA v Petra Foods Ltd* [2014] SGHC 252 that the products were sold to the general public, and not only to "a person who likes chocolate so much that he *eats it on a weekly basis.*"

Therefore, the sufficient or appropriate composition of respondents would depend on the facts of the case. Case-law includes such considerations as familiarity with a particular product, whether that product is (by virtue of niche utility or its price-point) for the general public or a select group, the presumed linguistic familiarity of the relevant cross-div of the public, and so on.

As regards the point on language, it should be remembered that Singapore is a highly diverse society, and so depending on the target audience for a product and the mark in question, it may be useful or necessary for surveys to take into account Singapore's demographics (as pertains to race/ethnicity, religion, and language proficiency, as well as age, nationality, and other relevant factors) in their framing.

6 Is the court or IP office involved in the set-up of the survey, or can it be, and, if so, to what extent?

No

Please Explain

The Court and the Intellectual Property Office of Singapore ("IPOS") do not involve themselves in the set-up of surveys.

7 What weight or value is generally given by the court or IP office to consumer survey evidence, if such is admitted, and which factors are relevant in considering the extent of such weight or value?

The weight given to survey evidence generally varies depending on how well the survey comports with the criteria mentioned in 4(b), above. IPOS and the court have repeatedly stressed that survey evidence, while useful, is not *necessary* for trademark proceedings. Ultimately, the main factor that determines the weight of survey evidence appears to be the relevance and probative value of what the evidence discloses.

As stated by the IP Adjudicator in the case of *Courts (Singapore) Pte Ltd v Big Box Corporation Pte Ltd* [2017] SGIPOS 5, the survey evidence must go to the factual questions in support of which it is intended to be adduced.

II. Policy considerations and proposals for improvements of your Group's current law

8 Could any of the following aspects of your Group's current law or practice relating to consumer survey evidence be improved? If YES, please explain.

8.a Types of trademark proceedings in which survey evidence is admissible;

No

Please Explain

8.b What survey evidence can prove or help prove;

No

Please Explain

No, because survey evidence is generally admissible to establish a wide range of propositions.

8.c Requirements of surveys;

No

Please Explain

No. Guidance for how survey evidence should be used, and how surveys should be structured, is abundantly provided in the case-law and in the various guides and articles published by IPOS.

8.d The application, or lack thereof, of bench-mark percentages;

No

Please Explain

8.e The weight or value given to consumer survey evidence.

No

Please Explain

9 Are there any other policy considerations and/or proposals for improvement to your Group's current law falling within the scope of this Study Question?

Yes

Please Explain

In general survey evidence is often criticized by the courts and care must be taken to comply closely with the guidelines.

It would be helpful to have more specific guidelines for use than general principles.

III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

10 Do you believe that there should be harmonisation in relation to consumer survey evidence?

Yes

Please Explain

To the extent that harmonisation involves establishing common principles for the preparation and administration of a survey, yes. We are also in favour of harmonisation of the types of proceedings and issues that admit survey evidence.

However, there should not be harmonisation in the sense of a common binding standard regarding the weight and value to be attributed to such evidence, as each jurisdiction has a different consumer base.

If YES, please respond to the following questions without regard to your Group's current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group's current law or practice could be improved.

11 Should consumer survey evidence in principle be admissible in trademark proceedings? Please answer YES or NO.

Yes

Please Explain

2.a Should consumer survey evidence be admitted in all types of trademark proceedings (see also para. 13 in the full text of the Study Guidelines which can be found at the top of this webpage)?

Yes

Please Explain

2.b If consumer survey evidence should not be admitted in all types of trademark proceedings, in which types should it be admitted and in which types should it not be admitted (e.g. opposition proceedings, revocation, proceedings, infringement proceedings)?

N/A

13 What should consumer survey evidence be allowed to prove or help prove (e.g. confusion, acquired distinctiveness; see also para. 14 in the full text of the Study Guidelines which can be found at the top of this webpage)?

Survey evidence should be, and is, allowed to prove the various facts mentioned at 3(a). We note however that these categories are not closed.

14 Should there be specific requirements for surveys, e.g. as to the way of conducting the survey (e.g. internet or email survey, telephone survey, shopping mall interrupt surveys), the number and selection of respondents, the appropriate form and order of survey questions and the use or nature of controls? If so, which?

Yes

Please Explain

Yes, although it may be more helpful to have guidelines rather than strict requirements. Guidance as to appropriate sample sizes, for example, may assist businesses in structuring surveys.

5.a Should specific percentages of respondents answering certain questions be required or deemed sufficient to prove certain items? If so, which?

No

Please Explain

No. Such considerations, if any, are fact- and context-sensitive.

5.b What percentages of respondents answering certain questions should be deemed insufficient?

N/A

16 Should the court or IP office be involved in the set-up of the survey and, if so, to what extent?

No

Please Explain

No. The involvement of the court or IPOS should be limited to setting out guidelines (which has already been done) as to what principles should be observed when a party prepares and executes a survey. The court and IPOS should not be involved in assisting any party to prepare or execute any survey as this is not part of their function, and is inconsistent with their duty of impartiality.

17 What weight or value should be given by the court or IP office to consumer survey evidence, if such is admitted, and which factors should be relevant in considering the extent of such weight or value?

See 7.

18 Please comment on any additional issues concerning any aspect of consumer survey evidence you consider relevant to this Study Question.

Considering Singapore's diversity, the question of language and translation as pertains to trademarks is becoming increasingly relevant. Especially where the mark in question is disputed due to some linguistic element (for example, a word mark that is a Hanyu Pinyin transliteration of certain Chinese characters), ascertaining the fluency of a respondent in the relevant language(s) may be useful or necessary.

19 Please indicate which industry sector views provided by in-house counsel are included in your Group's answers to Part III.

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