

IPOS Decisions 2021: Year-in-Review




Selected Issues, Holdings and Comments of Interest

Please note:

- (1) Full Grounds of Decision and case summaries (where available) are accessible at: <https://www.ipos.gov.sg/manage-ip/resolve-ip-disputes/legal-decisions>
- (2) We have a mailing list where we provide updates on recent IPOS decisions. To join, please contact ipos_hmd@ipos.gov.sg.

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IPOS CASES IN 2021

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| <p><i>Application for Extension of Time to File Evidence in a Trade Mark Opposition by BEABA and Objection Thereto by Biba (Zhejiang) Nursing Products Co., Ltd</i> [2021] SGIPOS 1</p> | <p>This application arose in the context of trade mark opposition proceedings. The opponent did not file its evidence in time, and only filed a (late) request for extension of time 8 working days after the expiration of the deadline citing (among other things) delays and difficulties relating to Covid-19. Following an interlocutory hearing, IPOS allowed the extension of time request with costs.</p> | |
| <p><i>Xiaomi Inc. v MiChat Pte Ltd</i> [2021] SGIPOS 2</p> | <p>IPOS allowed an opposition brought by Xiaomi (which relied on its earlier trade marks "mitalk" and the stylised "MI" mark: ) against MiChat's application to register "MiChat" in Classes 9 and 42. However, the opposition did not succeed in respect of the application to register in classes 38 and 45. The case summary is located here.</p> <p>MiChat filed an appeal to the General Division of the High Court against IPOS' decision in respect of Classes 9 and 42. The appeal was successful, but no written grounds of decision are available.</p> | |
| <p><i>B.R. v Elements Cosmeceuticals Pte. Ltd.</i> [2021] SGIPOS 3</p> | <p>IPOS allowed an opposition brought by B.R. (which relied on its earlier stylised "BIOLOGIQUE RECHERCHE" trade mark ) against Elements Cosmeceutical's application to register the lightly stylised word mark "Recherche" (). The earlier mark was registered in Class 3 in respect of cosmetics / skincare products whereas the later application was sought to be registered in Class 3 (in respect of cosmetics / skincare products) as well as in Class 44 (for beauty services).</p> <p>It was undisputed that "Biologique" and "Recherche" would roughly translate from French into English as "biological" and "research" respectively. Interestingly, the evidence disclosed that</p> | <p>[3], [25]-[28]</p> |


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| | <p>"Recherche" could be found in English dictionaries (as a loanword originating from French). Notwithstanding this, it was found that "Recherche" is an obscure word that average consumers in Singapore would not be familiar with. Moreover, the relevant public would not be presumed to know French. Consequently, "Recherche" would be regarded as a meaningless word. As for "Biologique", although it cannot be regarded as descriptive, the fact that it shares similarities with "biological" or "biology" in English means that it would be inherently less distinctive than "Recherche".</p> <p>These considerations were taken into account in arriving at the conclusion that the marks are visually and aurally similar to a slight degree, and conceptually neutral (since their respective meanings would not be understood by the public in Singapore). As regards the similarity of goods/services, the Class 3 goods on both sides were found to be identical insofar as they relate to cosmetics/skincare. The applicant's Class 44 services (beauty services) were found to be similar to a moderate extent to the opponent's Class 3 goods (cosmetics and skincare). Ultimately, a likelihood of confusion was found.</p> | |
| <p><i>Australian Grape and Wine Incorporated v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco</i> [2021] SGIPOS 4</p> | <p>This was the Registrar's (brief) grounds of decision. The full decision can be found at [2021] SGIPOS 9.</p> | |
| <p><i>Application for Extension of Time to File Evidence in a Trade Mark Revocation by Symphony Holdings Limited and Objection Thereto by Skins IP Limited</i> [2021] SGIPOS 5</p> | <p>This application arose in the context of trade mark revocation proceedings. The registered proprietor of the impugned trade mark did not file its evidence in time, and only filed a (late) request for extension of time 4 working days after the expiration of the deadline citing (among other things) delays and difficulties relating to Covid-19. Following an interlocutory hearing, IPOS allowed the extension of time request, with parties bearing their own costs.</p> | |

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| <i>GCIH Trademarks Limited v Hardwood Private Limited</i> [2021] SGIPOS 6 | <p>This trade mark opposition was commenced by the owner of the “TANGO” trade mark, registered in Class 30 for chocolate and cocoa products, against a competitor’s application to register “OT TANGO” in Class 30 for chocolate and cocoa products. The opposition was successful.</p> <p>The decision contains a detailed discussion on the complex issue of the role of distinctiveness at the marks-similarity stage.</p> | [103]-[112] |
| <i>Warrior Pte Ltd v Nippon Paint (Singapore) Co. Pte. Ltd.</i> [2021] SGIPOS 7 | <p>This was an unsuccessful trade mark opposition against Nippon Paint (Singapore)’s application to register “NW1” in Class 1 in respect of adhesives and chemical additives/preparations. The opponent, Warrior, relied on the following earlier “W-1” marks</p> <p>(both registered in Class 1 for adhesives and other related goods: ; ). The marks were found more dissimilar than similar.</p> <p>An appeal was filed to the General Division of the High Court. However, the appeal was unsuccessful. No written grounds of decision are available.</p> | |
| <i>Baidu Europe B.V. v Baidu Online Network Technology (Beijing) Co., Ltd.</i> [2021] SGIPOS 8 | <p>This was a trade mark revocation commenced by Baidu Europe B.V., (incorporated in the Netherlands) against Baidu Online Network Technology (a subsidiary of Baidu Inc. in China)’s</p> <p> registration for the stylised Baidu mark:  in Classes 38 and 42. After consideration, IPOS made an order for revocation in Class 38 but not in 42.</p> | |
| <i>Australian Grape and Wine Incorporated v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco</i> [2021] SGIPOS 9 | <p>This was the first case to proceed to a full opposition hearing under the Geographical Indications Act 2014 (which came into force on 1 April 2019). One of the key issues was whether “Prosecco” is the name of a grape variety or a geographical indication (or both). The opponent, the Australian Grape and Wine Incorporated, a representative body for grape growers and winemakers in Australia argued that “Prosecco” is a name of a grape variety and should not be registered as a GI. The applicant, Consorzio di Tutela della Denominazione di</p> | |



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| | <p>Origine Controllata Prosecco, disputed that “Prosecco” is the name of a grape variety and argued that even if it is, the term can nevertheless be registered as a GI. The hearing officer found that while “Prosecco” is indeed the name of a grape variety, under Singapore law, it does not follow that “Prosecco” cannot also be a GI; that would only be the case if “Prosecco” is also likely to mislead consumers as to the true origin of the products bearing “Prosecco”. After considering the evidence, the hearing officer found that the opponent had not established that consumers would likely be so misled, and consequently dismissed the opposition.</p> <p>An appeal was filed to the General Division of the High Court. The court reversed IPOS’ decision on Section 41(1)(f) of the Geographical Indications Act 2014. An application for leave to appeal to the Appellate Division of the High Court was allowed shortly before this document was published.</p> | |
| <p><i>Combe International Ltd. v Dr. August Wolff GmbH & Co. KG Arzneimittel</i> [2021] SGIPOS 10</p> | <p>This trade mark opposition dispute involved the application mark “Dr. Wolff’s Vagisan” (), sought to be registered in Classes 3 and 5. The opponent, Combe International, relied on its earlier registered marks which comprise “VAGISIL”. The opposition failed on all grounds.</p> <p>The IPOS case summary is available here.</p> <p>The IP Adjudicator also commented on the vexed issue of the role of acquired distinctiveness in the marks similarity assessment: a brief summary is located in the final paragraph of the IPOS case summary (linked earlier). In so doing, the IP Adjudicator took a different view from the approach expressed in <i>GCIH</i> ([2021] SGIPOS 6). (Note: on the other hand, see [2021] SGIPOS 13 below.)</p> <p>An appeal was filed to the General Division of the High Court. It remains pending.</p> | <p>[26]-[30]</p> |




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| <p><i>Technopharma Limited v Unilever PLC</i> [2021] SGIPOS 11</p> | <p>This case was about whether three registered “FAIR & LOVELY” trade marks belonging to Unilever plc should be revoked for non-use. On the facts, none of the marks were put to use in the exact forms in which they were registered.</p> <p>The decision addresses various issues surrounding the legal requirements for “genuine use” of a registered trade mark, which the proprietor bears the burden of proving in order to resist the non-use revocation application. In the result, an order was made to revoke all three marks for non-use. The IPOS case summary is available here.</p> | |
| <p><i>Shenzhen Meixixi Catering Management Co., Ltd. v Heetea Pte. Ltd.</i> [2021] SGIPOS 12</p> | <p>This was a trade mark invalidation action against the mark “HEYTEA”, registered in Class 30 for tea and tea-based beverages. The applicant for invalidity had an earlier identical mark, “HEYTEA”, registered in Class 43 for cafés and related services. The hearing officer found the marks to be identical, the goods/services to be similar, and that there would be a likelihood of confusion. There was also unrebutted evidence that the registered proprietor had registered the mark in bad faith. The invalidation was allowed on grounds of s 7(6) as well as s 8(2) of the Trade Marks Act.</p> | |
| <p><i>Louis Vuitton Malletier v Human Horizons Holding (Shanghai) Co., Ltd.</i> [2021] SGIPOS 13</p> | <p>Louis Vuitton (“LV”) was successful in its trade mark opposition to Human Horizons’ application to register “HUMAN HORIZONS” in Classes 18 (for goods such as backpacks, luggage tags and leather products) and 25 (for clothing and related items). LV relied on its earlier registered mark “HORIZON” in Class 18, registered for “luggage” and various leather products. For the IPOS case summary, please click here.</p> <p>The IP Adjudicator expressed the view that it would be inappropriate to consider acquired distinctiveness at the marks similarity stage, for such a consideration would be inconsistent with the Court of Appeal’s decision in <i>Staywell</i>. (In essence, this view differed from <i>Combe</i> [2021] SGIPOS 10 while endorsing the approach in <i>GCIH</i> [2021] SGIPOS 6.)</p> | <p>[22]-[32]</p> |

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| <p><i>Monster Energy Company v Health and Happiness (H&H) Hong Kong Limited</i> [2021] SGIPOS 14</p> | <p>Monster Energy Company (“MEC”) was unsuccessful in opposing a trade mark application for</p>  <p>“NOISY BEAST” (and device) () in Class 35 in respect of various services including “Sales promotion for others; Provision of an on-line marketplace for buyers and sellers of goods and services; Advertising” and “marketing” on the basis of confusing similarity under s 8(2)(b) of the Trade Marks Act. MEC relied on its earlier registered marks “UNLEASH THE BEAST!” registered in Classes 5 (for nutritional supplements) and 32 (for non-alcoholic beverages) and “REHAB THE BEAST!” registered in Classes 5 (for nutritional supplements), 30 (for coffee, tea, and the like) and 32 (non-alcoholic beverages). The hearing officer found that the goods under the MEC’s earlier marks are wholly dissimilar to the services for which registration was sought under the application mark and refused the opposition on that basis.</p> | |
| <p><i>Weider Global Nutrition, LLC v Morinaga & Co., Ltd</i> [2021] SGIPOS 15</p> | <p>Weider Global Nutrition succeeded in its application to invalidate Morinaga’s trade mark “in”,</p>  <p>registered as “ ” in Class 5 (in series) for dietary/nutritional supplements. Weider Global Nutrition relied on, among other things, its word mark “IN”, registered in Class 32 for “non-alcoholic protein and/or carbohydrate energy drinks”. It was undisputed that the marks were similar, but Morinaga contended that the goods were dissimilar. The hearing officer found that the goods were “in competition with each other” and were similar to a degree that is “above average”. She also found that there would be a likelihood of confusion.</p> | |
| <p><i>S. C. Johnson & Son, Inc. v Off-White LLC</i> [2021] SGIPOS 16</p> | <p>S.C. Johnson & Son, Inc (“Applicant”) applied for a declaration of invalidity against Off-White LLC’s registration for the following series of stylised “OFF” marks in Class 3:</p> | |

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| |  <p>which were registered for, among other things, “lotions for skin care; non-medicated skin care preparations; non-medicated toiletry preparations”. The Applicant relied primarily on its two stylised “OFF!” marks ( and ), both registered in Class 5 for, among other things, fungicides, rodenticides, insecticides and insect repellent. The IP Adjudicator found that average consumers would find the respective marks to be markedly different, and that the relevant goods are dissimilar. The action for invalidation failed.</p> <p>In the introductory paragraphs of the decision, the IP Adjudicator emphasised the importance of viewing the registration of a composite mark in its entirety (even though one component may be more distinctive than others); otherwise, the registration of a composite mark can lead to unfairness through an illegitimate broadening of the scope of protection given by registration.</p> | [1]-[6] |

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